PTO Form 1930 (Rev 9/2007)
OMB No. 0651-0050 (Exp. 4/30/2009)

Request for Reconsideration after Final Action

The table below presents the data as entered.

Input Field	Entered
SERIAL NUMBER	79104646
LAW OFFICE ASSIGNED	LAW OFFICE 106
MARK SECTION (no change)	
ARGUMENT(S)	
Please see the actual argument text attached within the Evidence section.	
EVIDENCE SECTION	
EVIDENCE FILE NAME(S)	
ORIGINAL PDF FILE	evi_725416814-195314744_._RFR__MEYE03-00005_.pdf
CONVERTED PDF FILE(S) (4 pages)	\\TICRS\EXPORT16\IMAGEOUT16\791\046\79104646\xml4\RFR0002.JPG
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CONVERTED PDF FILE(S) (1 page)	\\TICRS\EXPORT16\IMAGEOUT16\791\046\79104646\xml4\RFR0024.JPG
ORIGINAL PDF FILE	evi_725416814-195314744_._EX_C.pdf
CONVERTED PDF FILE(S) (1 page)	\\TICRS\EXPORT16\IMAGEOUT16\791\046\79104646\xml4\RFR0025.JPG
ORIGINAL PDF FILE	evi_725416814-195314744_._EX_D.pdf
CONVERTED PDF FILE(S) (1 page)	\\TICRS\EXPORT16\IMAGEOUT16\791\046\79104646\xml4\RFR0026.JPG
DESCRIPTION OF EVIDENCE FILE	Applicant's argument and Exhibits A-D referenced therein.
SIGNATURE SECTION	
RESPONSE SIGNATURE	/Dyan House/
SIGNATORY'S NAME	Dyan M. House
SIGNATORY'S POSITION	Attorney of record, Texas bar member
SIGNATORY'S PHONE NUMBER	214-550-5081
DATE SIGNED	01/23/2013
AUTHORIZED SIGNATORY	YES
CONCURRENT APPEAL NOTICE FILED	YES

FILING INFORMATION SECTION	
SUBMIT DATE	Wed Jan 23 19:57:06 EST 2013
TEAS STAMP	USPTO/RFR-72.54.168.14-20 130123195706464918-791046 46-490aa76287cf0802ebbaed 2c2668542ba65-N/A-N/A-201 30123195314744255

PTO Form 1930 (Rev 9/2007)
OMB No. 0651-0050 (Exp. 4/30/2009)

Request for Reconsideration after Final Action

To the Commissioner for Trademarks:

Application serial no. **79104646** has been amended as follows:

ARGUMENT(S)
In response to the substantive refusal(s), please note the following:

Please see the actual argument text attached within the Evidence section.

EVIDENCE
Evidence in the nature of Applicant's argument and Exhibits A-D referenced therein. has been attached.
Original PDF file:
evi_725416814-195314744_._RFR__MEYE03-00005_.pdf
Converted PDF file(s) (4 pages)
Evidence-1
Evidence-2
Evidence-3
Evidence-4
Original PDF file:
evi_725416814-195314744_._EX_A.pdf
Converted PDF file(s) (18 pages)
Evidence-1
Evidence-2
Evidence-3
Evidence-4
Evidence-5
Evidence-6
Evidence-7
Evidence-8
Evidence-9
Evidence-10

Evidence-11
Evidence-12
Evidence-13
Evidence-14
Evidence-15
Evidence-16
Evidence-17
Evidence-18
Original PDF file:
evi_725416814-195314744_._EX_B.pdf
Converted PDF file(s) (1 page)
Evidence-1
Original PDF file:
evi_725416814-195314744_._EX_C.pdf
Converted PDF file(s) (1 page)
Evidence-1
Original PDF file:
evi_725416814-195314744_._EX_D.pdf
Converted PDF file(s) (1 page)
Evidence-1

SIGNATURE(S)
Request for Reconsideration Signature
Signature: /Dyan House/ Date: 01/23/2013
Signatory's Name: Dyan M. House
Signatory's Position: Attorney of record, Texas bar member

Signatory's Phone Number: 214-550-5081

The signatory has confirmed that he/she is an attorney who is a member in good standing of the bar of the highest court of a U.S. state, which includes the District of Columbia, Puerto Rico, and other federal territories and possessions; and he/she is currently the applicant's attorney or an associate thereof; and to the best of his/her knowledge, if prior to his/her appointment another U.S. attorney or a Canadian attorney/agent not currently associated with his/her company/firm previously represented the applicant in this matter: (1) the applicant has filed or is concurrently filing a signed revocation of or substitute power of attorney with the USPTO; (2) the USPTO has granted the request of the prior representative to withdraw; (3) the applicant has filed a power of attorney appointing him/her in this matter; or (4) the applicant's appointed U.S. attorney or Canadian attorney/agent has filed a power of attorney appointing him/her as an associate attorney in this matter.

The applicant is filing a Notice of Appeal in conjunction with this Request for Reconsideration.

