**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

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| Applicant: | Google LLC |
| Serial No.: | 88772732 |
| Filed: | January 24, 2020 |
| Mark: | OPENTITANIUM |
| Class: | 9, 42 |

**RESPONSE TO OFFICE ACTION**

Applicant Google LLC ("Applicant") submits the following remarks in response to the Office Action dated April 21, 2020 regarding Application Serial No. 88772732 for the mark OPENTITANIUM ("Applicant's Mark") covering goods and services in Classes 9 and 42 (the "Application").

## AMENDMENTS

The Examining Attorney has found that the language "access control, identification, authentication, security and safety" is indefinite and must be clarified.

Applicant submits that "access control, identification, authentication, security and safety" is sufficiently specific and well understood in the relevant industry, and does not require further clarification or specification. Moreover, the USPTO recently accepted this exact language without requiring clarification in another application filed by Applicant for the same offering, shown below.

- App. Ser. No. 88484050 for OPENTITAN by the Applicant, allowed on March 24, 2020, covering "Open source downloadable software for use in developing, executing, and managing hardware-based Roots of Trust (RoTs), silicon microprocessors, microcontrollers and chipsets for use in *access control, identification, authentication, security and safety*; downloadable computer software development tools for deploying, running and managing hardware-based Roots of Trust (RoTs), silicon microprocessors, microcontrollers and chipsets for use in *access control, identification, authentication, security and safety*; downloadable computer software for remote attestation and certificate-based security; downloadable computer software for use in *access control, identification, authentication, security and safety*; downloadable authenticating application software for cloud computing services" in Class 9 and "Design and

development of open source computer hardware, silicon microprocessors, microcontrollers and chipsets for use in *access control, identification, authentication, security and safety*" in Class 42.

Pursuant to the U.S. Trademark Office's Consistency Initiative, Applicant requests consistent examination with its U.S. App. Ser. No. 88484050, which shows that "access control, identification, authentication, security and safety" is sufficiently specific and well understood in the industry and does not require further clarification or specification.

In response to the Examiner's request to clarify the term "open source software," please amend the identification of goods and services in the Application as follows:

> Class 9: Open source **downloadable** software for use in developing, executing, and managing hardware-based Roots of Trust (RoTs), silicon microprocessors, microcontrollers and chipsets for use in access control, identification, authentication, security and safety; **downloadable** open source computer software development tools for deploying, running and managing hardware-based Roots of Trust (RoTs), silicon microprocessors, microcontrollers and chipsets for use in access control, identification, authentication, security and safety; **downloadable** open source computer software for remote attestation and certificate-based security.

> Class 42: Design and development of open source computer hardware, silicon microprocessors, microcontrollers and chipsets for use in access control, identification, authentication, security and safety

Applicant submits that the revised identification of goods and services is sufficiently clear and satisfies the Examining Attorney's request.

## REMARKS

The Examining Attorney has issued an initial refusal to register the Application under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), on the ground of a potential likelihood of confusion with the prior-filed registration shown below (the "Cited Registration"):

| Mark | Reg. No. | Owner | Goods |
|------|----------|-------|-------|
| TITANIU M | 4561715 | Trend Micro Kabushiki Kaisha | Class 9: computer, data, and network security software; computer antivirus and content security software; computer utility software; malicious code and content screening software; anti-spam, anti-fraud, and anti-phishing computer software; |

| | | | computer software for monitoring, filtering, and reporting messages, files, programs and data retrieved or received from computer and communication networks; computer software for use in scanning, detecting, quarantining, eliminating, blocking and reporting on viruses, worms, trojans, spyware, adware, malware, security exploits, bots and unauthorized data and programs on computers, electronic devices, and handheld and mobile computing and communication devices; computer software for use in detecting viruses, worms, trojans, spyware, adware, malware, security exploits, bots and unauthorized data and programs on computers and electronic devices; web browser security add-on software, namely, computer software for protecting web browser users from malicious, untrustworthy and unwanted content and programs; computer software for ensuring the security of wireless communications; computer software for the authentication of wireless internet access points; computer software for remotely securing data and files in the event of theft; electronic software updates, namely, downloadable computer software and associated data files for updating computer software in the fields of computer and network security; computer software to protect the confidentiality of data and passwords; computer software for protecting the integrity of data, computers, computer software, and mobile computing and communication devices from viruses, worms, trojans, spyware, adware, malware and unauthorized access |
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In addition, the Examining Attorney has issued an advisory for the prior-pending applications listed in the chart below based on a potential likelihood of confusion under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d).

