

ESTTA Tracking number: **ESTTA484577**

Filing date: **07/20/2012**

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	PANDA SECURITY, S.L.
Granted to Date of previous extension	08/08/2012
Address	Gran Vía-a de Don Diego López de Haro, 4 Bilbao (Vizcaya), E-48001 SPAIN

Attorney information	Francis J. Duffin Wiggin and Dana LLP One Century Tower, P.O. Box 1832 New Haven, CT 06508-1832 UNITED STATES fduffin@wiggin.com, trademarkdocketing@wiggin.com Phone:203-498-4347
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Applicant Information

Application No	85457591	Publication date	04/10/2012
Opposition Filing Date	07/20/2012	Opposition Period Ends	08/08/2012
Applicant	Data Panda LLC 1L 14 Relay Place Stamford, CT 06901 UNITED STATES		

Goods/Services Affected by Opposition

Class 042. First Use: 2008/11/01 First Use In Commerce: 2008/11/01
All goods and services in the class are opposed, namely: IT consulting services

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.	2921210	Application Date	11/26/2002
Registration Date	01/25/2005	Foreign Priority Date	NONE
Word Mark	PANDA		

Design Mark	PANDA
Description of Mark	NONE
Goods/Services	Class 009. First use: First Use: 1990/00/00 First Use In Commerce: 1990/00/00 anti-virus computer software

U.S. Registration No.	3922206	Application Date	11/11/2009
Registration Date	02/22/2011	Foreign Priority Date	05/12/2009
Word Mark	PANDA SECURITY		
Design Mark	PANDA SECURITY		
Description of Mark	NONE		
Goods/Services	<p>Class 009. First use: Antivirus computer programmes; antivirus computer software and computer hardware; anti-malware computer programmes; anti-malware computer software and computer hardware; computer security programmes; computer security software and hardware; computer threat prevention computer programmes; computer threat prevention software and hardware</p> <p>Class 042. First use: Computer systems analysis for the installation of computer systems in connection with computer security, computer threat prevention, antivirus and anti-malware programmes; computer systems analysis in connection with computer security, computer threat prevention, antivirus and anti-malware programmes; * design of computer networks for third parties in connection with computer security, computer threat prevention, antivirus and/or anti-malware programmes; * design and development of computer systems in connection with computer security, computer threat prevention, antivirus and anti-malware programmes; design and development of computer hardware and software, * for third parties * in connection with computer security, computer threat prevention, antivirus and anti-malware programmes; computer consulting in connection with computer security, computer threat prevention, antivirus and anti-malware programmes; rental of computers in connection with computer security, computer threat prevention, antivirus and anti-malware programmes; computer programming * for third parties * in connection with computer security, computer threat prevention, antivirus and anti-malware programmes; development of computer software in connection with computer security, computer threat prevention, antivirus and anti-malware programmes; installation of computer software in connection with computer security, computer threat prevention, antivirus and anti-malware programmes; rental of computer software in connection with computer security, computer threat prevention, antivirus and anti-malware programmes; maintenance of computer software in connection with computer security, computer threat prevention, antivirus and anti-malware</p>		

	<p>programmes; updating of computer software * for third parties * in connection with computer security, computer threat prevention, antivirus and anti-malware programmes; duplication of computer programmes in connection with computer security, computer threat prevention, antivirus and anti-malware programmes; conversion of data or documents from physical to electronic media in connection with computer security, computer threat prevention, antivirus and anti-malware programmes; data conversion of computer programmes and data in connection with computer security, computer threat prevention, antivirus and anti-malware programmes; database reconstruction in connection with computer security, computer threat prevention, antivirus and anti-malware programmes for others; web site creation and maintenance for third parties in connection with computer security, computer threat prevention, antivirus and anti-malware programmes; server hosting of web sites in connection with computer security, computer threat prevention, antivirus and anti-malware programmes; technical * consulting, namely, * project studies in the nature of feasibility studies in the fields of computer security, computer threat prevention, antivirus and anti-malware programmes; application service provider (ASP) featuring software for use in data protection in connection with computer security, computer threat prevention, antivirus and anti-malware programmes; maintenance of software in computer systems in connection with computer security, computer threat prevention, antivirus and anti-malware programmes</p> <p>Class 045. First use:</p> <p>Licensing of computer software licenses in connection with computer security, computer threat prevention, antivirus and anti-malware programmes</p>
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Attachments	<p>76473182#TMSN.gif (1 page)(bytes) 79079862#TMSN.jpeg (1 page)(bytes) DATA PANDA Notice of Opposition.pdf (14 pages)(411380 bytes)</p>
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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	/fjd/
Name	Francis J. Duffin
Date	07/20/2012

