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

Proceeding	91248845
Party	Defendant SKOUT SECURE INTELLIGENCE LLC
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UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

NetScout Systems, Inc., Opposer, v. Skout Secure Intelligence LLC, Applicant.	Opposition No. 91248845

MOTION TO DISMISS OPPOSER NETSCOUT SYSTEMS, INC.'S NOTICE OF OPPOSITION

Applicant Skout Secure Intelligence LLC ("Applicant"), through its undersigned counsel, hereby moves the Trademark Trial and Appeal Board (the "Board") to dismiss the Notice of Opposition (the "Notice of Opposition") filed by Opposer NetScout Systems, Inc. ("Opposer") pursuant to Rule 12(b)(6) of the Federal Rules of Civil Procedure and Section 503.02 of the Trademark Trial and Appeal Board's Manual of Procedure because, as matter of fact and law, there is no likelihood of confusion between Applicant's Mark and Opposer's Marks.

FACTUAL AND PROCEDURAL BACKGROUND

I. The Parties

Applicant is a New York-based cybersecurity monitoring and data analytics limited liability company that was founded in 2013. Applicant's primary place of business is located at 270 South Service Road, Melville, NY 11747. On January 24, 2018, following its customary due diligence, Applicant filed an application for registration of the unique mark SKOUT SECURE INTELLIGENCE (plus design) (the "SKOUT Mark") (Serial No. 87/978,616) for regulatory compliance consulting in the field of data security in International Class 045 and the

monitoring of data for business purposes in International Class 035.

Opposer purports to be a public corporation organized under the laws of the state of Delaware that engages in the business of application and network performance management and offers products and other goods and services under the mark NETSCOUT. *See* Notice of Opposition at 1-2. Opposer claims to own the United States Patent and Trademark Office ("USPTO") registered mark NETSCOUT (Reg. No. 1,764,154) 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 099, and the pending Application Serial Number 87/630,078, for, *inter alia*, computer hardware, computer software for the monitoring and management of performance and availability of software applications, in International Class 009 (collectively, "Opposer's Marks").

II. Opposer's Notice Of Opposition

On June 16, 2019, Opposer commenced this opposition proceeding against Applicant, opposing Applicant's application to register Application Serial No. 87/978,616 for the SKOUT Mark (plus design) related to its cybersecurity services. The SKOUT Mark consists of the words "SKOUT SECURE INTELLIGENCE" in stylized font with "SKOUT" appearing above "SECURE INTELLIGENCE," with the letter "O" in the word "Skout" presenting an inner circular ring and the letter "K" appearing in lowercase font with the vertical line portion extending higher than the top of the "S."

The grounds that Opposer alleges as a basis for its Notice of Opposition include: (i) seniority; and (ii) a likelihood of confusion. Based on the facts alleged in the Notice of Opposition, the grounds asserted by Opposer lack merit, and as such the Notice of Opposition fails to state a claim upon which relief can be granted and warrants dismissal pursuant to Rule

12(b)(6) of the Federal Rules of Civil Procedure.

ARGUMENT

Opposer's Notice of Opposition fails to meet the pleading requirements of the Federal Rules of Civil Procedure. Rule 8 requires "a short and plain statement of the claim showing that the pleader is entitled to relief." Fed. R. Civ. P. 8(a)(2). Under the pleading standards established by *Ashcroft v. Iqbal*, 556 U.S. 662 (2009), and *Bell Atlantic Corp. v. Twombly*, 550 U.S. 544 (2007), Opposer must do more than merely state that the law has been violated—Opposer must plead sufficient facts to show that it has a plausible claim for relief. Opposer has failed to do so here, because Opposer has not (and cannot) reasonably allege that a likelihood of confusion exists between Opposer's Marks and Applicant's SKOUT Mark due to the plain and patent dissimilarity of these marks. Specifically, under the relevant *DuPont* analysis, Opposer's Notice of Opposition should be dismissed as a matter of law. *See In re E. I. DuPont DeNemoitrs & Co.*, 476 F.2d 1357, 1361 (C.C.P.A. 1973) (listing the factors dispositive to a determination of whether marks are similar so as to create a likelihood of confusion). The Notice of Opposition is both factually and legally deficient, and as such warrants dismissal pursuant to Rule 12(b)(6) of the Federal Rules of Civil Procedure.

I. Legal Standard

A motion to dismiss under Rule 12(b)(6) tests the legal sufficiency of a complaint. *See Adv. Cardiovascular Sys. Inc. v. SciMed Life Sys. Inc.*, 26 U.S.P.Q.2d 1038, 1041 (Fed. Cir. 1993); *see also Space Base Inc. v. Stadis Corp.*, 17 U.S.P.Q.2d 1216, 1218 (T.T.A.B. 1990). Under Rule 12(b)(6), dismissal is appropriate if a pleading fails to "state a claim upon which relief can be granted." *See* Fed. R. Civ. P. 12(b)(6). "To survive a motion to dismiss under Rule 12(b)(6), a notice of opposition need only allege facts as would, if proven, establish opposer's standing to maintain the proceeding and a ground or grounds for refusing registration to

applicant." *See Schlumberger Tech. Corp. v. Halliburton Energy Servs., Inc.*, 2003 TTAB LEXIS 285, at *1 (T.T.A.B. Jun. 18, 2003). To successfully prosecute an opposition based on likelihood of confusion, an opposer must "assert[] more than a mere possibility of confusion; a probability of confusion is required." *See* James E. Hawes and Amanda v. Dwight, 1 Trademark Registration Practice § 16:11. Dismissal is appropriate where a pleading does not allege the facts necessary to establish that a petitioner is entitled to relief. *See* Fed. R. Civ. P. 12(b)(6).

