

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

Applicant : Google LLC  
Serial No. : 88657194  
Filed : October 16, 2019  
Mark :  
Law Office : 128  
Examining Attorney : Carlita Jaye Solano  
Attorney : 039430-000380  
Docket No.



Classes : 9 and 38

Commissioner for Trademarks  
P.O. Box 1451  
Alexandria, VA 22313-1451

**RESPONSE TO OFFICE ACTION**

Applicant submits this Response to the Office Action dated August 10, 2020, issued against



Application Serial No. 88657194 to register the mark (**“Applicant’s Mark”**), in which the U.S. Patent and Trademark Office (**“PTO”**) Examining Attorney found that the specimens submitted by Applicant on June 30, 2020 (the **“Specimens”**) in connection with the services identified in Class 38, namely *Communication services, namely, transmission of voice, audio, and data by telecommunications networks, wireless communication networks, the Internet, information services networks and data networks* (**“Applicant’s Services”**), did not show use of Applicant’s Mark in commerce, and refused registration of Application Serial No. 88657194 (**“Applicant’s Application”**). For the reasons set forth below, Applicant respectfully disagrees with the Examining Attorney’s conclusion that Applicant’s Specimens do not adequately show use of Applicant’s Mark in commerce in connection with Applicant’s Services and requests that the Examining Attorney withdraw her refusal of registration.

On June 30, 2020, Applicant submitted a Statement of Use attaching Applicant’s Specimens of Use for Classes 9 and 38 of Applicant’s Application. The Specimens consisted of screenshots from the Google Play store page for Applicant’s Recorder App. As shown below, the Specimens prominently featured Applicant’s Mark as the icon for the Recorder App, and provided a description of the services offered by the app, including, as highlighted in the Specimens, a function which

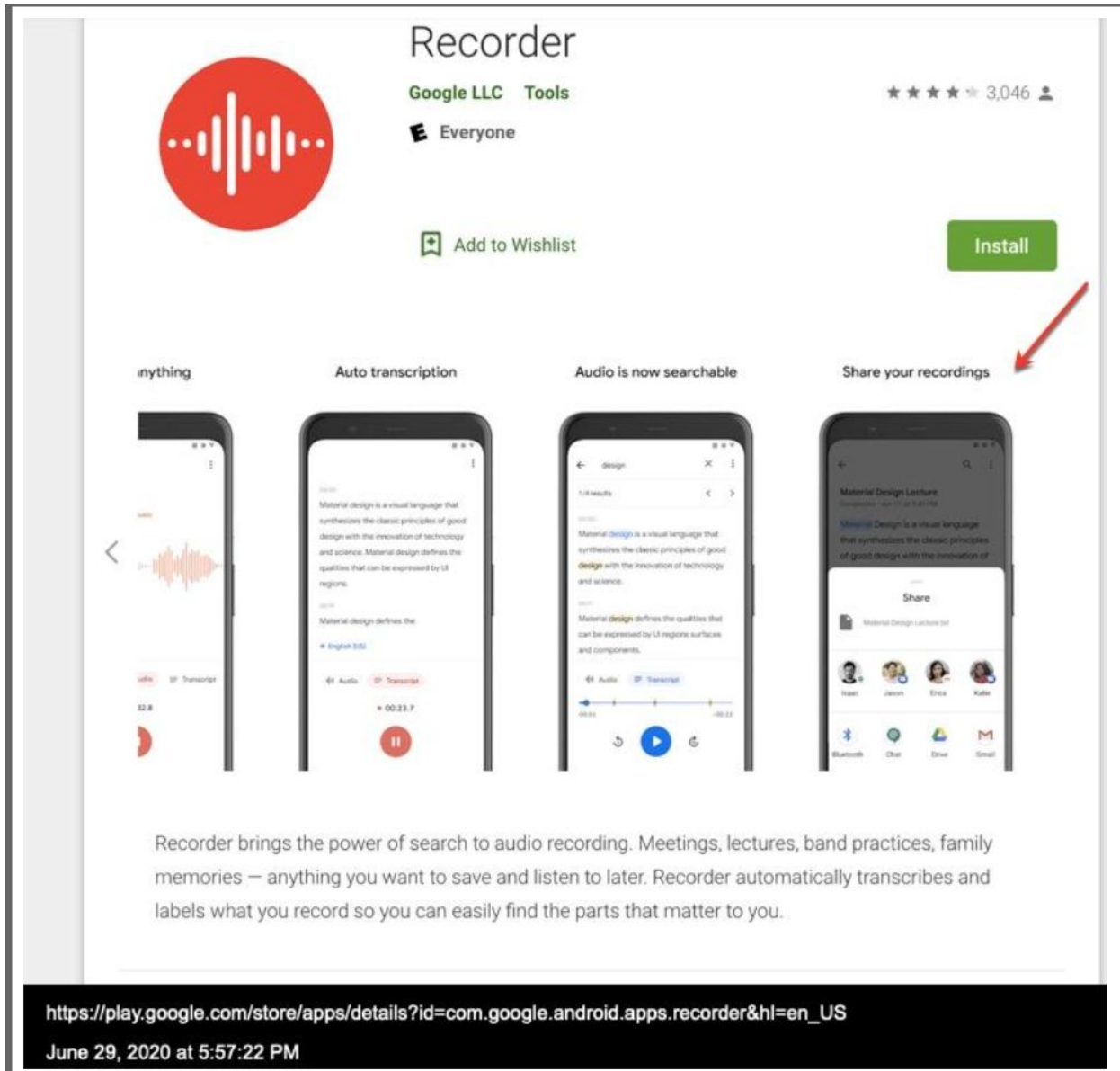
allows users to share recordings with others. Images of the Specimens are reproduced below for ease of reference:

**Recorder**  
Google LLC Tools  
★★★★★ 3,046  
Everyone  
Add to Wishlist  
Install

**Record anything**  
**Auto transcription**  
**Audio is now searchable**  
**Share your**

Recorder brings the power of search to audio recording. Meetings, lectures, band practices, family memories – anything you want to save and listen to later. Recorder automatically transcribes and labels what you record so you can easily find the parts that matter to you.

[https://play.google.com/store/apps/details?id=com.google.android.apps.recorder&hl=en\\_US](https://play.google.com/store/apps/details?id=com.google.android.apps.recorder&hl=en_US)  
June 29, 2020 at 5:56:17 PM



In the Office Action dated August 10, 2020, the Examining Attorney determined that Applicant's Specimen did not show use of Applicant's Mark in connection with Applicant's Services because the "sharing services" highlighted in Applicant's Specimen "d[id] not amount to transmission of voice, audio, or data," as identified in Class 38. The Examining Attorney further noted that "such services are generally provided by parties that control the movement, or transmission, of information, e.g. data, audio, images, from providers of things such as software, cable or radio signals, and the end user of such."

As shown in more detail in the sections below, Applicant respectfully disagrees with the Examining Attorney's conclusion for a number of reasons. First, dictionary definitions of the terms

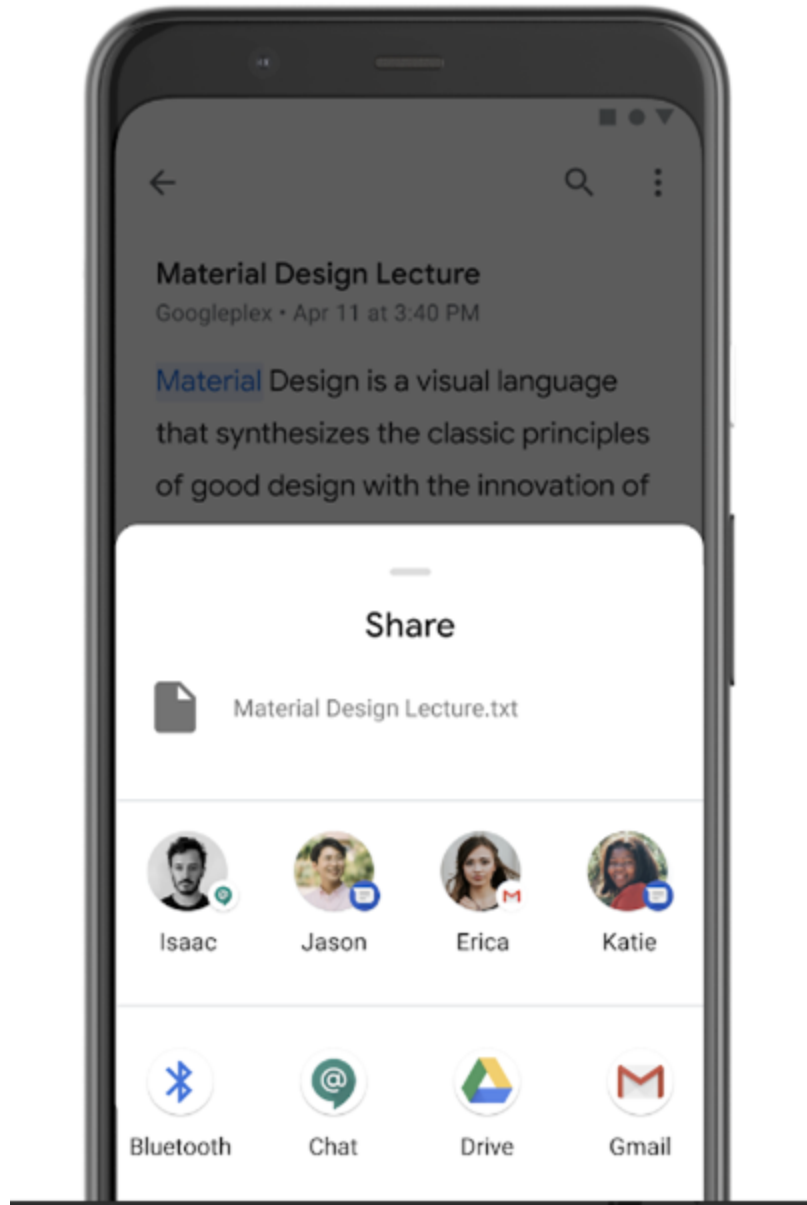
“transmission” and “share” demonstrate that these verbs are often synonymous and/or overlapping in meaning. Indeed, the PTO itself has made this determination by incorporating a definition of “sharing services” into the Trademark Acceptable Identification Manual, which identifies “transmission services” as a subset of “sharing services.” Finally, Applicant notes that historically the PTO has accepted specimens for Class 38 transmission services that are nearly identical to the type of Specimens that Applicant has submitted here, and which the Examining Attorney has rejected. In view of these facts, Applicant asserts that the refusal of Applicant’s Specimens in connection with Applicant’s Services should be withdrawn, the Statement of Use should be accepted, and Applicant’s Application allowed to proceed to registration.

