

ESTTA Tracking number: **ESTTA1027621**

Filing date: **01/08/2020**

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	DigiCert, Inc.
Granted to Date of previous extension	01/08/2020
Address	2801 NORTH THANKSGIVING WAY; SUITE 500 LEHI, UT 84043 UNITED STATES

Correspondence information	DEBORAH A. GUBERNICK SNELL & WILMER LLP 600 ANTON BLVD., SUITE 1400 COSTA MESA, CA 92626 UNITED STATES ipocdocket@swlaw.com, dgubernick@swlaw.com, tmdocket@swlaw.com 714-427-7000
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**Applicant Information**

Application No	88353418	Publication date	09/10/2019
Opposition Filing Date	01/08/2020	Opposition Period Ends	01/08/2020
Applicant	Thawd, Inc. 9229 122nd Court N.E., C127 Kirkland, WA 98033 UNITED STATES		

**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: Downloadable computer software for use in social networking by enabling the uploading, posting, showing, displaying, tagging of images and communication, and also enabling blogging, communicating, and sharing of electronic media or information over the Internet or other communications network among users; downloadable computer software for social networking by users and for interacting with online communities; downloadable software for creating and managing a social networking page, and for interacting with an online community; downloadable software for use in organizing events, searching for events, calendaring and managing events; downloadable mobile application software for use in social networking for creating, editing, uploading, downloading, accessing, viewing, posting, displaying, tagging, blogging, streaming, linking, annotating, indicating sentiment about, commenting on, embedding, transmitting, and sharing of electronic media or information by users via a computer, the internet, and communication networks; downloadable computer application software for modifying and enabling transmission of images, audio, audio visual and video content and data; downloadable computer software for sending and receiving electronic messages, alerts, notifications and reminders; downloadable computer and</p>
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mobile application software for planning activities with other users and making recommendations; downloadable computer software for creating, managing and accessing social media groups within virtual communities; downloadable computer and mobile application software for performing location-based searching and receiving related alerts; downloadable computer and mobile application software for viewing and interacting on social media feeds of images, audio-visual and video content, and associated text and data; downloadable computer and mobile application software for use in creating and managing social media profiles and user accounts; downloadable computer and mobile application software for use in uploading, downloading, streaming, archiving, transmitting, and sharing of images, audio-visual and video content and associated text and data on social media pages; downloadable computer and mobile application software for use in taking and editing photographs and recording and editing videos; downloadable mobile application software for sending and receiving electronic messages, graphics, images, audio and audiovisual content among users via the internet and communication networks; downloadable mobile application software for use in allowing users to participate in social networking websites

Class 042. First Use: 0 First Use In Commerce: 0


All goods and services in the class are opposed, namely: Providing on-line non-downloadable computer software for use in social networking by enabling the uploading, posting, showing, displaying, and tagging of images and communication and also enabling blogging, communicating, and sharing of electronic media or information over the Internet or other communications network among users; providing on-line non-downloadable computer software for social networking by users and for interacting with online communities; providing on-line non-downloadable software for creating and managing a social networking page, and for interacting with an online community; providing on-line non-downloadable software for use in organizing events, searching for events, calendaring and managing events; providing on-line non-downloadable software for use in social networking for creating, editing, uploading, downloading, accessing, viewing, posting, displaying, tagging, blogging, streaming, linking, annotating, indicating sentiment about, commenting on, embedding, transmitting, and sharing of electronic media or information by users via a computer, the internet, and communication networks; providing on-line non-downloadable computer software for modifying and enabling transmission of images, audio, audio visual and video content and data; providing on-line non-downloadable computer software for sending and receiving electronic messages, alerts, notifications and reminders; providing on-line non-downloadable software for planning activities with other users and making recommendations; providing on-line non-downloadable computer software for creating, managing and accessing social media groups within virtual communities; providing on-line non-downloadable computer software for performing location-based searching and receiving related alerts; providing on-line non-downloadable computer software for viewing and interacting on social media feeds of images, audio-visual and video content, and associated text and data; providing on-line non-downloadable computer software for use in creating and managing social media profiles and user accounts; providing on-line non-downloadable software for use in uploading, downloading, streaming, archiving, transmitting, and sharing of images, audio-visual and video content and associated text and data on social media pages; providing on-line non-downloadable computer software for use in taking and editing photographs and recording and editing videos; providing on-line non-downloadable computer software for sending and receiving electronic messages, graphics, images, audio and audio visual content among users via the internet and communication networks; providing on-line non-downloadable computer software for use in allowing users to participate in social networking websites


