

**To:** Novalyst IT AG ([trademarks@carterstafford.com](mailto:trademarks@carterstafford.com))  
**Subject:** U.S. TRADEMARK APPLICATION NO. 79104646 - I SMART OPENID - MEYE03-00005 - EXAMINER BRIEF  
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## UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)

U.S. APPLICATION SERIAL NO. 79104646

MARK: I SMART OPENID

**\*79104646\***

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**GENERAL TRADEMARK INFO**

<http://www.uspto.gov/trademarks>

**TTAB INFORMATION:**

<http://www.uspto.gov/trademarks/process>

**APPLICANT:** Novalyst IT AG

**CORRESPONDENT'S REFERENCE/DOCKET NO :**

MEYE03-00005

**CORRESPONDENT E-MAIL ADDRESS:**

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### EXAMINING ATTORNEY'S APPEAL BRIEF

INTERNATIONAL REGISTRATION NO. 1096037

#### I. STATEMENT OF THE CASE

The applicant has appealed the final refusal to register the proposed mark, I SMART OPENID and design, for use with "providing user access to a global computer network; providing user access to computer programmes in data networks; providing access to the internet; internet service provider services, namely, providing multiple user bandwidth and dedicated access to the internet to enable electronic access to computer software, websites, software applications, electronic databases, digital content, and business

computer software applications of others accessible via the internet,” in International Class 38; and “updating of computer software; updating of websites for others; design and development of computer software; design and development of computer systems; computer programming; engineering; design and development of electronic data security systems; computer services, namely, electronic data storage by providing data storage facilities; technological services, namely, research in the field of computer networking hardware, computer security technology and computer datacenter architecture; technical support services, namely, technical administration of servers for others and troubleshooting in the nature of diagnosing server problems; computer security services, namely, restricting access to and by computer networks; design, development and implementation of software for authenticating digital signatures; computer services, namely, designing and implementing websites for others,” in International Class 42. Registration was refused under Section 2(d) of the Trademark Act, 15 U.S.C. Section 1052(d), on the ground that the proposed mark is likely to be confused with the mark in U.S. Registration No. 3222861, OPENID, in standard characters, for use in connection with “software for authentication, identity management, security, information sharing, social networking, messaging, and personal communications,” in International Class 9. It is respectfully requested that the Trademark Act Section 2(d) refusal be affirmed.

## **II. FACTS**

On August 12, 2011, the applicant filed the instant application, in the form of a request for extension of protection of an international registration under the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks, for the mark I SMART OPENID and design for use in connection with “providing user access to a global computer network; providing user access to computer programmes in data networks; providing access to the internet; internet service provider services, namely, upload of web pages,” in International Class 38, and “updating of computer software; updating of websites for others; design and development of computer software; design and development of computer systems; computer programming; engineering; design and development of electronic data security systems; computer services, namely, electronic data storage by providing data storage facilities; technological services, namely, research in the field of computer networking hardware, computer security technology and computer datacenter architecture; technical support services, namely, technical administration of servers for others and troubleshooting in the nature of diagnosing server problems;

computer security services, namely, restricting access to and by computer networks; design, development and implementation of software for authenticating digital signatures; computer services, namely, designing and implementing websites for others,” in International Class 42.

In the first Office action, mailed December 15, 2011, registration was refused under Trademark Act Section 2(d), 15 U.S.C. §1052(d), because of a likelihood of confusion with the mark in U.S. Registration No. 3222861, OPENID, in standard characters, for use with “computer software for authentication, identity management, security, information sharing, social networking, messaging, and personal communications,” in International Class 9. In addition, requirements were issued for a disclaimer of the exclusive right to use the word SMART, an acceptable claim of color in the mark and description of the mark, and an acceptable identification of International Class 38 services.

On June 15, 2012, the applicant responded to the first Office action with arguments in favor of withdrawal of the Section 2(d) refusal and disclaimer requirement. The applicant also submitted an amended color claim and description of the mark and amended the identification of International Class 38 services to “providing user access to a global computer network; providing user access to computer programmes in data networks; providing access to the internet; internet service provider services, namely, providing multiple user bandwidth and dedicated access to the internet to enable electronic access to computer software, websites, software applications, electronic databases, digital content, and business computer software applications of others accessible via the internet.”

