

ESTTA Tracking number: **ESTTA1200978**

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 | 04/06/2022 |
| 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. | 871110738001 |

Applicant information

| | | | |
|------------------------|--|------------------------|------------|
| Application no. | 90606456 | Publication date | 12/07/2021 |
| Opposition filing date | 04/05/2022 | Opposition period ends | 04/06/2022 |
| Applicant | Tripwire Interactive, LLC SUITE 100 1775 WOODSTOCK ROAD ROSEWELL, GA 30075 UNITED STATES | | |

Goods/services affected by opposition

Class 041. First Use: None First Use In Commerce: None
All goods and services in the class are opposed, namely: Entertainment services, namely, providing information about video games; Entertainment services, namely, providing webcasts in the fields of games, video games

Grounds for opposition

| | |
|--------------------------------------|----------------------------|
| Priority and likelihood of confusion | Trademark Act Section 2(d) |
|--------------------------------------|----------------------------|


Marks cited by opposer as basis for opposition

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|-------------------|---------|------------------|------------|
| U.S. registration | 2306881 | Application date | 10/08/1997 |
|-------------------|---------|------------------|------------|

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|---------------------|---|-----------------------|------|
| no. | | | |
| 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 | | |

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|-----------------------|---|-----------------------|------------|
| 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</p> <p>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</p> <p>Computer software consulting; computer software installation and maintenance; customizing computer software</p> | | |

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|-----------------------|---------|------------------|------------|
| U.S. registration no. | 5172885 | Application date | 03/04/2016 |
|-----------------------|---------|------------------|------------|

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|---------------------|---|-----------------------|------|
| 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> | | |

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|-------------|--|
| Attachments | <p>75370152#TMSN.png(bytes) 85530162#TMSN.png(bytes) 86929937#TMSN.png(bytes) Notice of Opposition of TRIPWIRE PRESENTS App. 90606456 Class 41.pdf(272587 bytes)</p> |
|-------------|--|

| | |
|-----------|----------------|
| Signature | /kevin hayes/ |
| Name | KEVIN M. HAYES |
| Date | 04/05/2022 |

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 services in International Class 41.

13. The Opposed Application identifies entertainment services, namely, providing information about video games; entertainment services, namely, providing webcasts in the fields of games, video games.

14. On information and belief, ordinary consumers of entertainment services include consumers of security software.

15. On information and belief, ordinary consumers of Applicant's identified entertainment services include consumers of computer software consulting; computer software installation and maintenance; and customizing computer software services.

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

17. Applicant's identified entertainment services are related to the goods and services of Opposer's TRIPWIRE Marks.

18. On information and belief, Applicant controls the domain name tripwireinteractice.com and the associated website at

<https://www.tripwireinteractive.com/>.

19. On information and belief, Applicant controls the content of the website at

<https://www.tripwireinteractive.com/>.

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

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

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

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

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

25. 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:

A handwritten signature in blue ink, appearing to read "K. M. Hayes", written over a horizontal line.

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

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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