## 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.	3159438	Application Date	04/27/2004
Registration Date	10/17/2006	Foreign Priority Date	NONE
Word Mark	THAWTE		

Design Mark	
Description of Mark	NONE
Goods/Services	<p>Class 009. First use: First Use: 1996/07/12 First Use In Commerce: 1996/07/12  Computer software in the field of cryptographic network security and data security functions; computer software for integration of information logic and data between computer networks; computer software for automating a process for authentication of identity using existing databases in connection with the issuance and management of digital certificates used for authentication or encryption of digital communications, or authentication of a digital signature in an electronic transaction or communication, over the Internet and other computer networks; computer software, namely encryption software to enable secure transmission of digital information, namely, confidential, financial and credit card information over the Internet as well as over other modes of communication between computing devices; computer software to integrate managed security services, namely public key infrastructure (PKI) services, digital certificate issuance, verification, and management, and enterprise software integration, with existing communications networks, software, and services, downloadable electronic publications in the nature of a newsletter in the field of information technology</p> <p>Class 036. First use: First Use: 1996/07/12 First Use In Commerce: 1996/07/12  [ Financial services, namely, providing financial transaction processing services by electronic means via the Internet and other computer networks in the field of electronic fund transfer and payment processing services; financial management services for electronic delivery, processing and transfer of funds, payments, financial transactions and financial information via the Internet and other computer networks ]</p> <p>Class 042. First use: First Use: 1996/07/12 First Use In Commerce: 1996/07/12  Providing authentication of identity; issuance and management of digital certificates for authentication or encryption of a digital communication, or authentication of a digital signature in an electronic transaction or communication, over the Internet and other computer network and providing technical and customer support in connection therewith; computer related services, namely, managed computer network and Internet security services, namely, public key infrastructure ("PKI") verification, authentication, distribution and management, digital certificate issuance, verification and management, and enterprise software integration</p>

U.S. Registration No.	3060762	Application Date	04/27/2004
Registration Date	02/21/2006	Foreign Priority Date	NONE
Word Mark	THAWTE		
Design Mark			
Description of	NONE		

Mark	
Goods/Services	<p>Class 009. First use: First Use: 1997/02/00 First Use In Commerce: 1997/02/00  Computer software in the field of cryptographic network security and data security functions; computer software for integration of information logic and data between computer networks; computer software for automating a process for authentication of identity using existing databases in connection with the issuance and management of digital certificates used for authentication or encryption of digital communications, or authentication of a digital signature in an electronic transaction or communication, over the Internet and other computer networks; computer software, namely encryption software to enable secure transmission of digital information, namely, confidential, financial and credit card information over the Internet as well as over other modes of communication between computing devices; computer software to integrate managed security services, namely public key infrastructure (PKI) services, digital certificate issuance, verification, and management, and enterprise software integration, with existing communications networks, software, and services, downloadable electronic publications in the nature of a newsletter in the field of information technology</p> <p>Class 036. First use: First Use: 1997/02/00 First Use In Commerce: 1997/02/00  [ Financial services, namely, providing financial transaction processing services by electronic means via the Internet and other computer networks in the field of electronic fund transfer and payment processing services; financial management services for electronic delivery, processing and transfer of funds, payments, financial transactions and financial information via the Internet and other computer networks ]</p> <p>Class 042. First use: First Use: 1997/02/00 First Use In Commerce: 1997/02/00  Providing authentication of identity; issuance and management of digital certificates for authentication or encryption of a digital communication, or authentication of a digital signature in an electronic transaction or communication, over the Internet and other computer network and providing technical and customer support in connection therewith; computer related services, namely, managed computer network and Internet security services, namely, public key infrastructure ("PKI") verification, authentication, distribution and management, digital certificate issuance, verification and management, and enterprise software integration</p>

