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

Proceeding	91267155
Party	Defendant Entrust Datacard Corporation
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Attachments	2021-02-25 Commvault Answer.pdf(124633 bytes)

Registrations Subject to the filing

Registration No.	5286814	Registration date	09/12/2017
Registrant	COMMVault SYSTEMS, INC. 1 COMMVault WAY TINTON FALLS, NJ 07724 UNITED STATES		

Goods/Services Subject to the filing

Class 042. First Use: 2015/07/14 First Use In Commerce: 2015/07/31

All goods and services in the class are requested, namely: Computer programming for others; computer consultation; computer software design for others; computer software development for others; computer software development in the field of mobile applications; computer monitoring services which track software performance and processes and send out historical reports and alerts, and providing back-up computer programs and facilities; integration of computer systems and networks; customization of computer hardware and software for endusers; consulting services in the field of cloud computing; design, deployment and management of wireless networks for others; electronic data storage; temporary electronic storage of information and data; technical support, namely, providing computer facilities for the electronic storage of digital data; providing a web-based system and on-line portal for others to download information about data management software in the nature of software documentation, company-produced informational material and information regarding technical issues; technical consulting services in the fields of datacenter architecture, public and private cloud computing solutions, and evaluation and implementation of internet technology and services; technical support services, namely, remote and on-site infrastructure management services for monitoring, administration and management of public and private cloud computing IT and application systems; computer security services, namely, enforcing, restricting and controlling access privileges of users of

computing resources for cloud, mobile or network resources; Providing temporary use of online non-downloadable computer software for use in data backup, data protection, data replication, and disaster recovery; providing temporary use of online non-downloadable computer software for use in monitoring computer performance, computer configuration, and change management for physical, virtual, cloud, and hybrid computer environments; providing temporary use of online non-downloadable computer software for data backup, data protection, data replication, disaster recovery and performance management in data centers, virtual machines, servers, desktops, and virtualization performance management; providing temporary use of online non-downloadable computer software for use in automation and monitoring of physical and virtual computers; computer security services, namely, enforcing, restricting and controlling access privileges of users of computing resources for cloud resources based on assigned credentials; Computer services, namely, integration of private and public cloud computing environments; Consulting services in the field of cloud computing technology, infrastructure-as-a-service (IAAS) cloud computing technology, software-as-a-service (SAAS) cloud computing technology, and platform-as-a-service (PAAS) cloud computing technology; Providing virtual computer systems and virtual computer environments through cloud computing; application service provider (ASP), namely, hosting computer software applications of others; cloud computing featuring software for use in creating web applications, data storage and backup, database management, virtualization, networking, collaboration, remote access, remote support, cloud computing, data sharing, data security, and access, administration and management of computer applications and computer hardware, and computer application distribution; computer services, namely, creating cloud-based indexes of information

Registration No.	5286815	Registration date	09/12/2017
Registrant	COMMVAULT SYSTEMS, INC. 1 COMMVAULT WAY TINTON FALLS, NJ 07724 UNITED STATES		

Goods/Services Subject to the filing

Class 042. First Use: 2015/07/14 First Use In Commerce: 2015/07/31

All goods and services in the class are requested, namely: Computer programming for others; computer consultation; computer software design for others; computer software development for others; computer software development in the field of mobile applications; computer monitoring services which track software performance and processes and send out historical reports and alerts, and providing back-up computer programs and facilities; integration of computer systems and networks; customization of computer hardware and software for endusers; consulting services in the field of cloud computing; design, deployment and management of wireless networks for others; electronic data storage; temporary electronic storage of information and data; technical support, namely, providing computer facilities for the electronic storage of digital data; providing a web-based system and online portal for others to download information about data management software in the nature of software documentation, company-produced informational material and information regarding technical issues; technical consulting services in the fields of datacenter architecture, public and private cloud computing solutions, and evaluation and implementation of internet technology and services; technical support services, namely, remote and on-site infrastructure management services for monitoring, administration and management of public and private cloud computing IT and application systems; computer security services, namely, enforcing, restricting and controlling access privileges of users of computing resources for cloud, mobile or network resources; Providing temporary use of online non-downloadable computer software for use in data backup, data protection, data replication, and disaster recovery; providing temporary use of online non-downloadable computer software for use in monitoring computer performance, computer configuration, and change management for physical, virtual, cloud, and hybrid computer environments; providing temporary use of online non-downloadable computer software for data backup, data protection, data replication, disaster recovery and performance management in data centers, virtual machines, servers, desktops, and virtualization performance management; providing temporary use of online non-downloadable computer software for use in automation and monitoring of physical and virtual computers; computer security services, namely, enforcing, restricting and controlling access privileges of users of computing resources for cloud resources based on assigned credentials; Computer services, namely, integration of private and public cloud computing environments; Consulting services in the field of cloud computing technology, infrastructure-as-a-service (IAAS) cloud computing technology, software-as-a-service (SAAS)

cloud computing technology, and platform-as-a-service (PAAS) cloud computing technology; Providing virtual computer systems and virtual computer environments through cloud computing; application service provider (ASP), namely, hosting computer software applications of others; cloud computing featuring software for use in creating web applications, data storage and backup, database management, virtualization, networking, collaboration, remote access, remote support, cloud computing, data sharing, data security, and access, administration and management of computer applications and computer hardware, and computer application distribution; computer services, namely, creating cloud-based indexes of information			
Registration No.	5286816	Registration date	09/12/2017
Registrant	COMMVault SYSTEMS, INC. 1 COMMVault WAY TINTON FALLS, NJ 07724 UNITED STATES		

