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UNITED STATES PATENT AND TRADEMARK OFFICE
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February 12, 2020

Opposition No. 91246497 (**Parent**)

Skout Secure Intelligence LLC

v.

NetScout Systems, Inc.

Opposition No. 91248844
Opposition No. 91248845

NetScout Systems, Inc.

v.

SKOUT SECURE INTEELIGENCE LLC

By the Trademark Trial and Appeal Board:

The above-captioned proceedings now come before the Board for consideration of the motions of Skout Secure Intelligence LLC ("Skout Secure") to dismiss the notices of opposition of NetScout Systems, Inc. ("NetScout") in Opposition Nos. 91248844 and 91248845 for failure to state a claim upon which relief can be granted pursuant to

Fed. R. Civ. P. 12(b)(6). After being granted extensions of time, 7 TTABVUE, NetScout filed a response to each of the motions to dismiss on October 7, 2019.[1]

I. Sua Sponte Consolidation

It has come to the Board's attention that the above-captioned proceedings involve common questions of law and fact and the parties are the same.

When cases involving common questions of law or fact are pending before the Board, the Board may order the consolidation of the cases. *See* Fed. R. Civ. P. 42(a); *see also*, *Regatta Sport Ltd. v. Telux-Pioneer Inc.,* 20 USPQ2d 1154 (TTAB 1991) and *Estate of Biro v. Bic Corp*., 18 USPQ2d 1382 (TTAB 1991).

Accordingly, the Board sua sponte orders the consolidation of the above-captioned proceedings.

In view thereof, Opposition Nos. 91246497, 91248844, and 91248845 are hereby consolidated. Opposition Nos. 91248844 and 91248845 are treated effectively as counterclaims in Opposition No. 91246497.

The consolidated cases may be presented on the same record and briefs. *See Helene Curtis Industries Inc. v. Suave Shoe Corp*., 13 USPQ2d 1618 (TTAB 1989) and *Hilson Research Inc. v. Society for Human Resource Management*, 26 USPQ2d 1423 (TTAB 1993).

The Board file for these consolidated cases will be maintained in Opposition No. 91246497 as the "parent" case. As a general rule, from this point on, only a single

[1] NetScout's change of correspondence address, filed October 23, 2019, is noted. Board records have been updated accordingly. Unless otherwise specified, citations to TTABVUE entries indicate docket entries in Opposition No. 91244844.

copy of any paper or motion should be filed in the parent case of the consolidated proceedings, but that copy should bear all proceeding numbers in its caption.

The parties are further advised that despite being consolidated, each proceeding retains its separate character. The decision on the consolidated cases shall take into account any differences in the issues raised by the respective pleadings and a copy of the final decision shall be placed in each proceeding file.[2]

II. Relevant Background

NetScout seeks to register the mark NETSCOUT, in standard characters, for the following goods and services:[3]

- "Computer hardware; computer software, namely, computer software for monitoring and management of performance and availability of software applications; computer software, namely, computer software for analyzing wireless, cable, and wireline service performance; computer software for analyzing computer network performance; Telecommunications hardware devices, namely, switches and servers and software for transporting voice, data and video communications across multiple network infrastructures and communications protocols; Telecommunications Network test equipment, namely, servers and switches and parts therefor and testing software relating thereto, for use in operation support systems for billing, fraud prevention, marketing, service quality assurance, network management, early warning and troubleshooting; Computer software for collection, storage, analysis and re-assembly of data traffic over computer and communications networks; computer utility software; computer software for network intrusion detection applications; computer software for network management; and manuals provided together with each of the foregoing goods; Computer hardware and software for collection, storage, analysis and re-assembly of data traffic over computer and communications networks; computer utility software and hardware for supporting the utility of the computer infrastructure; computer hardware and software for monitoring network and system activities for network intrusion activity; computer hardware and software for use in network management; and

[2] The parties should promptly inform the Board in writing of any other related inter partes proceedings. See Fed. R. Civ. P. 42(a).

