Letter Response to Office Action – USPTO

Applicant:	Cloudflare, Inc.
Serial No.:	88455403
Filed:	May 31, 2019
Mark:	WARP
Examiner:	Kevin M. Dinallo
Trademark Law Office:	107

Dear Colleague:

This is in response to the Office Action issued on August 22, 2019, in which the examining attorney (the "**Examiner**") objected to Applicant Cloudflare, Inc. ("**Applicant**")'s WARP mark, bearing serial number 88455403 ("**WARP Mark**"), on the basis of a prior registration, and requesting a substituted specimen with respect to Class 009 only. The Examiner also notes six (6) prior pending applications that may present a likelihood of confusion if granted registration.

Section 2(d) – Likelihood of Confusion Refusal

Applicant respectfully submits that the registration cited by the Examiner as confusingly similar to the WARP Mark, namely third-party registration for IP-WARP (Registration No. 4733794) ("**Prior Registration**") will not cause confusion with the subject mark for the following reasons.

In testing for likelihood of confusion under Section 2(d), the *Du Pont* factors need to be considered, including factors such as the similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation, and commercial impression; the similarity or dissimilarity and nature of the goods or services as described in an application or registration or in connection with which a prior mark is in use; the purchasers of the goods i.e. "impulse" vs. careful, sophisticated purchasing; and the number and nature of similar marks in use on similar goods. *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357 (C.C.P.A. 1973). The proper test for likelihood of confusion is not a side-by-side comparison of two marks, but rather the entire way in which they are used and perceived. *In re Nat'l Data Corp.*, 753 F.2d 1056, 1058 (Fed. Cir. 1985). Here, distinctions between the sound, meaning, connotation, commercial impression, and nature of the goods and services of Applicant's subject WARP Mark and the Prior Registration dictate against a refusal on the basis of likelihood of confusion.

Applicant's WARP Mark Appears and Sounds Different from the Prior Registration.

In a likelihood of confusion analysis, the entirety of the marks, and not their component word elements, must be compared. *See Opryland USA Inc. v. Great American Music Show, Inc.*, 970 F.2d 847, 23 USPQ2d 1471 (Fed. Cir. 1992). Here, the WARP Mark produces a starkly different commercial impression from that of the Prior Registration, especially when considering their visual and audible distinctions.

Visually, while both Applicant's Mark and NTT PC Communications Incorporated's Prior Registration contain the word "WARP," their entire appearances differ, as Applicant's WARP Mark is one word; whereas the Prior Registration (i) features the hyphenated modifier "IP-", and (ii) is a compound modifier consisting of an acronym and a word, or two acronyms, connected by a hyphen. The words "WARP" and "IP-WARP" bear sufficient visual distinctions that no reasonable person glancing at the marks would mistake one for the other – they are clearly two different words.

The addition of the "IP-" portion of the Prior Registration further lends to the significant phonetic differences between the Prior Registration for "IP-WARP" and Applicant's "WARP" mark. From a linguistic perspective,

the pronunciation of the preceding "IP-" hyphenate in the Prior Registration presents two additional syllables, starting with the short open front vowel sound that moves to the near-close position in the first-syllable diphthong /aɪ/, followed by the plosive bilabial paired consonant [p] preceding the monophthong [i] in the second syllable /pi/, with the primary stress placed on the second syllable in /ˌaɪ ˈpi /, and the secondary stress on the first syllable. These phonemes are altogether absent from Applicant's WARP Mark, which consists solely of the single syllable word "warp", which in American English contains the voiced labial-velar approximant unpaired consonant [w] followed by the open-mid pre-r vowel /ɔ/, leading into the rhotic alveolar approximant constant /r/ plus stop /p/, to generate the sound /wɔɹp/. Moreover, the transition in the Prior Registration from the "P" in the second syllable necessitates an external open juncture leading into the "W" in the third syllable, and final word, "warp". No juncture exists prior to the word "warp" in Applicant's Mark, as it is the only word. Simply put, "IP-WARP" and "WARP" sound very different, and anyone hearing a good or service described as "IP-WARP" would not mistake the product or service as "WARP".

These differences in appearance and sound bolster the distinction between the commercial impressions associated with Applicant's mark and the cited Prior Registration.

Applicant's WARP Mark and the Prior Registration Have Different Commercial Impression.

The Examiner has refused registration of Applicant's WARP Mark based in part on the assertion that the word "IP" is the less dominant element of third-party registrant's IP-WARP mark. With all due respect to the Examiner, this conclusion rests on an improper dissection of registrant's mark. In fact, there is no likelihood of confusion between the registered IP-WARP mark and Applicant's WARP Mark because even a cursory comparison of the marks reveals extensive differences.

It is well established that "likelihood of confusion cannot be predicated on dissection of a mark . . . the ultimate conclusion rests on consideration of the marks in their entireties." *In re Nat'l Data Corp*., 753 F.2d at 1058; TMEP § 1207.01(b)(iv). When the marks are compared in their entireties, they are significantly different in meaning and in overall commercial impression.

The Examiner asserts that the word IP in registrant's mark should be given less weight because it is highly descriptive as used in the Prior Registration. However, no argument or evidence is presented in support of this position. Rather, if any portion of the mark could be considered dominant, it would be "IP" as the first part of the mark. *See Presto Prods., Inc. v. Nice-Pak Prods., Inc.,* 9 USPQ2d 1895, 1897 (TTAB 1988) ("it is often the first part of a mark which is most likely to be impressed upon the mind of a purchaser and remembered").