Goods/Services Subject to the filing

Class 009. First Use: 2015/07/14 First Use In Commerce: 2015/07/31 All goods and services in the class are requested, namely: Computer hardware; computer peripheral devices; computer software for information document and data storage, back-up and retrieval, namely, to access, retrieve, manage, and recover data stored on magnetic disk, tape, and other forms of electronic storage of data; computer software for use in systems management; computer software for use in data storage management and storage area networks; computer software and hardware for use in datacommunications; computer software for backing up and restoring computer data; computer software for use in disaster recovery; computer software for use in removable storage media management; computersoftware for use in the field of enterprise data and information management; computer software for use in searching enterprise data; computer software for generating reports from databases; computer software for use in the central management of computers attached to a computer network; computer software for replicating and archiving files from one data store to another; computer software for use in developing data analysis applicationsand data analysis computer software; computer software for monitoring, analyzing, reporting and solving performance and data availability issues of applicationsoftware, databases, network, storage, computer hardware, and computer peripherals; computer software for data and storage management namely, to back-up, retrieve, recover, replicate, migrate, archive and manage resources; publications in electronic form, downloadable via computer, communication networks, and the internet, namely, work books, quick reference guides, technical reference manuals, user manuals, and evaluation guides in the field of computers, computer software,computer peripherals, and computer networks. computer software for connecting to and use of a remote computer network, a remote computer and mobile devices; software for facilitating computer use at remote locations and for facilitating communications among mobile users over networks; computer software for cloud computing, data sharing, data security, and access, administration and management of computer applications and computer hardware, computer application distribution; downloadable computer software for use in data backup, data protection, data replication, and disaster recovery; downloadable computer software for use in monitoring computer performance, computer configuration, and change management for physical, virtual, cloud, and hybrid computer environments; downloadable computer software for data backup, data protection, data replication, disaster recovery and performance management in data centers, virtual machines, servers, desktops; downloadable computer software for use in automation and monitoring of physical and virtual computers; and instruction manuals sold as a unit with the foregoinggoods			
Registration No.	5286817	Registration date	09/12/2017
Registrant	COMMVault SYSTEMS, INC. 1 COMMVault WAY TINTON FALLS, NJ 07724 UNITED STATES		

Goods/Services Subject to the filing

Class 009. First Use: 2015/07/14 First Use In Commerce: 2015/07/31 All goods and services in the class are requested, namely: Computer hardware; computer peripheral devices; computer software for information document and data storage, back-up and retrieval,			
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namely, to access, retrieve, manage, and recover data stored on magnetic disk, tape, and other forms of electronic storage of data; computer software for use in systems management; computer software for use in data storage management and storage area networks; computer software and hardware for use in datacommunications; computer software for backing up and restoring computer data; computer software for use in disaster recovery; computer software for use in removable storage media management; computersoftware for use in the field of enterprise data and information management; computer software for use in searching enterprise data; computer software for generating reports from databases; computer software for use in the central management of computers attached to a computer network; computer software for replicating and archiving files from one data store to another; computer software for use in developing data analysis applicationsand data analysis computer software; computer software for monitoring, analyzing, reporting and solving performance and data availability issues of applicationsoftware, databases, network, storage, computer hardware, and computer peripherals; computer software for data and storage management namely, to back-up, retrieve, recover, replicate, migrate, archive and manage resources; publications in electronic form, downloadable via computer, communication networks, and the internet, namely, work books, quick reference guides, technical reference manuals, user manuals, and evaluation guides in the field of computers, computer software, computer peripherals, and computer networks. computer software for connecting to and use of a remote computer network, a remote computer and mobile devices; software for facilitating computer use at remote locations and for facilitating communications among mobile users over networks; computer software for cloud computing, data sharing, data security, and access, administration and management of computer applications and computer hardware, computer application distribution; downloadable computer software for use in data backup, data protection, data replication, and disaster recovery; downloadable computer software for use in monitoring computer performance, computer configuration, and change management for physical, virtual, cloud, and hybrid computer environments; downloadable computer software for data backup, data protection, data replication, disaster recovery and performance management in data centers, virtual machines, servers, desktops; downloadable computer software for use in automation and monitoring of physical and virtual computers; and instruction manuals sold as a unit with the foregoinggoods

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

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Commvault Systems, Inc.,)	
)	
)	
Opposer,)	Opposition No. 91267155
)	
v.)	
)	
Entrust Datacard Corporation,)	
f/k/a/ Entrust Datacard Corporation)	
)	
Applicant.)	
_____)	

**APPLICANT’S ANSWER, AFFIRMATIVE DEFENSES,
AND COUNTERCLAIMS TO NOTICE OF OPPOSITION**

Applicant, Entrust Corporation, f/k/a/ Entrust Datacard Corporation (“Applicant”), hereby sets forth its Answer, Affirmative Defenses, and Counterclaims to the Notice of Opposition of Commvault Systems, Inc. (“Opposer”), and responds as follows:

Regarding the allegations contained in the preamble of the Notice of Opposition, Applicant denies that Opposer will be damaged by the registration of Application Serial No. 88/790,292 for the Entrust and Design Mark, as the foregoing mark is not confusingly similar to any of Opposer’s asserted marks.

