

ESTTA Tracking number: **ESTTA1119998**

Filing date: **03/12/2021**

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	U.S. Department of Homeland Security Office Of The General Counsel
Granted to Date of previous extension	03/24/2021
Address	245 MURRAY LANE MAIL STOP 0205, S&T OGC WASHINGTON, DC 20528 UNITED STATES
Attorney information	ANNE STERBA 245 MURRAY LANE MAIL STOP 0205, S&T OGC WASHINGTON, DC 20528 UNITED STATES Primary Email: anne.sterba@hq.dhs.gov Secondary Email(s): megan.smith1@associates.hq.dhs.gov, michelle.mccummings@associates.hq.dhs.gov, mary.klumpp@hq.dhs.gov 2022548918
Docket Number	

Applicant Information

Application No.	88876126	Publication date	11/24/2020
Opposition Filing Date	03/12/2021	Opposition Period Ends	03/24/2021
Applicant	Safepassport, Inc 1139 OFFSHORE DR 1139 OFFSHORE DR FAYETTEVILLE, NC 28305 UNITED STATES		

Goods/Services Affected by Opposition

Class 045. First Use: 0 First Use In Commerce: 0 All goods and services in the class are opposed, namely: Licensing of software in the framework of software publishing
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Grounds for Opposition

Priority and likelihood of confusion	Trademark Act Section 2(d)
False suggestion of a connection with persons, living or dead, institutions, beliefs, or national symbols, or brings them into contempt, or disreputable	Trademark Act Section 2(a)

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Deceptiveness	Trademark Act Section 2(a)

Marks Cited by Opposer as Basis for Opposition

U.S. Registration No.	4559587	Application Date	10/31/2013
Registration Date	07/01/2014	Foreign Priority Date	NONE
Word Mark	TSA PRE		
Design Mark			
Description of Mark	The mark consists of the letters "TSA" and "Pre" in blue, with a green checkmark on the right of "Pre".		
Goods/Services	Class 045. First use: First Use: 2011/10/31 First Use In Commerce: 2011/10/31 Airline passenger security screening services, namely, an expedited screening initiative that enhances aviation security and expedites the travel experience bypre-screening individuals who volunteerto participate in the program		

U.S. Registration No.	6178077	Application Date	11/12/2019
Registration Date	10/20/2020	Foreign Priority Date	NONE
Word Mark	TSA PRECHECK		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 045. First use: First Use: 2011/10/31 First Use In Commerce: 2011/10/31 Airline passenger security screening services, namely, an expedited screening initiative that enhances aviation security and expedites the travel experience bypre-screening individuals who volunteerto participate in the program		

Attachments	NOO for Safepassport.pdf(165538 bytes)
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Signature	/Anne M. Sterba/
Name	ANNE STERBA
Date	03/12/2021

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

In the matter of Trademark Application: 88/876,126
For the mark: COVID PRE and Design
Filing Date: April 17, 2020
Published in the *Official Gazette* on: November 24, 2020

UNITED STATES DEPARTMENT OF)
HOMELAND SECURITY,)
)
Opposer,)
)
v.)
)
Safepassport, Inc.,)
)
Applicant.)

NOTICE OF OPPOSITION

The United States Department of Homeland Security (“DHS”) with an address at 245 Murray Lane, Mail Stop 0205, Washington, DC 20528, a federal agency of the United States of America (“Opposer”) believes that it will be damaged by registration of the trademark COVID PRE and Design (the “Opposed Mark”) for use in connection with “Licensing of software in the framework of software publishing” in International Class 45 (the “Identified Services”), as set forth in its intent-to-use Application Serial No. 88/876,126 (the “Application”), filed on April 17, 2020 by Safepassport, Inc., a Delaware corporation with an address at 1139 Offshore Drive, Fayetteville, North Carolina 28305 (“Applicant”) and published for opposition on November 24, 2020. As grounds for this opposition, Opposer alleges that:

1. Since at least as early as October 31, 2011, Opposer has used the trademark TSA PRE and Design (the “TSA PRECHECK Mark”) in connection with, *inter alia*, airline passenger security screening services.