As the Examiner correctly asserts, "IP" is short for "internet protocol", and VPNs generally hide or mask the IP address, and by extension the identity, of the user from the website they are accessing or to access geo-restricted content. However, Applicant's "WARP" software specifically was not intended to do this. *See attached* Exhibit 1, pp. 1-2 ("WARP is a VPN that doesn't hide your origin IP [and i]t's not advertised to be either, and the terms of service even tell you that your original IP (the one your ISP gave you) is being reported to Cloudflare servers" [excerpt from third-party expert technology information source Android Central]; "[T]he 1.1.1.1 Application is not designed to hide your identity from the Internet properties you access from your device" [excerpt from Cloudflare's "WARP" software Terms of Service]). Applicant's "WARP" software keeps the user's browsing private from would-be third-party snoopers, but not necessarily from the website the user is accessing. In fact, Cloudflare's WARP will provide the source/client IP address of the user to the website whenever possible. *See attached* Exhibit 2 ("[WARP] is designed for a very different audience than a traditional VPN. WARP is not designed to allow you to access geo-restricted content when you're traveling. It will not hide your IP address from the websites you visit."); *see also* Exhibit 1, p. 2 ("Warp and Warp+ will not route traffic data from your device through the Cloudflare network for certain Internet properties, such as over-the-top content provider websites, as determined by Cloudflare in its sole discretion." [excerpt from Cloudflare's

"WARP" software Terms of Service]). In essence, Applicant's WARP software keeps users' data secure without necessarily masking their identity (i.e., IP addresses) from the website being accessed.

Accordingly, beyond the general sense in which an internet protocol address is involved in any internet activity, Applicant's WARP Mark is not used in connection with IP addresses, and the widely acknowledged terms of service for the software, and the absence of any reference to "IP" in the mark are crucial to the public's overall impression of the meaning of the WARP Mark and the software offered in connection therewith, and the express description of the software makes it clear that unlike typical VPN applications, Applicant's Warp software is not for hiding one's IP address. Thus, the absence of the "IP" in Applicant's mark is a crucial source-indicating feature of the WARP Mark, and the cited Prior Registration is not confusingly similar as to the source or features of the goods and/or services offered.

Applicant's WARP Mark and the Prior Registration Have Different Meaning and Connotation.

It is well settled that even where two marks are identical, or nearly identical, differences in connotation can outweigh visual and phonetic similarity. *See Blue Man Prods. Inc. v. Tarmann*, 75 U.S.P.Q.2d 1811, 1820-21 (T.T.A.B. 2005) (finding that BLUE MAN GROUP "has the connotation of the appearance of the performers" and that applicant's BLUEMAN mark "has no such connotation for cigarettes or tobacco.") Such is the case here, as the connotations of Applicant's "WARP" clearly differs from that of third-party registrant's "IP-WARP". Notably, the Examiner recognizes the absence of the descriptor "IP" in Applicant's Mark, which Applicant respectfully asserts vastly changes the overall impression and meaning of the WARP Mark, and additionally serves to bolster the suggestive nature of Applicant's Mark, in contrast to the more descriptive nature of registrant's Prior Registration.

A suggestive trademark is a distinctive, but not descriptive, mark which does not describe a product, but suggests or references it, requiring consumers to exercise imagination to connect the mark with the product.

Each category of trademark is defined by the degree of distinctiveness inherent in its use. They were put in place by a federal appeals court ruling in the case of *Abercrombie & Fitch Co. vs. Hunting World, Inc.*, listed in increasing order of distinctiveness and protectability as "(1) generic; (2) descriptive; (3) suggestive; (4) arbitrary; [and] (5) fanciful." *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 768 (1992) (*citing Abercrombie & Fitch Co. v. Hunting World, Inc.*, 537 F.2d 4, 9 (2d Cir. 1976). As such, the standard used to determine under which category a mark falls is called the Abercrombie Test. Within the above classifications, a suggestive trademark is a mark which suggests or connotes a characteristic or quality of goods, without describing. *Sara Lee Corp. v. Kayser-Roth Corp.*, 81 F.3d 455, 464 (4th Cir.), cert. denied, 519 U.S. 976 (1996). It is a term that, while it does not expressly state the nature of the goods or service, can still be associated with said goods through a basic relationship.

Suggestive trademarks encourage and require the public to engage imagination, perception and thought to create an association with the goods. They are also deemed in the eyes of the courts and government to be inherently distinctive from their first use in commerce, and entitled to protection. *Two Pesos, Inc.*, 505 U.S. at 768.

As used in the WARP Mark in connection with VPN software, absent any reference to IP and expressly not used to conceal a user's IP address, the term "WARP" suggests that the software allows users fast and efficient services (e.g. warp speed) without expressly stating or describing the nature of the goods.

Applicant's WARP Mark and the Prior Registration Describe Different Goods and Services, Both In Their Respective Target Audience and Purpose.

The Examiner has refused registration of Applicant's WARP Mark on the grounds that the goods and services are identical to those offered under the Prior Registration. With all due respect, Applicant submits that both the

goods themselves and the target audiences differ such that there is no likelihood of confusion as to the source of Applicant's goods bearing the WARP Mark and those bearing the Prior Registration mark.

In assessing whether likelihood of confusion exists, it is necessary to compare the applicant's goods with those set forth in the existing registrations. *See Squirtco v. Tomy Corp.*, 697 F.2d 1038, 1042 (Fed. Cir. 1983). Here, the Prior Registration and Applicant's WARP Mark describe differing goods and services, both in their respective target audience and purpose.