ANSWER

1. Applicant is without knowledge and information sufficient to form a belief as to the allegations contained in Paragraph 1 of the Notice of Opposition and therefore denies same, leaving Opposer to strict proof thereof.

2. Applicant admits the allegations of Paragraph 2.

3. Applicant is without knowledge and information sufficient to form a belief as to the allegations contained in Paragraph 3 of the Notice of Opposition and therefore denies same, leaving Opposer to strict proof thereof.

4. Applicant is without knowledge and information sufficient to form a belief as to the allegations contained in Paragraph 4 of the Notice of Opposition and therefore denies same, leaving Opposer to strict proof thereof.

5. Admitted to the extent that the records of the U.S. Patent and Trademark Office show that Opposer is listed as the owner of Registration Nos. 5286814, 5286815, 5286816, 5286818, 5286819 and 5286817.

6. Applicant is without knowledge and information sufficient to form a belief as to the allegations contained in Paragraph 6 of the Notice of Opposition and therefore denies same, leaving Opposer to strict proof thereof.

7. Applicant is without knowledge and information sufficient to form a belief as to the allegations contained in Paragraph 6 of the Notice of Opposition and therefore denies same, leaving Opposer to strict proof thereof. Opposer's use and/or registration of its alleged marks outside of the United States is irrelevant to the issue of whether the registration of Applicant's mark would cause confusion in the United States.

8. Applicant is without knowledge and information sufficient to form a belief as to the allegations contained in Paragraph 8 of the Notice of Opposition and therefore denies same, leaving Opposer to strict proof thereof.

9. Denied. Opposer's asserted marks are fully distinguishable from the mark of Application Serial No. 88790292, and thus, there was never any need for Applicant to obtain permission from Opposer for the use and registration of the applied for mark.

10. Admitted that Applicant is the record owner of the subject Application.
11. Admitted that Applicant filed the subject Application on an intent-to-use basis on February 8, 2020.
12. Admitted that the subject Application was published for opposition on September 22, 2020, and Opposer requested and was granted an extension of the Opposition deadline until January 20, 2021.
13. Applicant is without knowledge and information sufficient to form a belief as to the allegations contained in Paragraph 13 of the Notice of Opposition and therefore denies same, leaving Opposer to strict proof thereof.
14. Applicant is without knowledge and information sufficient to form a belief as to the allegations contained in Paragraph 14 of the Notice of Opposition and therefore denies same, leaving Opposer to strict proof thereof.
15. Applicant is without knowledge and information sufficient to form a belief as to the allegations contained in Paragraph 15 of the Notice of Opposition and therefore denies same, leaving Opposer to strict proof thereof.
16. Applicant denies each and every allegation contained in Paragraph 16 of the Notice of Opposition.
17. Applicant denies each and every allegation contained in Paragraph 17 of the Notice of Opposition.
18. Applicant denies each and every allegation contained in Paragraph 18 of the Notice of Opposition.
19. Applicant denies each and every allegation contained in Paragraph 19 of the Notice of Opposition.

20. Applicant denies each and every allegation contained in Paragraph 20 of the Notice of Opposition.

21. Applicant denies each and every allegation contained in Paragraph 21 of the Notice of Opposition.

22. Applicant denies each and every allegation contained in Paragraph 22 of the Notice of Opposition.

FIRST AFFIRMATIVE DEFENSE

23. The Notice of Opposition fails to state a cause of action upon which relief may be granted in law or equity.

SECOND AFFIRMATIVE DEFENSE

24. The extensive amount of third party use and registration of marks depicting hexagonal designs precludes Opposer from claiming the exclusive right to use and registration of a hexagonal design mark.

THIRD AFFIRMATIVE DEFENSE

25. Applicant reserves the right to raise additional affirmative defenses and to supplement those asserted herein upon discovery of further information and investigation into the Opposer's claims.

COUNTERCLAIM – PETITIONS FOR CANCELLATION

ENTRUST CORPORATION (hereinafter “Applicant/Petitioner”) alleges the following Counterclaims against COMMVault SYSTEMS, INC. (“Opposer/Respondent”), on knowledge as to their own acts and otherwise on information and belief as follows.

NATURE OF COUNTERCLAIM

26. This Counterclaim arises from Opposer/Respondent's assertion of proprietary trademark rights based upon its ownership of trademark registrations for the mark



which is the subject of Trademark Registration Nos. 5286814 and 5286816 and its lack of actual use and/or lack of the requisite level of *bona fide* intent to use the foregoing mark in connection with all of the goods/services listed in the foregoing Registrations thereby resulting in a misuse of such registrations to wage a campaign of unnecessary and punitive oppositions against others seeking the registration of distinguishable marks also consisting of hexagonal designs.