[3] Application Serial No. 87630078, filed October 2, 2017, pursuant to Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a).

manuals therewith sold as a unit; Computer hardware and software for managing computer networks, namely, hardware and software to monitor, analyze, identify, report, troubleshoot, and forecast the performance and efficiency of application and content delivery over network infrastructures; computer software that manages switches that direct packet flows used in network testing" in International Class 9;

- "Installation and repair of computer hardware; customizing computer hardware; maintenance of computer hardware" in International Class 37; and

- "Software as a service (saas) services, namely, software as a service featuring software for monitoring and management of performance and availability of software applications; software as a services, namely, software as a service for analyzing wireless, cable, and wireline service performance; software as a service for analyzing computer network performance; design and development of computer hardware and computer software; consulting services in the field of application and network performance management; computer software consulting; computer consultation; installation, repair and maintenance of computer software; technical support services, namely, troubleshooting computer software problems; technical support services, namely, monitoring technological functions of computer network systems" in International Class 42.

On February 19, 2019, Skout Secure filed a notice of opposition opposing registration of NetScout's involved application on the sole ground of likelihood of confusion pursuant to Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d). In its June 4, 2019 answer, NetScout denied the salient allegations therein.

Skout Secure seeks to register the mark SKOUT SECURE INTELLIGENCE, in standard characters, for "Monitoring of data for business purposes" in International Class 35 and "Regulatory compliance consulting in the field of data security" in International Class 45.[4] Additionally, Skout Secure seeks to register the mark

[4] Application Serial No. 87978615, filed January 19, 2018, pursuant to an allegation of a bona fide intent to use the mark in commerce under Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b). "SECURE INTELLIGENCE" is disclaimed.

SKOUT SECURE INTELLIGENCE and Design, as shown below, for the same services:[5]

On June 14, 2019, NetScout filed separate notices of opposition opposing registration of Skout Secure's involved applications on the sole ground of likelihood of confusion pursuant to Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d).

In support of its standing and claims, NetScout pleaded, inter alia, ownership of Registration No. 1764154 for the mark NETSCOUT, in typeset form,[6] for "software for use on local area networks and wide area networks to analyze network information traffic for the purpose of measuring network performance and isolating and diagnosing errors, delays and faults" in International Class 9.[7]

In lieu of an answer, Skout Secure filed motions to dismiss the notices of opposition for failure to state a claim upon which relief can be granted. Inasmuch as the motions to dismiss are largely identical, the Board addresses them together.

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[5] Application Serial No. 87978616, filed January 24, 2018, pursuant to an allegation of a bona fide intent to use the mark in commerce under Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b). "SECURE INTELLIGENCE" is disclaimed. The description of the mark is as follows: "The mark consists of 'SKOUT SECURE INTELLIGENCE' in stylized font with 'SKOUT' appearing above 'SECURE INTELLIGENCE.' The letter 'O' in 'Skout' has an inner circular ring. The letter 'K' in 'Skout' appears in lowercase font with the vertical line portion of the 'k' extending higher than the top of the 'S' in "Skout.'"

[6] Prior to November 2, 2003, "standard character" drawings were known as "typed" drawings. A typed or typeset mark is the legal equivalent of a standard character mark. TMEP § 807.03(i) (October 2018).

[7] Registration No. 1764154, issued April 13, 1993, pursuant to Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a).

The Board has considered the parties' briefs on the contested motions, but does not repeat or discuss all of their arguments, except as necessary to explain the Board's order. *Guess? IP Holder LP v. Knowluxe LLC*, 116 USPQ2d 2018, 2019 (TTAB 2015).