Applicant's WARP Mark was filed in Class 009 for "downloadable software for enabling virtual private network (VPN) operation on electronic devices; Downloadable software for providing secure and private access for users to the Internet; Downloadable software for enabling users of electronic devices to securely connect to a remote server in order to allow for secure and private transmission of communications over the Internet; Downloadable software for encrypting electronic data for transmission through a secure and private connection over the Internet"; and Class 038 for "providing virtual private network (VPN) services, namely, private and secure electronic communications over a private or public computer network; providing secure and private access for users to the internet; providing electronic telecommunication connections to enable users of computers and mobile computing devices to securely connect to a remote server in order to allow for secure and private transmission and receipt of data and communications over the internet; electronic transmission of data through a secure and private connection over the internet featuring encryption", based on use in commerce in the U.S. since April 1, 2019.

Conversely, the Prior Registration was granted registration through operation of the Madrid Protocol on May 12, 2015, based on trademark registration in Japan, in Class 009 for "Virtual private network VPN hardware; virtual private network VPN operating software"; Class 037 for "repair and maintenance of virtual private network VPN hardware"; Class 038 for "providing virtual private networks VPN"; and Class 042 for "design, programming and maintenance of virtual private network VPN operating software".

Though both are filed in Classes 009 and 038, the actual goods and services, and target consumers for the Prior Registration are distinct from Applicant's goods and services, which specifically relate to individual user encryption and telecommunication services. The Prior Registration, on the other hand, relates to providing services to sophisticated third-party internet service companies that develop VPN software, not the individual users themselves.

The key inquiry in considering likelihood of confusion is not whether people will necessarily confuse the marks, but whether the marks will be likely to confuse consumers into believing the goods emanate from the same source. *Kangol, Ltd. v. KangaROOS U.S.A., Inc.*, 974 F.2d 161, 163 (Fed. Cir. 1992).

Distinctions between the service and the audience for Applicant's WARP Mark and the Prior Registration demonstrate that consumers are not likely to be confused into believing they emanate from the same source. The owner of the Prior Registration, NTT PC Communications Incorporated ("NTT"), has a target audience for its services that is corporate internet service providers. The goods and services offered under the Prior Registration are for sophisticated software development companies.

Applicant's services, on the other hand, are for average Internet users who do not necessarily have a deep technical understanding of computer networks. *See attached* Exhibit 3 ("[WARP] is a VPN for People Who Don't Know What V.P.N. Stands For")*; see also* Exhibit 2 ("WARP, instead, is built for the average consumer."). Applicant's target audience is individual consumers, particularly, mobile device users, who may download Applicant's WARP software from Apple's App Store or Google Play Store, for their own personal use. As of April 14, 2020, Applicant's WARP software had more than 200,000 reviews with an average rating of 4.5 stars on Apple's App Store and more than 100,000 reviews with 4.5 stars on Google Play Store. *See attached* Exhibit 4.

Unlike Applicant's WARP software, NTT's IP-WARP is not made available on Apple's App Store or Google Play Store. NTT's English website refers to IP-WARP as one of its services, but does not specify how it can be purchased. *See* Exhibit 5, p. 1 (https://www.nttpc.co.jp/english/service/). Notably, the specifics on NTT's website regarding the IP-WARP services are not accessible in English, so the general English-speaking U.S.-based internet user/consumer would be incapable of using the goods purportedly offered. *See* Exhibit 5, p. 2 (https://www.nttpc.co.jp/service/ip-warp/).

Simply put, the audience for goods bearing the IP-WARP mark is necessarily far more advanced than that to whom Applicant's goods are marketed, and the functionality of the goods reflects this difference.

The strong distinction in the nature of the goods and target audience, as well as the marketing and distribution channels, associated with Applicant's WARP Mark and the Prior Registration weighs against a finding of likelihood of confusion. NTT's IP-WARP is a VPN solution for businesses that are for companies that want to connect their Internet of Things ("IoT") devices and other corporate internal network endpoints. *See* Exhibit 5, p. 1. On the other hand, the purpose of Applicant's WARP software is two-fold: (1) increased security; and (2) accessing third-party websites through the open Internet via Cloudflare's network. The intended audience is general consumers that wish to download apps from, e.g., Apple App Store or Google Play Store, for their own personal use.

The stark difference in the nature of the goods associated with each mark, the intended audience to which the services are offered, and circumstances surrounding the appropriate marketing for these groups highlights that the marks will not be likely to confuse consumers into believing the goods emanate from the same source, thus weighing against a finding of a likelihood of confusion.

Applicant's WARP Mark and the Prior Registration Are Not Confusingly Similar, Particularly Because Third-Party Registrant NTT Is Not Using Its Mark In The U.S.

At its most basic level, the likelihood of confusion analysis involves a factual inquiry into whether consumers can distinguish the applicant's goods from the registrant's goods. *See In re E.I. Du Pont de Nemours & Co.*, 476 F.2d at 1360. Here, the only potential confusion between the IP-WARP Mark and Applicant's WARP Mark arises because the marks contain the word "WARP". However, the Prior Registration's registrant, NTT, does not gain a monopoly on the term "WARP" by virtue of its Madrid Protocol-based registration from the Japan trademark office. As discussed above, the appearance, sound, commercial impression, meaning and connotation, goods and services, and target audience differ vastly for the subject WARP Mark and the Prior Registration. The market is clearly capable of distinguishing these goods from one another. Thus, it seems unlikely that the public would mistake products bearing the WARP Mark as originating from the same source as products bearing the Prior Registration.

