

ESTTA Tracking number: **ESTTA927214**

Filing date: **10/09/2018**

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	American International Group, Inc.
Granted to Date of previous extension	10/10/2018
Address	175 Water Street New York, NY 10038 UNITED STATES

Attorney information	Mark J. Liss Leydig, Voit & Mayer, Ltd. 180 N. Stetson Suite 4900 Chicago, IL 60601 UNITED STATES trademark@leydig.com, mliss@leydig.com, lschaefer@leydig.com no phone number provided
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Applicant Information

Application No	87699385	Publication date	06/12/2018
Opposition Filing Date	10/09/2018	Opposition Period Ends	10/10/2018
International Registration No.	NONE	International Registration Date	NONE
Applicant	Hiscox Connect Limited 1 Great St Helens London, EC3A6HX UNITED KINGDOM		

Goods/Services Affected by Opposition

<p>Class 009. First Use: 0 First Use In Commerce: 0 All goods and services in the class are opposed, namely: Computer software, computer programmes, and downloadable mobile application software for use in managing, monitoring, protecting, authenticating, and securing data, emails, computer systems, computernetworks, servers, the Internet, and mobile devices; computer software, computer programmes, and downloadable mobile application software for computer network security, communications network security and data security; computer software, computer programmes, and downloadable mobile application software for enforcing data policies; data processing apparatus; electronic database in the field of computer software recorded on computer media; downloadable computer security software for preventing information disclosure; software for network and device security for identifying and authenticating users; software for ensuring the security of electronic mail; printed publications in electronically, magnetically or optically recorded and recordable form in the nature of books, magazines, manuals, newsletters featuring information relating to cyber security, computer security, network security, application security, data</p>
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security, and information security
<p>Class 035. First Use: 0 First Use In Commerce: 0 All goods and services in the class are opposed, namely: Business management; business administration services; business risk assessmentservices; business risk management services; computerised data management for use in computer network security, communications network security and data security, namely, electronic data collection; computerised data verification; data processing verification services; computerised business information services; compilation of statistics; analysis of marketresearch data and statistics; employment placement services, namely, providing on-site and remote staffing to train on and manage security processes and procedures, all in the fields of cyber security, computer security, network security, application security, data security, andinformation security; consultancy, advisory and information services relating to any of the aforesaid services</p>
<p>Class 036. First Use: 0 First Use In Commerce: 0 All goods and services in the class are opposed, namely: Insurance underwriting services; insurance consultation; insurance agency services; insurance claims services, namely, assessing insurance claims, insurance claims administration and insurance claimsprocessing; insurance underwriting services in the field of business owners; financial risk management services; consultancy, advisory and information servicesrelating to any of the aforesaid services</p>
<p>Class 042. First Use: 0 First Use In Commerce: 0 All goods and services in the class are opposed, namely: Design, development, programming, installation, maintenance and updating of computer software relating to data security, computer security and the prevention of computer risks; data security services, namely, computer security threat analysis for protecting data; creating and maintaining bespoke technology platforms and websites; providing temporary use of non-downloadable software for database management; providing temporary use of non-downloadable software for analysing data and generating reports; providing on-line support services for computer software users, namely, help desk services; technical support, namely, monitoring technological functions of computer networksystems; computer security services forprotection against illegal network access, namely, restricting unauthorized access to computer networks; programming ofsoftware for information platforms on the Internet; application service provider (ASP) services, namely, hosting computer software applications of others; software as a service (SAAS) services featuring software for use in managing, monitoring, protecting, authenticating, and securing data, emails, computer systems, computer networks, servers, the Internet,and mobile devices in the fields of cyber security, computer security, data security, communication security, network security, application security, and the prevention of computer risks; platform asa service (PAAS) featuring computer software platforms for integrating, managing, implementing and optimizing network and cyber security infrastructure and applications; consultancy, advisory and information services relating to any of theaforesaid services</p>

Grounds for Opposition

Priority and likelihood of confusion	Trademark Act Section 2(d)
The mark is merely descriptive	Trademark Act Section 2(e)(1)
No bona fide intent to use mark in commerce for identified goods or services	Trademark Act Section 1(b)
Fraud on the USPTO	In re Bose Corp., 580 F.3d 1240, 91 USPQ2d 1938 (Fed. Cir. 2009)