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

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PANDA SECURITY, S.L.	:	
	:	
Opposer,	:	
	:	
v.	:	Opposition No.
	:	
DATA PANDA LLC	:	
	:	
Applicant.	:	
-----X		

NOTICE OF OPPOSITION

In the matter of the trademark application of Data Panda LLC, for registration of the designation "DATA PANDA" for "IT consulting services" in International Class 42, Application Serial No. 85/457591, filed October 27, 2011 in the name of Data Panda LLC, and published in the *Official Gazette* of April 10, 2012, Opposer, Panda Security, S.L., a Spanish Sociedad Limitada, with a place of business at Gran Via de Don Diego Lopez de Haro 4, Bilbao (Vizcaya), Spain 48001, believes it will be damaged by the registration of the mark shown in the above application in Class 042, and hereby opposes same.

The grounds for the opposition are:

1. Opposer is engaged in commerce that may be lawfully regulated by Congress in the business of concept creation, development, manufacture and sale of technologies, products and services for keeping information technology resources free from viruses and computer threats, and consulting and technical support services related thereto (the "Panda Goods and Services"). Opposer offers the Panda Goods and Services under a number of marks, including the **PANDA** mark, which is also its housemark, and the mark **PANDA SECURITY**.

2. Since at least as early as 1997, Opposer has been using the **PANDA** mark in commerce in connection with the Panda Goods and Services.

3. Opposer is the owner, by assignment from World Wide Fund for Nature, of federal registration number 2921210 for the **PANDA** mark, which has been registered in the United States Patent and Trademark Office since January 25, 2005, in respect of "Anti-virus computer software," in Class 9. The said registration is valid and in force. Attached as Exhibit A is a copy of said registration, and the Patent and Trademark Office assignment abstract record.

4. Opposer is the owner of federal registration number 3922602 for the **PANDA SECURITY** mark, which has been registered in the United States Patent and Trademark Office since February 22, 2011, in respect of "Antivirus computer programmes; antivirus computer software and computer hardware; anti-malware computer programmes; anti-malware computer software and computer hardware; computer security programmes; computer security software and hardware; computer threat prevention computer programmes; computer threat prevention software and hardware" in Class 9; "Computer systems analysis for the installation of computer systems in connection with computer security, computer threat prevention, antivirus and anti-malware programmes; computer systems analysis in connection with computer security, computer threat prevention, antivirus and anti-malware programmes; design and development of

computer systems in connection with computer security, computer threat prevention, antivirus and anti-malware programmes; design and development of computer hardware and software in connection with computer security, computer threat prevention, antivirus and anti-malware programmes; computer consulting in connection with computer security, computer threat prevention, antivirus and anti-malware programmes; rental of computers in connection with computer security, computer threat prevention, antivirus and anti-malware programmes; computer programming in connection with computer security, computer threat prevention, antivirus and anti-malware programmes; development of computer software in connection with computer security, computer threat prevention, antivirus and anti-malware programmes; installation of computer software in connection with computer security, computer threat prevention, antivirus and anti-malware programmes; rental of computer software in connection with computer security, computer threat prevention, antivirus and anti-malware programmes; maintenance of computer software in connection with computer security, computer threat prevention, antivirus and anti-malware programmes; updating of computer software in connection with computer security, computer threat prevention, antivirus and anti-malware programmes; duplication of computer programmes in connection with computer security, computer threat prevention, antivirus and anti-malware programmes; conversion of data or documents from physical to electronic media in connection with computer security, computer threat prevention, antivirus and anti-malware programmes; data conversion of computer programmes and data in connection with computer security, computer threat prevention, antivirus and anti-malware programmes; database reconstruction in connection with computer security, computer threat prevention, antivirus and anti-malware programmes for others; web site creation and maintenance for third parties in connection with computer security, computer threat prevention, antivirus and anti-malware programmes; server hosting of web sites in connection