Moreover, the registrant for IP-WARP, NTT PC Communications Incorporated, is a company based in Japan. The registration was granted through Madrid protocol on May 12, 2015, with no claim made as to any use of the mark in the U.S. Notably, the Section 66(a) Madrid Protocol application for IP-WARP (Intl. Reg. No. 1187613) did not require any claim of use in the U.S., no such claim has been subsequently made, and NTT's website does not support a finding that the IP-WARP services are available to consumers in the U.S., as discussed above.

Under 15 U.S.C. § 1127, a trademark is considered abandoned if "its use has been discontinued with intent not to resume such use." Specifically, nonuse of a mark for three (3) consecutive years from the date registration issues is prima facie evidence, and creates a legal presumption that the mark has been abandoned without the intent to resume use. 15 U.S.C. § 1127; *see Imperial Tobacco Ltd. v. Phillip Morris Inc.*, 899 F.2d 1575, 14 USPQ2d 1390 (Fed. Cir. 1990); *Dragon Bleu (SARL) v. VENM, LLC*, Serial No. 91212231 (TTAB Dec. 1,

2014) (precedential) (period of nonuse that constitutes prima facie evidence of abandonment for a newly registered mark begins the day registration issues); *Executive Coach Builders, Inc. v. SPV Coach Company, Inc.*, 123 USPQ2d 1175 (TTAB 2017). Typically, when a product is available for consumer purchase a company will indicate some means of obtaining the product on its website, where the rest of their products are advertised, or somewhere otherwise discoverable via an internet search, even if only to indicate a third-party through which the goods can be obtained. In particular, because these are not physical goods, but internet services and downloadable software, one would expect the goods to be accessible electronically. Moreover, NTT actively sought trademark registration in the U.S., so it stands to reason they would want to be able to sell their products to the public in the U.S. via the internet, not secret them away. This evidence demonstrates NTT is not offering the subject goods and/or services in connection with its IP-WARP mark, and has not done so in the nearly five (5) years since it was granted U.S. trademark registration.

In all trademark applications filed in the U.S., through any mechanism, it is necessary for the applicant to assert, under penalty of criminal perjury, that it is either using the mark or has a bona fide intent to use the mark *in the U.S.* on all of the goods and to provide all of the services in the application. If the applicant does not have the requisite intent at the time the application is filed, the application and any resulting registration are vulnerable to being canceled or declared void at a later date. Thus, although Section 66(a) applicants need not prove use in order to obtain a U.S. registration, they still do need to have the requisite intent to use the mark in the U.S. at the time their U.S. applications are filed, and they cannot maintain the registration without engaging in use. 15 U.S.C. § 1127. The level of "use" necessary to satisfy this threshold must be a bona fide use of the mark in the "ordinary course of trade" for the specific industry in question, and cannot be a use, such as a token use, made merely as an attempt to reserve a right in a mark, or merely isolated or de minimis use. *Executive Coach Builders, Inc. v. SPV Coach Company, Inc.*, 123 USPQ2d 1175 (TTAB 2017).

Accordingly, pursuant to U.S. trademark law, NTT's failure to use and/or demonstrate use of mark within 3 years of the May 12, 2015 registration date is prima facie evidence that it has been abandoned in the U.S. On the other hand, Applicant's WARP software has garnered more than 200,000 and 100,000 ratings on Apple's App Store and Google Play Store, respectively, averaging 4.5 stars. There can be no consumer confusion based on a trademark that has been abandoned and is not in use in the U.S. In short, the consumers of goods bearing Applicant's WARP Mark are for the most part incapable of even accessing information regarding the Prior Registration in any practical sense.

As there is no showing of record that registrant's IP-WARP is actually in use in commerce in the U.S., there is unlikely to be any confusion in the market from registrant's referenced goods in opposition to Applicant's WARP Mark. Accordingly, Applicant respectfully requests that the Examiner rescind the Office Action and allow registration of the subject WARP Mark.

Specimen Refusal – Class 9 Only

The Examiner has refused registration of Applicant's WARP Mark in International Class 009 only, on the grounds that the specimen appears to be mere advertising material, which fails to show the mark in use in commerce for the downloadable software. Applicant respectfully submits the attached verified "substitute" specimen that was (a) in actual use in commerce at least as early as the filing date of the application and (b) shows the mark in actual use in commerce to download the software identified in the application, namely the Google Play Store displaying the Mark in connection with purchasing and/or downloading the software.

Accordingly, Applicant respectfully requests that the Examiner remove this objection as to Class 009 and allow registration of the WARP Mark as applied-for.

The Pending Applications

Applicant respectfully submits that the applications cited by the Examiner as confusingly similar to the WARP Mark, namely third-party applications for WARP-G (Serial No. 87900764), WARP-G MOBILE (Serial No. 88173736), WARPVPN (Serial No. 88415242), WARP (Serial No. 88415212), WARPENGINE (Serial No. 88415187), and WARPTCP (Serial No. 88415070) (collectively, the "**Pending Applications**") will not cause confusion with the subject mark for the following reasons.

In testing for likelihood of confusion under Section 2(d), the *Du Pont* factors need to be considered, including factors such as the similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation, and commercial impression; the similarity or dissimilarity and nature of the goods or services as described in an application or registration or in connection with which a prior mark is in use; the purchasers of the goods i.e. "impulse" vs. careful, sophisticated purchasing; and the number and nature of similar marks in use on similar goods. *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357 (C.C.P.A. 1973). The proper test for likelihood of confusion is not a side-by-side comparison of two marks, but rather the entire way in which they are used and perceived. *In re Nat'l Data Corp*., 753 F.2d 1056, 1058 (Fed. Cir. 1985). Here, distinctions between the sound, meaning, connotation, commercial impression, and nature of the goods and services of Applicant's subject WARP Mark and the Pending Applications dictate against a refusal on the basis of likelihood of confusion.

