

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Serial No. 88777679
Trademark: **NO IDENTITY
LEFT BEHIND**
Applicant: ID.me, Inc.
Office Action Date: April 24, 2020

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Attorney-Advisor
Law Office 114
U.S. Patent and Trademark Office

APPLICANT'S RESPONSE TO NONFINAL OFFICE ACTION

The following is the response of Applicant ID.me, Inc., by counsel, to the Nonfinal Office Action issued on April 24, 2020, by Attorney-Advisor Alex Seong Keam.

CLASS 38 PARTIAL REFUSAL

The Attorney-Advisor has refused registration of Applicant's standard character mark NO IDENTITY LEFT BEHIND pursuant to Trademark Act Sections 1 and 45 on the grounds that "the specimen does not show the applied-for mark in use in commerce in connection with the services specified in International Class 38 in the application." The Attorney-Advisor states:

Specifically, the specimens appear to show the use of the mark for class 42 services and the electronic transmission of data services appears to be an ancillary activity of the authentication services. Electronic transmission services in class 38 are generally for companies such as Verizon or ATT which provide the means for electronic transmission.

Applicant believes it would assist the Attorney-Advisor to provide a more detailed explanation of the purpose and functions of Applicant's services, as it is Applicant's position that, while the computer services described in its application for protection under Class 42 is indeed a primary activity, the "electronic transmission of personal data via global and local

computer networks” described under Class 38 in its application is *also* a primary activity that is integral to the services that Applicant provides and not merely an ancillary activity of the authentication services. By providing this explanation, Applicant believes that the Attorney-Advisor will accept the submitted specimen as a valid example of Applicant using the NO IDENTITY LEFT BEHIND mark in commerce in connection with the Class 38 services described.

Applicant’s Electronic Transmission Services are a Primary Activity.

In its most basic form, Applicant’s business and purpose in the global marketplace is to enable safe and secure digital access for both companies and individuals. Applicant accomplishes this purpose by providing verification data to companies that their individual customers are indeed who they represent themselves to be. Before the Internet age, such verification was a long and laborious process.

As a pioneer in the digital identity verification industry, Applicant has changed this process. By using Applicant’s services, companies bypass any need to expend their own resources to ensure their customers’ identities. Moreover, Applicant provides the verification data to the companies using technology of its own design that itself uses established Internet protocols to electronically transfer the verification data securely. In other words, the very operation of the identification verification services that Applicant provides to its customers requires *both* the computer services that process the data *and* the secure transmission of that data to and from its customers over global and local networks via open Internet protocols. Indeed, this describes the Applicant’s value to its client companies. In short, the electronic transmission of data is core to Applicant’s services—without that transmission, Applicant’s duties to its customers are unfulfilled.

Exhibit 1 is a visual depiction of this process. After gathering identifying data from the individual using the application programming interface (part of the services described in the Class 42 description), Applicant secures the data using a multi-factor authentication process and assigns identifying attributes as part of its identity proofing and validating function. Applicant then packages this data and electronically and securely transmits the attributes to its customers using widely-accepted Internet identity protocols that adhere to federal and industry standards. Applicant's electronic transmission of this secure data to its customers is central to Applicant's business and, indeed is an integral component of the services that Applicant's customers need and require.

Applicant does not own the global computer networks over which the secure data is transmitted. Rather, it uses these networks to conduct its own transmission of the individual's collected data and attributes to its customer's businesses in a form that is highly secure and complies with strict standards. Metaphorically speaking, Applicant owns, loads, and operates armored trucks full of sensitive data that it transports to its customers on a network of highways. The highways do not transport the data; Applicant's trucks do. Accordingly, Applicant's electronic transmission of individuals' personal data to its customers *using* global and local computer networks is a central, primary activity and function of Applicant's business.

The critical nature of this transmission activity is reflected in Applicant's existing trademark registrations, in which the USPTO has already granted protection for Applicant's ID.ME and ID.ME IDENTITY GATEWAY marks in connection with the same electronic transmission function, with and under the identical description that Applicant used in its application for Class 38 protection for NO IDENTITY LEFT BEHIND. This function is

primary, not ancillary to Applicant's services and, for this reason, Applicant respectfully requests that the Attorney-Advisor lift the Class 38 partial refusal on this basis.

The Original Specimen Shows a Direct Association Between the Mark and Applicant's Electronic Transmission Services.

The advertising and marketing material that Applicant submitted as a specimen with its application describes Applicant's No Identity Left Behind program. In short, Applicant designed the program to support in-person identity proofing, thereby extending secure, online digital access to groups that are technologically disadvantaged. Applicant offers this option to individuals who may be prevented from, or have difficulty with, navigating the initial online process for proving identity. Once a "trusted referee" (essentially, a selected third party who assists the disadvantaged individual) completes the in-person identity proofing process, the referee then submits the data to Applicant on behalf of the individual. From that point, identity verification proceeds in essentially the same way as with any other individual—including the electronic transmission of the verified identity credentials and attributes to Applicant's customers using global and local computer networks.