Serial Number: 79104646
Internet Transmission Date: Wed Jan 23 19:57:06 EST 2013
TEAS Stamp: USPTO/RFR-72.54.168.14-20130123195706464
918-79104646-490aa76287cf0802ebbaed2c266
8542ba65-N/A-N/A-20130123195314744255

DOCKET NO.: MEYE03-00005

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Applicant	:	Novalyst IT AG
Serial Number	:	79/104,646
Mark	:	Smart OpenID
Filing Date	:	August 12, 2011
Classes	:	038 & 042
Trademark Attorney	:	Martha L. Fromm
Law Office	:	106

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

REQUEST FOR RECONSIDERATION

In response to the final Office Action mailed July 23, 2012 (the "Final Action"), Applicant makes the following remarks:

I.

NO LIKELIHOOD OF CONFUSION

The Office has maintained its refusal to register Applicant's Smart OpenID (& Design) Mark ("Applicant's Mark" or the "Mark") on the grounds that there is a likelihood of confusion with U.S. Registration No. 3,222,861 for the mark OpenID ("Registered Mark"). Applicant respectfully submits that there is substantial dissimilarity in the essential characteristics of the Marks such that there is no likelihood of confusion. Applicant also asserts that there has been no actual confusion, and that the registrant has not objected to Applicant's use of the Mark.

When comparing marks, the "fundamental inquiry mandated by Section 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and the differences in the marks." *Federated Foods, Inc. v. Fort Howard Paper Co.,* 192 USPQ 24, 29 (CCPA 1976). When the essential characteristics of Applicant's Mark and the Registered Mark are compared and the relevant factors from *In re E.I. DuPont DeNemours & Co.*, 476 F.2d 1357, 1361 (CCPA 1973) are applied, no likelihood of confusion exists between Applicant's Mark and the Registered Mark.

As Applicant detailed in the Response to the First Office Action filed on June 15, 2012 (the "First Response"), Applicant's Mark has a different sound, look, and connotation compared to the Registered Mark. When spoken as a whole, the marks do not sound the same. The addition of the distinctive wording "Smart" to Applicant's Mark alone is sufficient to distinguish the two marks in terms of sound and connotation. The Office removed its requirement that the Applicant disclaim the term "Smart," finding that term is not descriptive of Applicant's services. The appearance of the term "Smart" in Applicant's Mark is a significant element that clearly distinguishes Applicant's Mark from the Registered Mark. Of course, as Applicant mentioned in the First Response, the design elements and colors used in Applicant's Mark serve to distinguish it even more from the Registered Mark.

In addition to the differences in the marks as referenced above and the other arguments presented in the First Response, Applicant would like to call to the Office's attention that it is not aware of any instances of confusion between the two marks. The Applicant and the Registrant target the same, sophisticated audience. By way of example, Applicant 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. *See* Exhibit A attached hereto for a copy of the slides from

Applicant's presentation. In addition to the slides in Exhibit A, the Applicant presented a slide announcing its project under the Mark:

The IIW is a conference organized in connection with the Identity Commons group, which also includes the registrant. *See* Exhibit B for a print out from the Identity Commons website highlighting both the IIW and OpenID Foundation. http://www.identitycommons.net (last accessed January 23, 2013). *See* Exhibit C for a description of the OpenID Foundation at the Identity Commons' website. http://www.identitycommons.net (last accessed January 23, 2013). Exhibit D is a print out of the IIW Wiki page that contains information regarding Applicant's presentation.http://iiw.idcommons.net/SMART_OpenID_%E2%80%93_What_Mobile_Network_ Operators_Can_Contribute_to_OpenID_%285D%29 (last accessed January 23, 2013).

Not only has the same, sophisticated audience not been confused as between Applicant's Mark and the Registered Mark, the registrant has not objected to Applicant's Mark.

II.
REMARKS

Applicant respectfully submits that all issues raised in the Final Action have been fully addressed and satisfied and that the Application should be allowed. If any outstanding issues remain, or if the Examining Attorney has any further suggestions for expediting allowance of this application, Applicant respectfully invites the Examining Attorney to contact the undersigned at the telephone number indicated below.

EXHIBIT A (79/104,646)