Rule 8 of the Federal Rules of Civil Procedure requires that a complaint must include "enough facts to state a claim to relief that is plausible on its face." *Twombly*, 550 U.S. at 570. Without requiring at least the facial plausibility of asserted claims, "claim[s] would survive a motion to dismiss whenever the pleadings left open the possibility that a plaintiff might later establish some 'set of [undisclosed] facts' to support recovery." *Id.* at 561. Such a minimal pleading standard would render meaningless a court's "power to insist upon some specificity in pleading before allowing a potentially massive factual controversy to proceed." *Id.* at 558 (quoting *Assoc. Gen. Contractors of Cal., Inc. v. California State Council of Carpenters*, 459 U.S. 519, 528 n.17 (1983)).

II. Opposer Has Failed To State A Claim Against Applicant For Likelihood Of Confusion

In considering Applicant's Motion to Dismiss, the Board is required to consider not only the specific facts alleged in the Notice of Opposition, but also the particulars of the marks of Applicant and the history of Opposer's registrations, since those applications and registrations are central to the issues presented in this opposition proceeding and are incorporated by reference in Opposer's Notice of Opposition. See *Tellabs, Inc. v. Makor Issues & Rights, Ltd.*, 127 S. Ct. 2499, 2509 (2007) ("courts must consider the complaint in its entirety, as well as other sources courts ordinarily examine when ruling on Rule 12(b)(6) motions to dismiss, in particular,

documents incorporated into the complaint by reference, and matters of which a court may take judicial notice."); *Pani v. Empire Blue Cross Blue Shield*, 152 F.3d 67, 75 (2d. Cir 1998) (a court may consider matters of public record and documents integral to plaintiff's complaint when deciding a motion to dismiss).

In an opposition proceeding alleging likelihood of confusion, Opposer must allege facts sufficient to establish that: (1) Opposer has priority of rights in and to the mark at issue; and (2) Applicant's mark, as applied for, is so similar to Opposer's mark as to be likely to cause confusion, mistake, or deception. *Bongrain Int'l (Am.) Corp. v. Moquet, Ltd*., 230 U.S.P.Q. 626, 626 (T.T.A.B. 1986). Here, Opposer has failed to do so, because the relevant *DuPont* factors demonstrate no likelihood of confusion.

A. The Relevant *DuPont* Factors Demonstrate No Likelihood of Confusion

Determination of the existence of a likelihood of confusion is based upon an analysis of the probative facts relevant to the likelihood of confusion factors set forth in *In re E. I. DuPont DeNemows & Co.*, 476 F.2d 1357, 1361 (C.C.P.A. 1973). *See Shen Mfg. Co., Inc. v. The Ritz Hotel Ltd.*, 393 F.3d 1241 (Fed. Cir. 2004). These factors are:

> (1) The similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression;
>
> (2) The similarity or dissimilarity and nature of the goods or services as described in an application or registration or in connection with which a prior mark is in use;
>
> (3) The similarity or dissimilarity of established, likely-to-continue trade channels;
>
> (4) The conditions under which and buyers to whom sales are made, i.e. "impulse" vs. careful, sophisticated purchasing;
>
> (5) The fame of the prior mark (sales, advertising, length of use);
>
> (6) The number and nature of similar marks in use on similar goods;

(7) The nature and extent of any actual confusion;

(8) The length of time during and conditions under which there has been concurrent use without evidence of actual confusion;

(9) The variety of goods on which a mark is or is not used (house mark, "family" mark, product mark);

(10) The market interface between applicant and the owner of a prior mark:

(a) a mere "consent" to register or use;

(b) agreement provisions designed to preclude confusion, i.e. limitations on continued use of the marks by each party;

(c) assignment of mark, application, registration and good will of the related business;

(d) laches and estoppel attributable to owner of prior mark and indicative of lack of confusion;

(11) The extent to which applicant has a right to exclude others from use of its mark on its goods;

(12) The extent of potential confusion, i.e., whether de minimis or substantial;

(13) Any other established fact probative of the effect of use.

Id. (emphasis added.)