27. Applicant/Petitioner hereby re-alleges and restates paragraphs 1 - 26 above as if fully set forth herein.

Petition for Cancellation – Registration No. 5286814

28. On July 28, 2015, Opposer/Respondent filed Application Serial No. 86/707214 for the mark



covering services in Class 42 described as:

Software as a service (SAAS) services; platform as a service (PAAS) services; infrastructure as a service (IAAS) services; application service provider, namely, hosting, managing, developing, and maintaining applications, software, hardware and web sites; providing temporary use of on-line non-downloadable cloud computing software; computer programming for others; computer consultation; computer support services, namely, provision of technical assistance and technical support; computer software design for others; computer software development for others; computer software development in the field of mobile applications; developing and managing application software; remote or on-site monitoring of

computer systems; computer monitoring services which track software performance and processes and send out historical reports and alerts, and providing back-up computer programs and facilities; integration of computer systems and networks; customization of computer hardware and software for end users; computer services, namely cloud computing; computer services, namely, cloud hosting provider services; consulting services in the field of cloud computing; design, deployment and management of wireless networks for others; electronic data storage; temporary electronic storage of information and data; technical support, namely, providing computer facilities for the electronic storage of digital data; providing a web-based system and on-line portal for others to download information about data management software in the nature of software documentation, company-produced informational material and information regarding technical issues; technical consulting services in the fields of datacenter architecture, public and private cloud computing solutions, and evaluation and implementation of internet technology and services; technical support services, namely, remote and on-site infrastructure management services for monitoring, administration and management of public and private cloud computing IT and application systems; computer security services, namely, enforcing, restricting and controlling access privileges of users of computing resources for cloud, mobile or network resources; technical consulting services, namely, providing and managing a data center for others; Providing temporary use of online non-downloadable computer software for use in data backup, data protection, data replication, and disaster recovery; providing temporary use of online non-downloadable computer software for use in monitoring computer performance, computer configuration, and change management for physical, virtual, cloud, and hybrid computer environments; providing temporary use of online non-downloadable computer software for data backup, data protection, data replication, disaster recovery and performance management in data centers, virtual machines, servers, desktops, and virtualization performance management; providing temporary use of online non-downloadable computer software for use in automation and monitoring of physical and virtual computers; computer security services, namely, enforcing, restricting and controlling access privileges of users of computing resources for cloud resources based on assigned credentials; Computer services, namely, integration of private and public cloud computing environments; Consulting services in the field of cloud computing technology, infrastructure-as-a-service (IAAS) cloud computing technology, software-as-a-service (SAAS) cloud computing technology, and platform-as-a-service (PAAS) cloud computing technology; Providing virtual computer systems and virtual computer environments through cloud computing; application service provider (ASP), namely, hosting computer software applications of others; cloud computing featuring software for use in creating web applications, data storage and backup, database management, virtualization, networking, collaboration, remote access, remote support, cloud computing, data sharing, data security, and access, administration and management of computer applications and computer hardware, and computer application distribution; computer services, namely, creating cloud-based indexes of information; in Class 42.

29. Upon information and belief, on July 28, 2015, and at the time it filed its Application, Opposer/Respondent lacked the requisite *bona fide* intent to use the mark of Application Serial No. 86/707214 on or in connection with all of the services listed in the Application.

30. On August 3, 2017, Opposer/Respondent filed a Statement of Use and specimens alleging use of the mark in connection with Class 42 services described as:

Computer programming for others; computer consultation; computer software design for others; computer software development for others; computer software development in the field of mobile applications; computer monitoring services which track software performance and processes and send out historical reports and alerts, and providing back-up computer programs and facilities; integration of computer systems and networks; customization of computer hardware and software for end users; consulting services in the field of cloud computing; design, deployment and management of wireless networks for others; electronic data storage; temporary electronic storage of information and data; technical support, namely, providing computer facilities for the electronic storage of digital data; providing a web-based system and on-line portal for others to download information about data management software in the nature of software documentation, company-produced informational material and information regarding technical issues; technical consulting services in the fields of datacenter architecture, public and private cloud computing solutions, and evaluation and implementation of internet technology and services; technical support services, namely, remote and on-site infrastructure management services for monitoring, administration and management of public and private cloud computing IT and application systems; computer security services, namely, enforcing, restricting and controlling access privileges of users of computing resources for cloud, mobile or network resources; Providing temporary use of online nondownloadable computer software for use in data backup, data protection, data replication, and disaster recovery; providing temporary use of online non-downloadable computer software for use in monitoring computer performance, computer configuration, and change management for physical, virtual, cloud, and hybrid computer environments; providing temporary use of online non-downloadable computer software for data backup, data protection, data replication, disaster recovery and performance management in data centers, virtual machines, servers, desktops, and virtualization performance management; providing temporary use of online nondownloadable computer software for use in automation and monitoring of physical and virtual computers; computer security services, namely, enforcing, restricting and controlling access privileges of users of computing resources for cloud resources based on assigned credentials; Computer services, namely, integration of private and public cloud computing

environments; Consulting services in the field of cloud computing technology, infrastructure-as-a-service (IAAS) cloud computing technology, software-as-a-service (SAAS) cloud computing technology, and platform-as-a-service (PAAS) cloud computing technology; Providing virtual computer systems and virtual computer environments through cloud computing; application service provider (ASP), namely, hosting computer software applications of others; cloud computing featuring software for use in creating web applications, data storage and backup, database management, virtualization, networking, collaboration, remote access, remote support, cloud computing, data sharing, data security, and access, administration and management of computer applications and computer hardware, and computer application distribution; computer services, namely, creating cloud-based indexes of information; in Class 42.