with computer security, computer threat prevention, antivirus and anti-malware programmes; technical project studies in the nature of feasibility studies in the fields of computer security, computer threat prevention, antivirus and anti-malware programmes; application service provider (ASP) featuring software for use in data protection in connection with computer security, computer threat prevention, antivirus and anti-malware programmes; maintenance of software in computer systems in connection with computer security, computer threat prevention, antivirus and anti-malware programmes” in Class 42; and “Licensing of computer software licenses in connection with computer security, computer threat prevention, antivirus and anti-malware programmes” in Class 45. The said registration is valid and in force. Attached as Exhibit B is a copy of said registration.

5. There is no issue as to priority. Opposer has used the **PANDA** mark in connection with the offering of the Panda Goods and Services in commerce since at least as early as 1990. Opposer has used the **PANDA SECURITY** mark in connection with the offering of the Panda Goods and Services in commerce since as early as 2007. Opposer’s date of first use of both the **PANDA** and **PANDA SECURITY** marks precedes Applicant's November 1, 2008 purported date of first use.

6. Opposer has spent considerable sums of money advertising and promoting the Panda Goods and Services being offered under the **PANDA** and **PANDA SECURITY** marks.

7. As a result of the long and extensive use, advertisement and promotion of the **PANDA** and **PANDA SECURITY** marks in connection with the offering of the Panda Goods and Services in commerce, the **PANDA** and **PANDA SECURITY** marks have become closely associated with Opposer, have acquired great value and good will, and identify Opposer and Opposer's goods and services exclusively.

8. Applicant seeks to register the confusingly similar designation “**DATA PANDA**”

for closely related, if not identical, services. Indeed, on information and belief, Applicant's IT consulting services include consulting in the field of computer security, computer threat prevention, and anti-virus and antimalware programs.

9. In view of the fact that the Opposer's **PANDA** mark is literally identical to the dominant portion of the "DATA PANDA" designation for which Applicant seeks registration, together with the fact that both parties provide closely-related, if not identical, goods and services, Applicant's designation so resembles Opposer's mark as to be likely to cause confusion or to cause mistake or to deceive within the meaning of Section 2(d) of the Lanham Act, 15 U.S.C.1052(d).

10. In view of the fact that the dominant part of Opposer's **PANDA SECURITY** mark, **PANDA**, is literally identical to the dominant portion of the "DATA PANDA" designation for which Applicant seeks registration, together with the fact that both parties provide closely-related, if not identical, goods and services, Applicant's designation so resembles Opposer's mark as to be likely to cause confusion or to cause mistake or to deceive within the meaning of Section 2(d) of the Lanham Act, 15 U.S.C.1052(d).

11. Opposer believes and alleges that Applicant's "DATA PANDA" designation, when used in connection with the goods and services set forth in the application is likely to cause confusion, or mistake or to deceive and will deceive and mislead the purchasing public into believing that Applicant is licensed or controlled by Opposer when it is not, that Applicant is a subsidiary of or in some way associated or affiliated with Opposer when it is not, or that Opposer is the source or sponsor of the services provided by Applicant when it is not.

12. Applicant's registration and use of its "DATA PANDA" designation will enable Applicant to trade upon and utilize the good will established by Opposer in its **PANDA** and **PANDA SECURITY** marks.