The Badu Applications Have Been Abandoned For Failure to Timely Respond to Office Actions.

In addition to the distinctions in the goods and services offered, and visual, phonetic, and overall commercial impression between Applicant's subject Mark and Badu Networks, Inc. ("**Badu**")'s WARP, WARPTCP, WARPENGINE, and WARPVPN mark applications (Serial Nos. 88415212, 88415070, 88415187, and 88415242, respectively) (collectively, the "**Badu Applications**"), the Badu Applications were also each the subject of an Office Action on various grounds issued July 24, 2019. Badu accordingly had until January 24, 2020, to respond to each of these Office Actions, or the applications be deemed abandoned. Having filed no response by the January 24, 2020 deadline, each of the Badu Applications was properly abandoned per the February 5, 2020 Notices of Abandonment. The 2-month revival period lapsed on April 5, 2020, without any filing as to the WARPENGINE (SN 88415187) and WARPTCP (SN 88415070) applications, and accordingly these applications are dead and do not present an impediment to Applicant's WARP Mark. Moreover, though the WARP (SN 88415212) and WARPVPN (SN 88415212) applications (together, the "**Badu VPN Applications**") were revived, Badu has to date filed no responses to the respective pending Office Actions.

Accordingly, Applicant respectfully requests all objections on the basis of the WARPENGINE and WARPTCP applications be removed, and Applicant's subject application be permitted to proceed.

Applicant's WARP Mark Appears and Sounds Different from the Remaining Pending Applications.

In a likelihood of confusion analysis, the entirety of the marks, and not their component word elements, must be compared. *See Opryland USA Inc. v. Great American Music Show, Inc.*, 970 F.2d 847, 23 USPQ2d 1471 (Fed. Cir. 1992). Here, the WARP Mark produces a starkly different commercial impression from that of the Badu VPN Applications and Webstar Technology Group, Inc. ("**Webstar**")'s WARP-G & WARP-G MOBILE applications (Serial Nos. 87900764 & 88173736, respectively) (together, the "**Webstar Applications**") (collectively, the "**Remaining Pending Applications**"), especially when considering their visual and audible distinctions.

Visually, while Applicant's Mark and the subject pending applications contain the word "WARP," their appearances differ, as Badu's WARPVPN mark features compound words comprised of two or more distinct words and/or acronyms, and the Webstar Applications feature the hyphenated modifier "-G". On the other hand,

Applicant's WARP Mark is a single fanciful or suggestive word when considered in connection with the goods and services offered therewith. Moreover, Webstar's WARP-G MOBILE mark also contains the additional term "MOBILE", forming a two-word phrase consisting of hyphenated compound word and an adjective. The word "WARP" bears sufficient visual distinctions from "WARPVPN," "WARP-G," and "WARP-G MOBILE" that no reasonable person glancing at the marks would mistake one for the other – they are clearly different words.

Furthermore, significant phonetic differences between "WARP" and the subject pending applications exist. From a linguistic perspective, the pronunciation of "WARP" differs vastly from the pronunciation of the words "WARPVPN," "WARP-G," and "WARP-G MOBILE". The terms contained in the pending third-party applications contain more syllables, and consist of additional terms and acronyms that are pronounced nothing like the term "WARP". Simply put, "WARP", and "WARPVPN," "WARP-G," and "WARP-G MOBILE" sound very differently, and anyone hearing a good described as "WARP" would not mistake the product – visually or audibly – as "WARPVPN," WARP-G," or "WARP-G MOBILE".

These differences in appearance and sound bolster the distinction between the commercial impressions associated with Applicant's mark and the marks in the referenced Pending Applications.

Applicant's WARP Mark and the Remaining Pending Applications Describe Different Goods and Services.

The Badu VPN Applications were filed on May 3, 2019, based on use commencing that same date in connection with broadband wireless equipment, namely, telecommunications base station equipment for cellular and fixed networking and communications applications (Class 009); and for high bit-rate data transmission services for telecommunication network operators, and transfer of data by telecommunication (Class 038). Badu's physical broadband equipment and telecommunication network services are dramatically different from the downloadable VPN software and services offered in connection with Applicant's WARP Mark.

The Badu VPN Applications are also applied for on an alleged intent-to-use basis in connection with downloadable virtual private network operating software. However, as demonstrated in Applicant's subject WARP Mark application filings and evidence, Cloudflare commenced widespread actual bona fide use of its mark in connection with VPN software and services as early as April 1, 2019, which use precedes both the filing date of Badu's subject applications, and the date of first use claimed for the goods and services for which they have alleged use. Moreover, pursuant to the pending Office Actions for the Badu VPN Applications, in addition to the pending refusal Badu faces in Class 009, they have also been refused in Class 038 for failure of the specimen to demonstrate the mark in commerce in connection with telecommunication services claimed.

In a likelihood of confusion analysis, a party must first establish that it has priority. Neither the filing dates nor the first-use dates claimed for any of the asserted goods or services in either of Badu's VPN Applications precedes Applicant's proven date of first use of the WARP Mark. In short, Applicant's WARP Mark cannot create confusion with Badu's VPN Applications because Badu is not using the marks in connection with VPN or related goods or services, and they have thus far failed to demonstrate use even in connection with telecommunication network operation services.