31. Upon information and belief, at the time Opposer/Respondent filed its Statement of Use, the mark was not used in commerce as required in 15 U.S.C. § 1051 on or in connection with all of the services listed in the Statement of Use.

32. Upon information and belief, the U.S. Patent and Trademark Office (“USPTO”) relied on the statements made by Opposer/Respondent that the mark was used on or in connection with all of the services recited in Application Serial No. 86/707214 when, on August 11, 2017 it accepted the Statement of Use and thereafter granted registration on September 12, 2017.

33. Upon information and belief, had the USPTO been aware that the mark of Application Serial No. 86/707214 was not in use in commerce on or in connection with all of the services recited therein, it would not have issued Registration No. 5286814.

34. Upon information and belief, since the issuance of Registration No. 5286814, the mark has not been used in interstate commerce on or in connection with all of the Class 42 services listed therein.

35. Upon information and belief, as a result of the misrepresentations made to the USPTO with regard to the owner’s *bona fide* intent to use the mark on all of the recited services of Application Serial No. 86/707214; the lack of actual use of the mark of Application Serial

No. 86/707214 on or in connection with all of the services recited therein at the time of the filing of the Statement of Use and issuance of the Registration; and because the mark of Registration No. 5286814 has not been used on or in connection with all of the services recited therein for at least three years prior to the filing of the instant Counter-claim, the foregoing Registration continues to exist to the detriment of Applicant/Petitioner and should therefore be ordered cancelled or restricted to only those services for which Opposer/Respondent can verify as being in actual use in commerce.

Petition for Cancellation – Registration No. 5286816

36. On July 28, 2015, Opposer/Respondent filed Application Serial No. 86/707227 for the mark



covering goods in Class 9 described as:

Computers; computer hardware; computer peripheral devices; computer software; downloadable computer software; mobile software applications; downloadable mobile software applications; cloud computing software; downloadable cloud computing software; computers and computer software for information document and data storage, back-up and retrieval, namely, to access, retrieve, manage, and recover data stored on magnetic disk, tape, and other forms of electronic storage of data; computer software for use in systems management; computer software for use in data storage management and storage area networks; computer software and hardware for use in data communications; computer software for backing up and restoring computer data; computer software for use in disaster recovery; computer software for use in removable storage media management; computer software for use in the field of enterprise data and information management; computer software for use in searching enterprise data; computer software for generating reports from databases; computer software for use in the central management of computers attached to a computer network; computer software for replicating and archiving files from one data store to another; computer software for use in developing data analysis applications and data analysis computer software; computer software for monitoring, analyzing, reporting and solving performance and data availability issues of application software, databases, network, storage, computer hardware, and computer

peripherals; computer software for data and storage management namely, to back-up, retrieve, recover, replicate, migrate, archive and manage resources; publications in electronic form, on magnetic and optical computer-readable media or downloadable via computer, communication networks, and the internet, namely, work books, quick reference guides, technical reference manuals, user manuals, and evaluation guides in the field of computers, computer software, computer peripherals, and computer networks. computer software for connecting to and use of a remote computer network, a remote computer and mobile devices; software for facilitating computer use at remote locations and for facilitating communications among mobile users over networks; computer software for cloud computing, data sharing, data security, and access, administration and management of computer applications and computer hardware, computer application distribution; downloadable computer software for use in data backup, data protection, data replication, and disaster recovery; downloadable computer software for use in monitoring computer performance, computer configuration, and change management for physical, virtual, cloud, and hybrid computer environments; downloadable computer software for data backup, data protection, data replication, disaster recovery and performance management in data centers, virtual machines, servers, desktops; downloadable computer software for use in automation and monitoring of physical and virtual computers; and instruction manuals sold as a unit with the foregoing goods; in Class 9.

37. Upon information and belief, on July 28, 2015, and at the time it filed its Application, Opposer/Respondent lacked the requisite *bona fide* intent to use the mark of Application Serial No. 86/707227 on or in connection with all of the goods listed in the Application.

38. On August 3, 2017, Opposer/Respondent filed a Statement of Use and specimens alleging use of the mark in connection with Class 9 goods described as:

computer hardware; computer peripheral devices; computer software for information document and data storage, back-up and retrieval, namely, to access, retrieve, manage, and recover data stored on magnetic disk, tape, and other forms of electronic storage of data; computer software for use in systems management; computer software for use in data storage management and storage area networks; computer software and hardware for use in data communications; computer software for backing up and restoring computer data; computer software for use in disaster recovery; computer software for use in removable storage media management; computer software for use in the field of enterprise data and information management; computer software for use in searching enterprise data; computer software for generating reports from databases; computer software for use in the central management of computers attached to a computer network; computer software for replicating and archiving files from one data store to

another; computer software for use in developing data analysis applications and data analysis computer software; computer software for monitoring, analyzing, reporting and solving performance and data availability issues of application software, databases, network, storage, computer hardware, and computer peripherals; computer software for data and storage management namely, to back-up, retrieve, recover, replicate, migrate, archive and manage resources; publications in electronic form, downloadable via computer, communication networks, and the internet, namely, work books, quick reference guides, technical reference manuals, user manuals, and evaluation guides in the field of computers, computer software, computer peripherals, and computer networks. computer software for connecting to and use of a remote computer network, a remote computer and mobile devices; software for facilitating computer use at remote locations and for facilitating communications among mobile users over networks; computer software for cloud computing, data sharing, data security, and access, administration and management of computer applications and computer hardware, computer application distribution; downloadable computer software for use in data backup, data protection, data replication, and disaster recovery; downloadable computer software for use in monitoring computer performance, computer configuration, and change management for physical, virtual, cloud, and hybrid computer environments; downloadable computer software for data backup, data protection, data replication, disaster recovery and performance management in data centers, virtual machines, servers, desktops; downloadable computer software for use in automation and monitoring of physical and virtual computers; and instruction manuals sold as a unit with the foregoing goods; in Class 9.

