

Please consider the following in response to the June 22, 2021 Office Action herein.

In the Office Action, the Examining Attorney has objected to the wording “for use in diabetes management” in Classes 9 and 42 as indefinite, alleging, “it only sets forth the field of use and not the function of the software.”¹ To remedy the alleged ambiguity, the Examining Attorney has required Applicant to amend the wording to specify the function of the software for both classes. Applicant respectfully traverses this requirement.

Applicant appreciates that software identifications “must be sufficiently specific to permit determinations with respect to likelihood of confusion.”² With respect to software specifically, the identification must indicate its “*function or purpose*” and, where the software is “for use in a particular field or [is] content-specific, the identification should also indicate the specific field or content.”³ On the other hand, however, the TMEP makes equally clear that “specifying the field of use or content is *not* required when the identified computer programs/software has a clear function and is not field- or content-specific.”⁴ The practical application of these rules is demonstrated by several USPTO resources, as follows.

TMEP Guidance -- TMEP §1402.03(d) notes the claim “downloadable computer software for editing cinematographic film” is acceptable because the program’s function (“editing cinematographic film”) is clearly specified and is not field/content-specific. Similarly, TMEP §1402.11(a)(xii) notes “providing on-line non-downloadable geographic information system (GIS) software” is acceptable as-is because the identified software “has a clear function and is not field-specific/content-specific.” Finally, the October 2018 TMEP indicates the claim “computer programs for use in cancer diagnosis” is acceptable because the software’s particular function (“cancer diagnosis”) is specified. Applicant respectfully submits its “for use in diabetes management” software claims are *equally* acceptable as the foregoing TMEP illustrations because the software’s function (“diabetes management”) is clearly specified and is not field- or content-specific.

USPTO ID Manual Guidance -- Applicant notes the USPTO’s *Acceptable Identification of Goods and Services Manual* (“*ID Manual*”) sets forth *dozens* of acceptable identifications without reference to field of use or content in cases where the software has a clear function, *viz.*,

- “Downloadable computer software for word processing,” in Class 9⁵

¹ Applicant gratefully acknowledges the Examining Attorney’s allowance of Class 44 herein “as-is.”

² TMEP §1402.03(d).

³ *Id.* (emphasis added). “The function is the action that the programs/software performs, for example, managing bank accounts.” *Id.*

⁴ *Id.* (emphasis added).

⁵ Term ID No. 009-5127.

- “Downloadable computer software for processing digital music files,” in Class 9⁶
- “Downloadable data compression software,” in Class 9⁷
- “Providing a website featuring on-line non-downloadable software tools for image editing,” in Class 42⁸
- “Providing temporary use of non-downloadable computer software for creating music videos,” in Class 42⁹
- “Providing temporary use of non-downloadable computer anti-virus software,” in Class 42¹⁰

As illustrated by the foregoing *ID Manual* excerpts, the Trademark Office routinely accepts software claims without reference to “field of use” in cases where the software has a clear function. For instance, the above claim, “downloadable computer software for word processing,” is acceptable because the software’s *function* (“word processing”) is clearly specified and is not field/content specific.

Like the above *ID Manual* entries, Applicant respectfully submits its “for use in diabetes management” claims in Classes 9 and 42 are acceptable “as-is” because the software’s *function* (“diabetes management”) is clearly specified and is not field/content specific. Accordingly, Applicant also requests withdrawal of the Examining Attorney’s current objection based on the Office’s ongoing practice of accepting claims demonstrated by the foregoing *ID Manual* excerpts.

Ongoing USPTO Acceptance of “Diabetes Management” Software Claims -- Finally, Applicant notes the Trademark Office has previously accepted “for use in diabetes management” (or an equivalent specification) in *dozens* of prior registrations for software and mobile applications in Class 9 and/or software as a service (SAAS) in Class 42, as illustrated by the following examples:

Class 9 – Software

<i>Reg. No.</i>	<i>Goods (excerpted)</i>
6158895	... software for diabetes management.
6164771	... software for diabetes management.

⁶ Term ID No. 009-2401.

⁷ Term ID No. 009-527.

⁸ Term ID No. 042-1236.

⁹ Term ID No. 042-2440.

¹⁰ Term ID No. 042-2371.

