

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

Applicant: Google LLC  
Mark: OPEN USAGE COMMONS  
Serial No. 88/922,688  
Class: 35  
Dated Filed: May 19, 2020  
To: Commissioner for Trademarks  
P.O. Box 1451  
Alexandria, Virginia 22313-1451  
Attention: Janet Lee  
Trademark Examining Attorney  
Law Office 124

**RESPONSE TO OFFICE ACTION DATED SEPTEMBER 14, 2020**

1. Background

Google LLC (“Applicant”) is the owner of application Serial No. 88/922,688 for registration of OPEN USAGE COMMONS (“Applicant’s Mark”). In an Examiner’s Amendment issued on August 3, 2020, the application was amended to cover the following services in International Class 35:

*Promoting the public awareness of the importance of free and open source software projects, namely, projects relating to software development, to computer system and application development, deployment and management, to connecting, managing, and monitoring microservice environments, and to collaborative code review; Promoting public awareness and the importance of non-proprietary software and open source projects used under agreements meeting certain requirements for distribution and redistribution;* Business management and business administration for others in the field of trademarks, namely, trademarks relating to non-proprietary software and open source projects; Business support services, namely, business consulting services regarding the management of trademarks relating to non-proprietary software and open source projects

On September 14, 2020, the Examining Attorney issued an office action refusing registration under Section 2(e)(1) of the Lanham Act, 15 U.S.C. §1052(e)(1), on the sole ground that Applicant's Mark is merely descriptive. On October 13, 2020, Applicant filed a Request to Divide, creating a "child" application that has been assigned application serial number 88/979,696 (the "Child Application"). The Child Application covers the services italicized and highlighted above, for promoting awareness of open-source software. On December 1, 2020, Applicant filed an Allegation of Use for the Child Application and an office action response amending the Child Application to seek registration on the Supplemental Register.

Given the creation of the Child Application and the amendment of the Child Application to seek registration on the Supplemental Register, the September 14, 2020 descriptiveness refusal applies only to the following services that remain in the "parent" application, serial no. 88/922,688 (the "Parent Application"):

Business management and business administration for others in the field of trademarks, namely, trademarks relating to non-proprietary software and open source projects;  
Business support services, namely, business consulting services regarding the management of trademarks relating to non-proprietary software and open source projects

For all of the reasons discussed below, the mark is not merely descriptive as applied to the business management, administration, support and consulting services covered by the Parent Application (collectively referenced below as "trademark management services"). Accordingly, Applicant respectfully requests that the examining attorney withdraw the Section 2(e)(1) refusal for the Parent Application.

**I. 2(E)(1) REFUSAL – APPLICANT'S MARK IS NOT MERELY DESCRIPTIVE**

The Examining Attorney based the descriptiveness refusal on the argument that Applicant's Mark "immediately indicates that applicant's services are related to the free utilization ("open usage") of software or other technology on the internet (digital "commons"),

typically with the goal of maximizing social benefits rather than impose costs through licenses.”

Office Action at 2. The examining attorney provided the following definitions in support of the refusal:

- “OPEN means ‘Of or relating to a file that can be accessed’” (Office Action at 2, citing American Heritage Dictionary of the English Language)
- “USAGE means ‘The act, manner, or amount of using; use’” (*id.*)
- “COMMONS is a term in widespread use for material shared on the Internet (*id.*, citing Wikipedia.org); and “is used to refer to widespread use of material shared on the Internet in the industry” (*id.*, citing excerpts from the websites of Creative Commons and Open Data Commons)

*Id.* Even if one assumes for the sake of argument that OPEN USAGE COMMONS describes open source or non-proprietary software,<sup>1</sup> the mark does not describe the business management, trademark administration, and related consulting services that remain in the Parent Application. *See In re Chamber of Commerce*, 675 F.3d 1297, 1300 (Fed. Cir. 2012) (determination of whether or not mark is descriptive must be made not in the abstract, but in relation to the goods or services for which registration is sought). Rather, the mark at most is suggestive of those services and is not legally descriptive.