III. Motion to Dismiss

To survive a motion to dismiss, "a complaint must contain sufficient factual matter, accepted as true, to 'state a claim to relief that is plausible on its face.'" *Ashcroft v. Iqbal*, 556 U.S. 662, 663, 129 S. Ct. 1937, 1949 (2009), *quoting Bell Atlantic Corp. v. Twombly*, 550 U.S. 544, 5470, 127 S. Ct. 1955, 1974 (2007). A claim has facial plausibility when the plaintiff pleads factual content that allows the court to draw a reasonable inference that the defendant is liable for the misconduct alleged. *See Twombly*, 550 U.S. at 556-57. However, the plausibility standard does not require that a plaintiff set forth detailed factual allegations. *Id.* Rather, a plaintiff need only allege "enough factual matter … to suggest that [a claim is plausible]" and "raise a right to relief above the speculative level." *Totes-Isotoner Corp. v. U.S.*, 594 F.3d 1346, 1354 (Fed. Cir. 2010). Moreover, it is well established that whether a plaintiff can actually prove its allegations is not a matter to be determined upon motion to dismiss, but rather at final hearing or upon summary judgment, after the parties have had an opportunity to submit evidence. *See Libertyville Saddle Shop Inc. v. E. Jeffries & Sons, Ltd.*, 22 USPQ2d 1594, 1597 (TTAB 1992) ("A motion to dismiss does not involve a determination of the merits of the case…").

In deciding Skout Secure's motions, the Board has given no consideration to the matters that are outside of the pleadings. *See, e.g., Compagnie Gervais Danone v.*

Precision Formulations LLC, 89 USPQ2d 1251, 1255-56 (TTAB 2009); TBMP § 503.04 (2019). Additionally, the Board has not considered arguments that go to the merits of the case and whether NetScout ultimately will be able to prove its allegations. *See, e.g., Advanced Cardiovascular Sys. Inc.*, 26 USPQ2d at 1041; *Covidien LLP v. Masimo Corp.*, 109 USPQ2d 1696, 1697 n.3 (TTAB 2017); *Scotch Whiskey Assos. v. U.S. Distilled Prods. Co.*, 18 USPQ2d 1391, 1393 (TTAB 1991).

A. Standing

Section 13 of the Trademark Act provides that "[a]ny person who believes that he would be damaged by the registration of a mark upon the principal register … may, upon payment of the prescribed fee, file an opposition in the Patent and Trademark Office, stating the grounds therefor… ." Section 13 thus establishes a broad doctrine of standing; by its terms, the statute requires only that a person have a belief that he would suffer some kind of damage if the mark is registered. As interpreted in binding precedent, a plaintiff must have a "real interest" in the outcome of the proceeding, and a "reasonable basis" for its belief that it would suffer some kind of damage by the registration of the mark. *See Empresa Cubana del Tabaco v. Gen. Cigar Co.*, 753 F.3d 1270, 111 USPQ2d 1058, 1062 (citing *Ritchie v. Simpson*, 170 F.3d 1902, 50 USPQ2d 1023, 1025-26 (Fed. Cir. 1999)); *Universal Oil Prods. Co. v. Rexall Drug & Co.*, 463 F.2d 1122, 1123, 174 USPQ 458, 459 (CCPA 1972). "A claim of likelihood of confusion that 'is not wholly without merit,' including prior use of a confusingly similar mark, may be sufficient 'to establish a reasonable basis for a belief that one is damaged.'" *Exec. Coach Builders, Inc. v. SPV Coach Co.*, 123 USPQ2d 1175, 1179 (TTAB 2017)

(quoting *Lipton Indus., Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185, 189 (CCPA 1982)).

The Board finds that NetScout has adequately pleaded its standing by virtue of its allegations of prior common law rights and ownership of a registration for a mark which NetScout believes is confusingly similar to the opposed applications. *See Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1844 (Fed. Cir. 2000).

B. Likelihood of confusion

To allege a valid ground for opposition under Section 2(d) of the Trademark Act, NetScout need only allege that it has valid proprietary rights that are prior to those of Skout Secure, or that it owns a registration, and that Skout Secure's mark so resembles NetScout's mark as to be likely to cause confusion. *See* 15 U.S.C. § 1052(d); *Otto Roth & Co. v. Universal Foods Corp.*, 640 F.2d 1317, 209 USPQ 40 (CCPA 1981).

The Board finds that NetScout has adequately pleaded its claim of likelihood of confusion by virtue of its allegation that it owns a registration for a mark that is allegedly confusingly similar to Skout Secure's involved marks for allegedly related services. Additionally, NetScout has pleaded prior common law rights in the same mark.

