

ESTTA Tracking number: **ESTTA1200974**

Filing date: **04/05/2022**

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	Tripwire, Inc.
Granted to date of previous extension	04/13/2022
Address	308 SW 2ND AVENUE PORTLAND, OR 97204 UNITED STATES
Attorney information	KEVIN M. HAYES KLARQUIST SPARKMAN, LLP 121 SW SALMON STREET, SUITE 1600 ONE WORLD TRADE CENTER PORTLAND, OR 97204 UNITED STATES Primary email: ptotmdocket@klarquist.com Secondary email(s): kevin.hayes@klarquist.com 5035955300
Docket no.	871110663801

Applicant information

Application no.	90606439	Publication date	12/14/2021
Opposition filing date	04/05/2022	Opposition period ends	04/13/2022
Applicant	Tripwire Interactive, LLC SUITE 100 1775 WOODSTOCK ROAD ROSEWELL, GA 30075 UNITED STATES		

Goods/services affected by opposition

Class 009. First Use: None First Use In Commerce: None All goods and services in the class are opposed, namely: Downloadable Video game software; Downloadable Computer game programs; Downloadable Computer game programs and computer-game software; Computer game and video game discs; Downloadable computer game software for portable media players; Downloadable computer game software for wireless mobile devices; Downloadable Electronic game software for wireless devices; Downloadable computer game software for multi-media smart phones; Downloadable Virtual reality game software; Downloadable Augmented reality game software; Downloadable webcasts and podcasts featuring news, interviews, and tips and strategies in the field of electronic games
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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.	2306881	Application date	10/08/1997
Register	Principal		
Registration date	01/11/2000	Foreign priority date	NONE
Word mark	TRIPWIRE		
Design mark	TRIPWIRE		
Description of mark	NONE		
Goods/services	Class 009. First use: First Use: Jan 1993 First Use In Commerce: Jan 1993 computer software for file system security		

U.S. registration no.	4307673	Application date	01/31/2012
Register	Principal		
Registration date	03/26/2013	Foreign priority date	NONE
Word mark	TRIPWIRE		
Design mark	TRIPWIRE		
Description of mark	NONE		
Goods/services	<p>Class 009. First use: First Use: Jan 31, 1993 First Use In Commerce: Jan 31, 1993 Computer network security, system security, file security, and data security software; computer software for management and monitoring of computer networks, systems, files, and data; computer software for detection, analysis, reporting, and restoration of changes to computer networks, systems, applications, files, and data; computer software for data and file security; computer software for managing hardware and software in an information technology environment; computer software for providing compliance monitoring and configuration control of hardware and software</p> <p>Class 042. First use: First Use: Dec 31, 2003 First Use In Commerce: Dec 31, 2003 Computer software consulting; computer software installation and maintenance;</p>		

	customizing computer software		
U.S. registration no.	5172885	Application date	03/04/2016
Register	Principal		
Registration date	03/28/2017	Foreign priority date	NONE
Word mark	TRIPWIRE AXON		
Design mark			
Description of mark	NONE		
Goods/services	<p>Class 009. First use: First Use: Mar 30, 2016 First Use In Commerce: Mar 30, 2016</p> <p>Cybersecurity software for controlling and monitoring system configurations, monitoring identification and security vulnerabilities, detecting security attack and breaches, automating security processes, integrating security intelligence with operational software, identifying compromised servers, monitoring servers for security compliance, generating security reports, auditing system changes and anomalies for security risk, monitoring compliance with regulations, initiatives and standards, tracking security risk factors due to system configuration changes, utilizing encrypted communications; computer network security software; computer security software for providing compliance monitoring and configuration control; computer security software for detecting changes, indicators of compromise, and threats against the integrity of software and systems, virtual or physical</p>		

Attachments	75370152#TMSN.png(bytes) 85530162#TMSN.png(bytes) 86929937#TMSN.png(bytes) Notice of Opposition of TRIPWIRE PRESENTS App. 90606439 Class 9.pdf(273599 bytes)
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Signature	/kevin hayes/
Name	KEVIN M. HAYES
Date	04/05/2022