39. Upon information and belief, at the time Opposer/Respondent filed its Statement of Use, the mark was not used in commerce as required in 15 U.S.C. § 1051 on or in connection with all of the goods listed in the Statement of Use.

40. Upon information and belief, the U.S. Patent and Trademark Office (“USPTO”) relied on the statements made by Opposer/Respondent that the mark was used on or in connection with all of the goods recited in Application Serial No. 86/707227 when, on August 11, 2017 it accepted the Statement of Use and thereafter granted registration on September 12, 2017.

41. Upon information and belief, had the USPTO been aware that the mark of Application Serial No. 86/707227 was not in use in commerce on or in connection with all of the goods recited therein, it would not have issued Registration No. 5286816.

42. Upon information and belief, since the issuance of Registration No. 5286816, the mark has not been used in interstate commerce on or in connection with all of the Class 9 goods listed therein.

43. Upon information and belief, as a result of the misrepresentations made to the USPTO with regard to the owner's *bona fide* intent to use the mark on all of the recited services of Application Serial No. 86/707227; the lack of use of the mark of Application Serial No. 86/707227 on or in connection with all of the goods recited therein at the time of the filing of the Statement of Use and issuance of the Registration; and because the mark of Registration No. 5286816 has not been used on or in connection with all of the goods recited therein for at least three years prior to the filing of the instant Counter-claim, the foregoing Registration continues to exist to the detriment of Applicant/Petitioner and should therefore be ordered cancelled or restricted to only those goods for which Opposer/Respondent can verify as being in actual use in commerce.

Petition for Cancellation – Registration No. 5286817

44. On July 28, 2015, Opposer/Respondent filed Application Serial No. 86/707234 for the mark:



covering goods in Class 9 described as:

Computers; computer hardware; computer peripheral devices; computer software; downloadable computer software; mobile software applications; downloadable mobile software applications; cloud computing software; downloadable cloud computing software; computers and computer software for information document and data storage, back-up and retrieval, namely, to access, retrieve, manage, and recover data stored on magnetic disk, tape, and other forms of electronic storage of data; computer software for use in systems management; computer software for use in data storage management and storage area networks; computer software and hardware for use in data communications; computer

software for backing up and restoring computer data; computer software for use in disaster recovery; computer software for use in removable storage media management; computer software for use in the field of enterprise data and information management; computer software for use in searching enterprise data; computer software for generating reports from databases; computer software for use in the central management of computers attached to a computer network; computer software for replicating and archiving files from one data store to another; computer software for use in developing data analysis applications and data analysis computer software; computer software for monitoring, analyzing, reporting and solving performance and data availability issues of application software, databases, network, storage, computer hardware, and computer peripherals; computer software for data and storage management namely, to back-up, retrieve, recover, replicate, migrate, archive and manage resources; publications in electronic form, on magnetic and optical computer-readable media or downloadable via computer, communication networks, and the internet, namely, work books, quick reference guides, technical reference manuals, user manuals, and evaluation guides in the field of computers, computer software, computer peripherals, and computer networks. computer software for connecting to and use of a remote computer network, a remote computer and mobile devices; software for facilitating computer use at remote locations and for facilitating communications among mobile users over networks; computer software for cloud computing, data sharing, data security, and access, administration and management of computer applications and computer hardware, computer application distribution; downloadable computer software for use in data backup, data protection, data replication, and disaster recovery; downloadable computer software for use in monitoring computer performance, computer configuration, and change management for physical, virtual, cloud, and hybrid computer environments; downloadable computer software for data backup, data protection, data replication, disaster recovery and performance management in data centers, virtual machines, servers, desktops; downloadable computer software for use in automation and monitoring of physical and virtual computers; and instruction manuals sold as a unit with the foregoing goods; in Class 9.

45. Upon information and belief, on July 28, 2015, and at the time it filed its Application, Opposer/Respondent lacked the requisite *bona fide* intent to use the mark of Application Serial No. 86/707234 on or in connection with all of the goods listed in the Application.