The trademark management services covered by the Parent Application at most are only tangentially related to the broad concept of “the free utilization (‘open usage’) of software or other technology on the internet (digital commons)”. Office Action at 2. Specifically, Applicant’s mission is to provide independent business support and management services relating to the trademarks of numerous entities in the open source community. As part of this service, Applicant will perform administrative tasks pertaining to the prosecution and

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<sup>1</sup> Applicant does not concede that OPEN USAGE COMMONS is descriptive of open source or non-proprietary software, nor that the mark describes the services contained in the Child Application. Rather, Applicant argues throughout this response that, *even if one assumes* that the mark is descriptive of open source or non-proprietary software, the mark is not descriptive of the business management services included in the Parent Application.

enforcement of such trademarks, and will publish brand guidelines and technical conformance tests to educate the community on their proper use. The connection between the coined name OPEN USAGE COMMONS and these specialized services is far too remote to support a finding of descriptiveness.

A mark is merely descriptive only if “it **forthwith** conveys an **immediate** idea of the ingredients, qualities or characteristics” of an applicant’s goods or services. *In re Stroh Brewery Co.*, 34 U.S.P.Q.2d 1796, 1797 (T.T.A.B. 1994) (emphasis in original). As stated by the Second Circuit Court of Appeals, “[t]he meaning of a descriptive mark is narrowly tailored to its associated product, such that it calls that product immediately to mind.” *Cross Commerce Media, Inc. v. Collective, Inc.*, 841 F.3d 155, 163 (2d. Cir. 2016) (COLLECTIVE suggestive for business software to facilitate marketing).

In contrast, suggestive marks are those that, when applied to the goods or services at issue, require “imagination, thought, or perception to reach a conclusion as to the nature of those goods” or services. *Stix Prods., Inc. v. United Merchs. & Mfrs, Inc.*, 295 F. Supp. 479, 488 (S.D.N.Y. 1968); *see also* T.M.E.P. § 1209.01(a). The primary distinguishing factor between descriptive and suggestive marks is “‘the imaginativeness of the suggestion,’ that is, how immediate and direct is the thought process from the mark to the particular product.” *AMF, Inc. v. Sleekcraft Boats*, 599 F.2d 341, 349 (9th Cir. 1979) (quoting RESTATEMENT OF TORTS § 721, Comment a (1938)).

The connection between OPEN USAGE COMMONS and Applicant’s trademark management services is neither “immediate” nor “direct,” and can be appreciated only with the customer’s exercise of “imagination.” In other words, in order for the public to understand the

relationship between OPEN USAGE COMMONS and Applicant’s trademark management services, it must engage in the following multi-stage thought process:

1. OPEN USAGE COMMONS describes open source or proprietary software;<sup>2</sup>
2. Applicant provides business management, administration, support and consulting services;
3. those services specifically relate to the management of trademarks, such as trademark administrative and enforcement duties as well as the establishment of brand usage guidelines; and
4. the trademarks at issue are used in connection with open source or non-proprietary software.

The “multi-stage reasoning” required for the customer to understand the connection between mark and services is the hallmark of a distinctive mark: “If a consumer must use imagination or any type of multistage reasoning to understand the mark’s significance, then the mark does not describe the products, but suggests them. Such a mark is therefore classified as ‘suggestive rather than ‘descriptive.’” *Kendall-Jackson Winery, Ltd. v. E. & J. Gallo Winery*, 150 F.3d 1042, 1047 (9<sup>th</sup> Cir. 1998). Where, as here “‘the mental leap between the word and the product’s attributes is not almost instantaneous, this strongly indicates suggestiveness, not direct descriptiveness.’” *Cross Commerce Media, Inc. v. Collective, Inc., supra*, 841 F.3d at 162 (quoting 2. J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition* § 11:67 (4<sup>th</sup> ed.)).