OpenID in mobile devices

Carry your Identity Provider in your pocket

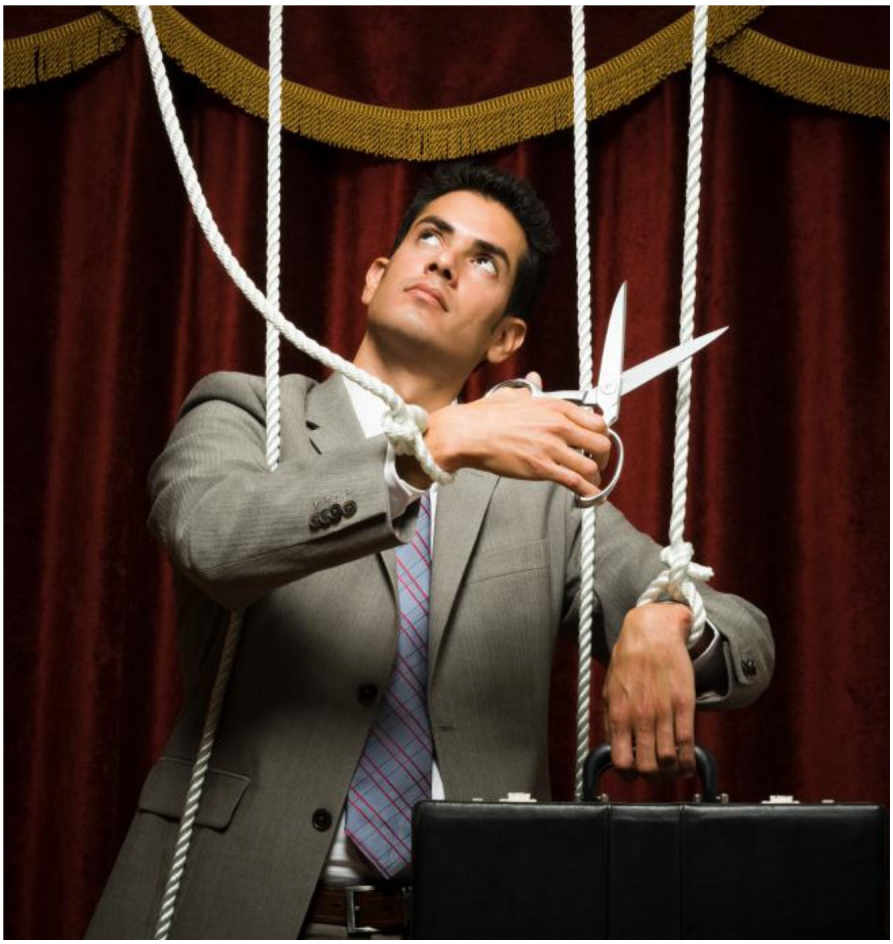
IIW 13, Oct 2011, Mountain View, CA

Andreas Leicher
Novalyst IT
andreas.leicher@novalyst.de

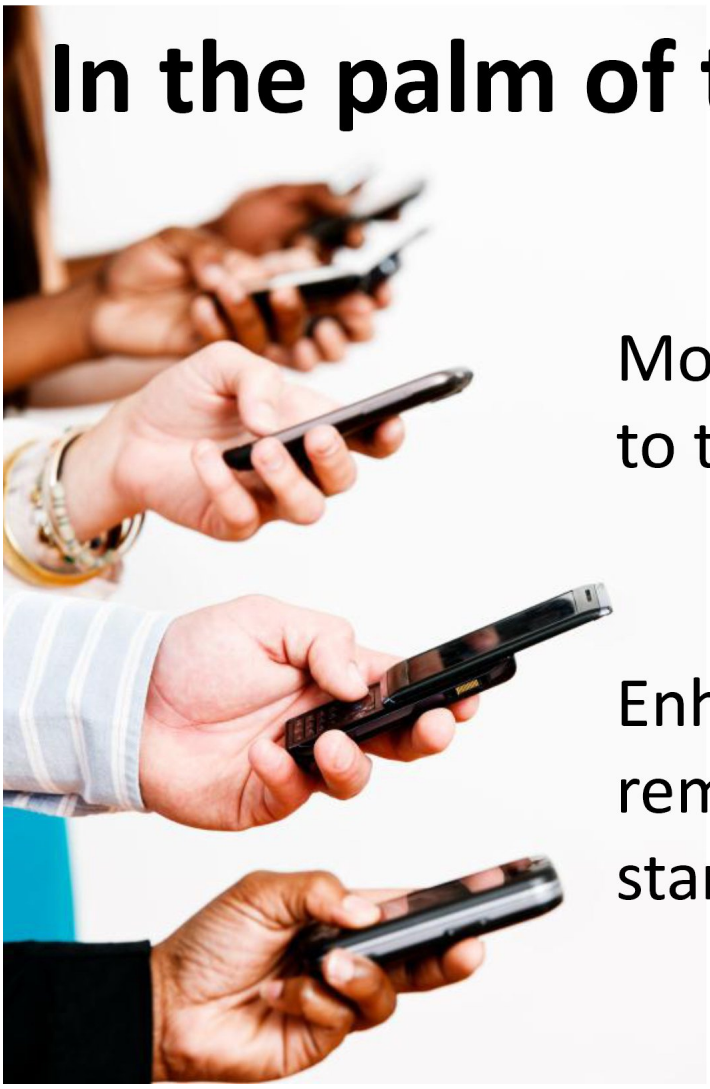
User Control of Identity

Put the user in control of his identity attributes