U.S. Registration No.	2648941	Application Date	08/17/2001
Registration Date	11/12/2002	Foreign Priority Date	NONE
Word Mark	THAWTE		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 009. First use: First Use: 1996/09/01 First Use In Commerce: 1996/09/01 Computer software, namely, encryption software sold to individuals and businesses to enable secure transmission of digital information, namely, confidential,		

	financial and credit card information over the global computer network as well as over other modes of communication between computing devices
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Attachments	76588972#TMSN.png( bytes ) 76588970#TMSN.png( bytes ) 76301916#TMSN.png( bytes ) thawd.pdf(35588 bytes )
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Signature	/dag/
Name	DEBORAH A. GUBERNICK
Date	01/08/2020

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

In the matter of:

DigiCert, Inc.,

a Utah corporation,

Opposer,

v.

Thawd, Inc.,

a Delaware corporation,

Applicant.

**NOTICE OF OPPOSITION**

Opposition No.: \_\_\_\_\_

Application No.: 88/353418

Published: September 10, 2019

**NOTICE OF OPPOSITION**

DigiCert, Inc. (“Opposer”), a Utah corporation, having a business address at 2801 N. Thanksgiving Way, Suite 500, Lehi, Utah 84043 believes that it is being and will continue to be damaged by Application No. 88/353418 (the “Application”), filed by Thawd, Inc. (“Applicant”), having an address at 9229 122<sup>nd</sup> Court N.E., C127, Kirkland, Washington 98033. Opposer hereby files this Notice of Opposition pursuant to Section 13 of the Trademark Act (15 U.S.C. § 1063).

As grounds for Opposition, Opposer alleges as follows:

1. Opposer owns three valid trademark registrations for THAWTE on file with the U.S. Patent and Trademark Office for goods and services in Class 09 and Class 42 (hereinafter the “Registered Marks”) as described below:

Trademark	Goods/Services	Registration Number/ Registration Date
<p><b><i>thawte</i></b></p>	<p>Computer software in the field of cryptographic network security and data security functions; computer software for integration of information logic and data between computer networks; computer software for automating a process for authentication of identity using existing databases in connection with the issuance and management of digital certificates used for authentication or encryption of digital communications, or authentication of a digital signature in an electronic transaction or communication, over the Internet and other computer networks; computer software, namely encryption software to enable secure transmission of digital information, namely, confidential, financial and credit card information over the Internet as well as over other modes of communication between computing devices; computer software to integrate managed security services, namely public key infrastructure (PKI) services, digital certificate issuance, verification, and management, and enterprise software integration, with existing communications networks, software, and services, downloadable electronic publications in the nature of a newsletter in the field of information technology in Class 09 and Providing authentication of identity; issuance and management of digital certificates for authentication or encryption of a digital communication, or authentication of a digital signature in an electronic transaction or communication, over the Internet and other computer network and providing technical and customer support in connection therewith; computer related services, namely, managed computer network and Internet security services, namely, public key infrastructure ("PKI") verification, authentication, distribution and management, digital certificate issuance, verification and management, and enterprise software integration in Class 42</p>	<p>3159438 Registered October 17, 2006</p>
<p><b>THAWTE</b></p>	<p>Computer software in the field of cryptographic network security and data security functions; computer software for integration of information logic and data between computer networks; computer software for automating a process for authentication of identity using existing databases in connection with the issuance and management of digital certificates used for authentication or encryption of digital communications, or authentication of a digital signature in an electronic transaction or communication, over the Internet and other computer networks; computer software, namely encryption software to enable secure transmission of digital information, namely, confidential, financial and credit card</p>	<p>3060762 Registered February 21, 2006</p>