In *Cross Commerce Media*, the court held that COLLECTIVE is suggestive of data analysis software because the association between the mark and product “lacks the specificity that would enable an average consumer to intuit the nature of [the] business from the ... mark, at least absent considerable imaginative effort (or luck).” *Id.* at 164. Similarly, even if one assumes for the sake of argument that OPEN USAGE COMMONS describes open source software, the connection between the mark and Applicant’s trademark management services is so

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<sup>2</sup> Again, Applicant does not concede that the mark is descriptive of such software, but accepts that proposition only for the sake of this argument.

attenuated that consumers would not be able to intuit the nature of Applicant's services without very substantial imaginative effort. The mark thus is suggestive. *See also Physicians Formula Cosmetics v. West Cabot Cosm.*, 857 F.2d 80, 82 (2d Cir. 1988) (PHYSICIANS FORMULA suggestive of skin creams and lotions because "the mark does little to identify the product other than to locate it in the realm of medicine." *Id.*; compare *Thompson Med. Co. v. Pfizer Inc.*, 753 F.2d 208, 216 (2d Cir. 1985) (SPORTSCREME descriptive because the mark has a meaning specific to "a cream useful in connection with sports").

As is true in the instant case, "the meaning of a suggestive mark typically evokes an array of goods, which means that consumers must make an additional mental effort to identify the associated product in particular." *Cross Commerce Media, supra*, 841 F.3d at 163. "A suggestive mark ... is ordinarily one that 'describes an attribute of the product' but 'could plausibly describe a wide variety of [other] products as well.'" *Id.*, quoting *Starbucks Corp. v. Wolfe's Borough Coffee, Inc.*, 588 F.3d 97, 107-108 (2d Cir. 2009). *See also Playtex Prods., Inc. v. Ga.-Pac. Corp.*, 390 F.3d 158, 164 (2d Cir. 2004) (WET ONES suggestive because it evokes qualities (dampness and one-by-one usage) shared by a wide range of goods, which makes it difficult for consumers to divine the nature of the product from the mark alone); *Application of the Realistic Company*, 440 F.2d 1393 (C.C.P.A. 1971) (CURV held inherently distinctive and not merely descriptive because "the word 'curve' is as suggestive of almost any article of manufacture (i.e., anything having or producing any type of curved shape) as it is of permanent wave curling solution ....").

OPEN USAGE COMMONS is suggestive of Applicant's trademark management services because it "evokes an array of goods" or services and "could plausibly describe a wide variety of [other] products as well." *Cross Commerce*, 841 F.3d at 163. Even if one accepts for

the sake of argument that the mark describes open source or non-proprietary software, the mark “evokes an array of” hypothetical services that have some relationship to such software including, to list just a few examples:

- Software development services involving open source software
- IT consulting and integration involving open source software
- Guides to open source software resources
- Product liability services for developers who utilize open source software
- Legal advice in the field of licensing, enforceability and risks in use of open source software

The relationship between the mark and the services described in the Parent Application is indirect and the mark could plausibly describe at least some aspect of many other goods or services. This provides strong evidence that OPEN USAGE COMMONS is legally suggestive of Applicant’s services.

## **II. CONCLUSION**

Applicant has demonstrated that OPEN USAGE COMMONS does not directly describe characteristics or features of the business and trademark management services retained in the Parent Application and that the mark is inherently distinctive as applied to those services. The T.T.A.B. and numerous courts have held that any doubt concerning whether a mark is descriptive or suggestive should be resolved in the applicant’s favor. *See, e.g., In re Conductive Systems, Inc.*, 220 U.S.P.Q. 84, 86 (T.T.A.B. 1983); *In re Pennwalt Corp.*, 173 U.S.P.Q. 317, 319 (T.T.A.B. 1972). Applicant respectfully requests that the Parent Application be forwarded for publication.