

ESTTA Tracking number: **ESTTA1114305**

Filing date: **02/13/2021**

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	DigiCert, Inc.
Granted to Date of previous extension	02/14/2021
Address	2801 N. THANKSGIVING WAY SUITE 500 LEHI, UT 84043 UNITED STATES
Correspondence information	DEBORAH A. GUBERNICK SNELL & WILMER, LLP 600 ANTON BOULEVARD SUITE 1400 COSTA MESA, CA 92626 UNITED STATES Primary Email: ipocdoCKET@swlaw.com Secondary Email(s): dgubernick@swlaw.com, aezzell@swlaw.com, gmorlock@swlaw.com 714-427-7000

Applicant Information

Application No.	88751231	Publication date	08/18/2020
Opposition Filing Date	02/13/2021	Opposition Period Ends	02/14/2021
Applicant	GOTRUSTID Inc. SUITE 402, 800 N. STATE STREET, DOVER, COUNTY OF KENT., DE 19901 UNITED STATES		

Goods/Services Affected by Opposition

Class 009. First Use: 2019/12/16 First Use In Commerce: 2019/12/16

All goods and services in the class are opposed, namely: Computer software for controlling and managing access server applications; Computer software for encryption; Computer software for wireless content delivery; Computer application software for mobile phones, namely, software for signing onto the computer and web service; Communications software for encryption; Mobile applications for use in computer access control; Mobile applications for use in the encryption and decryption of digital files, including audio, video, text, binary, still images, graphics and multimedia files; Downloadable mobile applications for signing onto the computer and webservice; Downloadable computer software for signing onto the computer; Secure Digital (SD) Memory Cards; USB (universalserial bus) hardware; USB computer security key; USB computer access control key; Cards with integrated circuits;

Integrated circuits cards and components; Encoded integrated circuits cards containing programming used for data protection and user identity; Encoded smart cards embedded with transponders and containing programming used for data protection and user identity; Encoded electronic chip cards containing programming used for data protection and user identity; Electronic security token in the nature of a fob-like device used by an authorized user of a computer system to facilitate authentication

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.	4949792	Application Date	07/31/2015
Registration Date	05/03/2016	Foreign Priority Date	NONE
Word Mark	GEOTRUST		
Design Mark			
Description of Mark	NONE		
Goods/Services	<p>Class 009. First use: First Use: 1999/06/04 First Use In Commerce: 1999/06/04 Computer software for providing network, Internet, and computer security; Internet security software, including computer software for use in the monitoring and control of computer and online activity; computer software for providing on-line transaction security; privacy control software</p> <p>Class 042. First use: First Use: 1999/06/04 First Use In Commerce: 1999/06/04 Computer consultation; computer consultation in the field of computer security; providing information in the field of computer network and Internet security; providing information concerning encryption of electronic data for website and e-commerce transaction security; computer and software consultancy services in the fields of digital media, data encryption, computer security, communication security and computer software; encryption and decryption of data; computer services, namely, on-line scanning and detecting of malware on websites</p> <p>Class 045. First use: First Use: 1999/06/04 First Use In Commerce: 1999/06/04 Providing information concerning authentication of user identification data for e-commerce transaction security; computer security services in the nature of providing authentication, issuance, validation and revocation of digital certificates; providing user authentication services in e-commerce transactions</p>		

U.S. Registration No.	2556558	Application Date	04/14/1999
Registration Date	04/02/2002	Foreign Priority Date	NONE
Word Mark	GEOTRUST		
Design Mark			
Description of Mark	NONE		
Goods/Services	<p>Class 009. First use: First Use: 1999/06/04 First Use In Commerce: 1999/06/04 COMPUTER SOFTWARE PROGRAMS THAT ALLOW USERS TO BUILD, ACCESS AND CONTROL SYSTEMS, POLICIES AND PROCEDURES FOR THE SECURITY OF DATA AND MONITORING THE SECURITY OF DATA AND MONITORING THE PRIVACY AND CONFIDENTIALITY OF DATA ON A COMPUTER WEBSITE</p>		

