

Request for Reconsideration after Final Action

The table below presents the data as entered.

Input Field	Entered
SERIAL NUMBER	86175521
LAW OFFICE ASSIGNED	LAW OFFICE 108
MARK SECTION	
MARK	http://tmng-al.uspto.gov/resting2/api/img/86175521/large
LITERAL ELEMENT	IT'SME
STANDARD CHARACTERS	YES
USPTO-GENERATED IMAGE	YES
MARK STATEMENT	The mark consists of standard characters, without claim to any particular font style, size or color.
ARGUMENT(S)	
<p>This is response to the final office action ("Final Office Action") mailed on January 11, 2016 objecting to the subject IT'SME mark on the basis of three prior registrations and requesting clarification of goods covered by the subject application. Identification of Goods and Services By this Request for Reconsideration, Applicant has amended the Goods and Services description in International Classes 009 and 042 to the following to address the clarification of goods issues: International Class 009: Communications software for providing real-time transaction authorization or access to physical premises using out-of-band security as a service (SECaaS) over an intranet, internet, or communication channel by using contextual information to verify the authority of the initiator of the transaction or access through any electronic device including electronic smart tattoos, implanted electronics in the nature of biometric identification apparatus, and handheld devices in the nature of mobile phones, smart connected devices and traditional computing devices, namely, personal computers, notebooks, tablet computers, phones and netbooks; other portable computers, computer peripherals; personal digital assistants; or any embedded computing and communication devices, namely, electronics devices comprised primarily of software and display screens for viewing, sending and receiving texts, emails, data, and information from smart phones, tablet computers and portable computers. International Class 036: Credit and cash card services; Electronic banking via a global computer network; On-line banking services; On-line banking services featuring electronic alerts that alert credit and debit card users when a single transaction exceeds a certain amount; On-line financial planning services; On-line prepaid card services; On-line real-time currency trading; On-line trading of financial instruments, shares, options and other derivative products; On-line trading of options on the options exchange market; Online, real-time tax payment processing, tax payment management, and tax payment analysis services. International Class 038: Communication services, namely, transmission of voice, audio, visual images and data by telecommunications networks, wireless communication networks, the Internet, information services networks and data networks; Wireless digital messaging services; Wireless electronic transmission of data, wireless communication networks, the Internet, information services networks and data networks; Electronic transmission for others of securities and financial information via computer linking services, namely, communicating and routing trade information involving orders, entry and execution services, to others via a global computer network; Worldwide switched text and message transmission services International Class 042: Scientific and technological services, namely, research and design in the field of secure and private transaction using multifactor authentication techniques including contextual and biometrics as part of policy orchestration for secure transaction authorization by authorized users and machines; Software as a service (SAAS) services featuring software for trust elevation and security of online transactions; Software application development services; Security as a Service (SECaaS) featuring communication software use in providing real-time transaction authorization for intranet and Internet transactions; cloud computing featuring communication software for use in providing real-time transaction authorization or access to physical premises using an out-of-band security as a service; online content management services via the Internet, namely, providing a website that gives computer users real-time transaction authorization; providing a web hosting platform for use of software for enabling, facilitating or enhancing interactive transaction history and data for business and consumers. Section 2(d) - Likelihood of Confusion Refusals The Applicant's application was refused registration based on U.S. Registration Nos. 4040144, 4061863, and 4098281. 4040144 (MARK: IT'S ME!) and 4061863 (MARK: IT'S ME! with color design) The Goods & Services are: 1) Computer software for access protection, namely, computerized non-biometric user authentication software to provide secure access to electronic devices; computer servers; personal digital assistants; cellular telephones; ATM machines; credit and debit card scanners and processors in U.S. Classes 021, 023, 026, 036, 038. 2) Identification verification services, namely, providing authentication of personal identification information in U.S. Classes 100, 101. First, it should be noted initially that one</p>	