In determining whether a likelihood of confusion exists, the Board need not consider every *DuPont* factor. *Id.* (citing *Han Beauty Inc. v. Alberto-Culver Co.*, 236 F.3d 1333, 1336 (Fed. Cir. 2001) ("While it must consider each factor for which it has evidence, ***the Board may focus its analysis on dispositive factors, such as similarity of the marks and relatedness of the goods***.") (emphasis added.)). The Board may dismiss an opposition based on a determination of the first *DuPont* factor alone. *See Champagne Louis Roederer, S.A. v. Delicato Vineyards*, 148 F.3d 1373, 1374-75 (Fed. Cir. 1998) (affirming the Board's dismissal of opposition action where it "treated the dissimilarity of the marks with respect to appearance, sound, significance, and

commercial impression as the dispositive *DuPont* factor, concluding that this dissimilarity alone precluded any reasonable likelihood of confusion."); *Kellogg Co. v. Pack'em Enterprises, Inc.*, 951 F.2d 330 (Fed. Cir. 1991) (affirming decision finding no likelihood of confusion based on the first *DuPont* factor alone).

Here, the first *DuPont* factor—"[t]he similarity or dissimilarity of the marks in their entireties as to appearance, sound connotation and commercial impression"—is dispositive of this case by itself. *In re E. I. DuPont Nemours & Co.*, 476 F.2d at 1361 (emphasis added). Thus, Opposer's Notice of Opposition should be dismissed in its entirety for failure to state a claim upon which relief can be granted.

B. The SKOUT Mark And Opposer's Marks Are Dissimilar In Their Appearance And Sound Connotation

The Notice of Opposition fails at the outset because the marks at issue are patently dissimilar. Indeed, no common words are shared. Additionally, the marks, in their entireties, are clearly dissimilar in appearance. *See Miller Brewing Co. v. Premier Beverages, Inc.*, 210 U.S.P.Q. 43, 48-49 (T.T.A.B. 1981) (finding no likelihood of confusion based on dissimilarity between MILLER and OL' BOB MILLER'S); *Hershey Foods Corp. v. Cerreta*, 195 U.S.P.Q. 246 (T.T.A.B. 1977) (finding no likelihood of confusion based on dissimilarity between A BIG KISS FOR YOU and SEALED WITH A KISS).

The SKOUT Mark consists of the words "SKOUT" followed by the words "SECURE INTELLIGENCE." The SKOUT Mark is described 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."

Figure 1 below accurately represents the visual design of the SKOUT Mark:

On the other hand, Opposer's Marks are comprised of the standard character mark "NETSCOUT," which consists of only one word, a word which forms no part of the SKOUT Mark. Figure 2 below accurately represents Opposer's Mark:

NETSCOUT

Such patent dissimilarity of the marks precludes a likelihood of confusion. *See Shen Mfg. Co., Inc.*, 393 F.3d at 1243; *Bell Labs, Inc. v. Colonial Prods., Inc.*, 644 F. Supp. 542 (S.D. Fla. 1986) (finding no likelihood of confusion based on dissimilarity between FINAL and FINAL FLIP); *Champagne Louis Roederer*, S.A. 148 F.3d at 1375 (affirming finding of no likelihood of confusion between CRISTAL and CRYSTAL CREEK wines).

Moreover, the SKOUT Mark and Opposer's Marks are also verbally dissimilar, as the SKOUT Mark contains three words and six syllables, and Opposer's Marks contain only one word of two syllables. *See Jet, Inc. v. Sewage Aeration Sys.*, 165 F.3d 419 (6th Cir. 1999) (finding the marks JET and AEROB-A-JET visually and verbally distinct).

C. The SKOUT Mark And Opposer's Marks Are Dissimilar In Their Commercial Impression

Finally, in determining whether two marks have similar commercial impressions, the

Board has looked at whether purchasers or prospective purchasers would mistakenly believe upon encountering an applicant's mark that the applicant's mark originated with the opposer. *Puma-Sportsclmhfabriken Rudolf Dassier KG v. Roller Derby Skate Corp.*, 206 U.S.P.Q. 255 (T.T.A.B. 1980). No purchaser or prospective purchaser familiar with the SKOUT Mark would believe upon seeing the Opposer's Marks that the SKOUT Mark originated with Opposer, due to differences in appearance, sound impression, spelling, design, and to the divergent underlying goods and services provided by Applicant and Opposer. In addition, the SKOUT Mark has additional terms, which create a different commercial impression in the minds of consumers.

CONCLUSION

WHEREFORE, Applicant respectfully requests that the Board enter an Order granting Applicant's Motion to Dismiss, or in the alternative, granting this Motion entering summary judgment against Opposer to the extent and for the reasons set forth above, dismissing the Notice of Opposition with prejudice as a matter of law, and granting such other and further relief as the Board deems just and proper.

Dated: New York, NY

July 18, 2019

Respectfully submitted,
HAUG PARTNERS LLP

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CERTIFICATE OF SERVICE

I hereby certify that on this 18th day of July, 2019, a true and correct copy of the foregoing document was served by e-mailing a copy to Opposer's Attorney of Record, Amanda K. Greenspon, at the address of ttab@munckwilson.com, as required by the Trademark Trial and Appeal Board.

/s/ Ben Natter
Ben Natter