Marks Cited by Opposer as Basis for Opposition

U.S. Application No.	87613877	Application Date	09/19/2017
Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	CYBERMATICS		

Design Mark	<h1>CYBERMATICS</h1>		
Description of Mark	NONE		
Goods/Services	Class 036. First use: First Use: 0 First Use In Commerce: 0 Insurance underwriting in the field of internet liability, cyber extortion, business interruption and property and casualty insurance		

U.S. Application No.	87613864	Application Date	09/19/2017
Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	CYBERMATICS		
Design Mark	<h1>CYBERMATICS</h1>		
Description of Mark	NONE		
Goods/Services	Class 035. First use: First Use: 2017/12/12 First Use In Commerce: 2017/12/12 Business consulting services in the field of cyber risk; Business data analysis; Business risk management		

Attachments	87613877#TMSN.png(bytes) 87613864#TMSN.png(bytes) Opposition - CYBERMATICS.pdf(32526 bytes)
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Signature	/Mark J. Liss/
Name	Mark J. Liss
Date	10/09/2018

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

American International Group, Inc.,)	
)	
Opposer,)	Opposition No. _____
)	
v.)	Serial No. 87/699,385
)	
Hiscox Connect Limited,)	
)	
<u>Applicant.</u>)	

NOTICE OF OPPOSITION

American International Group, Inc. (“Opposer”), a Delaware corporation, located at 175 Water Street, New York, NY 10038, hereby brings this Opposition against Application Serial No. 87/699,385 for the mark “CYBERMATICS” (the “Application” or “Applicant’s Mark”), filed by Hiscox Connect Limited (“Applicant”), and published in the Official Gazette on June 12, 2018. Opposer has secured additional extensions of time to oppose, which expires October 10, 2018. Opposer believes it will be damaged by the registration of this Application and therefore opposes the same. As grounds for the opposition, Opposer alleges as follows:

FACTS COMMON TO ALL COUNTS

1. Opposer is a highly successful insurance and financial services company based in the United States and operating in numerous countries around the world.
2. In addition to its insurance and financial services, Opposer offers a variety of other services, including business consulting services and data analytics in the field of cyber risk and cyber security. Opposer offers these cyber-related services under the mark, “CYBERMATICS”.

3. Opposer is the owner of Application Serial No. 87/613,877 for the mark “CYBERMATICS” in Class 36 covering “Insurance underwriting in the field of internet liability, cyber extortion, business interruption and property and casualty insurance” and Application Serial No. 87/613,864 for the mark “CYBERMATICS” in Class 35 for “Business consulting services in the field of cyber risk; Business data analysis; Business risk management” (collectively referred to as “Opposer’s Applications”).

4. On November 28, 2017, Applicant filed an application for the mark “CYBERMATICS” for use in connection with the following:

Class 9: “Computer software, computer programmes, and downloadable mobile application software for use in managing, monitoring, protecting, authenticating, and securing data, emails, computer systems, computer networks, servers, the Internet, and mobile devices; computer software, computer programmes, and downloadable mobile application software for computer network security, communications network security and data security; computer software, computer programmes, and downloadable mobile application software for enforcing data policies; data processing apparatus; electronic database in the field of computer software recorded on computer media; downloadable computer security software for preventing information disclosure; software for network and device security for identifying and authenticating users; software for ensuring the security of electronic mail; printed publications in electronically, magnetically or optically recorded and recordable form in the nature of books, magazines, manuals, newsletters featuring information relating to cyber security, computer security, network security, application security, data security, and information security”;

Class 35: “Business management; business administration services; business risk assessment services; business risk management services; computerised data management for use in computer network security, communications network security and data security, namely, electronic data collection; computerised data verification; data processing verification services; computerised business information services; compilation of statistics; analysis of market research data and statistics; employment placement services, namely, providing on-site and remote staffing to train on and manage security processes and procedures, all in the fields of cyber security, computer security, network security, application security, data security, and information security; consultancy, advisory and information services relating to any of the aforesaid services”;