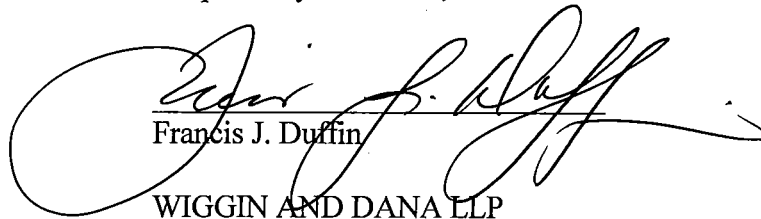
13. By reason of the foregoing, Opposer believes and submits that it will be irreparably

damaged by the registration of Applicant's mark.

WHEREFORE, Opposer believes it will be damaged by the registration of the claimed trademark in Application Serial No. 85/457591 in Class 042 and prays that such registration be denied. Opposer appoints as its attorneys, Francis J. Duffin, Joseph Saphia, Laura A. Chubb, Erika Selli, and all duly-admitted attorneys with the firm of Wiggin and Dana LLP.

Dated: July 20, 2012

Respectfully submitted,

A large, stylized handwritten signature in black ink, appearing to read "Francis J. Duffin". The signature is written over a horizontal line that serves as a separator between the signature and the printed name below it.

Francis J. Duffin

WIGGIN AND DANA LLP
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(203) 498-4400

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New York, New York 10017-1700
(212) 490-1700

Attorneys for Opposer
Panda Security, S.L.

CERTIFICATE OF SERVICE

It is hereby certified that this Notice of Opposition was served by mailing a copy to:
Mr. Christopher Scalzi, DATA PANDA LLC, 1L, 14 Relay Place, Stamford, Connecticut 06901,
by First Class Mail, postage prepaid, on July 20, 2012.

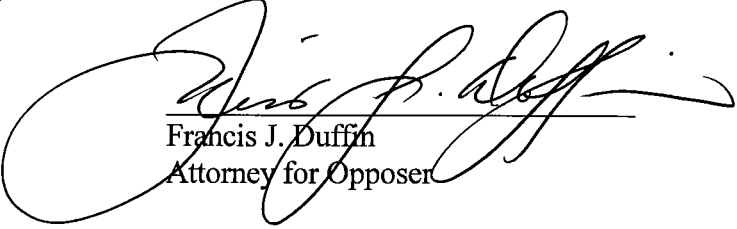

Francis J. Duffin
Attorney for Opposer

EXHIBIT A

Int. Cl.: 9

Prior U.S. Cls.: 21, 23, 26, 36, and 38

United States Patent and Trademark Office

Reg. No. 2,921,210

Registered Jan. 25, 2005

**TRADEMARK
PRINCIPAL REGISTER**

PANDA

WWF-WORLDWIDE FUND FOR NATURE (FORMERLY WORLD WILDLIFE FUND) (SWITZERLAND NON-PROFIT FOUNDATION)
AVENUE DU MONT-BLANC
1196 GLAND, SWITZERLAND

FIRST USE 0-0-1990; IN COMMERCE 0-0-1990.

SN 76-473,182, FILED 11-26-2002.

FOR: ANTI-VIRUS COMPUTER SOFTWARE, IN CLASS 9 (U.S. CLS. 21, 23, 26, 36 AND 38).

CAROLYN CATALDO, EXAMINING ATTORNEY

Side - 1



**NOTICE OF ACCEPTANCE OF §8
DECLARATION
MAILING DATE: Jan 29, 2011**

The declaration filed in connection with the registration identified below meets the requirements of Section 8 of the Trademark Act, 15 U.S.C. §1058. The declaration is accepted and the registration remains in force.

For further information about this notice, visit our website at: <http://www.uspto.gov>. To review information regarding the referenced registration, go to <http://tarr.uspto.gov>.

REG NUMBER: 2921210
MARK: PANDA
OWNER: PANDA SECURITY, S.L.