In the final Office action, mailed July 23, 2012, the amended identification of services, color claim and description of the mark were accepted and entered into the record and the disclaimer requirement was withdrawn. The refusal under Trademark Act Section 2(d) was made final. On January 23, 2013, the applicant responded to the final refusal with a notice of appeal and a request for reconsideration which was subsequently denied.

### **III. ARGUMENT**

Trademark Act Section 2(d) bars registration of an applied-for mark that so resembles a registered mark

that it is likely a potential consumer would be confused, mistaken, or deceived as to the source of the goods and services of the applicant and registrant. *See* 15 U.S.C. §1052(d). A determination of likelihood of confusion under Section 2(d) is made on a case-by case basis and the factors set forth in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (C.C.P.A. 1973) aid in this determination. *Citigroup Inc. v. Capital City Bank Grp., Inc.*, 637 F.3d 1344, 1349, 98 USPQ2d 1253, 1256 (Fed. Cir. 2011) (citing *On-Line Careline, Inc. v. Am. Online, Inc.*, 229 F.3d 1080, 1085, 56 USPQ2d 1471, 1474 (Fed. Cir. 2000)). Not all the *du Pont* factors, however, are necessarily relevant or of equal weight, and any one of the factors may control in a given case, depending upon the evidence of record. *Citigroup Inc. v. Capital City Bank Grp., Inc.*, 637 F.3d at 1355, 98 USPQ2d at 1260; *In re Majestic Distilling Co.*, 315 F.3d 1311, 1315, 65 USPQ2d 1201, 1204 (Fed. Cir. 2003); *see In re E. I. du Pont de Nemours & Co.*, 476 F.2d at 1361-62, 177 USPQ at 567.

In the instant *ex parte* examination, the following factors are the most relevant: similarity of the marks, similarity and nature of the goods and services, and similarity of the trade channels of the goods and services. *See In re Viterra Inc.*, 671 F.3d 1358, 1361-62, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012); *In re Dakin's Miniatures Inc.*, 59 USPQ2d 1593, 1595-96 (TTAB 1999); TMEP §§1207.01 *et seq.*

The overriding concern is not only to prevent buyer confusion as to the source of the goods and services, but to protect the registrant from adverse commercial impact due to use of a similar mark by a newcomer. *See In re Shell Oil Co.*, 992 F.2d 1204, 1208, 26 USPQ2d 1687, 1690 (Fed. Cir. 1993). Therefore, any doubt regarding a likelihood of confusion determination is resolved in favor of the registrant. *In re Power Distrib., Inc.*, \_\_\_ USPQ2d \_\_\_, Ser. No. 77825939, 2012 TTAB LEXIS 402, at \*12 (Sept. 29, 2012); TMEP §1207.01(d)(i); *see In re Hyper Shoppes (Ohio), Inc.*, 837 F.2d 463, 464-65, 6 USPQ2d 1025, 1025 (Fed. Cir. 1988).

#### **A. The Proposed Mark Is Very Similar In Commercial Impression To The Cited Mark**

In any likelihood of confusion determination the marks are compared in their entireties for similarities in appearance, sound, connotation, and commercial impression. *In re Viterra Inc.*, 671 F.3d 1358, 1362, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012) (quoting *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563, 567 (C.C.P.A. 1973)); TMEP §1207.01(b)-(b)(v).

The applicant argues that the proposed and cited marks are different in sound, appearance and commercial impression. The applicant points to the additional elements and stylization in the proposed mark and the fact that the registrant's mark is comprised solely of the wording OPENID, in standard characters.

Initially, in response to the applicant's arguments it is noted that, as a standard character mark, the registrant's mark could be presented in a font identical to the font used by the applicant. A mark in typed or standard characters may be displayed in any lettering style; the rights reside in the wording or other literal element and not in any particular display or rendition. See *In re Viterra Inc.*, 671 F.3d 1358, 1363, 101 USPQ2d 1905, 1909 (Fed. Cir. 2012); *In re Mighty Leaf Tea*, 601 F.3d 1342, 1348, 94 USPQ2d 1257, 1260 (Fed. Cir. 2010); 37 C.F.R. §2.52(a); TMEP §1207.01(c)(iii).