| Mark | App. No. | Owner | Relevant Goods/Services |
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| TITANIUM SECURITY SUITE | 88206950 | Star Lab Corp. | Class 9: Recorded computer software for controlling access to software applications, files, networks, devices, and services provided by a computer's operating system, controlling |

| | | | and auditing the computer users' activity, and preventing breaches of the computer's security |
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| TITANIUM TECHNOLOGIES | 87741587 | Win Long USA, LLC | Class 9: optical cables; electric cables; electronic cables; electric charging cables; high definition multimedia interface cables; coaxial cables; electric power charging connectors; cable connectors; connectors for electronic circuits; power supply connectors and adaptors for user with portable electronic devices; audio and video connection cables; cable modems; cable set top boxes; computer card adapters; cables, namely, parallel and serial signal cables for use with computers, modems printers, and other devices; data adaptors for use with portable electronic devices; data connector face plates for use in cabling or wiring; data jacks; digital display interface (DisplayPort) adapters; digital display interface (DisplayPort) cables; electric connections; electric connectors; electrical face plates; electrical power connectors; Ethernet adapters; Ethernet connectors; Ethernet face plates for use in cabling or wiring; Ethernet patch panels for connecting electrical connectors and electrical switches; Network hardware, namely, Ethernet network routers, namely, Ethernet network hubs, Ethernet network media converters, Managed or unmanaged Ethernet network switches, power over Ethernet power injectors and power over Ethernet power splitters; extension cords; fiber optic connectors; fiber optic jumper cables; fiber optic junction boxes; fiber optic patch panels for connecting optical connectors and optical switches; glass optical cables; high definition multimedia interface wireless extenders; high definition multimedia interface wireless repeaters; high definition multimedia interface signal splitters; high definition multimedia interface signal switches; mini digital display interface (DisplayPort) adapters; mini digital display interface (DisplayPort) cables; multimedia jacks; LAN (local area network) access points for connecting users to a computer network; |