Third-party applicant Webstar filed the WARP-G application on an intent to use basis in Class 042 for "digital compression of computer data, providing technology information in the field of cable services, technology consultation in the field of data speed, technology consultation in the technology field of data compression and software development, computer software development in the field of data bandwidth, computer software development in the field of data security". Applicant has not alleged use, and was granted its 2nd extension of time to file a Statement of Use on November 22, 2019. Applicant's deadline to file the Statement of Use or request a 3rd 6-month extension is May 20, 2020.

Webstar filed the WARP-G MOBILE application with no basis claimed, and no class of goods or services, for "technology business with proprietary software for B2C and B2B that optimizes data compression, data speed and data storage serving the mobile, internet, TV cable industry". On August 15, 2019, the filing basis was amended to 1(b), again applying only in Class 042, for "technology business with proprietary software for B2C and B2B that optimizes data compression, data speed and data storage serving the mobile, internet, TV cable industry. Downloadable software for B2C and B2B that optimizes data compression, data speed and data storage serving the mobile, internet, TV cable industry". An Office Action issued regarding the WARP-G MOBILE application on September 5, 2019, which in pertinent part denied registration on grounds that the identification of goods and/or services were indefinite, and the examining attorney suggested amending to Class 009 for "downloadable software for B2C and B2B that optimizes data compression, data speed and data storage service the mobile, internet, TV cable industry." However, the suggested amendment was *not* adopted as Webstar's position, and in its March 5, 2020 Office Action response it rejected Class 009, confirming Class 042 as the appropriate class of services offered under the WARP-G MOBILE mark, and amending the description of services to "[p]roviding use of non-downloadable software for B2C and B2B that optimizes data compression, data speed and data storage serving the mobile, internet, TV cable industry. Digital compression and electronic storage of computer data featuring software for B2C and B2B in the mobile, internet, TV cable industry". The application also remains on a 1(b) intent-to-use basis.

Moreover, the scope of the goods and/or services in Webstar's original application sets the outer limit for any amendments that can be made for the WARP-G MOBILE application. *See* TMEP §§ 1402.06(b). 1402.07(a)-(b). Accordingly, no amendment can be made to the pending WARP-G MOBILE application to add Class 009 downloadable software for enabling VPN operations or Class 038 VPN services, as asserted in Applicant's WARP application.

There is no indication in the record that Webstar intends to offer goods or VPN services in connection with the WARP-G MOBILE mark. The application of record for both WARP-G and WARP-G MOBILE presently provides only the intent to use the marks in connection with technology business and consulting services, which is distinct from the goods and services described in Applicant's WARP application. As applied-for, Cloudflare's "WARP" mark is not used in connection with a technology business, but rather downloadable software and VPN services.

Applicant's WARP Mark and the Pending Applications Are Not Confusingly Similar.

As discussed above, the differences in the appearance and sound, and dissimilarity and nature of the goods and services as described in the applications, between Applicant's WARP Mark and the Remaining Pending Applications weigh in favor of a finding against a likelihood of confusion. Accordingly, Applicant respectfully requests that the Examining Attorney rescind the Office Action and allow registration of the subject WARP Mark.

Conclusion

For the foregoing reasons, Applicant requests that the objections of the Examiner be withdrawn, the "substitute" specimen in Class 009, filed concurrently herewith, be accepted and made of record, and the subject application be permitted to proceed.

Respectfully submitted,

BLUE WATER LAW, P.C.

Courtney R. Blackwell

EXHIBIT 1

WARP is a VPN that doesn't hide your origin IP (where or who you are) but does encrypt your traffic and use Cloudflare's 1.1.1.1 DNS service. It's rolled into the 1.1.1.1 app and shouldn't be considered a separate thing. The 1.1.1.1 app protects your DNS queries from being "sniffed" on local and unsecured networks, like the Wi-Fi router at your local Starbucks, and when WARP is activated from inside the app it adds a VPN encryption layer that adds to that protection.

A VPN can bolster your online privacy, but that wasn't Cloudflare's original intent

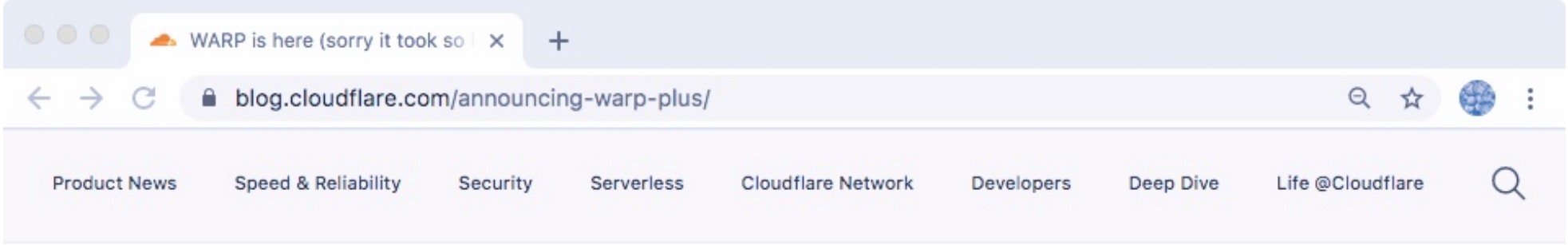
This is all the 1.1.1.1 app does, and it's not any good for hiding your location or browsing anonymously. It's not advertised to be either, and the terms of service even tell you that your original IP (the one your ISP gave you) is being reported to Cloudflare servers. Cloudflare