In addition, when comparing marks, the test is not whether the marks can be distinguished in a side-by-side comparison, but rather whether the marks are sufficiently similar in their entireties that confusion as to the source of the goods and services offered under applicant's and registrant's marks is likely to result.

*Midwestern Pet Foods, Inc. v. Societe des Produits Nestle S.A.*, 685 F.3d 1046, 1053, 103 USPQ2d 1435, 1440 (Fed. Cir. 2012); *Edom Labs., Inc. v. Lichter*, 102 USPQ2d 1546, 1551 (TTAB 2012); TMEP §1207.01(b). The focus is on the recollection of the average purchaser, who normally retains a general rather than specific impression of trademarks. *L'Oreal S.A. v. Marcon*, 102 USPQ2d 1434, 1438 (TTAB 2012); *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106, 108 (TTAB 1975); TMEP §1207.01(b).

Here, the applicant's mark merely adds a design element encompassing the letter "I" and the highly suggestive word "SMART" to the registrant's mark. The mere addition of a term to a registered mark generally does not obviate the similarity between the marks nor does it overcome a likelihood of confusion under Trademark Act Section 2(d). See *In re Chatam Int'l Inc.*, 380 F.3d 1340, 71 USPQ2d 1944 (Fed. Cir. 2004) (GASPAR'S ALE and JOSE GASPAR GOLD); *Coca-Cola Bottling Co. v. Jos. E. Seagram & Sons, Inc.*, 526 F.2d 556, 188 USPQ 105 (C.C.P.A. 1975) (BENGAL and BENGAL LANCER); *Lilly Pulitzer, Inc. v. Lilli Ann Corp.*, 376 F.2d 324, 153 USPQ 406 (C.C.P.A. 1967) (THE LILLY and LILLI ANN); *In re Toshiba Med. Sys. Corp.*, 91 USPQ2d 1266 (TTAB 2009) (TITAN and VANTAGE TITAN);

*In re El Torito Rests., Inc.*, 9 USPQ2d 2002 (TTAB 1988) (MACHO and MACHO COMBOS); *In re Corning Glass Works*, 229 USPQ 65 (TTAB 1985) (CONFIRM and CONFIRMCELLS); *In re U.S. Shoe Corp.*, 229 USPQ 707 (TTAB 1985) (CAREER IMAGE and CREST CAREER IMAGES); *In re Riddle*, 225 USPQ 630 (TTAB 1985) (ACCUTUNE and RICHARD PETTY'S ACCU TUNE); TMEP §1207.01(b)(iii).

**B. The Applicant's Services Are Closely Related To The Registrant's Goods**

The goods and services in a likelihood of confusion analysis are compared to determine whether they are similar or commercially related or travel in the same trade channels. *See Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 1369-71, 101 USPQ2d 1713, 1722-23 (Fed. Cir. 2012); *Herbko Int'l, Inc. v. Kappa Books, Inc.*, 308 F.3d 1156, 1165, 64 USPQ2d 1375, 1381 (Fed. Cir. 2002); TMEP §1207.01, (a)(vi).

The goods and services of the parties need not be identical or even competitive to find a likelihood of confusion. *See On-line Careline Inc. v. Am. Online Inc.*, 229 F.3d 1080, 1086, 56 USPQ2d 1471, 1475 (Fed. Cir. 2000); *Recot, Inc. v. Becton*, 214 F.3d 1322, 1329, 54 USPQ2d 1894, 1898 (Fed. Cir. 2000) (“[E]ven if the goods in question are different from, and thus not related to, one another in kind, the same goods can be related in the mind of the consuming public as to the origin of the goods.”); TMEP §1207.01(a)(i).