| | | | network cable connectors computer network switches; networking dongles, namely, USB dongles being wireless network adaptors; networking dongles, namely, USB dongles being wired network adaptors; optical fiber cables; plastic optical cables; plastic optical connectors; plastic optical jacks; plug connectors; power supply adaptors for use with portable electronic devices; power connectors; power strips; audio and video cables; relocatable electric power taps; smart home controllers and detectors in the nature of home automation systems comprising wireless and wired controllers, controlled devices, and software for lighting, HVAC, security, safety and other home monitoring and control applications; smart home door sensors in the nature of electronic sensors for door or gate opening; smart home security products, namely, entry door systems primarily comprising touch pads, electric locks and security doors and also including door handles and deadbolt locks; smart home electronic sensors for glass breakage; smart home motion capture devices and video cameras; smart home motion sensors; Internet protocol video camera; motion detection video cameras; smart home remotes controls for radios, televisions and stereos; smart home sensors for sensing temperature, noise, moisture, water leaks, and motion; smart home smoke/heat detectors; smart home carbon monoxide detectors; smart home sensors for sensing smoke/heat; smart home sensors for sensing carbon monoxide; smart home window sensors in the nature of electronic sensors for window opening; speaker cable; speaker connectors; electric wires for speakers; stereo cables; surge protectors; telephone faces plates; telephone wall plates; telephone jacks; telecommunication cables; optical audio cables; universal serial bus adapters; universal serial bus cables; universal serial bus cards; universal serial bus hubs; VGA video, audio and stereo cables; video cables; video display cards; networking |
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| | | | hardware, namely, wireless access point (WAP) devices; bulk multi conductor cables; bulk category style shielded or unshielded network or telecommunications cable; bulk coaxial cables; bulk fiber optic cables; bulk speaker cable; coaxial cable connectors; coaxial face plates for use in cabling; coaxial signal splitters for electronic apparatus; coaxial wall plates for use in cabling; data connector wall plates for use in cabling or wiring; electrical wall plates in the nature of switch plates; electrical wall plates in the nature of outlet plates; Ethernet wall plates for use in cabling or wiring; fiber optic face plates for use in cabling or wiring; fiber optic wall plates for use in cabling or wiring; generic face plates for keystone style connectors for use in cabling or wiring; generic wall plates for keystone style connectors for use in cabling or wiring; generic face plates for multimedia jacks for use in cabling or wiring; generic wall plates for multimedia jacks for use in cabling or wiring; generic face plates for telephone jacks; generic wall plates for telephone jacks; high definition multimedia interface face plates for use in cabling or wiring; high definition multimedia interface jacks; high definition multimedia interface wall plates for use in cabling or wiring; high definition multimedia interface to audio and video converters; keystone style jacks for holding a connector; multimedia face plates for use in cabling or wiring; multimedia wall plates for use in cabling or wiring; surface mount boxes for keystone style connectors; surface mount boxes for multimedia jacks; surface mount boxes for telephone jacks; webcams; earbuds; wireless earbuds; telephone headsets with microphone; telephone headsets; computer microphones; headsets for use with computers; radio-frequency antennas; radio-frequency components, namely, radio-frequency cables and connectors; printed circuit boards (PCBs); power cables; DC/AC power converters; Ultrasonic sensors; Temperature sensors; Pressure sensors; Pollutant sensors; |
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| | | | Acceleration sensors; Touchscreen sensors; Timing sensors; Optical sensors; Alarm sensors; Photoelectric sensors; Vibration sensors; Infrared sensors; Proximity sensors; Electric sensors; Oil level sensors; Liquid level sensors; LED position sensors; Industrial calibration sensors; Electronic proximity sensors and switches; Vibration sensors for installation in windmill housings; Light systems comprising light sensors and switches; Vehicle safety equipment, namely, back-up sensors and cameras; Sensors for the determination of temperatures, positions and distances; Sensors for determining position, velocity, acceleration and temperature; Electric, electronic, or electrochemical oxygen monitors and sensors for environmental use; Microsensors for measurement of pressure, acceleration, force and flow, namely, silicon piezoresistive pressure sensors; Sensors and detector units for use in controlling the actuation and operation of automotive safety apparatus and equipment; Environmental monitoring system comprised of meters and sensors that measure pressure, humidity, temperature and includes alarm and reporting functions; Occupancy sensors, namely, electronic devices which detect the presence of occupants and control the lighting system accordingly; Vehicle detection equipment, namely, display monitors, computers, image sensors, video cameras, and operating system and application software to detect vehicle location; Safety and driving assistant system for mobile vehicles and vessels comprised of electronic proximity sensors and switches, high-resolution cameras, integrated circuits for the purpose of imaging processing, and display monitors; Microcontrollers for internet of things (IoT) enabled devices; Camera containing a linear image sensor<br><br>Class 42: Product research and development |

Initially, Applicant submits that Application No. 88206950 for TITANIUM SECURITY SUITE was abandoned on April 14, 2020. As a result, Applicant respectfully requests that the Examining Attorney remove the advisory in relation to this application.

Applicant submits that there is no likelihood of confusion between the Cited Registration, Application No. 87741587 for TITANIUM TECHNOLOGIES (the "Cited Application"), and Applicant's OPENTITANIUM mark, for the reasons discussed below.

**I.      There is No Likelihood of Confusion Between Applicant's Mark and the Cited Registration.**

A likelihood of confusion evaluation under Section 2(d) is based on an analysis of all of the probative facts in evidence that are relevant to the factors set forth in *In re E.I. du Pont DeNemours & Co.*, 177 U.S.P.Q. 563, 567 (C.C.P.A. 1973). But "not all of the *Du Pont* factors are relevant or of similar weight in every case," and any one of the factors may control. *Opryland USA Inc. v. Great Am. Music Show*, 23 U.S.P.Q.2d 1471, 1473 (Fed. Cir. 1992); *Du Pont*, 177 at 567. Indeed, if the goods in question "are not related or marketed in such a way that they would be encountered by the same persons in situations that would create the incorrect assumption that they originate from the same source, then, even if the marks are identical, confusion is not likely." T.M.E.P. § 1207.01(a)(i).