46. On August 3, 2017, Opposer/Respondent filed a Statement of Use and specimens alleging use of the mark in connection with Class 9 goods described as:

computer hardware; computer peripheral devices; computer software for information document and data storage, back-up and retrieval, namely, to access, retrieve, manage, and recover data stored on magnetic disk, tape, and other forms of electronic storage of data; computer software for use in systems management; computer software for use in data storage management and storage area networks; computer software and hardware for use in data communications; computer software for backing up and restoring computer data; computer software for use in disaster recovery; computer software for use in removable storage media management; computer software for use in the field of enterprise data and information management; computer software for use in searching enterprise data; computer software for generating reports from databases; computer software for use in the central management of computers attached to a computer network; computer software for replicating and archiving files from one data store to another; computer software for use in developing data analysis applications and data analysis computer software; computer software for monitoring, analyzing, reporting and solving performance and data availability issues of application software, databases, network, storage, computer hardware, and computer peripherals; computer software for data and storage management namely, to back-up, retrieve, recover, replicate, migrate, archive and manage resources; publications in electronic form, downloadable via computer, communication networks, and the internet, namely, work books, quick reference guides, technical reference manuals, user manuals, and evaluation guides in the field of computers, computer software, computer peripherals, and computer networks. computer software for connecting to and use of a remote computer network, a remote computer and mobile devices; software for facilitating computer use at remote locations and for facilitating communications among mobile users over networks; computer software for cloud computing, data sharing, data security, and access, administration and management of computer applications and computer hardware, computer application distribution; downloadable computer software for use in data backup, data protection, data replication, and disaster recovery; downloadable computer software for use in monitoring computer performance, computer configuration, and change management for physical, virtual, cloud, and hybrid computer environments; downloadable computer software for data backup, data protection, data replication, disaster recovery and performance management in data centers, virtual machines, servers, desktops; downloadable computer software for use in automation and monitoring of physical and virtual computers; and instruction manuals sold as a unit with the foregoing goods; in Class 9.

47. Upon information and belief, at the time Opposer/Respondent filed its Statement of Use, the mark was not used in commerce as required in 15 U.S.C. § 1051 on or in connection with all of the goods listed in the Statement of Use.

48. Upon information and belief, the U.S. Patent and Trademark Office (“USPTO”) relied on the statements made by Opposer/Respondent that the mark was used on or in connection with all of the goods recited in Application Serial No. 86/707234 when, on August 11, 2017 it accepted the Statement of Use and thereafter granted registration on September 12, 2017.

49. Upon information and belief, had the USPTO been aware that the mark of Application Serial No. 86/707234 was not in use in commerce on or in connection with all of the goods recited therein, it would not have issued Registration No. 5286817.

50. Upon information and belief, since the issuance of Registration No. 5286817, the mark has not been used in interstate commerce on or in connection with all of the Class 9 goods listed therein.

51. Upon information and belief, as a result of the misrepresentations made to the USPTO with regard to the owner’s *bona fide* intent to use the mark on all of the recited services of Application Serial No. 86/707234; the lack of use of the mark of Application Serial No. 86/707234 on or in connection with all of the goods recited therein at the time of the filing of the Statement of Use and issuance of the Registration; and because the mark of Registration No. 5286817 has not been used on or in connection with all of the goods recited therein for at least three years prior to the filing of the instant Counter-claim, the foregoing Registration continues to exist to the detriment of Applicant/Petitioner and should therefore be ordered cancelled or restricted to only those goods for which Opposer/Respondent can verify as being in actual use in commerce.

Petition for Cancellation – Registration No. 5286815

52. On July 28, 2015, Opposer/Respondent filed Application Serial No. 86/707221

for the mark:



covering services in Class 42 described as:

Software as a service (SAAS) services; platform as a service (PAAS) services; infrastructure as a service (IAAS) services; application service provider, namely, hosting, managing, developing, and maintaining applications, software, hardware and web sites; providing temporary use of on-line non-downloadable cloud computing software; computer programming for others; computer consultation; computer support services, namely, provision of technical assistance and technical support; computer software design for others; computer software development for others; computer software development in the field of mobile applications; developing and managing application software; remote or on-site monitoring of computer systems; computer monitoring services which track software performance and processes and send out historical reports and alerts, and providing back-up computer programs and facilities; integration of computer systems and networks; customization of computer hardware and software for end users; computer services, namely cloud computing; computer services, namely, cloud hosting provider services; consulting services in the field of cloud computing; design, deployment and management of wireless networks for others; electronic data storage; temporary electronic storage of information and data; technical support, namely, providing computer facilities for the electronic storage of digital data; providing a web-based system and on-line portal for others to download information about data management software in the nature of software documentation, company-produced informational material and information regarding technical issues; technical consulting services in the fields of datacenter architecture, public and private cloud computing solutions, and evaluation and implementation of internet technology and services; technical support services, namely, remote and on-site infrastructure management services for monitoring, administration and management of public and private cloud computing IT and application systems; computer security services, namely, enforcing, restricting and controlling access privileges of users of computing resources for cloud, mobile or network resources; technical consulting services, namely, providing and managing a data center for others; Providing temporary use of online non-downloadable computer software for use in data backup, data protection, data replication, and disaster recovery; providing temporary use of online non-downloadable computer software for use in monitoring computer performance, computer configuration, and change management for physical, virtual, cloud, and hybrid computer environments; providing temporary use of online non-downloadable computer software for data backup, data protection, data replication, disaster recovery and performance management in data centers, virtual machines, servers, desktops, and virtualization performance management; providing temporary use of online non-downloadable computer software for use

in automation and monitoring of physical and virtual computers; computer security services, namely, enforcing, restricting and controlling access privileges of users of computing resources for cloud resources based on assigned credentials; Computer services, namely, integration of private and public cloud computing environments; Consulting services in the field of cloud computing technology, infrastructure-as-a-service (IAAS) cloud computing technology, software-as-a-service (SAAS) cloud computing technology, and platform-as-a-service (PAAS) cloud computing technology; Providing virtual computer systems and virtual computer environments through cloud computing; application service provider (ASP), namely, hosting computer software applications of others; cloud computing featuring software for use in creating web applications, data storage and backup, database management, virtualization, networking, collaboration, remote access, remote support, cloud computing, data sharing, data security, and access, administration and management of computer applications and computer hardware, and computer application distribution; computer services, namely, creating cloud-based indexes of information; in Class 42.