	<p>Class 035. First use: First Use: 1999/06/04 First Use In Commerce: 1999/06/04 [BUSINESS CONSULTATION AND INFORMATION SERVICES ON THE SUBJECT OF SECURITY OF DATA AND MONITORING THE PRIVACY AND CONFIDENTIALITY OF DATA ON A COMPUTER WEB SITE]</p> <p>Class 041. First use: First Use: 1999/06/04 First Use In Commerce: 1999/06/04 [EDUCATIONAL SERVICES, NAMELY, PROVIDING COURSES OF INSTRUCTION IN BUSINESS AND COMPUTER TRAINING SERVICES]</p> <p>Class 042. First use: First Use: 1999/06/04 First Use In Commerce: 1999/06/04 [COMPUTER SOFTWARE DEVELOPMENT SERVICES FOR OTHERS; COMPUTER CONSULTATION SERVICES; RATING OF WEB SITES FOR THE SECURITY OF DATA AND] MONITORING THE PRIVACY AND CONFIDENTIALITY OF DATA ON A COMPUTER WEB SITE; COMPUTER SERVICES, NAMELY, PROVIDING INFORMATION AND DATA BASES FOR THE SECURITY OF DATA AND MONITORING THE PRIVACY AND CONFIDENTIALITY OF DATA ON A COMPUTER WEB SITE</p>
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Related Proceedings	91250267
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Attachments	76763.00006 - DigiCert - GoTrusID _ GOTRUSTID_88751231 - Notice of Opposition 4819-7180-2580 v.2.pdf(276336 bytes)
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Signature	/dag/
Name	DEBORAH A. GUBERNICK
Date	02/13/2021

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

In the matter of:

DIGICERT, INC., a Utah corporation
Opposer,

v.

GOTRUSTID, INC., a Delaware
corporation
Applicant.

NOTICE OF OPPOSITION

Opposition No.: _____

Application No.: 88/751,231

GoTrustID

Published: August 18, 2020

NOTICE OF OPPOSITION

DigiCert, Inc. (“Opposer”), a Utah corporation, having a principal place of business at 2801 N. Thanksgiving Way Suite 500 Lehi, Utah 84043, believes that it will be damaged by registration of the design mark shown in U.S. Application No. 88/751,231 GOTRUSTID (stylized) filed by GoTrustID, Inc. (“Applicant”), a Delaware corporation, having a principal address of record at 800 N. State Street Suite 402 Dover, Delaware 19901. Opposer hereby files this Notice of Opposition pursuant to Section 13 of the Trademark Act (15 U.S.C. § 1063). As grounds for Opposition, Opposer alleges as follows:

1. Opposer owns two valid trademark registrations for GEOTRUST on file with the U.S. Patent and Trademark Office for goods and services in Class 09, Class 42, and Class 45 (hereinafter the “Registered Marks”) as described below:

Trademark	Goods/ Services	Registration Number/ Registration Date
<p>GEOTRUST</p>	<p>Computer software for providing network, Internet, and computer security; Internet security software, including computer software for use in the monitoring and control of computer and online activity; computer software for providing online transaction security; privacy control software in Class 9</p> <p>Computer consultation; computer consultation in the field of computer security; providing information in the field of computer network and Internet security; providing information concerning encryption of electronic data for website and e-commerce transaction security; computer and software consultancy services in the fields of digital media, data encryption, computer security, communication security and computer software; encryption and decryption of data; computer services, namely, on-line scanning and detecting of malware on websites in Class 42.</p> <p>Providing information concerning authentication of user identification data for e-commerce transaction security; computer security services in the nature of providing authentication, issuance, validation and revocation of digital certificates; providing user authentication services in e-commerce transactions in Class 45.</p>	<p>4949792</p> <p>Registered May 3, 2016</p>
<p>GEOTRUST</p>	<p>Computer software programs that allow users to build, access and control systems, policies and procedures for the security of data and monitoring the security of data and monitoring the privacy and confidentiality of data on a computer web site.</p> <p>Monitoring the privacy and confidentiality of data on a computer web site; computer services, namely, providing information and data bases for the security of data and monitoring the privacy and confidentiality of data on a computer website in Class 42.</p>	<p>2556558</p> <p>Registered April 2, 2002</p>

2. Opposer's Registered Marks are valid, unrevoked, and in full force and effect.
3. Through longstanding use, Opposer also owns common law trademark rights in and to GEOTRUST.
4. Opposer offers its services online and in manners customary to the trust-industry trade and has continuously done so long before the Application was filed.
5. Opposer owns the goodwill and reputation connected with and symbolized by the Registered Marks.
6. Long after Opposer's first use of Opposer's Registered Marks, Applicant applied

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