1. The TRIPWIRE PRESENTS mark, both as shown in the Opposed Application and as used by Applicant, is likely to cause confusion as to its source or sponsorship with Opposer's TRIPWIRE Marks noted below.
2. Opposer owns the following "TRIPWIRE Marks" for which it has secured the noted registrations.
3. Opposer owns and has used its TRIPWIRE mark for computer software for file system security since at least as early as January 1993.
4. In that regard, Opposer owns Trademark Registration No. 2306881 for TRIPWIRE in connection with International Class 9 for computer software for file system security, issued January 11, 2000.
5. Opposer owns and has used its TRIPWIRE mark for computer network security, system security, file security, and data security software; computer software for management and monitoring of computer networks, systems, files, and data; computer software for detection, analysis, reporting, and restoration of changes to computer networks, systems, applications, files, and data; computer software for data and file security; computer software for managing hardware and software in an information technology environment; computer software for providing compliance monitoring and configuration control of hardware and software since at least as early as January 1993.
6. Opposer owns and has used its TRIPWIRE mark for computer software consulting; computer software installation and maintenance; customizing computer software since at least as early as December 2003.
7. In that regard, Opposer owns Trademark Registration No. 4307673 for TRIPWIRE in Class 9 for computer network security, system security, file security, and

data security software; computer software for management and monitoring of computer networks, systems, files, and data; computer software for detection, analysis, reporting, and restoration of changes to computer networks, systems, applications, files, and data; computer software for data and file security; computer software for managing hardware and software in an information technology environment; computer software for providing compliance monitoring and configuration control of hardware and software; and in Class 42 for computer software consulting; computer software installation and maintenance; customizing computer software, issued March 26, 2013.

8. Opposer owns and has used its TRIPWIRE AXON mark for cybersecurity software for controlling and monitoring system configurations, monitoring identification and security vulnerabilities, detecting security attacks and breaches, automating security processes, integrating security intelligence with operational software, identifying compromised servers, monitoring servers for security compliance, generating security reports, auditing system changes and anomalies for security risk, monitoring compliance with regulations, initiatives and standards, tracking security risk factors due to system configuration changes, utilizing encrypted communications; computer network security software; computer security software for providing compliance monitoring and configuration control; computer security software for detecting changes, indicators of compromise, and threats against the integrity of software and systems, virtual or physical since at least as early as March 30, 2016.

9. Opposer owns Trademark Registration No. 5172885 TRIPWIRE AXON in connection with International Class 9 for cybersecurity software for controlling and monitoring system configurations, monitoring identification and security vulnerabilities,

detecting security attacks and breaches, automating security processes, integrating security intelligence with operational software, identifying compromised servers, monitoring servers for security compliance, generating security reports, auditing system changes and anomalies for security risk, monitoring compliance with regulations, initiatives and standards, tracking security risk factors due to system configuration changes, utilizing encrypted communications; computer network security software; computer security software for providing compliance monitoring and configuration control; computer security software for detecting changes, indicators of compromise, and threats against the integrity of software and systems, virtual or physical, issued March 28, 2017.

10. The TRIPWIRE PRESENTS mark, both as shown in the Opposed Application and as used by Applicant, is likely to cause confusion as to its source or sponsorship with Opposer's TRIPWIRE Marks.

11. Opposer continues to expand its TRIPWIRE formative brands in connection with security software and services.

12. The Opposed Application identifies goods in International Class 9.

13. The Opposed Application identifies downloadable video game software; downloadable computer game programs; downloadable computer game programs and computer game software; computer game and video game discs; downloadable computer game software for portable media players; downloadable computer game software for wireless mobile devices; downloadable electronic game software for wireless devices; downloadable computer game software for multi-media smart phones; downloadable virtual reality game software; downloadable augmented reality game software;

downloadable webcasts and podcasts featuring news, interviews, and tips and strategies in the field of electronic games.

14. On information and belief, ordinary consumers of video game software include consumers of security software.

15. There are registrations that identify both security software and video game software (e.g., 6656265, 6413933, 6363339, and 6563243).

16. Applicant's identified goods in the Opposed Application are related to the goods and services of Opposer's TRIPWIRE Marks.

17. On information and belief, Applicant controls the domain name tripwireinteractice.com and the associated website at <https://www.tripwireinteractive.com/>.

18. On information and belief, Applicant controls the content of the website at <https://www.tripwireinteractive.com/>.

19. Opposer has priority in its use and registration of the TRIPWIRE Marks.

20. The TRIPWIRE PRESENTS mark as shown in the Opposed Application is similar to Opposer's TRIPWIRE Marks in appearance, sound, meaning, and commercial impression.

21. Opposer's TRIPWIRE Marks are well-known.

22. Applicant is aware of Opposer's TRIPWIRE Marks.

23. Applicant was aware of Opposer's TRIPWIRE Marks when filing the Opposed Application.

24. There are no live Federal Trademark Registrations including the word TRIPWIRE for International Class 9 that are not owned by Opposer.

25. Applicant is not aware of any live Federal Trademark Registrations including the word TRIPWIRE for International Class 9 that are not owned by Opposer.

26. Opposer would be damaged by registration of Applicant's Opposed Application.

WHEREFORE, Opposer prays that this Opposition be sustained and that the Opposed Application be refused registration.