The Application is sufficiently distinguishable from the Cited Registration based on (1) the dissimilarity between the parties' respective marks, (2) the dissimilarity of the goods and services as described in the respective application and registration, and (3) the sophistication of the relevant consumers.

**A.      Applicant's OPENTITANIUM Mark and the Cited Registration are Dissimilar in Overall Commercial Impression**

It is well settled that for the purposes of a likelihood of confusion analysis, the marks must be considered in their entireties. Importantly, the Supreme Court has noted that "[t]he commercial impression of a trademark is derived from it as a whole, not from its elements separated and considered in detail. For this reason it should be considered in its entirety." *Estate of P.D. Beckwith, Inc. v. Comm'r of Patents*, 252 U.S. 538, 545-46 (1920).

For example, in *In re Hearst Corporation*, the Federal Circuit found that VARGAS was not confusingly similar to the mark VARGA GIRL, both for calendars, and criticized the Board for emphasizing the VARGA portion of the mark while discounting the GIRL element. 25 U.S.P.Q.2d 1238 (Fed. Cir. 1992). The Board has similarly found that marks can share a common term and still not cause a likelihood of confusion when there is an additional word in the mark that creates an entirely different commercial impression. *See In re Merchandising Motivation, Inc.*, 184 U.S.P.Q. 364 (T.T.A.B. 1974) (MMI MENSWEAR not confusingly similar to MEN'S WEAR); *Standard Brands, Inc. v. Peters*, 191 U.S.P.Q. 168 (T.T.A.B. 1975) (CORN-ROYAL for butter not likely to cause confusion with ROYAL marks on food products).

In this case, Applicant's OPENTITANIUM Mark and the cited TITANIUM mark are sufficiently dissimilar in overall commercial impression and are unlikely to cause consumer confusion. Applicant's Mark begins with a completely different prefix of "OPEN" that, when combined with "TITANIUM," forms a singular word, OPENTITANIUM, which has a distinct meaning and connotation from the term TITANIUM. Specifically, the "OPEN" portion of Applicant's Mark suggests a product and service that is available to all, while the Cited Mark TITANIUM suggests a product that is impenetrable and closed off. In addition, as Applicant's Mark is a unitary term, the "OPEN" prefix forms the dominant portion of the mark, not the "TITANIUM" portion. Based on these differences, consumers will no doubt be able to distinguish between the marks and are unlikely to be confused.

Therefore, when the marks are compared in their *entireties*, and in the context of the identified goods and services, as discussed below, the differences between the marks in overall appearance, sound, and commercial impression are more than sufficient to avoid a likelihood of confusion.

### B. The Parties' Respective Goods and Services Are Dissimilar

The Examining Attorney argues that the goods and services in the Application and the Cited Registration are related because they both cover software. However, it is well settled that computer software is not automatically related for the purposes of likelihood of confusion. *See Electronic Data Sys. v. EDSA Micro Corp.*, 23 USPQ2d 1460, 1463 (TTAB 1992). Confusion is

unlikely where the parties' respective services, as listed in the application or registration, are sufficiently dissimilar. See T.M.E.P. § 1207.01(a)(iii).

In this case, the Applicant's goods and services are sufficiently dissimilar from the goods recited in the Cited Registration and are not likely to cause confusion. Although the Application and the Cited Registration both cover computer software, the function of the respective software is distinct. In particular, the Application covers open source technology used only with various types of computer chips to provide a function of access control and authentication. Applicant's open source technology is a specific subset of software that is publicly shared with others for the purpose of modification and enhancement by others. Moreover, Applicant's software is further limited to use in connection with computer chips.