The submitted specimen addresses this essential function on page six, under the heading "Support for Identity Protocols." This paragraph notes that digital credentials require a network to transmit electronic data and that, accordingly, Applicant's services support the Internet identity protocols described above, as these protocols make it easier for customers to "consume" the credentials. Although this electronic transmission remains a critical link in the overall identity verification process, the focus of the No Identity Left Behind program—and this specimen—requires no more than this short description of the transmission function. Nevertheless, the inclusion of this description in this specimen sufficiently shows that Applicant uses the NO IDENTITY LEFT BEHIND mark in commerce in connection with Applicant's

electronic transmission services. As the Attorney-Advisor states in the Office Action, “the exact nature of the services does not need to be specified in the specimen” so long as there is “something which creates in the mind of the purchaser an association between the mark and the services.”

Applicant submits that the specimen creates an association between the NO IDENTITY LEFT BEHIND mark and Applicant’s electronic transmission services. For this reason, Applicant respectfully requests that the Attorney-Advisor accept the original specimen as adequately showing that Applicant uses the mark in commerce for the Class 38 services described in the application.

Class 38 Registrations Have Not and Should Not Be Limited to Large Providers Such as Verizon and AT&T.

The Attorney-Advisor states that electronic transmission services covered by Class 38 are generally for companies such as Verizon and AT&T, which provide the means for electronic transmission. Applicant does not challenge the general nature of Attorney-Advisor’s statement, but the USPTO’s own records show that, even if such a policy is indeed applied agency-wide, the exceptions are so substantial and numerous that refusing coverage to Applicant for its electronic transmission services is both unfair and prejudicial.

To be frank, the USPTO has granted *thousands* of trademark registrations for the “electronic transmission” of data under Class 38 in the past twelve months alone—but only a relative few of these recent registrations are held by large service providers. ***Exhibit 2***, attached hereto, is a spreadsheet listing a *small subset* of these registrations, which have been selected and provided here merely as examples of the USPTO’s acceptance of Class 38 descriptions similar to Applicant’s own from companies that in no way resemble large service providers such as Verizon and AT&T.

To discuss a single, specific example—less than one month ago, the USPTO granted registration under Class 38 for the mark FACTPEDIA (Reg. No. 6099626). The registrant—Factpedia Association Incorporated—operates a website that describes itself as “a budding digital content portal that aims at putting digital content for our readers in and across the country [sic]” similar to the much larger and more well-known content aggregator Wikipedia. The Class 38 description in Factpedia’s application is lengthy but includes claimed descriptive phrases such as “[e]lectronic delivery of images and photographs via a global computer network” and “[o]n-line document delivery via a global computer network.” Nothing in the USPTO file for FACTPEDIA (including the specimen) and nothing from publicly-available information sources shows that Factpedia operates as a service provider such as Verizon or AT&T. Nevertheless, the USPTO granted Class 38 protection based on these descriptions—descriptions that are comparable to Applicant’s description of its own Class 38 services as “electronic transmission of personal data via global and local computer networks.”

Indeed, the USPTO Trademark Identification Manual lists the following entry as an acceptable description under Class 38:

Transmission and delivery of {indicate type of data, e.g., digital music, satellite images, etc.} via {indicate broadcast medium, e.g., cable television, wireless communication networks, the internet, etc.}

Term ID 038-555 (effective Nov. 20, 2014). The use of this entry requires an applicant to indicate the type of data being transmitted and delivered—a requirement that would not be necessary for large service providers such as Verizon and AT&T. Moreover, Applicant’s own existing trademark registrations show that the USPTO still approves of this Class 38 description. See registrations for ID.ME (Reg. No. 4661818, granted December 30, 2014) and ID.ME IDENTITY GATEWAY (Reg. No. 5310987, granted Oct. 17, 2017). Applicant’s Class 38

description for in its NO IDENTITY LEFT BEHIND application follows this same format, identifying the data as “personal data” and the medium as “global and local computer networks.”

On a final note, the Attorney-Advisor’s statement that Class 38 services are reserved only for service providers such as Verizon and AT&T is problematic because of such a policy’s adverse effect on fair competition. For example, Verizon is a *direct competitor* of Applicant in the identity verification services industry, offering nearly identical services to the same customers. *See Exhibit 3.* A USPTO policy that prohibits Applicant and other identity management companies from enjoying trademark protection for their electronic transmission services while making that protection available to larger competitors unfairly influences competition.

For these reasons, Applicant respectfully requests that the Attorney-Advisor lift that portion of the Class 38 partial refusal based on the restriction of Class 38 protection to companies such as Verizon and AT&T.

CLASS 45 PARTIAL REQUIREMENT

The Attorney-Advisor has stated that Applicant’s identification of services in Class 45 is indefinite and must be clarified. The Attorney-Advisor further notes that, “[i]dentification verification services is no longer acceptable in class 45 since September 2017 because the services may encompass class 42.”

The Attorney-Advisor then suggests that Applicant amend the description of services in the application, as follows:

- a) Adopt the following identification to Applicant’s Class 42 description (with the amended language in bold italics):

Computer services, namely, application service provider (ASP) featuring application programming interface (API) software for allowing data retrieval, upload, access and management for purposes of authentication of personal identification information; ***Identification verification services, namely, user authentication services authenticating personal identification information using technology for e-commerce transactions.***

b) Delete the Class 45 portion of the application.

Applicant thanks the Attorney-Advisor for the suggestion and accepts and adopts the amendment as suggested by the Attorney-Advisor.

Applicant has responded to all issues raised in the Office Action. If any further information or response is required, please contact the undersigned as Applicant's attorney.

Respectfully submitted,



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