Class 36: “Insurance underwriting services; insurance consultation; insurance agency services; insurance claims services, namely, assessing insurance claims, insurance claims administration and insurance claims processing; insurance underwriting services in the

field of business owners; financial risk management services; consultancy, advisory and information services relating to any of the aforesaid services”; and

Class 42: “Design, development, programming, installation, maintenance and updating of computer software relating to data security, computer security and the prevention of computer risks; data security services, namely, computer security threat analysis for protecting data; creating and maintaining bespoke technology platforms and websites; providing temporary use of non-downloadable software for database management; providing temporary use of non-downloadable software for analysing data and generating reports; providing on-line support services for computer software users, namely, help desk services; technical support, namely, monitoring technological functions of computer network systems; computer security services for protection against illegal network access, namely, restricting unauthorized access to computer networks; programming of software for information platforms on the Internet; application service provider (ASP) services, namely, hosting computer software applications of others; software as a service (SAAS) services featuring software for use in managing, monitoring, protecting, authenticating, and securing data, emails, computer systems, computer networks, servers, the Internet, and mobile devices in the fields of cyber security, computer security, data security, communication security, network security, application security, and the prevention of computer risks; platform as a service (PAAS) featuring computer software platforms for integrating, managing, implementing and optimizing network and cyber security infrastructure and applications; consultancy, advisory and information services relating to any of the aforesaid service”.

5. The Application alleges an intent to use the mark “CYBERMATICS” in connection with all of the aforesaid goods and services, and is based on Sections 1(b) and 44(d) of the Trademark Act, 15 U.S.C. §§ 1051(b) and 1126(d). The Application was assigned Serial No. 87/699,385.

COUNT I – LIKELIHOOD OF CONFUSION

6. Opposer repeats and realleges the allegations set forth in paragraphs 1-5 as fully set forth herein.

7. Opposer has made continuous use of the mark with both actual use and/or analogous use starting March 2017.

8. Upon information and belief, Opposer's use and/or analogous use of "CYBERMATICS" in the United States predates Applicant's use and application to register "CYBERMATICS" in the United States.

9. Upon information and belief, Applicant knew or should have known of Opposer's use of the mark dating back to March 2017, as such use was published in a cyber trade journal and made well before Applicant's claimed priority date.

10. Opposer's Applications have been suspended pending the outcome of the Application subject to this Opposition as well as Applicant's application for "HISCOX CYBERMATICS", Application Serial No. 87/699,412 (collectively referred to as "Applicant's Applications").

11. According to the Suspension Notices dated January 24, 2018, Opposer's Applications "may be refused registration under Section 2(d) because of a likelihood of confusion". Thus, Opposer's Applications may be refused based on a perceived likelihood of confusion with Applicant's Applications.

12. Applicant's mark is identical to Opposer's mark.

13. Applicant's applied for goods and services are closely overlapping and/or related to Opposer's services. However, as set forth in more detail below, upon information and belief, Applicant did not have a bona fide intent to use the mark in connection with all the goods and services covered by its Application.

14. Opposer will be damaged by the registration of the Application, and the Application should be refused on the basis that Opposer has priority and there is a perceived basis for a likelihood of confusion.

COUNT II – LACK OF BONA FIDE INTENT

15. Opposer repeats and realleges the allegations set forth in paragraphs 1-14 as fully set forth herein.

16. The Application claims an intent to use basis under Section 1(b) of the Trademark Act.

17. Upon information and belief, Applicant did not have an intent to use the mark in connection with all of the applied-for goods and services at the time of filing the Application. In fact, on information and belief, Applicant does not intend to use the “CYBERMATICS” mark on the vast majority of goods and services covered by its Application.

18. Upon information and belief, Applicant only uses the mark in connection with a mobile application. Applicant does not use and will not be using the mark for the remaining applied-for goods and services.

19. This lack of bona-fide intent to use is further evidenced by the fact that the Application failed to include a declaration attesting to Applicant’s bona fide intent to use the mark. As of this date, and over a year from the claimed priority date of August 30, 2017, the Application remains unsigned and without a verification of Applicant’s bona fide intent to use the mark in connection with all applied-for goods and services.