3. Application Services

The Application Services comprise the 1.1.1.1 Application and related Application Services, which enable you to route your devices DNS queries and traffic data through the Cloudflare network. The 1.1.1.1 Application may require that you install a VPN profile on your device to be enabled. Once installed, you can enable the 1.1.1.1 only setting in the 1.1.1.1 Application to route all of your devices DNS queries in an encrypted fashion to Cloudflare's Public DNS resolver (referred to as the 1.1.1.1 Resolver) using either (1) DNS over HTTPS, or (2) DNS over TLS. You can also enable Warp in the 1.1.1.1 Application, which includes everything from the 1.1.1.1 setting and will also route traffic from your device through the Cloudflare network via encrypted tunnels. Warp+ is a premium version of Warp, which includes everything from the 1.1.1.1 with Warp and will also route your devices traffic through the Cloudflare network utilizing Cloudflare's smart traffic routing algorithms known as Argo Smart Routing. Warp and Warp+ will not route traffic data from your device through the Cloudflare network for certain Internet properties, such as over-the-top content provider websites, as determined by Cloudflare in its sole discretion. The 1.1.1.1 Application provides you with access to certain diagnostic information regarding your devices use of the Application Services, such as DNS logs, console logs, and other diagnostic information, as may be updated by Cloudflare from time to time.

*Although the 1.1.1.1 Application may need to install a VPN profile on your device and operates similarly to a VPN product or service, the 1.1.1.1 Application is not designed to hide your identity from the Internet properties you access from your device. *

EXHIBIT 2



What WARP Is Not

From a technical perspective, WARP is a VPN. But it is designed for a very different audience than a traditional VPN. WARP is not designed to allow you to access geo-restricted content when you're traveling. It will not hide your IP address from the websites you visit. If you're looking for that kind of high-security protection then a traditional VPN or a service like Tor are likely better choices for you.

WARP, instead, is built for the average consumer. It's built to ensure that your data is secured while it's in transit. So the networks between you and the applications you're using can't spy on you. It will help protect you from people sniffing your data while you're at a local coffee shop. It will also help ensure that your ISP isn't hoovering up data on your browsing patterns to sell to advertisers.

WARP isn't designed for the ultra-techie who wants to specify exactly what server their traffic will be routed through. There's basically only one button in the WARP interface: ON or OFF. It's simple on purpose. It's designed for my mom and dad who ask me every holiday dinner what they can do to be a bit safer online. I'm excited this year to have something easy for them to do: install the 1.1.1.1 App, enable WARP, and rest a bit easier.

How Fast Is It?

Once we got WARP to a stable place, this was my first question. My initial inclination was to go to one of the many Speed Test sites and see the results. And the results were... weird. Sometimes much faster, sometimes much slower. Overall, they didn't make a lot of sense. The reason why is

EXHIBIT 3

A VPN for People Who Don't Know What V.P.N. Stands For

Technically, Warp is a VPN. However, we think the market for VPNs as it's been imagined to date is severely limited. Imagine trying to convince a non-technical friend that they should install an app that will slow down their Internet and drain their battery so they can be a bit more secure. Good luck.

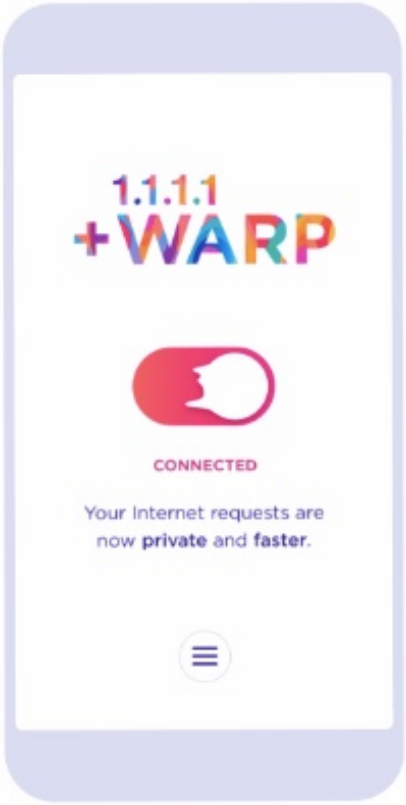


EXHIBIT 4

1.1.1.1: Faster Internet on the A

apps.apple.com/us/app/1-1-1-1-faster-internet/id1423538627

Mac iPad iPhone Watch TV Music Support

App Store Preview

This app is available only on the App Store for iPhone and iPad.