Side - 2

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Francis J. Duffin
WIGGIN AND DANA LLP
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P.O. BOX 1832
NEW HAVEN, CT 06508-1832



United States Patent and Trademark Office

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BILBAO (VIZCAYA), SPAIN 48001**Correspondent:** FRANCIS J. DUFFIN, WIGGIN AND DANA LLPONE CENTURY TOWER, P.O. BOX 1832
NEW HAVEN, CT 06508-1832**Domestic rep:** FRANCIS J. DUFFIN265 CHURCH STREET, ONE CENTURY TOWER
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EXHIBIT B

United States of America

United States Patent and Trademark Office

PANDA SECURITY

Reg. No. 3,922,206

Registered Feb. 22, 2011

Int. Cls.: 9, 42 and 45

TRADEMARK

SERVICE MARK

PRINCIPAL REGISTER

PANDA SECURITY, S.L. (SPAIN SOCIEDAD LIMITADA)
GRAN VÍA DE DON DIEGO LÓPEZ DE HARO, 4
E-48001 BLBAO (VIZCAYA)
SPAIN

FOR: ANTIVIRUS COMPUTER PROGRAMMES; ANTIVIRUS COMPUTER SOFTWARE AND COMPUTER HARDWARE; ANTI-MALWARE COMPUTER PROGRAMMES; ANTI-MALWARE COMPUTER SOFTWARE AND COMPUTER HARDWARE; COMPUTER SECURITY PROGRAMMES; COMPUTER SECURITY SOFTWARE AND HARDWARE; COMPUTER THREAT PREVENTION COMPUTER PROGRAMMES; COMPUTER THREAT PREVENTION SOFTWARE AND HARDWARE, IN CLASS 9 (U.S. CLS. 21, 23, 26, 36 AND 38).

FOR: COMPUTER SYSTEMS ANALYSIS FOR THE INSTALLATION OF COMPUTER SYSTEMS IN CONNECTION WITH COMPUTER SECURITY, COMPUTER THREAT PREVENTION, ANTIVIRUS AND ANTI-MALWARE PROGRAMMES; COMPUTER SYSTEMS ANALYSIS IN CONNECTION WITH COMPUTER SECURITY, COMPUTER THREAT PREVENTION, ANTIVIRUS AND ANTI-MALWARE PROGRAMMES; DESIGN AND DEVELOPMENT OF COMPUTER SYSTEMS IN CONNECTION WITH COMPUTER SECURITY, COMPUTER THREAT PREVENTION, ANTIVIRUS AND ANTI-MALWARE PROGRAMMES; DESIGN AND DEVELOPMENT OF COMPUTER HARDWARE AND SOFTWARE IN CONNECTION WITH COMPUTER SECURITY, COMPUTER THREAT PREVENTION, ANTIVIRUS AND ANTI-MALWARE PROGRAMMES; COMPUTER CONSULTING IN CONNECTION WITH COMPUTER SECURITY, COMPUTER THREAT PREVENTION, ANTIVIRUS AND ANTI-MALWARE PROGRAMMES; RENTAL OF COMPUTERS IN CONNECTION WITH COMPUTER SECURITY, COMPUTER THREAT PREVENTION, ANTIVIRUS AND ANTI-MALWARE PROGRAMMES; COMPUTER PROGRAMMING IN CONNECTION WITH COMPUTER SECURITY, COMPUTER THREAT PREVENTION, ANTIVIRUS AND ANTI-MALWARE PROGRAMMES; DEVELOPMENT OF COMPUTER SOFTWARE IN CONNECTION WITH COMPUTER SECURITY, COMPUTER THREAT PREVENTION, ANTIVIRUS AND ANTI-MALWARE PROGRAMMES; INSTALLATION OF COMPUTER SOFTWARE IN CONNECTION WITH COMPUTER SECURITY, COMPUTER THREAT PREVENTION, ANTIVIRUS AND ANTI-MALWARE PROGRAMMES; RENTAL OF COMPUTER SOFTWARE IN CONNECTION WITH COMPUTER SECURITY, COMPUTER THREAT PREVENTION, ANTIVIRUS AND ANTI-MALWARE PROGRAMMES; MAINTENANCE OF COMPUTER SOFTWARE IN CONNECTION WITH COMPUTER SECURITY, COMPUTER THREAT PREVENTION, ANTIVIRUS AND ANTI-MALWARE PROGRAMMES; UPDATING OF COMPUTER SOFTWARE IN CONNECTION WITH COMPUTER SECURITY, COMPUTER THREAT PREVENTION, ANTIVIRUS AND ANTI-MALWARE PROGRAMMES; DUPLICATION OF COMPUTER PROGRAMMES IN CONNECTION WITH COMPUTER SECURITY, COMPUTER THREAT PREVENTION, ANTIVIRUS AND ANTI-MALWARE PROGRAMMES; CONVERSION OF DATA OR DOCUMENTS FROM PHYSICAL TO ELECTRONIC MEDIA IN CONNECTION WITH COMPUTER SECURITY, COMPUTER THREAT PREVENTION, ANTIVIRUS AND ANTI-MALWARE PROGRAMMES; DATA CONVERSION OF COMPUTER PROGRAMMES AND DATA IN CONNECTION WITH COMPUTER SECURITY, COMPUTER THREAT PREVENTION, ANTIVIRUS AND ANTI-MALWARE PROGRAMMES; DATABASE RECONSTRUCTION IN CONNECTION WITH COMPUTER SECURITY, COMPUTER THREAT PREVENTION, ANTIVIRUS AND ANTI-MALWARE PROGRAMMES FOR OTHERS; WEB SITE CREATION AND MAINTENANCE FOR THIRD PARTIES IN CONNECTION WITH COMPUTER SECURITY.