2. In addition to owning common law trademark rights in and to the TSA PRECHECK Mark, Opposer owns the following trademark registrations at the U.S. Patent and Trademark Office:

- i. Incontestable Reg. No. 4,559,587 for TSA PRE and Design, covering “Airline passenger security screening services, namely, an expedited screening initiative that enhances aviation security and expedites the travel experience by pre-screening individuals who volunteer to participate in the program” in Class 45, registered on July 1, 2014, asserting a date of first use of October 31, 2011;
- ii. Reg. No. 6,178,077 for TSA PRECHECK, covering “Airline passenger security screening services, namely, an expedited screening initiative that enhances aviation security and expedites the travel experience by pre-screening individuals who volunteer to participate in the program” in Class 45, registered on October 20, 2020, asserting a date of first use of October 31, 2011.

3. By virtue of the uncompromising and prestigious quality of DHS’s services provided, advertised and promoted under the TSA PRECHECK Mark and by virtue of the extensive promotion and advertising of such high-quality services for almost ten (10) years, the TSA PRECHECK Mark has become well-known and has acquired extensive recognition and strength throughout the United States.

4. The Opposed Mark is confusingly similar to Opposer’s TSA PRECHECK Mark in terms of sight, sound, and overall commercial impression.

5. The Application identifies goods that are closely related to the services Opposer provides under its TSA PRECHECK Mark. Upon information and belief, Applicant offers or intends to offer the Identified Services under the Opposed Mark.

6. Upon information and belief, Opposer's date of first use in commerce for the TSA PRECHECK Mark predates Applicant's earliest available priority date for the Opposed Mark. Applicant filed its intent-to-use application on April 17, 2020, which is well after Opposer's first use date of October 31, 2011.

7. The Opposed Mark so closely resembles Opposer's TSA PRECHECK Mark that its use in connection with the Identified Services is likely to cause confusion, or to cause mistake or deceive consumers, in violation of Section 43(a) of the Trademark Act of 1946, 15 U.S.C. § 1125(a). Consumers of Applicant's services in the United States likely will assume that Opposer is somehow affiliated with, licenses, or endorses Applicant's use of the Opposed Mark when Opposer is not connected in any way with Applicant.

8. The Opposed Mark so closely resembles Opposer's TSA PRECHECK Mark that its use in connection with the Identified Services is likely to cause confusion, or to cause mistake or deceive consumers, in violation of Section 2(d) of the Trademark Act of 1946, 15 U.S.C. § 1152(d). Consumers of Applicant's services in the United States likely will assume that Opposer is somehow affiliated with, licenses, or endorses Applicant's use of the Opposed Mark when Opposer is not connected in any way with Applicant.

9. The Opposed Mark so closely resembles Opposer's TSA PRECHECK Mark that its use in connection with the Identified Services is likely to falsely suggest a connection with the Federal Government, in violation of Section 2(a) of the Trademark Act of 1946, 15 U.S.C. § 1052(a). Consumers of Applicant's services in the United States likely will assume a false connection

between Applicant and the Federal Government when Opposer is not connected in any way with Applicant.

10. Opposer is not affiliated with Applicant or the Identified Services, nor has Opposer endorsed or sponsored Applicant or its Identified Services. Opposer is not connected to Applicant or the Identified Services in any way whatsoever.

11. Opposer has no control over the nature and quality of Applicant's Identified Services and any deficiency, objection, or fault found in connection with such services marketed under the Opposed Mark would necessarily reflect upon the reputation Opposer has established for the quality of services offered under the TSA PRECHECK Mark.

12. Registration of the Opposed Mark will be inconsistent with Opposer's rights in the TSA PRECHECK Mark and will damage Opposer.

WHEREFORE, Opposer prays that the Trademark Trial and Appeal Board will sustain this opposition and refuse registration of the Application.

Respectfully submitted,

By: /Anne M. Sterba/
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Date: March 12, 2021