6134144	... downloadable computer software used for diabetes management.
5542535	... software used for diabetes monitoring and management.
5500523	Medical software for use in managing diabetes.
5443856	Software used for the management of diabetes.
5324784	... software and hardware used for diabetes monitoring and management.
5260858	Software used for the management of diabetes.
5251425	... software and hardware used for diabetes monitoring and management.
5233316	... software and hardware used for diabetes monitoring and management.
5151584	... computer application software for diabetes and chronic disease management.
4960645	Medical software for use in diabetes treatment and management.
4860204	... software used for diabetes monitoring and management.
4824832	... computer hardware and software used for diabetes monitoring and management.
4191361	... software application used for the management of diabetes.
4246904	... software for diabetes management.
3585673	... diabetes management software.

Class 9 -- Mobile Applications

<i>Reg. No.</i>	<i>Goods (excerpted)</i>
6376317	Downloadable computer application software for mobile devices, namely, software for use in diabetes management.
6301639	...downloadable software in the nature of a mobile application for use in managing and monitoring diabetes.
6211187	Downloadable computer application software for mobile devices, namely, software for use in diabetes management.
6164771	... computer software application for mobile devices, namely, software for diabetes management and glucose tracking.
6079101	Downloadable software in the nature of a mobile application for management of diabetes.
5823164	Mobile device software applications for diabetes management.

5803327	...mobile software applications in the field of diabetes management.
5748014	Downloadable software in the nature of mobile applications for the management of diabetes.
5260858	... mobile software applications in the field of diabetes management
5235383	... downloadable mobile applications in the field of diabetes management.
5201074	Downloadable software in the nature of a mobile application for use in managing and monitoring diabetes.
4986972	... downloadable mobile applications used for diabetes monitoring and management.
4968711	Computer application software for mobile phones, tablets, and desktop computers, namely, software for diabetes management.
4661105	Downloadable software in the nature of a mobile application for use in monitoring and managing diabetes.
4272872	Computer application software for ... mobile phones ... software for ... and management of diabetes.

Class 10 Software as Integral Medical Device Component

<i>Reg. No.</i>	<i>Goods (excerpted)</i>
5810271	... computer hardware and software used for diabetes monitoring and management.

Class 42 Software as a Service

<i>Reg. No.</i>	<i>Services (excerpted)</i>
6422799	... providing temporary use of non-downloadable software for ... diabetes management.
6317350	Software as a service (SaaS) services featuring software for use in the field of health care, namely, software for use in the management of diabetes.
6317344	Software as a service (SaaS) services featuring ... software for use in the management of diabetes.
6200471	... providing temporary use of online non-downloadable computer software and mobile applications for use in diabetes management.
5994503	... providing temporary use of non-downloadable software for ... diabetes management.
5701257	Providing temporary use of non-downloadable cloud-based software used for diabetes monitoring and management.

5651042	... providing use of non-downloadable software for ... diabetes management.
5645960	... providing temporary use of online non-downloadable Internet-based software used for the management of diabetes.
5542802	Providing temporary use of on-line non-downloadable software for ... diabetes management.
5542535	Providing temporary use of non-downloadable cloud-based software used for diabetes monitoring and management.
5023121	Providing temporary use of non-downloadable software for ... diabetes management.
4990171	... providing temporary use of online non-downloadable software for use in diabetes management.
3585673	... providing online temporary use of non-downloadable computer software used for diabetes management.

TSDR printouts showing details for the above are attached. The foregoing examples demonstrate the Office's consistent and ongoing practice of accepting "for diabetes management" claims in the software space *without* demanding further field of use/content specificity. Considering this, Applicant respectfully submits its "for use in diabetes management" claims herein should be *equally* acceptable.

As the Board has noted, consistent and uniform treatment in examination is a goal of the Office.¹¹ Absent compelling reasons, therefore, Applicant respectfully asserts identification language the Office has previously found acceptable should remain acceptable.¹² Accordingly, Applicant respectfully submits its present software "for use in diabetes management" specifications in Classes 9 and 42 should be accepted "as-is."

Considering the foregoing information and arguments, Applicant respectfully requests withdrawal of the Examining Attorney's objections to the identification herein and allowance of Applicant's mark for publication.

¹¹ See, e.g., *In re Rodale Inc.*, 80 USPQ2d 1696, 1700 (TTAB 2006); *In re Finisair Corp.*, 78 USPQ2d 1618, 1621 (TTAB 2006); see also *In re Omega SA*, 83 USPQ2d 1541, 1544 (explaining that "the time and expense of complying with inconsistent applications burdens both the PTO and the public that depends on its services").

¹² Applicant recognizes standards may change, and that once-acceptable identifications may no longer be acceptable. In this instance, however, most of the registrations cited above issued within the last three years, including as recently as *three months* ago. Considering this, Applicant submits it is highly unlikely identification standards have so suddenly changed as to render Applicant's claims unacceptable.