	<p>information over the Internet as well as over other modes of communication between computing devices; computer software to integrate managed security services, namely public key infrastructure (PKI) services, digital certificate issuance, verification, and management, and enterprise software integration, with existing communications networks, software, and services, downloadable electronic publications in the nature of a newsletter in the field of information technology in Class 09 and</p> <p>Providing authentication of identity; issuance and management of digital certificates for authentication or encryption of a digital communication, or authentication of a digital signature in an electronic transaction or communication, over the Internet and other computer network and providing technical and customer support in connection therewith; computer related services, namely, managed computer network and Internet security services, namely, public key infrastructure ("PKI") verification, authentication, distribution and management, digital certificate issuance, verification and management, and enterprise software integration in Class 42</p>	
THAWTE	<p>Computer software, namely, encryption software sold to individuals and businesses to enable secure transmission of digital information, namely, confidential, financial and credit card information over the global computer network as well as over other modes of communication between computing devices in Class 09</p>	<p>2648941</p> <p>Registered November 12, 2002</p>

2. The Registered Marks have been in use long before Applicant filed the above application.

3. The Registered Marks have achieved incontestable status by way of the USPTO accepting its Combined Declaration of Use and Incontestability under Sections 8 & 15.

4. The Registered Marks cover goods/services in Classes 9 and 42 -- the same Classes included in the Application.

5. Opposer's Registered Marks are valid, unrevoked, and in full force and effect.

6. Through longstanding use, Opposer also owns common law trademark rights in and to THAWTE.

7. Opposer offers its services online and in manners customary to the trust-industry trade, online, and in the software context and has continuously done so long before the Application was filed.



8. Opposer owns the goodwill and reputation connected with and symbolized by the Registered Marks.

9. Long after Opposer's first use of Opposer's Registration, Applicant applied to register the Application for THAWD shown below:

Trademark	Goods/Services	Application No./Filing Date
THAWD	Downloadable computer software for use in social networking by enabling the uploading, posting, showing, displaying, tagging of images and communication, and also enabling blogging, communicating, and sharing of electronic media or information over the Internet or other communications network among users; downloadable computer software for social networking by users and for interacting with online communities; downloadable software for creating and managing a social networking page, and for interacting with an online community; downloadable software for use in organizing events, searching for events, calendaring and managing events; downloadable mobile application software for use in social networking for creating, editing, uploading, downloading, accessing, viewing, posting, displaying, tagging, blogging, streaming, linking, annotating, indicating sentiment about, commenting on, embedding, transmitting, and sharing of electronic media or information by users via a computer, the internet, and communication networks; downloadable computer application software for modifying and enabling transmission of images, audio, audio visual and video content and data; downloadable computer software for sending and receiving electronic messages, alerts, notifications and reminders; downloadable computer and mobile application software for planning activities with other users and making recommendations; downloadable computer software for creating, managing and accessing social media groups within virtual communities; downloadable computer and mobile application software for performing location-based searching and receiving related alerts; downloadable computer and mobile application software for viewing and interacting on social media feeds of images, audio-visual and video content, and associated text and data; downloadable computer and mobile application software for use in creating and managing social media profiles and user accounts; downloadable computer and mobile application software for use in uploading, downloading, streaming, archiving, transmitting, and sharing of images, audio-visual and video content and associated text and data on social media pages; downloadable computer and mobile application software for use in taking and editing photographs and recording and editing videos; downloadable mobile application software for sending and receiving electronic messages, graphics, images, audio and audio visual content among users via the internet and communication networks; downloadable mobile application software for use in allowing users to participate in social networking websites in Class 09 and Providing on-line non-downloadable computer software for	Application No. 88353418 Filing Date: March 23, 2019

