

U.S. Trademark Application No. 88/327,856
Mark: ADIANTUM
Applicant: Google LLC

RESPONSE TO OFFICE ACTION

Applicant, Google LLC (“Applicant”) is filing this in response to the Office Action of September 23, 2019, and submits it is timely. In the Office Action, the Examining Attorney refused to accept Applicant’s substitute specimen submitted August 1, 2019, and requested additional information and documentation regarding Applicant’s goods. Specifically, the Examining Attorney noted that, since the applied-for goods are open source software for use in the encryption and decryption of digital files, the substitute specimen is not acceptable because it features the software source code for download, not software that may be used for the specified function of encryption and decryption of digital files. To permit proper examination of the application, the Examining Attorney also required Applicant to respond to the following questions:

- (1) Does the zip file shown on Applicant’s substitute specimen contain executable software code for use in the encryption and decryption of digital files?
- (2) Does the zip file show on Applicant’s substitute specimen only contain source code and documentation for use by developers in further development of the code?
- (3) Would developers accessing the source code on the specimen be able to convert the code into an executable software for use in the encryption and decryption of digital files? If so, how would the developers do this?
- (4) If the answer to (1) is yes, provide screenshots showing each step from download to use of the software.
- (5) If the answer to (3) is yes, provide representative screenshots showing the steps in this process.
- (6) Is Applicant’s software available for sale/download on any other sites by third parties? If so, provide representative web addresses and screenshots.

Applicant respectfully submits that the substitute specimen indeed shows use of the mark in connection with the applied-for goods, namely, open source software for use in the encryption and decryption of digital files, and requests that the Examining Attorney reconsider her position based on the below-referenced information.

The Wikipedia article attached to the Office Action defines open source software as “a type of software in which source code is released under a license in which the copyright holder grants users the rights to study, change and distribute the software to anyone for any purpose.”

The Office Action also noted a Techopedia.com article which explained that “[o]pen-source software (OSS) is **software** that is distributed **with** source code that may be read or modified by users” (emphasis as noted by the Examining Attorney). As these references make clear, open source software *is* software. The fact that open source software is distributed with source code does not change that it is, in fact, software. The unique attribute of open source software is that it is released with source code that may be modified and, if so modified, there are certain requirements with regard to sharing the modified program with others. However, modification is not required so a person or entity downloading open source software may use it as is without any modification.

The fact that open source software *is* software should be controlling here, not that the software is being provided only in source code form or executable form and, if it not being provided in executable form, then Applicant’s substitute specimen is not acceptable. The applied-for goods are open source software for use in the encryption and decryption of digital files, which Applicant respectfully submits is shown in the specimen. If Applicant had applied for closed source or proprietary software, Applicant could understand the Examining Attorney’s objection to the substitute specimen but Applicant did not apply for closed source or proprietary software. Applicant applied for open source software, and the substitute specimen shows the mark used in connection with open source software.

Applicant respectfully submits that the Examining Attorney’s requirement that it prove use in connection with executable software code is beyond what is claimed in the application and required by the TMEP. Under TMEP §904.03(e), for “downloadable computer software, an applicant may submit a specimen that shows use of the mark on an Internet website [which] provides sufficient information to enable the user to download or purchase the software from the website.” Applicant’s substitute specimen shows the mark on the GitHub site and provides sufficient information to enable users to download the software from the site. Here, users of Applicant’s software are technology manufacturers for Android-based devices, such as phones, smart watches and televisions, as well as developers, rather than the end consumer. Consumers looking for Applicant’s software certainly understand that the nature of the software that they are downloading (i.e., open source software) and what they may or may not do with it. These are sophisticated users given the nature of Applicant’s software for the encryption and decryption of digital files. Attached under Exhibit A is a full screenshot of Applicant’s software on GitHub which references its encryption purpose, among other things. As such, Applicant respectfully submits that the substitute specimen does show use of the mark in connection with downloadable open source software for the encryption and decryption of digital files and that any further requirements to show use in connection with executable software is not appropriate under the circumstances. Consequently, Applicant respectfully believes that the Examining Attorney’s additional questions regarding the software is also inappropriate and should now be considered moot.

Given the above, Applicant respectfully requests that the Examining Attorney accept the substitute specimen and approve the application for publication. Please contact the undersigned attorney if you have any questions.