The respective goods and services need only be “related in some manner and/or if the circumstances surrounding their marketing [be] such that they could give rise to the mistaken belief that [the goods and services] emanate from the same source.” *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 1369, 101 USPQ2d 1713, 1722 (Fed. Cir. 2012) (quoting *7-Eleven Inc. v. Wechsler*, 83 USPQ2d 1715, 1724 (TTAB 2007)); *Gen. Mills Inc. v. Fage Dairy Processing Indus. SA*, 100 USPQ2d 1584, 1597 (TTAB 2011); TMEP §1207.01(a)(i).

The Court of Appeals for the Federal Circuit and the Trademark Trial and Appeal Board have held that various electronic goods are sufficiently related to computer or technology-related services such that a likelihood of confusion exists when the marks at issue are otherwise identical or highly similar. *See*

*Hewlett-Packard Co. v. Packard Press, Inc.*, 281 F.3d 1261, 62 USPQ2d 1001 (Fed. Cir. 2002) (holding “electronic transmission of data and documents via computer terminals” to be sufficiently related to facsimile machines, computers, and computer software such that confusion would be likely where the marks at issue convey a similar commercial impression); *MSI Data Corp. v. Microprocessor Sys., Inc.*, 220 USPQ 655 (TTAB 1983) (holding MSI for “computer hardware manufacturing services to the order of or specification of others” likely to be confused with MSI for “electronic ordering systems for gathering and transmitting source data comprising a recorder-transmitter and data receiver”); *Commc’ns Satellite Corp. v. Comcet, Inc.*, 429 F.2d 1245, 166 USPQ 353 (4th Cir. 1970) (holding COMSAT for satellite services likely to be confused with COMCET for computers because computers can be used to receive data transmitted by satellites).

In this case the applicant seeks registration of the proposed mark for use in relation to “providing user access to a global computer network; providing user access to computer programmes in data networks; providing access to the internet; internet service provider services, namely, providing multiple user bandwidth and dedicated access to the internet to enable electronic access to computer software, websites, software applications, electronic databases, digital content, and business computer software applications of others accessible via the internet,” and “updating of computer software; updating of websites for others; design and development of computer software; design and development of computer systems; computer programming; engineering; design and development of electronic data security systems; computer services, namely, electronic data storage by providing data storage facilities; technological services, namely, research in the field of computer networking hardware, computer security technology and computer datacenter architecture; technical support services, namely, technical administration of servers for others and troubleshooting in the nature of diagnosing server problems; computer security services, namely, restricting access to and by computer networks; design, development and implementation of software for authenticating digital signatures; computer services, namely, designing and implementing websites for others.”

The registrant’s goods are “computer software for authentication, identity management, security, information sharing, social networking, messaging, and personal communications.”

As demonstrated by the third party registrations and website excerpts made of record in the first and final Office actions, computer software and communications and computer services are commonly offered by the same parties under the same marks. The third party registrations from the USPTO's X-Search database of pending and registered marks show that the goods and services listed therein are of a kind that may emanate from a single source under a single mark. *See In re Anderson*, 101 USPQ2d 1912, 1919 (TTAB 2012); *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783, 1785-86 (TTAB 1993); *In re Mucky Duck Mustard Co.*, 6 USPQ2d 1467, 1470 n.6 (TTAB 1988); TMEP §1207.01(d)(iii). The website excerpts establish that the same entity commonly produces and provides the relevant goods and services and markets the goods and services under the same mark and that the relevant goods and services are sold or provided through the same trade channels and used by the same classes of consumers in the same fields of use. Therefore, applicant's and registrant's goods and services are considered related for likelihood of confusion purposes. *See, e.g., In re Davey Prods. Pty Ltd.*, 92 USPQ2d 1198, 1202-04 (TTAB 2009); *In re Toshiba Med. Sys. Corp.*, 91 USPQ2d 1266, 1268-69, 1271-72 (TTAB 2009).

In response to the applicant's argument that the registrant "does not produce any software products," it is noted that a trademark or service mark registration on the Principal Register is prima facie evidence of the validity of the registration and the registrant's exclusive right to use the mark in commerce in connection with the specified goods and/or services. *See* 15 U.S.C. §1057(b); TMEP §1207.01(d)(iv). Thus, evidence and arguments that constitute a collateral attack on a cited registration, such as information or statements regarding a registrant's nonuse of its mark, are not relevant during ex parte prosecution. *See In re Dixie Rests.*, 105 F.3d 1405, 1408, 41 USPQ2d 1531, 1534-35 (Fed. Cir. 1997); *In re Peebles Inc.*, 23 USPQ2d 1795, 1797 n.5 (TTAB 1992); TMEP §1207.01(d)(iv).