Enable privacy, controlled by the user…



In the palm of the user‘s hand

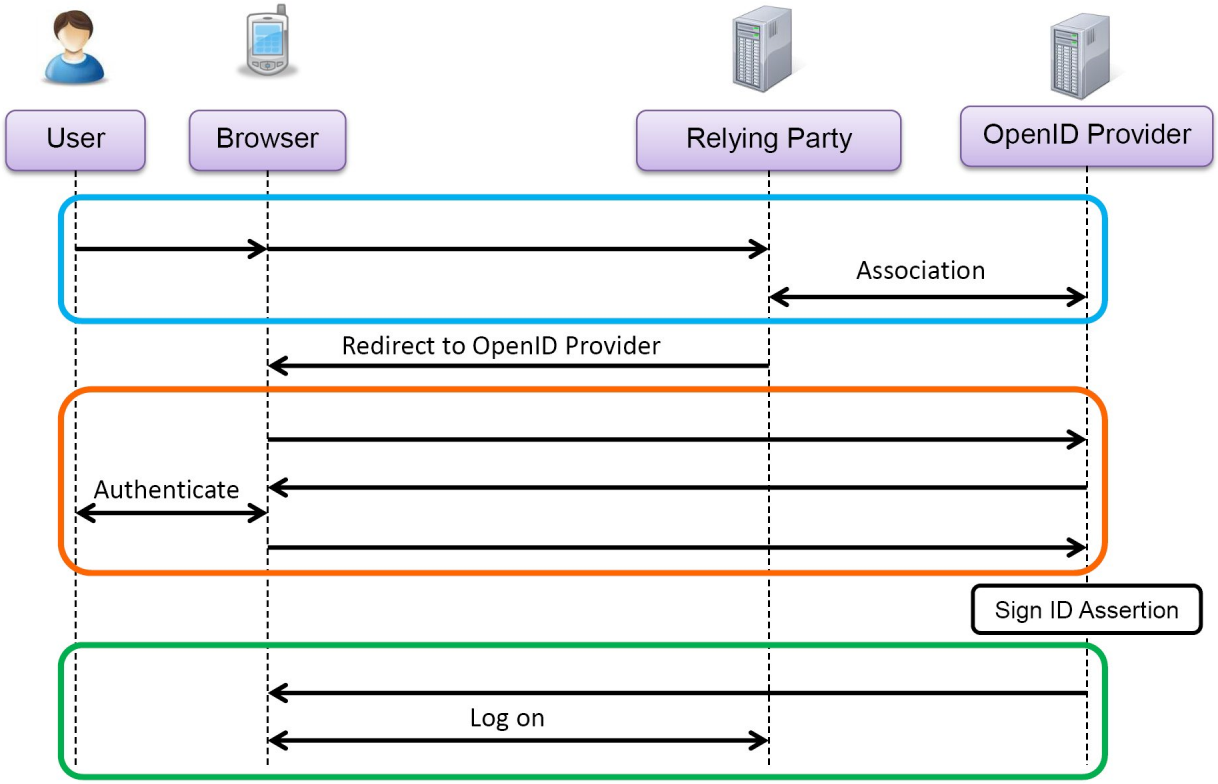


Move the Identity Provider to the user‘s device

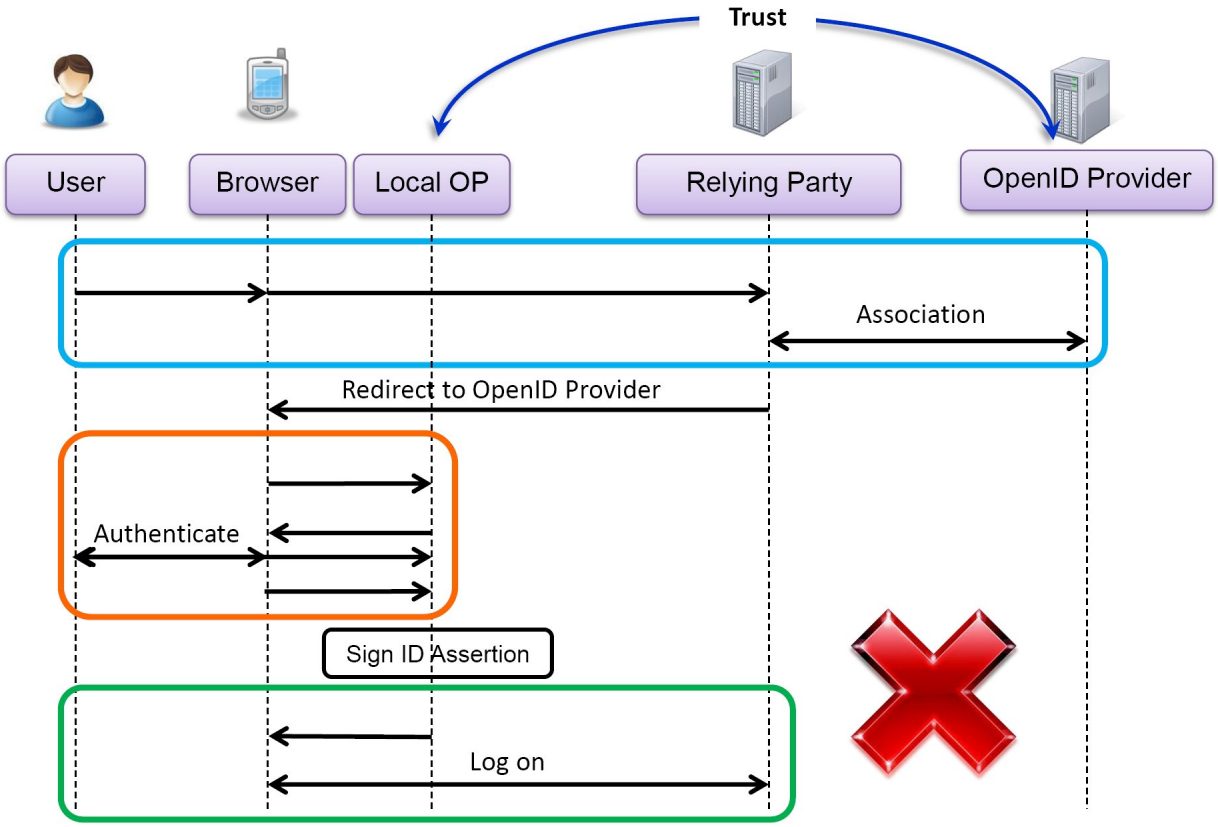
Enhanced OpenID which remains compliant to the standard OpenID protocol