The Cited Registration, on the other hand, is narrowly tailored to *only* encompass software used in connection with computer and network security, which is separate and apart from computer chips. Indeed, the software in the Cited Registration is *not* used in connection with computer chips, nor could it be construed to encompass use with computer chips. The software in the Cited Registration functions as a security software that protects against malicious software. Moreover, the Cited Registration does not include open source software. As the Cited Registration only encompasses a narrowly tailored type of network security software, it cannot overlap with any of Applicant's goods or services, particularly since Applicant's products and services are all limited to open source software used in connection with computer chips that offer a distinguishable functionality.

Accordingly, the parties' respective goods and services are sufficiently dissimilar to avoid a likelihood of confusion.

### C. The Goods and Services at Issue are Purchased by Sophisticated Consumers.

Purchaser care and sophistication must also be considered when evaluating a potential likelihood of confusion. A consumer who exercises scrutiny in selecting a product is likely to pay close attention to the distinguishing trademarks of the product, and is not likely to confuse them with the products of another. *See In re E.I. du Pont de Nemours & Co.*, 476 F.2d at 1361, 177 USPQ at 567 (whether buyers are likely to buy a product on "impulse" or after careful deliberation is an important factor in evaluating the likelihood of confusion). Where the product

and/or service is a sophisticated technology that requires careful assessment by professionals before purchasing, those consumers are unlikely to be confused by even slight differences in the marks. *See, e.g., Checkpoint Systems, Inc. v. Check Point Software Technologies, Inc.*, 269 F.3d 270 (3d Cir. 2001) (use of CHECKPOINT for firewall security programs sold to computer technology specialists not likely to cause confusion with CHECKPOINT for physical surveillance equipment because the purchasers are sophisticated and the purchasing process is lengthy and a significant investment over time).

In this case, Applicant's consumers are computer software developers who will be modifying and enhancing Applicant's open source software for use in connection with computer chips, as well as computer chip manufacturers, platform providers, and enterprise organizations who will be using Applicant's open source software and design of open source hardware for a very specific functionality. These consumers are not only highly sophisticated, but they will no doubt exercise a high degree of care before making a decision to purchase Applicant's products and services because the products and services will be components of a complex piece of computer hardware, such as a server or computer. They will also already be familiar with the well-known OpenTitan project (https://opentitan.org/), which this offering will be a part of. Given the sophistication and knowledge of Applicant's targeted user base, it is unlikely that relevant consumers would be confused as to the source of Applicant's goods and services. As a result, confusion is unlikely.

**II.     There is No Likelihood of Confusion Between Applicant's Mark and the Cited Application.**

Applicant submits that Applicant's Mark is not likely to cause confusion with the Cited Application for TITANIUM TECHNOLOGIES.

Applicant's OPENTITANIUM Mark is distinguishable from the cited TITANIUM TECHNOLOGIES mark. Specifically, Applicant's OPENTITANIUM Mark begins with the prefix "OPEN" that serves as the first and dominant portion of the mark, and is combined with the term "TITANIUM" to create a unitary mark with a distinct overall commercial impression and connotation to the cited mark TITANIUM TECHNOLOGIES. In addition, the cited mark

contains an additional term TECHNOLOGIES that further distinguishes the two marks, particularly when the two marks are properly compared in their entireties.

In addition, Applicant's OPENTITANIUM Mark covers distinguishable goods and services from the Cited Application. Specifically, the Application covers open source software used in connection with computer chips for access control. The Cited Application does not cover software of any kind. Instead, it covers a wide variety of electronic devices under Class 9 and "product research and development" in Class 42, neither of which can be construed to be related to Applicant's open source software or design of open source hardware.

Finally, as discussed above, Applicant's consumers are highly sophisticated and will exercise a high degree of care before making a decision to purchase Applicant's products and services. The sophistication of Applicant's consumers makes confusion unlikely in this case.

As a result of these factors, it is highly unlikely that the Application is likely to cause consumer confusion with the Cited Application.

## CONCLUSION

Applicant believes that it has responded to all of the issues raised in the Office Action and therefore respectfully requests that the Examining Attorney remove the refusals and approve the Application for publication. If the Examining Attorney has any questions, please contact the undersigned.