

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:)	
SecureWorks Corp.)	
Serial No.: 77/576,878)	Post Registration Division
Registration No.: 3,727,258)	Attn: Vicky Copeland
Filed: September 23, 2008)	Trademark Specialist
Mark: TERAGUARD)	

RESPONSE TO OFFICE ACTION

This is in Response to the Office Action that issued on March 9, 2016 in connection with the captioned application.

ASSIGNMENT

The subject application was assigned on March 31, 2016 to SecureWorks Corp. The assignment has been recorded with the United States Patent and Trademark Office at Reel/Frame No. 005762/0322. The assignment took place after the Section 8 & 15 Declarations were filed on January 6, 2016. The undersigned submits this response on behalf of the new owner, SecureWorks Corp.

REJECTION OF CLASS 9 SPECIMEN

I. INTRODUCTION

This matter is an example of where the goods are complex or sophisticated goods that require technical assistance in selecting the product or determining the product specifications. In such a

case, the TMEP considers webpages to be a display associated with the goods and a specimen of use, even if one cannot directly order or download the goods from the website. *See* TMEP 904.03(i)(C)(2). Here, the goods are highly complex security software that is uniquely tailored to each customer's computer systems. The goods must be installed via a secure tunnel. Moreover, Registrant, SecureWorks Corp. ("SecureWorks") or its predecessor in interest Dell Inc. could not disclose the details of the software to everyone and anyone. That would render the purpose of the software moot because then anyone could hack into the system. In order to ensure that it was communicating with genuine consumers, the website of SecureWorks' predecessor in interest Dell Inc. allowed consumers to enter their contact and business information and then a security specialist contacted the consumer directly in a secure way. Accordingly, because the software is highly complex, uniquely tailored security software that cannot just be downloaded from the Internet, the webpage submitted should be considered a display associated with the goods and an acceptable specimen of use.

II. PRODUCT DESCRIPTION

The TERAGUARD software platform provides continuous monitoring of an organizations network security infrastructure. The TERAGUARD security monitoring software was developed to provide customers with an early warning system for Internet based security events. The TERAGUARD software complies a wide range of disparate data sources and data formats from security and network hardware and devices and converts the data into a single stream of security related events. The TERAGUARD software then analyzes and prioritizes these events. The TERAGUARD software identifies security issues and alerts customers of relevant security issues while communicating appropriate response measures, such as activating an incident response and forensics team.

The TERAGUARD software is uniquely tailored to each customer's computer network. As explained in the specimen: "TERAGUARD allows for services to be uniquely tailored to each customer's operational processes and IT environment." TERAGUARD is complicated security software that is individually tailored to meet each customer's needs. It is not software that can be simply downloaded from the Internet. It must be installed on the customer's network in a secure manure to ensure that the security monitoring services are not compromised.

III. THE SPECIMEN IS A DISPLAY ASSOCIATED WITH THE GOODS

A. The Standard

The Trademark Manual of Examining Procedure ("TMEP") Section 904.03(i) explains: "A web page that displays a product can constitute a "display associated with the goods" if it:

- (1) contains a picture or textual description of the identified goods;
- (2) shows the mark in association with the goods; and
- (3) provides a means for ordering the identified goods.

See In re Sones, 590 F.3d 1282, 1288, 93 USPQ2d 1118, 1123 (Fed Cir. 2009); *In re Azteca Sys., Inc.*, 102 USPQ2d 1955, 1957-58 (TTAB 2012) ; *In re Dell Inc.*, 71 USPQ2d 1725, 1727 (TTAB 2004).

Here, the specimen describes the Class 9 goods, shows the mark TERAGUARD in connection with such goods and provides a means for ordering the software. Accordingly, the specimen submitted in connection with the Class 9 goods should be accepted.