Regular OpenID Flow

EXHIBIT A (79/104,646)

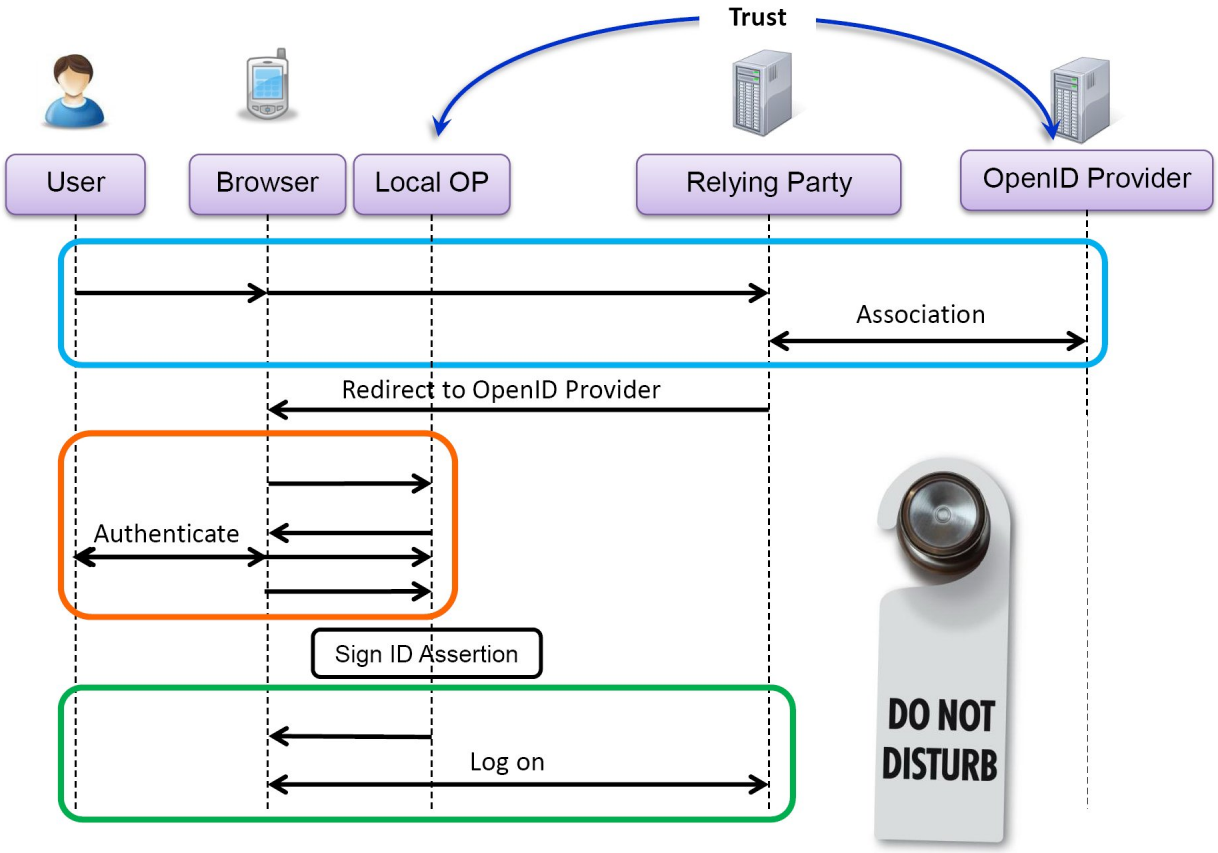


Smart OpenID Flow with a local IdP



No feedback to Server side for authentication

No feedback to Server side for authentication



Creates privacy towards the network

Identity claims

Claims are verified and then enabled in the user's device

The user can create different profiles locally on his device

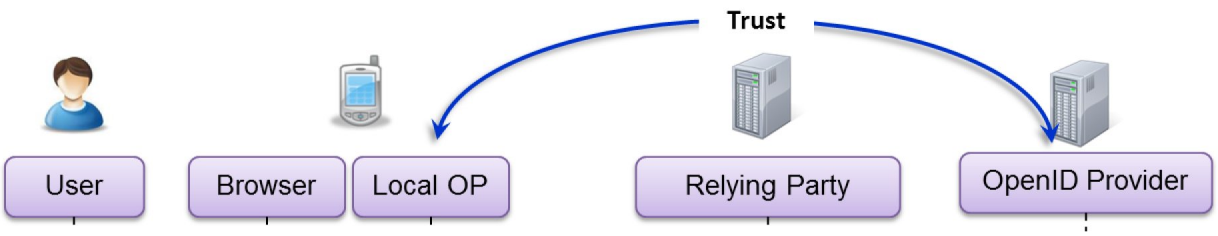
Profiles allow sharing of identity information with services without network knowing every transaction