	<p>use in social networking by enabling the uploading, posting, showing, displaying, and tagging of images and communication and also enabling blogging, communicating, and sharing of electronic media or information over the Internet or other communications network among users; providing on-line non-downloadable computer software for social networking by users and for interacting with online communities; providing on-line non-downloadable software for creating and managing a social networking page, and for interacting with an online community; providing on-line non-downloadable software for use in organizing events, searching for events, calendaring and managing events; providing on-line non-downloadable software for use in social networking for creating, editing, uploading, downloading, accessing, viewing, posting, displaying, tagging, blogging, streaming, linking, annotating, indicating sentiment about, commenting on, embedding, transmitting, and sharing of electronic media or information by users via a computer, the internet, and communication networks; providing on-line non-downloadable computer software for modifying and enabling transmission of images, audio, audio visual and video content and data; providing on-line non-downloadable computer software for sending and receiving electronic messages, alerts, notifications and reminders; providing on-line non-downloadable software for planning activities with other users and making recommendations; providing on-line non-downloadable computer software for creating, managing and accessing social media groups within virtual communities; providing on-line non-downloadable computer software for performing location-based searching and receiving related alerts; providing on-line non-downloadable computer software for viewing and interacting on social media feeds of images, audio-visual and video content, and associated text and data; providing on-line non-downloadable computer software for use in creating and managing social media profiles and user accounts; providing on-line non-downloadable software for use in uploading, downloading, streaming, archiving, transmitting, and sharing of images, audio-visual and video content and associated text and data on social media pages; providing on-line non-downloadable computer software for use in taking and editing photographs and recording and editing videos; providing on-line non-downloadable computer software for sending and receiving electronic messages, graphics, images, audio and audio visual content among users via the internet and communication networks; providing on-line non-downloadable computer software for use in allowing users to participate in social networking websites in Class 42</p>	
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10. The mark in the Application is substantially similar to Opposer’s Registered Marks, covering the same Classes of goods/services.

11. The Application was published for opposition on September 10, 2019.

12. Opposer’s Registered Marks pre-date the Application and any use or intention to use the mark shown therein, affording Opposer priority.

13. Based on the substantially similar nature of the marks covering the same Classes of goods/services, the purchasing public is likely to falsely associate Applicant's goods with Opposer, or may erroneously believe the goods offered under the mark shown in the Application are sponsored, licensed, or otherwise endorsed and/or authorized by or affiliated with Opposer.

WHEREFORE, Opposer prays that Application No. 88/353418 be denied registration and that this Notice of Opposition be granted in favor of Opposer.

Opposer hereby appoints Deborah A. Gubernick, Esq. of the law firm Snell & Wilmer, member of the bar of the State of California, to act as attorney for Opposer, with full power to prosecute the underlying Opposition, to transact all relevant business with the United States Patent and Trademark Office and in the United States Courts, and to receive all official communications in connection with this Consolidated Notice of Opposition.

Respectfully submitted,

SNELL & WILMER L.L.P.

Dated: January 8, 2020

By: /Deborah A. Gubernick/

Deborah A. Gubernick

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Attorneys for Opposer, DigiCert, Inc

**CERTIFICATE OF SERVICE/ELECTRONIC SERVICE**

I hereby certify that a true and complete copy of the foregoing NOTICE OF OPPOSITION against Application Number 88/353418 is being served on the Applicant's attorney of record via electronic mail to the correspondent email listed on the records of the United States Patent and Trademark Office:

Lucas S. Michels  
2311 N. 45<sup>th</sup> Street  
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[trademarks@ironmarklaw.com](mailto:trademarks@ironmarklaw.com)

I declare under penalty of perjury under the laws of the United States of America that the foregoing is true and correct, and that this Certificate is executed on January 8, 2020.

/Deborah A. Gubernick/  
Deborah A. Gubernick