registrant own U.S. Registration Nos. 4040144 and 4061863 while another registrant owns 4098281. The current similar marks are existing peacefully on the trademark register. The fact that these marks are peacefully coexisting without confusion on the register lends weight to the fact that the subject mark will likewise not cause confusion. Second, in testing for likelihood of confusion under Section 2(d), the Du Pont factors need to be considered. In re E.I. du Pont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563 (C.C.P.A. 1973). For the out of band multi-factor authentication services of the Applicant, they are not likely to cause confusion with the registered mark IT'S ME for "computer software for access protection, namely, computerized non-biometric user authentication software to provide secure access to electronic devices; computer servers; personal digital assistants; cellular telephones; ATM machines; credit and debit card scanners and processors" and "identification verification services, namely, providing authentication of personal identification information". The differences in the goods/services and the sophistication of the customers "strongly outweigh" the other relevant du Pont factors, including the similarity of the marks and the strength of Plaintiff's mark. See: Calypso Technology, Inc. v. Calypso Capital Management, LP, 100 USPQ2d 1213 (TTAB 2011). The Mark: Applicant seeks to register the compound mark IT'SME. As the eye scans this mark, the truncation is significant and differentiates from the marks in registrations 4040144 and 4061863. The Goods/Services: As to the respective goods and services, the fact that both are in the "computer authentication field" does not mean that they are necessarily related in this broad field for 2(d) purposes. The Examiner fails to show the necessary connection that would cause consumers of these goods and services to believe that they emanate from a single source. Purchaser Sophistication: The consumers are primarily financial product users and are not likely to assume that the disparate goods and services emanate from the same source merely because they are offered under marks comprising or containing the words IT'SME. This is not a situation of a shopper grabbing goods off the shelf of in a market. The purchasers would be aware of the practices of the industry, and recognize that such goods and services do not emanate from a single source. Balancing the relevant duPont factors, the Applicants submit that the marks are not confusing. 4098281 (MARK: HEY IT'S ME) Telecommunications services, namely, electronic transmission of messages, information and data for others; providing access to online databases; providing online forums for information retrieval and communication in U.S. Classes 100, 101, 104. In addition to the arguments put forth above, the 4098281 registration is prefaced with the word "Hey" as well as a separation between the words "IT'S" and "ME". A sophisticated consumer would not likely to be confused between the marks.

SIGNATURE SECTION

RESPONSE SIGNATURE	/Christopher J. Horgan/
SIGNATORY'S NAME	Christopher J. Horgan
SIGNATORY'S POSITION	Attorney of Record, CA Bar Member
SIGNATORY'S PHONE NUMBER	408-687-8306
DATE SIGNED	07/07/2016
AUTHORIZED SIGNATORY	YES
CONCURRENT APPEAL NOTICE FILED	YES

FILING INFORMATION SECTION

SUBMIT DATE	Thu Jul 07 22:33:38 EDT 2016
TEAS STAMP	USPTO/RFR-XX.X.XXX.XX-201 60707223338171966-8617552 1-550ddcda19d3127502d4417 e6648a70fc1032e5e8e4bbcb1 f819b763ad22e06ec8-N/A-N/ A-20160707220626912605

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PTO Form 1960 (Rev 10/2011)
OMB No. 0651-0050 (Exp 07/31/2017)

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To the Commissioner for Trademarks:

Application serial no. **86175521** IT'SME(Standard Characters, see <http://tmng-al.uspto.gov/resting2/api/img/86175521/large>) has been amended as follows:

ARGUMENT(S)