EXHIBIT A (79/104,646)

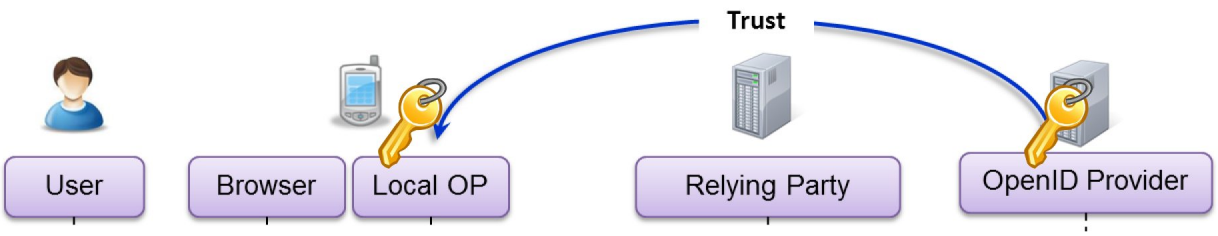
Trust

How can services **trust** the claims coming from the device ?

There needs to be a link

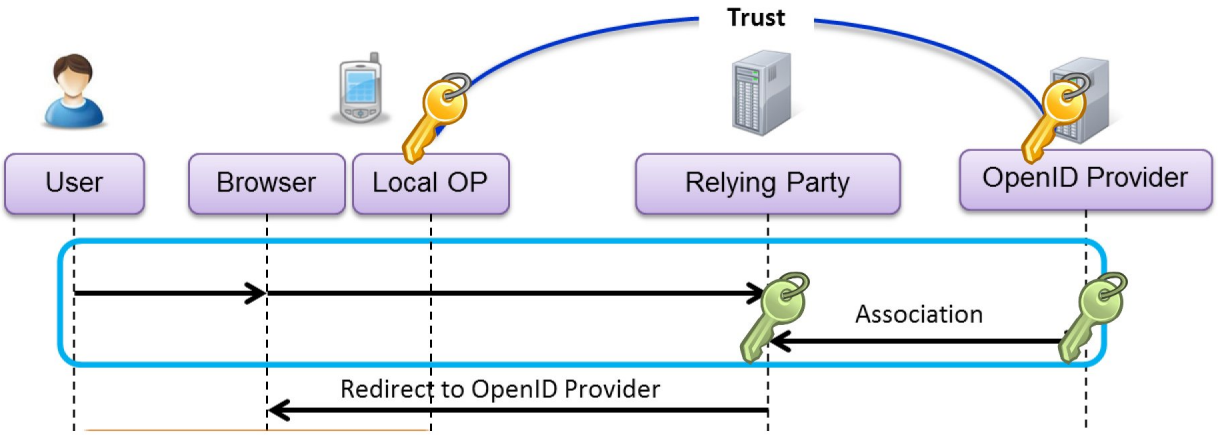


The network provides the needed link

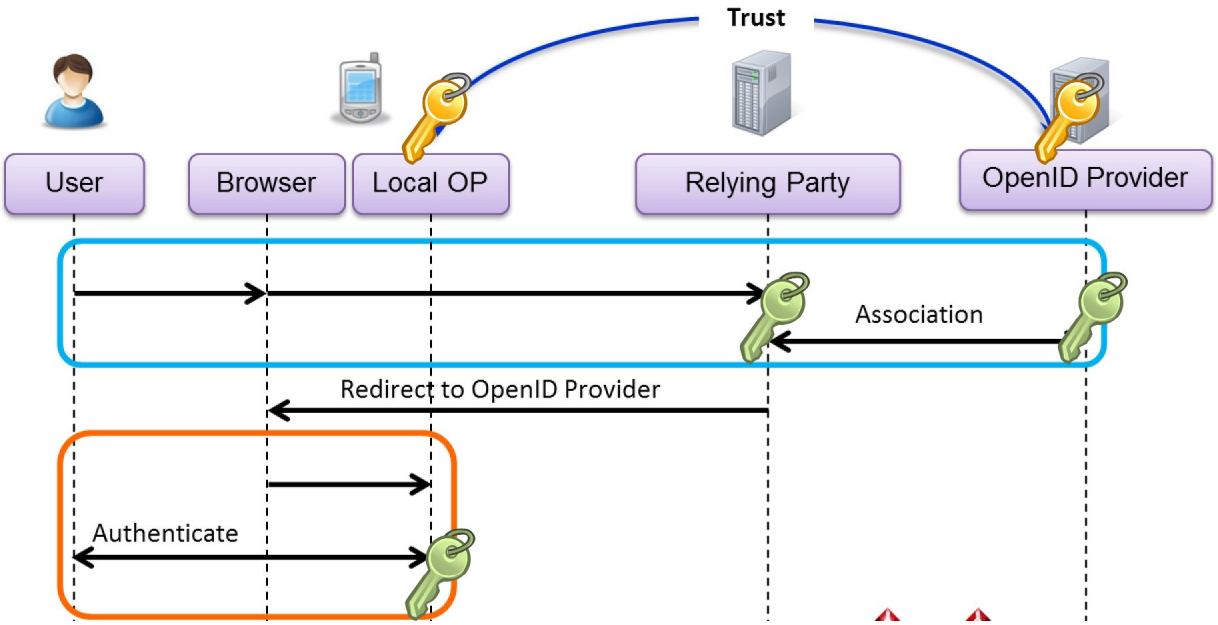


The network provides the needed link

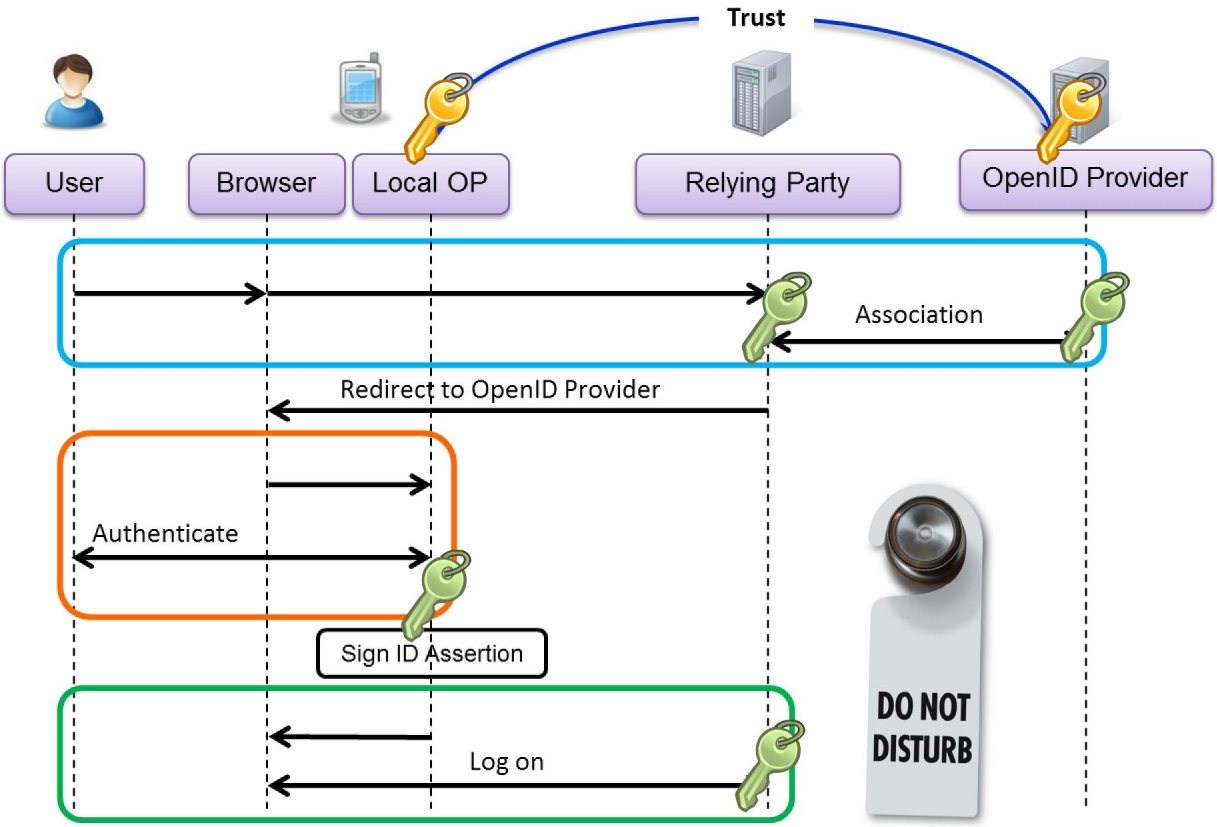
A shared secret is established between the device and network



The associaton secret is derived from that key and shared with the RP



The same key is then derived in the device and used to sign the assertion



The service uses the key to verify the assertion independent from the network

Who could provide such a system?

Mobile network operators

They have an authentication infrastructure

They already know the identity of their subscribers

They can provide the claims and the needed trust

Name

Date of Birth

Address

Billing Information…

EXHIBIT A (79/104,646)

Security

Can be provided by the device or by the SIM card

This work is a joint development of:

novalyst IT InterDigital®

We have started a project:

Smart® OpenID

novalyst IT InterDigital® SAFRAN Morpho

Visit smartopenid.novalyst.de or email me.

Andreas Leicher
Novalyst IT
andreas.leicher@novalyst.de

smartopenid.novalyst.de

Image sources:

Protocol Flows: own illustration

Photos: istockphoto.com

Police officer (slide 11): Julien Tromeur, www.jt-book.com, via http://www.sxc.hu/photo/1262266/

Identity Commons

www.identitycommons.net

identitycommons

GRAB THE FEED

Home | Collaboration | Background | Working Groups | Purpose and Principles | Contact Us

DataPortability Project
Higgins Project
ID-Legal
Identity Gang
Identity Schemas
Information Card Foundation
Internet Identity Workshop
Kids Online
NSTIC.US
OpenID Foundation
OSIS
Pamela Project
Project VRM

Login
Register (New User)

earch this site Go

Support Identity Commons
Donate

Upcoming Events

No events.

