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

Proceeding	91179185
Party	Defendant Middleware Associates, LLC
Correspondence Address	MIDDLEWARE ASSOCIATES, LLC 1697 E CLASSICAL BLVD DELRAY BEACH, FL 33445-1204  patrick@ma-security.com
Submission	Answer
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Date	10/09/2007
Attachments	91179185_ma_response.pdf ( 6 pages )(281909 bytes )

### NOTICE OF OPPOSITION

Opposer AuthenTec, Inc., a Delaware corporation whose address is 709 S. Harbor City Blvd., Suite 400, Melbourne, Florida, 32901, believes it will be damaged by registration of the mark **AUTHENTIGO**, shown in Serial No. 78/973,389, in International Classes 9 for “facilities management software, namely, software to control building environmental, access and security systems,” and hereby opposes registration of the application in Class 9, pursuant to an Extension of Time allowed on May 22, 2007.

As grounds for opposition it is alleged that:

1. Applicant seeks to register the mark **AUTHENTIGO** as a trademark for the above-described goods, as evidenced by the publication of the mark in the Official Gazette on May 1, 2007.

ANSWER: Correct

2. Applicant filed its application on September 13, 2006, based on its intent to use the mark in commerce and has not yet filed an Amendment to Allege Use.

ANSWER: Incorrect: Middleware Associates has used the mark AuthentiGO™ with its customers, potential customers and has produced several publications using the mark on its web site.

3. Opposer is the owner of the U.S. Trademark Registration No. 2,670,775 for the mark **AUTHENTEC (Stylized)**, which registered on the Principal Register on January 7, 2003.

ANSWER: Correct

4. Opposer is also the owner of the U.S. Application Serial No. 77/226,868 for the standard character mark **AUTHENTEC**, which was filed on July 16, 2007 but has not yet been assigned to an Examining Attorney.

ANSWER: Correct

5. Opposer is also the owner of various other trademarks directed to goods and services within the biometric security industry, including **PERSONAL SECURITY FOR THE REAL WORLD** (U.S. Registration No. 2,470,452), **TRUEPRINT** (U.S. Registration No. 2,740,918), **ENTREPAD** (U.S. Registration No. 2,801,537), and **THE POWER OF TOUCH** (U.S. Registration No. 3,105,183).

ANSWER: Correct

6. Opposer has used its marks **AUTHENTEC (Stylized)** and **AUTHENTEC** in commerce in connection with “authentication and identification products, namely, computer software, biometric matching software, biometric indexing software, and cryptographic protection software, and related hardware, namely, fingerprint sensors and associated computer chips and electronic circuitry for use in determining the identity of unknown persons and to verify the claimed identity of persons” in International Class 9 since at least as early as January of 1996.

ANSWER: Correct

7. Opposer has extensively promoted and continuously used its marks throughout the U.S., and has made significant sales of products under each of its marks and, as a result, Opposer’s marks have developed and represent valuable goodwill to Opposer.

ANSWER: Correct

8. Opposer has exclusive rights to use its federally registered mark **AUTHENTEC (Stylized)** in the U.S. in connection with those goods identified in its registration.

ANSWER: Correct

9. Opposer used the marks **AUTHENTEC (Stylized)** and **AUTHENTEC** in commerce prior to Applicant’s filing of its application and, on information and belief, before Applicant’s first use of its mark in connection with its goods.

ANSWER: Correct

10. Applicant's mark **AUTHENTIGO** is confusingly and deceptively similar to Opposer's marks **AUTHENTEC (Stylized)** and **AUTHENTEC**. Applicant's mark is very similar in sight, sound, connotation, and commercial impression to both of Opposer's marks.