The applicant further argues that the record is "devoid of any evidence" that confusion has resulted from the coexistence of the applicant's and registrant's marks. However, the test under Trademark Act Section 2(d) is whether there is a likelihood of confusion. It is not necessary to show actual confusion to establish a likelihood of confusion. *Herbko Int'l, Inc. v. Kappa Books, Inc.*, 308 F.3d 1156, 1165, 64 USPQ2d 1375, 1380 (Fed. Cir. 2002) (citing *Giant Food, Inc. v. Nation's Foodservice, Inc.*, 710 F.2d 1565, 1571, 218 USPQ 390, 396 (Fed. Cir. 1983)); TMEP §1207.01(d)(ii). The Trademark Trial and Appeal Board

stated as follows:

[A]pplicant's assertion that it is unaware of any actual confusion occurring as a result of the contemporaneous use of the marks of applicant and registrant is of little probative value in an ex parte proceeding such as this where we have no evidence pertaining to the nature and extent of the use by applicant and registrant (and thus cannot ascertain whether there has been ample opportunity for confusion to arise, if it were going to); and the registrant has no chance to be heard from (at least in the absence of a consent agreement, which applicant has not submitted in this case).

*In re Kangaroos U.S.A.*, 223 USPQ 1025, 1026-27 (TTAB 1984).

The sophistication of the consumers of the goods and services at issue in the case at hand does not overcome the likelihood of confusion as to the source of the goods and services. The fact that purchasers are sophisticated or knowledgeable in a particular field does not necessarily mean that they are sophisticated or knowledgeable in the field of trademarks or immune from source confusion. *In re Power Distrib., Inc.*, \_\_\_ USPQ2d \_\_\_, Ser. No. 77825939, 2012 TTAB LEXIS 402, at \*11 (Sept. 29, 2012); TMEP §1207.01(d)(vii); *see Imagineering Inc. v. Van Klassens Inc.*, 53 F.3d 1260, 34 USPQ2d 1526, 1530 (Fed. Cir. 1995).

Finally, in response to the applicant's argument that the registrant has not objected to the applicant's use of the mark, it is noted that use and registration are separate issues. Assuming *arguendo* that the registrant is amenable to the applicant's use of the registrant's mark in providing its services, this does not equate to the registrant's consent to the applicant's registration of the proposed mark. Indeed, the *Wikipedia* article made of record by the applicant, and referenced in the applicant's brief, suggests that it is the registrant's intent to grant licenses to use OpenID, rather than allow anyone to own registrations for the mark thereby preventing others from being able to use it. The examining attorney refers to the sections entitled "OpenID Foundation" which states the registrant "was formed to help manage copyright, trademarks, marketing efforts and other activities related to the success of the OpenID community." The section entitled "Legal Issues" features a quote from the registrant's website stating that "[t]he goal is to release every part of this under the most liberal licenses possible, so there's no money or licensing or

registering required to play.”

#### **IV. CONCLUSION**

Consumers encountering the proposed mark, I SMART OPENID and design, for a variety of communications and computer services, including services involving computer security and research and development in relation to electronic data security, used simultaneously with the registrant’s mark, OPENID, in standard characters, for computer software for authentication, identity management, security, information sharing, social networking, messaging, and personal communications, are likely to mistakenly conclude that the goods and services are related and originate from a common source. Accordingly, it is respectfully requested that the refusal to register under Trademark Act Section 2(d), 15 U.S.C. Section 1052(d), be affirmed.

Respectfully submitted,

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**UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)**

**IMPORTANT NOTICE REGARDING YOUR  
U.S. TRADEMARK APPLICATION**

USPTO EXAMINING ATTORNEY'S APPEAL BRIEF  
HAS ISSUED ON **6/5/2013** FOR U.S. APPLICATION SERIAL NO. 79104646

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