Event Calendar

« Dec Feb »
January 2013

M	T	W	T	F	S	S
	1	2	3	4	5	6
7	8	9	10	11	12	13
14	15	16	17	18	19	20
21	22	23	24	25	26	27
28	29	30	31			

Welcome

Identity Commons is a community of groups working on
identity and social layer of the web. We are loosely conn
common purpose and principles. Our main community g
Internet Identity Workshop that happens twice a year.

We create opportunities for both innovators and competi
big guy and the small fry to come together in a safe and

Our organizational forms are diverse including:

- several dozen people on a mailing list
- nonprofit foundations behind particular technologi
- open source projects part of other foundations
- autonomous projects working on market advocac
  development

We formed to facilitate information sharing and coherenc
to support interoperability and convergence around open

NSTIC Moving Forward with Pilots and Steering Group

Posted Feb 1st, 2012 by jayunger

www.idcommons.org/working-groups/

identitycommons

GRAB THE FEED

Home | Collaboration | Background | Working Groups | Purpose and Principles | Contact Us

OpenID Foundation

Charter at Identity Commons

OpenID Website

Representative on the Identity Commons Stewards Council (Board): Chris Messina, Alternate: Don Thibeau

About the OpenID Foundation:
The OpenID Foundation (OIDF) was formed in June 2007 to help promote, protect and enable the OpenID technologies and community. This entails managing intellectual property, brand marks as well as fostering viral growth and global participation in the proliferation of OpenID. The OIDF does not dictate the technical direction of OpenID; instead it will help enable and protect whatever is created by the community.

- OpenID for Government
- Acccepting OpenID on your website
- OpenID for Bloggers and Individuals

How to Join the OpenID Foundation

Sponsoring Members

OpenID Website & News/Blog
OpenID Community Aggregate Blog
OpenID Wiki

Mailing Lists:

- General Discussion
- European OpenID Discussion
- Technical Specification Work
- Community Marketing and Evangelism
- Foundation Board Discussion
- Legal Discussion
- Security Discussion
- Code
- User-Experience Discussion
- Additional lists on Mailman

Executive Director: Don Thibeau
Board of Directors:

- Nat Sakimura (NRI), Chair
- Mike Jones (Microsoft), Secretary
- John Bradley (independent), Treasury
- Chris Messina (Google)
- Joseph Smarr (Google)
- Allen Tom (Yahoo!)
- Brian Kissel (Independent)
- Axel Nennker (Deutsche Telekom)
- Kick Willemse (Independent)

Corporate Board Members:

- VeriSign – Nico Popp, Vice Chair
- Facebook – David Recordon
- Google – Eric Sachs
- Microsoft – Anthony Nadalin
- PayPal – Farhang Kassaei
- Yahoo! – Raj Mata
- Ping Identity – Pam Dingle

- Login
- Register (New User)

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Upcoming Events

- No events.

Event Calendar

« Dec | Feb »

January 2013

M	T	W	T	F	S	S
	1	2	3	4	5	6
7	8	9	10	11	12	13
14	15	16	17	18	19	20
21	22	23	24	25	26	27
28	29	30	31			

Working Groups

- DataPortability Project
- Higgins Project
- ID-Legal
- Identity Gang
- Identity Schemas
- Information Card Foundation
- Internet Identity Workshop
- Kids Online
- NSTIC.US
- OpenID Foundation
- OSIS
- Pamela Project
- Project VRM
- XDI.ORG

Working Group Schedule

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Site Admin | Theme by Niyaz

SMART OpenID – What Mobile Network Operators Can Contribute to OpenID (5D)

Session Topic: Smart OpenID, SIMcard based OpenID; what can Mobile carriers bring to OpenID? (T5D)

Convener: Andreas Leicher

Notes-taker(s): Andreas Leicher

Tags for the session - technology discussed/ideas considered: OpenID; SIMcard based OpenID

Discussion notes, key understandings, outstanding questions, observations, and, if appropriate to this discussion: action items, next steps:

presented a concept which allows Mobile Carriers to be attribute and identity providers by leveraging the security and authentication infrastructure they already have

Mobile carriers have some identity information that they might want to monetize, e.g. verified address etc.

Mobile carriers also have some good and secure authentication system in place, especially with the SIM card.

What if the SIM card can be used not only to authenticate the device and user but be enhanced to host an identity provider instance which allows users to create identity attributes and sets of claims, based on the verified identity information from mobile carriers?

Smart OpenID is about creating an instance of an OpenID identity provider on the SIM card on the mobile device, allowing the user to authenticate towards services and share identity attribute data with services.

The mobile network carrier is not involved in the exchange of this attribute information, so a level of privacy towards the mobile carrier is created.

slides will be made available at http://smartopenid.novalyst.de/