1. *The Specimen Contains a Textual Description of the Goods*

Here, the Webpage submitted contains a textual description of the Class 9 software products. The Webpage states: "TERAGUARD is Dell SecureWorks large enterprise delivery

platform” PLATFORM is synonymous with software. Webopedia defines PLATFORM as “The underlying hardware or software for a system.” See printout from <http://www.webopedia.com/sgsearch/results?cx=partner-pub-8768004398756183%3A6766915980&cof=FORID%3A10&ie=UTF-8&q=platform> attached as Exhibit 1. Similarly Wikipedia defines PLATFORM as “A computing platform is, in the most general sense, whatever a pre-existing piece of computer software or code object is designed to run within, obeying its constraints, and making use of its facilities.” See printout from https://en.wikipedia.org/wiki/Computing_platform attached as Exhibit 2.

The subject specimen further describes the software in detail as a “multi-tenant security monitoring and management technology that supports flexible and scalable service delivery in the largest of environments ... TERAGUARD automates mature SOC process and management functions ensuring consistent service delivery and ongoing operational efficiency....” At the bottom of the specimen is a bulleted list of the “Features and Benefits” of the software.

Accordingly, the Webpage satisfies the first element of the test to determine whether the Webpage is a display associated with the goods.

2. The Specimen Shows the Mark in Connection with the Goods

The Webpage uses the subject mark TERAGUARD often to refer to the security software platform being offered. Specifically the specimen states:

- TERAGUARD is Dell SecureWorks large enterprise delivery platform
- TERAGUARD also features flexible operational support systems
- TERAGUARD automates mature SOC processes
- TERAGUARD allows for services to be uniquely tailored to each customer’s operational processes....

- A core element of TERAGAURD is the SDA, a secure fault tolerant communication and management device
- Deployed behind the firewall, the SDA connects to TERAGUARD via a secure tunnel.

Accordingly, the Webpage shows the subject mark in connection with the goods and satisfies the second element of the test to determine whether the Webpage is a display associated with the goods.

3. *The WebPage Provides a Means for Ordering the Identified Goods*

The subject services are an example of complex or sophisticated goods for which technical assistance is required in order to install and tailor the product to the consumer's computer systems. In such a case, the USPTO has accepted webpages as point of sales displays even if one cannot directly order the goods through the webpage. *See* TMEP 904.03(i)(C)(2).

A display used in association with the goods is essentially a point-of-sale display designed to catch the attention of purchasers as an inducement to consummate a sale. "Factually, we need to ask whether the purported point-of-sale display provides the potential purchaser with the information normally associated with ordering products of that kind." *In re Anpath Group Inc.*, 95 USPQ2d 1377, 1381 (TTAB 2010).

Here, the product is software complicated security software. In order to ensure that information about the software is disclosed in a secure way, it is necessary to screen potential customers. At the time the specimen was submitted, one way of screening to ensure that a true customer is inquiring about the software, was to require that the customer enter its contact information and having a security specialist contact the customer directly. The webpage serves as a point of sale display to allow consumers to learn about the features and benefits of the software. The nature of the software requires that a security specialist have detailed technical

discussions with potential customers to learn about their computer networks and systems. Moreover, such discussions are highly confidential and must occur in a secure way. Additionally, the installation and set up of the software must be performed in a secure environment as well. If anyone could call up and discuss the details of the software then its purpose would be moot because anyone could hack into the software and render it useless. In order to ensure that only actual consumers are interested in learning about the software the webpage provides a place for the consumer to enter their name, company, and contact information and a security specialist will contact the consumer in a secure way. Due to the specialized nature of the software, a security specialist contacts the customer, rather than the customer calling the Registrant.

Accordingly, the webpage serves as a point of sale display and should be considered an acceptable specimen for the Class 9 goods.

CONCLUSION

Based on the foregoing, Registrant respectfully requests that specimen be accepted for Class 9 and the registration renewed. Prompt and favorable action is requested.

Dated: September 8, 2016

By: /Abigail Rubinstein/

Abigail Rubinstein
arubinstein@weissarons.com
WEISS & ARONS, LLP
1540 Route 202, Suite 8
Pomona, New York 10970
Telephone: (845) 362-6100
Facsimile: (845) 362-6111

*Attorneys for Registrant
SecureWorks Corp.*