David J. Kappas

Director of the United States Patent and Trademark Office

Reg. No. 3,922,206 ITY, COMPUTER THREAT PREVENTION, ANTIVIRUS AND ANTI-MALWARE PROGRAMMES; SERVER HOSTING OF WEB SITES IN CONNECTION WITH COMPUTER SECURITY, COMPUTER THREAT PREVENTION, ANTIVIRUS AND ANTI-MALWARE PROGRAMMES; TECHNICAL PROJECT STUDIES IN THE NATURE OF FEASIBILITY STUDIES IN THE FIELDS OF COMPUTER SECURITY, COMPUTER THREAT PREVENTION, ANTIVIRUS AND ANTI-MALWARE PROGRAMMES; APPLICATION SERVICE PROVIDER (ASP) FEATURING SOFTWARE FOR USE IN DATA PROTECTION IN CONNECTION WITH COMPUTER SECURITY, COMPUTER THREAT PREVENTION, ANTIVIRUS AND ANTI-MALWARE PROGRAMMES; MAINTENANCE OF SOFTWARE IN COMPUTER SYSTEMS IN CONNECTION WITH COMPUTER SECURITY, COMPUTER THREAT PREVENTION, ANTIVIRUS AND ANTI-MALWARE PROGRAMMES, IN CLASS 42 (U.S. CLS. 100 AND 101).

FOR: LICENSING OF COMPUTER SOFTWARE LICENSES IN CONNECTION WITH COMPUTER SECURITY, COMPUTER THREAT PREVENTION, ANTIVIRUS AND ANTI-MALWARE PROGRAMMES, IN CLASS 45 (U.S. CLS. 100 AND 101).

THE MARK CONSISTS OF STANDARD CHARACTERS WITHOUT CLAIM TO ANY PARTICULAR FONT, STYLE, SIZE, OR COLOR.

PRIORITY DATE OF 5-12-2009 IS CLAIMED.

OWNER OF INTERNATIONAL REGISTRATION 1031331 DATED 11-11-2009, EXPIRES 11-11-2019.

OWNER OF U.S. REG. NO. 2,921,210.

NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "SECURITY", APART FROM THE MARK AS SHOWN.

SER. NO. 79-079,862, FILED 11-11-2009.

SUSAN STIGLITZ, EXAMINING ATTORNEY