Dated: April 5, 2022

By:



Kevin M. Hayes, OSB #01280
Shelby A. Stepper, OSB #191851

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Portland, Oregon 97204
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*Of Attorneys for Opposer
Tripwire, Inc.*

Int. Cl.: 9

Prior U.S. Cls.: 21, 23, 26, 36 and 38

Reg. No. 2,306,881

United States Patent and Trademark Office

Registered Jan. 11, 2000

**TRADEMARK
PRINCIPAL REGISTER**

TRIPWIRE

PURDUE RESEARCH FOUNDATION (INDI-
ANA NON-PROFIT CORPORATION)
1021 HOVDE HALL, ROOM 307
WEST LAFAYETTE, IN 479071021

FOR: COMPUTER SOFTWARE FOR FILE
SYSTEM SECURITY, IN CLASS 9 (U.S. CLS. 21,
23, 26, 36 AND 38).

FIRST USE 1-0-1993; IN COMMERCE
1-0-1993.
SEC. 2(F).

SER. NO. 75-370,152, FILED 10-8-1997.

KATHLEEN M. VANSTON, EXAMINING AT-
TORNEY

United States of America
United States Patent and Trademark Office

TRIPWIRE

Reg. No. 4,307,673

Registered Mar. 26, 2013

Int. Cls.: 9 and 42

TRADEMARK

SERVICE MARK

PRINCIPAL REGISTER

TRIPWIRE, INC. (DELAWARE CORPORATION)
101 SW MAIN STREET, SUITE 1500
PORTLAND, OR 97204

FOR: COMPUTER NETWORK SECURITY, SYSTEM SECURITY, FILE SECURITY, AND DATA SECURITY SOFTWARE; COMPUTER SOFTWARE FOR MANAGEMENT AND MONITORING OF COMPUTER NETWORKS, SYSTEMS, FILES, AND DATA; COMPUTER SOFTWARE FOR DETECTION, ANALYSIS, REPORTING, AND RESTORATION OF CHANGES TO COMPUTER NETWORKS, SYSTEMS, APPLICATIONS, FILES, AND DATA; COMPUTER SOFTWARE FOR DATA AND FILE SECURITY; COMPUTER SOFTWARE FOR MANAGING HARDWARE AND SOFTWARE IN AN INFORMATION TECHNOLOGY ENVIRONMENT; COMPUTER SOFTWARE FOR PROVIDING COMPLIANCE MONITORING AND CONFIGURATION CONTROL OF HARDWARE AND SOFTWARE, IN CLASS 9 (U.S. CLS. 21, 23, 26, 36 AND 38).

FIRST USE 1-31-1993; IN COMMERCE 1-31-1993.

FOR: COMPUTER SOFTWARE CONSULTING; COMPUTER SOFTWARE INSTALLATION AND MAINTENANCE; CUSTOMIZING COMPUTER SOFTWARE, IN CLASS 42 (U.S. CLS. 100 AND 101).

FIRST USE 12-31-2003; IN COMMERCE 12-31-2003.

THE MARK CONSISTS OF STANDARD CHARACTERS WITHOUT CLAIM TO ANY PARTICULAR FONT, STYLE, SIZE, OR COLOR.

OWNER OF U.S. REG. NO. 2,306,881.

SEC. 2(F).

SER. NO. 85-530,162, FILED 1-31-2012.

TASNEEM HUSSAIN, EXAMINING ATTORNEY



Sean Street Lee

Acting Director of the United States Patent and Trademark Office

United States of America

United States Patent and Trademark Office

TRIPWIRE AXON

Reg. No. 5,172,885

Tripwire, Inc. (DELAWARE CORPORATION)
101 SW Main Street, Suite 1500
Portland, OR 97204

Registered Mar. 28, 2017

Int. Cl.: 9

Trademark

Principal Register

CLASS 9: Cybersecurity software for controlling and monitoring system configurations, monitoring identification and security vulnerabilities, detecting security attacks and breaches, automating security processes, integrating security intelligence with operational software, identifying compromised servers, monitoring servers for security compliance, generating security reports, auditing system changes and anomalies for security risk, monitoring compliance with regulations, initiatives and standards, tracking security risk factors due to system configuration changes, utilizing encrypted communications; computer network security software; computer security software for providing compliance monitoring and configuration control; computer security software for detecting changes, indicators of compromise, and threats against the integrity of software and systems, virtual or physical

FIRST USE 3-30-2016; IN COMMERCE 3-30-2016

THE MARK CONSISTS OF STANDARD CHARACTERS WITHOUT CLAIM TO ANY PARTICULAR FONT STYLE, SIZE OR COLOR

OWNER OF U.S. REG. NO. 2306881, 4307673

SER. NO. 86-929,937, FILED 03-04-2016

BRENDAN D MCCAULEY, EXAMINING ATTORNEY



Michelle K. Lee

Director of the United States
Patent and Trademark Office