Skout Secure argues that the notice of opposition fails because "as a matter of fact and law, there is no likelihood of confusion" between the parties' respective marks. 4 TTABVUE 2. A motion to dismiss is **solely** a test of the sufficiency of the pleadings and "does not involve a determination of the merits of the case… ." *Libertyville Saddle*

Shop Inc., 22 USPQ2d at 1597. Here, Skout Secure argues the merits of NetScout's claims. In arguing that the claims are without merit, Skout Secure relies on numerous decisions finding no likelihood of confusion on the merits. *See, e.g.*, 4 TTABVUE 7-9. Each of the cited cases is inapposite, however, because the Board does not reach the merits of the claim on a motion to dismiss. NetScout has pleaded prior use and registration of an allegedly similar mark for allegedly similar goods and services. NetScout has sufficiently pleaded its claims of likelihood of confusion.

In view of the foregoing, Skout Secure's motions to dismiss the notice of opposition in Opposition Nos. 91248844 and 91248855 are **denied**.

Skout Secure is allowed until **March 3, 2020** in which to file and serve answers to the notices of opposition. Skout Secure should file the answers separately in Opposition Nos. 91248844 and 91248845 as an exception to the general rule that all filings be made in the parent case only.

IV. Schedule

Proceedings herein are resumed. Upon consolidation, the Board will reset dates for the consolidated proceeding, usually by adopting the dates as set in the most recently instituted of the cases being consolidated. Remaining dates are reset as follows:

Answers to Notices of Opposition in Child Cases Due	**3/3/2020**
Deadline for Discovery Conference[8]	**4/2/2020**
Discovery Opens in Child Cases	**4/2/2020**
Initial Disclosures Due	**5/2/2020**

[8] The Board presumes the parties held a timely discovery conference in the parent proceeding. The parties are nevertheless required to hold a discovery conference in the child proceedings.

Expert Disclosures Due	**8/30/2020**
Discovery Closes	**9/29/2020**
Pretrial Disclosures Due for Party in Position of Plaintiff in Parent Case	**11/13/2020**
30-day Trial Period Ends for Party in Position of Plaintiff in Parent Case	**12/28/2020**
Pretrial Disclosures Due for Party in Position of Defendant in Parent Case and in Position of Plaintiff in Child Cases	**1/12/2021**
30-day Trial Period Ends for Party in Position of Defendant in Parent Case, and in Position of Plaintiff in Child Cases	**2/26/2021**
Pretrial Disclosures Due for Rebuttal of Party in Position of Plaintiff in Parent Case and in Position of Defendant in Child Cases	**3/13/2021**
30-day Trial Period Ends for Rebuttal of Party in Position of Plaintiff in Parent Case, and in Position of Defendant in Child Cases	**4/27/2021**
Pretrial Disclosures Due for Rebuttal of Party in Position of Plaintiff in Child Cases	**5/12/2021**
15-day Trial Period Ends for Rebuttal of Party in Position of Plaintiff in Child Cases	**6/11/2021**
Opening Brief for Party in Position of Plaintiff in Parent Case Due	**8/10/2021**
Combined Brief for Party in Position of Defendant in Parent Case and Opening Brief as Plaintiff in Child Cases Due	**9/9/2021**
Combined Rebuttal Brief for Party in Position of Plaintiff in Parent Case and Brief as Defendant in Child Cases Due	**10/9/2021**
Rebuttal Brief for Party in Position of Plaintiff in Child Cases Due	**10/24/2021**
Request for Oral Hearing (optional) Due	**11/3/2021**

Generally, the Federal Rules of Evidence apply to Board trials. Trial testimony is taken and introduced out of the presence of the Board during the assigned testimony periods. The parties may stipulate to a wide variety of matters, and many requirements relevant to the trial phase of Board proceedings are set forth in Trademark Rules 2.121 through 2.125. These include pretrial disclosures, the manner and timing of taking testimony, matters in evidence, and the procedures for submitting and serving testimony and other evidence, including affidavits, declarations, deposition transcripts and stipulated evidence. Trial briefs shall be submitted in accordance with Trademark Rules 2.128(a) and (b). Oral argument at

final hearing will be scheduled only upon the timely submission of a separate notice as allowed by Trademark Rule 2.129(a).