53. Upon information and belief, on July 28, 2015, and at the time it filed its Application, Opposer/Respondent lacked the requisite *bona fide* intent to use the mark of Application Serial No. 86/707221 on or in connection with all of the services listed in the Application.

54. On August 3, 2017, Opposer/Respondent filed a Statement of Use and specimens alleging use of the mark in connection with Class 42 services described as:

Computer programming for others; computer consultation; computer software design for others; computer software development for others; computer software development in the field of mobile applications; computer monitoring services which track software performance and processes and send out historical reports and alerts, and providing back-up computer programs and facilities; integration of computer systems and networks; customization of computer hardware and software for end users; consulting services in the field of cloud computing; design, deployment and management of wireless networks for others; electronic data storage; temporary electronic storage of information and data; technical support, namely, providing computer facilities for the electronic storage of digital data; providing a web-based system and on-line portal for others to download information about data management software in the nature of software documentation, company-produced informational material and information regarding technical issues; technical consulting services in the fields of datacenter architecture, public and private cloud computing solutions, and evaluation and implementation of internet technology and services; technical support services, namely, remote and on-site infrastructure management services for monitoring,

administration and management of public and private cloud computing IT and application systems; computer security services, namely, enforcing, restricting and controlling access privileges of users of computing resources for cloud, mobile or network resources; Providing temporary use of online non-downloadable computer software for use in data backup, data protection, data replication, and disaster recovery; providing temporary use of online non-downloadable computer software for use in monitoring computer performance, computer configuration, and change management for physical, virtual, cloud, and hybrid computer environments; providing temporary use of online non-downloadable computer software for data backup, data protection, data replication, disaster recovery and performance management in data centers, virtual machines, servers, desktops, and virtualization performance management; providing temporary use of online non-downloadable computer software for use in automation and monitoring of physical and virtual computers; computer security services, namely, enforcing, restricting and controlling access privileges of users of computing resources for cloud resources based on assigned credentials; Computer services, namely, integration of private and public cloud computing environments; Consulting services in the field of cloud computing technology, infrastructure-as-a-service (IAAS) cloud computing technology, software-as-a-service (SAAS) cloud computing technology, and platform-as-a-service (PAAS) cloud computing technology; Providing virtual computer systems and virtual computer environments through cloud computing; application service provider (ASP), namely, hosting computer software applications of others; cloud computing featuring software for use in creating web applications, data storage and backup, database management, virtualization, networking, collaboration, remote access, remote support, cloud computing, data sharing, data security, and access, administration and management of computer applications and computer hardware, and computer application distribution; computer services, namely, creating cloud-based indexes of information; in Class 42.

55. Upon information and belief, at the time Opposer/Respondent filed its Statement of Use, the mark was not used in commerce as required in 15 U.S.C. § 1051 on or in connection with all of the services listed in the Statement of Use.

56. Upon information and belief, the U.S. Patent and Trademark Office (“USPTO”) relied on the statements made by Opposer/Respondent that the mark was used on or in connection with all of the services recited in Application Serial No. 86/707221 when, on August 11, 2017 it accepted the Statement of Use and thereafter granted registration on September 12, 2017.

57. Upon information and belief, had the USPTO been aware that the mark of Application Serial No. 86/707221 was not in use in commerce on or in connection with all of the services recited therein, it would not have issued Registration No. 5286815.

58. Upon information and belief, since the issuance of Registration No. 5286815, the mark has not been used in interstate commerce on or in connection with all of the Class 42 services listed therein.

59. Upon information and belief, as a result of the misrepresentations made to the USPTO with regard to the owner's *bona fide* intent to use the mark on all of the recited services of Application Serial No. 86/707221; the lack of actual use of the mark of Application Serial No. 86/707221 on or in connection with all of the services recited therein at the time of the filing of the Statement of Use and issuance of the Registration; and because the mark of Registration No. 5286815 has not been used on or in connection with all of the services recited therein for at least three years prior to the filing of the instant Counter-claim, the foregoing Registration continues to exist to the detriment of Applicant/Petitioner and should therefore be ordered cancelled or restricted to only those services for which Opposer/Respondent can verify as being in actual use in commerce.

WHEREFORE, Applicant/Petitioner prays that Opposer's Notice of Opposition against Applicant's Application Serial No. 88/790,292 for the Entrust and Design Mark be dismissed with prejudice and, that Registration Nos. 5286814; 5286815; 5286816; and 5286817 be ordered cancelled in their entirety, or in the alternative, subject to partial cancellation.

Respectfully submitted,

FOX ROTHSCHILD LLP.

Date: 25 February 2021

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CERTIFICATE OF SERVICE

I hereby certify that a true copy of the foregoing ANSWER TO NOTICE OF OPPOSITION was served on counsel for Opposer/Respondent, this 25th day of February 2021, by sending same via e-mail to:

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