ANSWER: The names are similar, yes; however there are many many trademarks which have been issued and used in commerce which sound similar yet the application is so broad that prohibiting similar names which use the root of the same word, in this case, "authentication", is not justification for denying the use of AUTHENTIGO within this product category. (see complete answer in response to #15 below)

11. Applicant's goods, "facilities management software, namely, software to control building environmental, access and security systems" in International Class 9, are very similar and closely related to Opposer's goods, "authentication and identification products, namely, computer software, biometric matching software, biometric indexing software, and cryptographic protection software, and related hardware, namely, fingerprint sensors and associated computer chips and electronic circuitry for use in determining the identity of unknown persons and to verify the claimed identity of persons" in International Class 9.

ANSWER: The opposer had the full right to choose *facilities management software, namely, software to control building environmental, access and security systems* as their class, but in fact the opposer did not, and rightfully so because their products are in a special niche market of "fingerprint biometrics". The defendant's product AuthentiGO™ has absolutely nothing in common with "fingerprint biometrics". The broad definition of Opposer's goods referenced above would also render the Live trademarks of many companies (further identified in response to #15 below) to be invalid. Middleware Associates believes the opposer is unjustified in their claim that the two names are so similar within a technology category that is broad as to render ANY use of the root word "authenticate", sic, "authen\*\*\*\*\*" within the field of "security", broadly defined but not limited in any way, as to be unfounded.

12. Upon information and belief, Applicant's channels of trade and class of purchasers are likely to be very similar to those of Opposer.

ANSWER: AuthentiGO™ is software that is used for facility management and the control of security systems. To suggest that technology, with its various methods of adoption and use by the end user community could in any way restrict the rights of Middleware Associates to represent and use AuthentiGO, is simply too broad to be valid.

13. Due to the similarity between Applicant's mark and goods and Opposer's previously used marks and goods, and the likely similarity of the respective channels of trade and classes of purchasers, the registration of Applicant's mark will cause great damage and injury to Opposer. Persons familiar with Opposer's marks and goods would likely confuse Applicant's goods with those provided by Opposer. Any defect, objection or fault found with Applicant's goods offered under the mark **AUTHENTIGO** may reflect upon and expose Opposer to liability, and seriously injure the reputation that Opposer has established for its goods.

ANSWER: Middleware Associates has been using this mark AuthentiGO™ for over two years now. The opposer has absolutely no proof of confusion of goods within this time period.

Regarding liability, how would the opposer's reputation be damaged more by AUTHENTIGO™ than by the following federally registered marks: VERGENCE AUTHENTICATOR, AUTHENTIUM ESP, ZERO-TOUCH CONSUMER AUTHENTICATION, YOUR AUTHENTIC VOICE, AUTHENTIUM, ActivIdentity Authentic8, authenticity, AUTHENTINET, AUTHENTISEC, AUTHENTICARE, AUTHENTIVERSE, AUTHENTIX, AUTHENEX, AUTHENTOS?

14. If Applicant is granted the registration herein opposed, it would obtain at least a *prima facie* exclusive right to use the mark **AUTHENTIGO** in the U.S., thereby causing damage and injury to Opposer.

ANSWER: We disagree (see explanation below in response to #15)

15. Registration of Applicant's mark is likely to dilute the ability of Opposer's marks to identify and distinguish Opposer as the source of its goods in the U.S. and worldwide.

ANSWER: AuthentiGO™ is clearly a product of Middleware Associates, LLC a Florida based company. Article 15 would only hold true if the company Authentec were to develop security or facility management software under the same name. If the oppose did this then they would be in violation of the defendant product trademark "AUTHENTIGO™". The response below is the basis of our claim that denying the legal right of the trademark AuthentiGO would represent a predatory and monopolistic use of the root of the word "authenticate", sic, "authen\*" by ANY other company whose products are used in the field of security; whether that be building security, personal security, information security, etc.

In conclusion:

Middleware Associates has been actively using the AUTHENTIGO™ trademark for over two years and has not infringed upon the trademarked company name, AUTHENTEC; our position is that the root of the word "authenticate" has been used

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