1.1.1.1: Faster Internet 4+

A More Private Internet

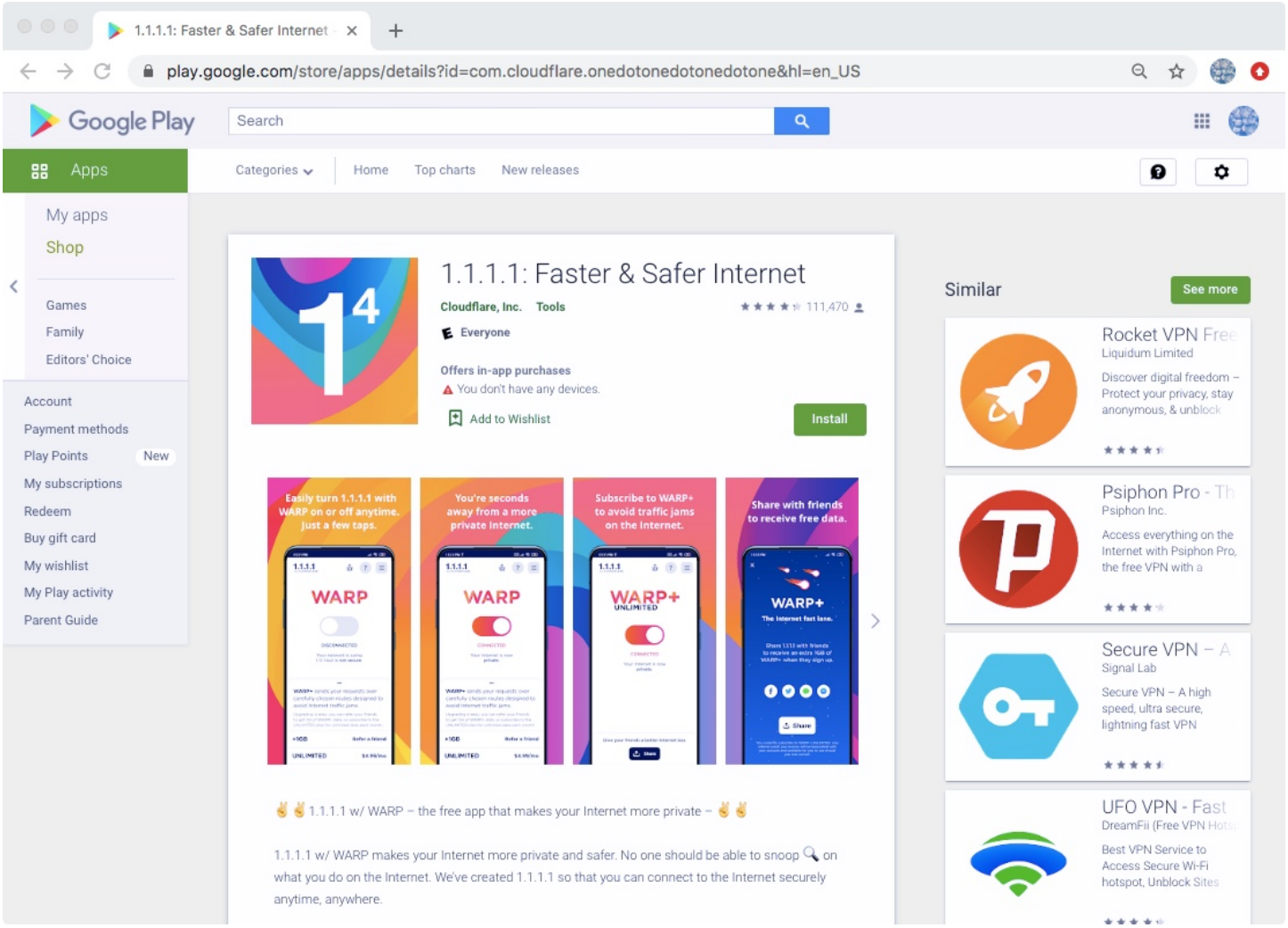
Cloudflare

#159 in Utilities

4.5, 215.9K Ratings

Free · Offers In-App Purchases

Screenshots iPhone iPad


1.1.1.1: Faster & Safer Internet
play.google.com/store/apps/details?id=com.cloudflare.onedotonedotonedotone&hl=en_US
Google Play
Search
Apps
Categories
Home
Top charts
New releases
My apps
Shop
Games
Family
Editors' Choice
Account
Payment methods
Play Points
New
My subscriptions
Redeem
Buy gift card
My wishlist
My Play activity
Parent Guide
1.1.1.1: Faster & Safer Internet
Cloudflare, Inc.
Tools
111,470
Everyone
Offers in-app purchases
You don't have any devices.
Add to Wishlist
Install
Easily turn 1.1.1.1 with WARP on or off anytime, just a few taps.
You're seconds away from a more private Internet.
Subscribe to WARP+ to avoid traffic jams on the Internet.
Share with friends to receive free data.
WARP
WARP+
UNLIMITED
The Internet fast lane.
✌✌ 1.1.1.1 w/ WARP – the free app that makes your Internet more private – ✌✌
1.1.1.1 w/ WARP makes your Internet more private and safer. No one should be able to snoop 🔍 on what you do on the Internet. We've created 1.1.1.1 so that you can connect to the Internet securely anytime, anywhere.
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Psiphon Pro - Th
Psiphon Inc.
Access everything on the Internet with Psiphon Pro, the free VPN with a
Secure VPN – A
Signal Lab
Secure VPN – A high speed, ultra secure, lightning fast VPN
UFO VPN - Fast
DreamFii (Free VPN Hots
Best VPN Service to Access Secure Wi-Fi hotspot, Unblock Sites

EXHIBIT 5

Solution Service | 【Official】

nttpc.co.jp/service/

NTTPC

Points of View | Solution service | Case study | 検索 | Contact Us | FAQ | JP

Partner programs | Customer support

Company information

Rakutaro Mishimari →

Bird and beast control IoT service adopted by a total of 50 local governments since 2011.

E-mail notification of trap operation status, greatly reducing patrol effort.

IP-WARP® →

A VPN service that realizes easy and low-cost secure IoT communication despite the Internet environment using NTTPC's unique technology

River monitoring package →

River monitoring with camera + cloud. Low-cost patrol and monitoring of river conditions such as water levels and gates

Data center hosting →

IP-WARP® | Solution Services

nttpc.co.jp/service/ip-warp/

NTTPC

Points of View | Solution service | Case study | Partner programs | Customer support | Company information

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Simple and low-cost IoT communication with high security for devices and sensors

IP-WARP is a VPN service that realizes a secure network environment that connects devices such as POS, multifunction devices, sensors, control / monitoring devices, and the customer's cloud based on NTTC's unique technology. If you have an Internet connection environment, you can easily and inexpensively build a network without any special knowledge, leaving the existing network as it is. Since various devices at remote locations can be identified, "things" can be controlled and data collected at all times.

“IP-WARP®” mechanism and provision type