20. Furthermore, upon information and belief, Applicant is improperly attempting to warehouse the “CYBERMATICS” mark by claiming rights for a broad range of goods and services when Applicant uses the Mark in connection with the narrow goods of a mobile application.

COUNT III – FRAUD IN THE APPLICATION

21. Opposer repeats and realleges the allegations set forth in paragraphs 1-20 as fully set forth herein.

22. Upon information and belief, Applicant knew or should have known of Opposer's intent to use the mark "CYBERMATICS" in connection with its cyber risk related services by way of an article featured in a cyber trade journal in March 2017.

23. As part of a trademark application, an applicant must attest, under oath, that to the best of the applicant's knowledge and belief, no other person has the right to use the mark in commerce that is likely to cause confusion, mistake or to deceive.

24. However, neither Applicant nor Applicant's representative signed the application or the declaration attesting that upon knowledge and belief, no other person had rights to "CYBERMATICS". Such representation is material to the registerability of the mark.

25. Upon information and belief, such omission was made knowingly with the intent to procure a registration to which Applicant was not entitled, and the Trademark Office relied on such omissions, as Applicant was successful in procuring favorable examination and publication of the Application.

26. In addition, upon information and belief, Applicant did not have an intent to use the mark in connection with all of the applied-for goods and services at the time of filing the Application. In fact, on information and belief, Applicant does not intend to use the "CYBERMATICS" mark on the vast majority of goods and services covered by its Application.

27. Upon information and belief, Applicant only uses the mark in connection with a mobile application. Applicant does not use and will not be using the mark for the remaining applied-for goods and services.

28. As part of a trademark application claiming a Section 1(b) basis, an applicant must attest, under oath, that the applicant has a bona fide intention to use the mark in commerce or in connection with the goods and services in the application. Further, an applicant must attest that to the best of its knowledge and belief, this information is accurate.

29. However, neither Applicant nor Applicant's representative signed the application or the declaration attesting that Applicant had a bona fide intention to use the mark in connection with all goods and services in the application. Such representation is material to the registerability of the mark.

30. Upon information and belief, such omission was made knowingly with the intent to procure a registration to which Applicant was not entitled, and the Trademark Office relied on such omissions, as Applicant was successful in procuring favorable examination and publication of the Application.

COUNT IV – DESCRIPTIVENESS

31. Opposer repeats and realleges the allegations set forth in paragraphs 1-30 as fully set forth herein.

32. Applicant's designation "CYBERMATICS" is merely descriptive of Applicant's applied-for goods and services.

33. The term "cybermatics" is commonly used in the industry to refer to the strategy, analytics, and/or technology issues as they relate to cyber networks or cyber security. The concept is similar to "telematics" in the telecommunications industry.

34. The designation merely describes all of Applicant's applied-for goods and services and therefore registration of the Application is prohibited under Section 2(e)(1) of the Trademark Act, 15 U.S.C. § 1052(e)(1).

35. Applicant's designation "CYBERMATICS" has not acquired secondary meaning and is not entitled to registration under Section 2(f), 15 U.S.C. § 1052(f).

WHEREFORE, by its undersigned attorneys, Opposer respectfully requests that this Notice of Opposition be sustained and that registration of Application Serial No. 87/699,385 be refused.

Please charge deposit account no. 12-1216 in the amount of \$1,600.00 to cover the filing fee of this Notice of Opposition against the Application. Please charge any additional fees to Deposit Account 12-1216, as necessary.

Respectfully submitted,

Date: October 9, 2018

By: /Mark J. Liss/

Mark J. Liss
Laura M. Schaefer
LEYDIG, VOIT & MAYER, LTD.
Two Prudential Plaza, 180 N. Stetson Ave.
Suite 4900
Chicago, Illinois 60601-6731
(312) 616-5600
Attorneys for Opposer

Opposition No. _____

Serial No. 87/699,385

CERTIFICATE OF ELECTRONIC FILING

I hereby certify that the attached NOTICE OF OPPOSITION was filed electronically with the Trademark Trial and Appeal Board on October 9, 2018.

_____/Laura M. Schaefer

Laura M. Schaefer