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

Proceeding	79104646
Applicant	Novalyst IT AG
Applied for Mark	I SMART OPENID
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In re Applicant : Novalyst IT AG  
Application Serial No. : 79/104,646  
Mark :  Smart  
OpenID  
Filing Date : August 12, 2011  
International Classes : 38 & 42  
Trademark Attorney : Martha L. Fromm  
Law Office : 106

Commissioner for Trademarks  
P.O. Box 1451  
Alexandria, VA 22313-1451

**REPLY BRIEF FOR APPELLANT**

The Appellant, Novalyst IT AG, files this Reply Brief in response to the Examining Attorney's Brief filed June 5, 2013.

**1. Marks Are Substantially Different**

The presence of the letter "I" and word "Smart" in Appellant's Mark is significant. As the Examining Attorney notes in her Brief, the word "Smart" is *highly suggestive*. Examining Attorney's Brief, p. 5 (emphasis added). The addition of the distinctive wording "Smart" to Appellant's Mark alone is sufficient to distinguish the two marks in terms of connotation and commercial impression. The stylized "I" in Appellant's Mark adds an element to further distinguish Appellant's Mark from Registrant's Mark. These elements are not just tacked on to the wording "OpenID" as the

Examining Attorney suggests. Rather the combination of these distinctive elements combined with the wording “OpenID” create a mark with a new and unique commercial impression – one that does not look like, sound like or carry the same connotation as Registrant’s Mark.

Appellant reiterates that it and the Registrant reach the same, sophisticated audience and is not aware of the occurrence of any confusion. As mentioned in Appellant’s Request for Reconsideration, Appellant gave a presentation in which it used the Mark at the Internet Identity Workshop (“IIW”) regarding the use of OpenID in mobile devices in October 2011. The IIW is a conference organized in connection with the Identity Commons group, which includes the Registrant. Appellant’s presentation at the IIW has already been made of record. Appellant’s participation in the IIW conference is but one example of a reasonable opportunity for confusion to have occurred. *See Nina Ricci S.A.R.L. v. E.T.F. Enterprises, Inc.*, 889 F.2d 1070, 12 USPQ2d 1901 1903 (Fed. Cir. 1989).

## **2. Sophisticated Purchasers**

As Appellant noted in its Appeal Brief, the relevant consumers are highly sophisticated. This fourth *Du Pont* factor is an important consideration in the likelihood of confusion analysis. *In re E.I. Du Pont DeNemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). The Examining Attorney has completely dismissed this factor in her Brief. Appellant asserts that the Examining Attorney’s dismissal of this important factor is misplaced.

As noted by McCarthy,

Where the relevant buyer class is composed solely of professional, or commercial purchasers, it is reasonable to set a higher standard of care than exists for

consumers. Many cases state that where the relevant buyer class is composed of professionals or commercial buyers familiar with the field, they are sophisticated enough not to be confused by trademarks that are closely similar. That is, it is assumed that such professional buyers are less likely to be confused than the ordinary consumer.

J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition*, §23:101 (4th ed. 2004); *see also Ford Motor Co. v. Summit Motor Products, Inc.*, 930 F.2d 277, 293, 18 USPQ 1417 (3d Cir. 1991) (“Professional buyers, or consumers of very expensive goods, will be held to a higher standard of care.”); *Perini Corp. v. Perini Constr., Inc.*, 915 F.2d 121, 128, 16 USPQ2d 1289 (4th Cir. 1990) (“[I]n a market with extremely sophisticated buyers, the likelihood of consumer confusion cannot be presumed on the basis of the similarity in trade name alone.”))

Where the relevant consumers are sophisticated purchasers, the likelihood of confusion with similar marks is remote. *See Haydon Switch & Instrument, Inc. v. Rexnord, Inc.*, 4 USPQ2d 1510, 1987 WL 26062 (D. Conn. 1987) (Where the parties produce non-competitive industrial parts for custom-designed assemblies, this “tips the weight of the evidence decisively” in favor of no likelihood of confusion. “[S]ophisticated purchases of the products of [the parties] enter the marketplace in search of specific products for specific industrial purposes. The sophistication of these purchases makes the likelihood of confusion remote.”); *see also Castle Oil Corp. v. Castle Energy Corp.*, 26 USPQ2d 1481, 1992 WL 394932 (E.D. Pa. 1992) (No likelihood of confusion found where buyers are sophisticated professionals in the fields of bulk heating oil and oil exploration investment. “Where, as here, different goods are sold, even if sold under the same mark, to different discriminating purchasers, there is no likelihood of confusion.”))

### **3. No Objection to Appellant's Use of Mark Is Instructive**

The Examining Attorney also dismisses the lack of objection to Appellant's use of the Mark by the Registrant. Appellant suggests that the lack of any objection on Registrant's part – when Registrant is well aware of Appellant's use of the Mark – is significant. This is indicative that Registrant does not find a likelihood of confusion between its mark and the Appellant's Mark. Finally, Appellant suggests that the Registrant is in the best position to analyze likelihood of confusion. Thus, the lack of any objection by Registrant is instructive on the likelihood of confusion issue.

### **4. Conclusion**

For the reasons set forth hereinabove, Appellant submits that there is no likelihood of confusion between its Mark and the Registrant's Mark. Accordingly, Appellant's Mark is entitled to registration and should be allowed. The Board is therefore respectfully requested to reverse the Examining Attorney's decision refusing registration of Appellant's Mark.

Respectfully submitted,



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