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

This is response to the final office action ("Final Office Action") mailed on January 11, 2016 objecting to the subject IT'SME mark on the basis of three prior registrations and requesting clarification of goods covered by the subject application. Identification of Goods and Services By this Request for Reconsideration, Applicant has amended the Goods and Services description in International Classes 009 and 042 to the following to address the clarification of goods issues: International Class 009: Communications software for providing real-time transaction authorization or access to physical premises using out-of-band security as a service (SECaaS) over an intranet, internet, or communication channel by using contextual information to verify the authority of the initiator of the transaction or access through any electronic device including electronic smart tattoos, implanted electronics in the nature of biometric identification apparatus, and handheld devices in the nature of mobile phones, smart connected devices and traditional computing devices, namely, personal computers, notebooks, tablet computers, phones and netbooks; other portable computers, computer peripherals; personal digital assistants; or any embedded computing and communication devices, namely, electronics devices comprised primarily of software and display screens for viewing, sending and receiving texts, emails, data, and information from smart phones, tablet computers and portable computers. International Class 036: Credit and cash card services; Electronic banking via a global computer network; On-line banking services; On-line banking services featuring electronic alerts that alert credit and debit card users when a single transaction exceeds a certain amount; On-line financial planning services; On-line prepaid card services; On-line real-time currency trading; On-line trading of financial instruments, shares, options and other derivative products; On-line trading of options on the options exchange market; Online, real-time tax payment processing, tax payment management, and tax payment analysis services. International Class 038: Communication services, namely, transmission of voice, audio, visual images and data by telecommunications networks, wireless communication networks, the Internet, information services networks and data networks; Wireless digital messaging services; Wireless electronic transmission of data, wireless communication networks, the Internet, information services networks and data networks; Electronic transmission for others of securities and financial information via computer linking services, namely, communicating and routing trade information involving orders, entry and execution services, to others via a global computer network; Worldwide switched text and message transmission services International Class 042: Scientific and technological services, namely, research and design in the field of secure and private transaction using multifactor authentication techniques including contextual and biometrics as part of policy orchestration for secure transaction authorization by authorized users and machines; Software as a service (SAAS) services featuring software for trust elevation and security of online transactions; Software application development services; Security as a Service (SECaaS) featuring communication software use in providing real-time transaction authorization for intranet and Internet transactions; cloud computing featuring communication software for use in providing real-time transaction authorization or access to physical premises using an out-of-band security as a service; online content management services via the Internet, namely, providing a website that gives computer users real-time transaction authorization; providing a web hosting platform for use of software for enabling, facilitating or enhancing interactive transaction history and data for business and consumers. Section 2(d) - Likelihood of Confusion Refusals The Applicant's application was refused registration based on U.S. Registration Nos. 4040144, 4061863, and 4098281. 4040144 (MARK: IT'S ME!) and 4061863 (MARK: IT'S ME! with color design) The Goods & Services are: 1) Computer software for access protection, namely, computerized non-biometric user authentication software to provide secure access to electronic devices; computer servers; personal digital assistants; cellular telephones; ATM machines; credit and debit card scanners and processors in U.S. Classes 021, 023, 026, 036, 038. 2) Identification verification services, namely, providing authentication of personal identification information in U.S. Classes 100, 101. First, it should be noted initially that one registrant own U.S. Registration Nos. 4040144 and 4061863 while another registrant owns 4098281. The current similar marks are existing peacefully on the trademark register. The fact that these marks are peacefully coexisting without confusion on the register lends weight to the fact that the subject mark will likewise not cause confusion. Second, in testing for likelihood of confusion under Section 2(d), the Du Pont factors need to be considered. In re E.I. du Pont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563 (C.C.P.A. 1973). For the out of band multi-factor authentication services of the Applicant, they are not likely to cause confusion with the registered mark IT'S ME for "computer software for access protection, namely, computerized non-biometric user authentication software to provide secure access to electronic devices; computer servers; personal digital assistants; cellular telephones; ATM machines; credit and debit card scanners and processors" and "identification verification services, namely, providing authentication of personal identification information". The differences in the goods/services and the sophistication of the customers "strongly outweigh" the other relevant du Pont factors, including the similarity of the marks and the strength of Plaintiff's mark. See: Calypso Technology, Inc. v. Calypso Capital Management, LP, 100 USPQ2d 1213 (TTAB 2011). The Mark: Applicant seeks to register the compound mark IT'SME. As the eye scans this mark, the truncation is significant and differentiates from the marks in registrations 4040144 and 4061863. The Goods/Services: As to the respective goods and services, the fact that both are in the "computer authentication field" does not mean that they are necessarily related in this broad field for 2(d) purposes. The Examiner fails to show the necessary connection that would cause consumers of these goods and services to believe that they emanate from a single source. Purchaser Sophistication: The consumers are primarily financial product users and are not likely to assume that the disparate goods and services emanate from the same source merely because they are offered under marks comprising or containing the words IT'SME. This is not a situation of a shopper grabbing goods off the shelf of in a market. The purchasers would be aware of the practices of the industry, and recognize that such goods and services do not emanate from a single source. Balancing the relevant duPont factors, the Applicants submit that the marks are not confusing. 4098281 (MARK: HEY IT'S ME) Telecommunications services, namely, electronic transmission of messages, information and data for others; providing access to online databases; providing online forums for information retrieval and communication in U.S. Classes 100, 101, 104. In addition to the arguments put forth above, the 4098281 registration is prefaced with the word "Hey" as well as a separation between the words "IT'S" and "ME". A sophisticated consumer would not likely to be confused between the marks.

SIGNATURE(S)

Request for Reconsideration Signature

Signature: /Christopher J. Horgan/ Date: 07/07/2016

Signatory's Name: Christopher J. Horgan
Signatory's Position: Attorney of Record, CA Bar Member

Signatory's Phone Number: 408-687-8306

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 owner's/holder'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 owner/holder in this matter: (1) the owner/holder 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 owner/holder has filed a power of attorney appointing him/her in this matter; or (4) the owner's/holder'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: 86175521
Internet Transmission Date: Thu Jul 07 22:33:38 EDT 2016
TEAS Stamp: USPTO/RFR-XX.X.XXX.XX-201607072233381719
66-86175521-550ddcda19d3127502d4417e6648
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