**I. Dictionary Definitions Demonstrate that Sharing and Transmission Services Are Synonymous or Overlapping**

As the Examining Attorney has pointed out in the August 10, 2020 Office Action, Applicant’s Specimens show use of Applicant’s Mark in commerce in connection with certain “sharing services.” However, the Examining Attorney erred in finding that such services were not equivalent to the “*transmission of voice, audio, and data*” services identified in Class 38 of Applicant’s Application. Merriam Webster defines the verb “to transmit” as “to send or convey from one person or place to another.” See **Exhibit A** (<https://www.merriam-webster.com/dictionary/transmit>). Similarly, one of the definitions provided by Merriam Webster for the verb “to share” is “to distribute on the Internet.” See **Exhibit B** (<https://www.merriam-webster.com/dictionary/share>). Logically, therefore, it follows that “to transmit” or the “transmission” of something is a means by which “sharing” can be accomplished, such as by distributing on the Internet, and vice versa.

Indeed, the “sharing” function highlighted in Applicant’s Class 38 Specimens for the Recorder App from the Google Play store demonstrates that the app does exactly that: it allows the user to transmit or distribute audio recordings to others via telecommunications networks (i.e. via text or Chat or Bluetooth options) or the Internet (i.e. via Gmail or Google Drive options). This sharing function is explicitly referenced in Applicant’s Specimens, as shown above. An enlarged image of the “sharing services” section of Applicant’s Specimens confirms as much, and Applicant reproduces this image below and attaches it hereto as **Exhibit C**.

## Share your recordings



Thus, Applicant's Specimens do in fact demonstrate use of Applicant's Mark in commerce in connection with Applicant's *Communication services, namely, transmission of voice, audio, and data by telecommunications networks, wireless communication networks, the Internet, information*

services networks and data networks in Class 38, and as such, the refusal of registration should be withdrawn.

**II. The PTO Has Concluded that Transmission Services Are A Type of Sharing Service**

Applicant’s assertion that the “sharing services” referenced in Applicant’s Specimens and the “transmission services” identified in Applicant’s Services are synonymous or overlapping is reinforced by the PTO’s Trademark Acceptable Identification Manual, which includes an acceptable Class 38 identification for “sharing services” which describes “transmission services” as a subset thereof. Specifically, Record 038-427 lists the following acceptable identification for Class 38:

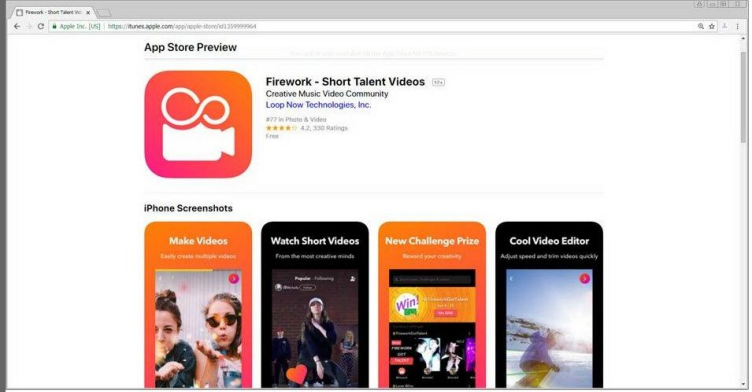
Select Record	038-427	038	Peer-to-peer photo <b>sharing services</b> , namely, electronic transmission of digital photo files among internet users	A	01/07/2010	SERVICES	09-2007
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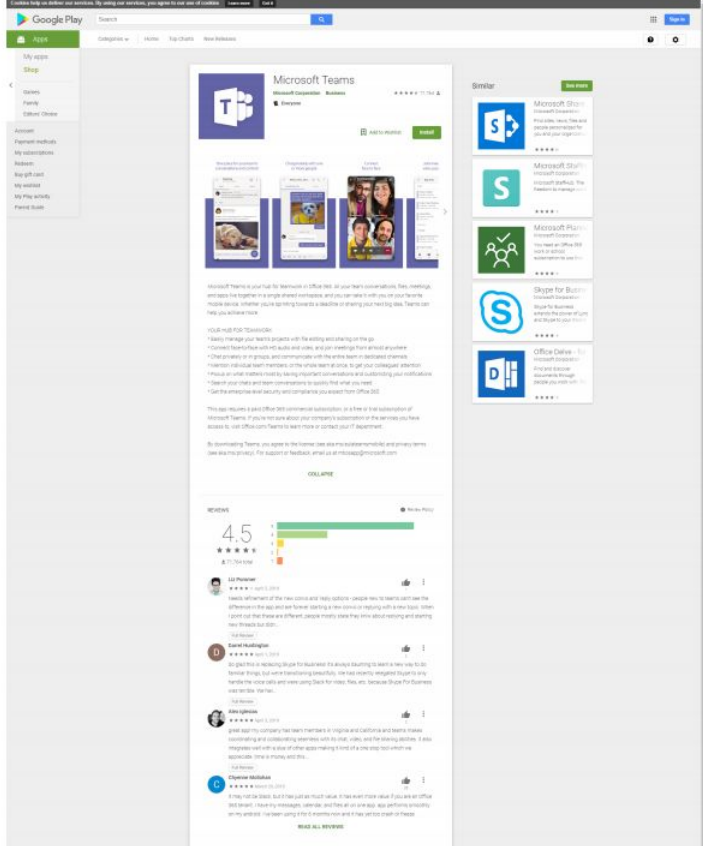
As the PTO has already determined that electronic transmission of data via the internet is a type of sharing service, the Examining Attorney should not draw a false distinction between the sharing services identified in Applicant’s Specimens and the transmission services identified in Applicant’s Class 38 Services, and the refusal of registration for failure to submit an adequate Class 38 specimen should be withdrawn.

**III. The PTO Has Historically Accepted Specimens of Use Like Applicant’s For Class 38**

Finally, Applicant notes that historically the PTO has accepted specimens of use that are nearly identical to Applicant’s Specimens – in that they consist of a Google Play or App Store page and show the mark in question in connection with an app - for similar or identical Class 38 services, including the examples set forth below:

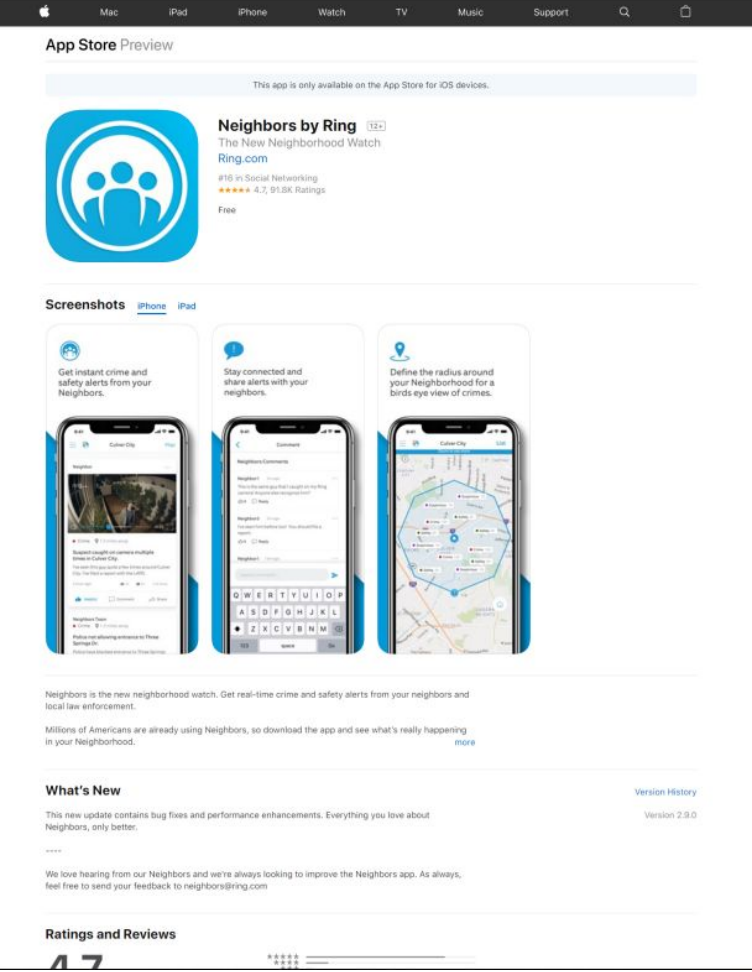

Reg./ App.	Mark	Class 38 Services	Specimen
5702369	FIREWORK	<b>Class 38: Telecommunication services, namely, transmission of voice, data, images, audio and video by means of tele-communications networks, wireless</b>	<a href="https://tsdr.uspto.gov/documentviewer?caselid=sn88062648&amp;docId=SPE20180806080816#docIndex=8&amp;page=1">https://tsdr.uspto.gov/documentviewer?caselid=sn88062648&amp;docId=SPE20180806080816#docIndex=8&amp;page=1</a>

		<p>communication networks, and the Internet; Providing an online community forum for users to share information, audio and video content, to form virtual communities, and to engage in social networking</p>	
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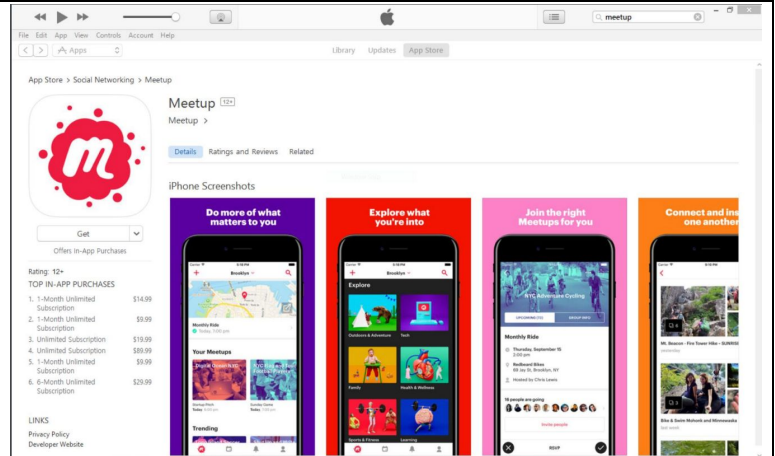
<p>5764500</p>		<p><b>Class 38:</b> Communication services, namely, electronic transmission of data and documents among users of computers; telecommunication services, namely, transmission of voice, data, graphics, images, audio and video by means of telecommunications networks, wireless communication networks, and the Internet; streaming of audio and video material over the Internet; information transmission via electronic communications networks; electronic transmission of mail and messages; electronic data transmission; electronic delivery of images and</p>	<p><a href="https://tsdr.uspto.gov/documentviewer?caselid=sn87659685&amp;docId=SOU20190410173559#docIndex=5&amp;page=1">https://tsdr.uspto.gov/documentviewer?caselid=sn87659685&amp;docId=SOU20190410173559#docIndex=5&amp;page=1</a></p> 
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		<p>photographs via a global computer network; instant messaging services; voice over internet protocol (VOIP) services; audio and video broadcasting services over the Internet; providing on-line chat rooms for social networking; consulting in the field of transmission of voice, data and documents via telecommunications networks; providing access to databases; providing user access to global computer networks; telecommunications gateway services; telecommunications services, namely, personal communications services via wireless networks</p>	
6043197	NEIGHBORS BY RING	<p><b>Class 38:</b>  <b>Telecommunication services, namely, data transmission and reception services via telecommunications networks;</b>          electronic exchange of voice, data, audio, video, text and graphics accessible via computer and telecommunications networks; instant</p>	<p><a href="https://tsdr.uspto.gov/documentviewer?caseId=sn87982888&amp;docId=SOU20200319161757#docIndex=7&amp;page=1">https://tsdr.uspto.gov/documentviewer?caseId=sn87982888&amp;docId=SOU20200319161757#docIndex=7&amp;page=1</a></p>

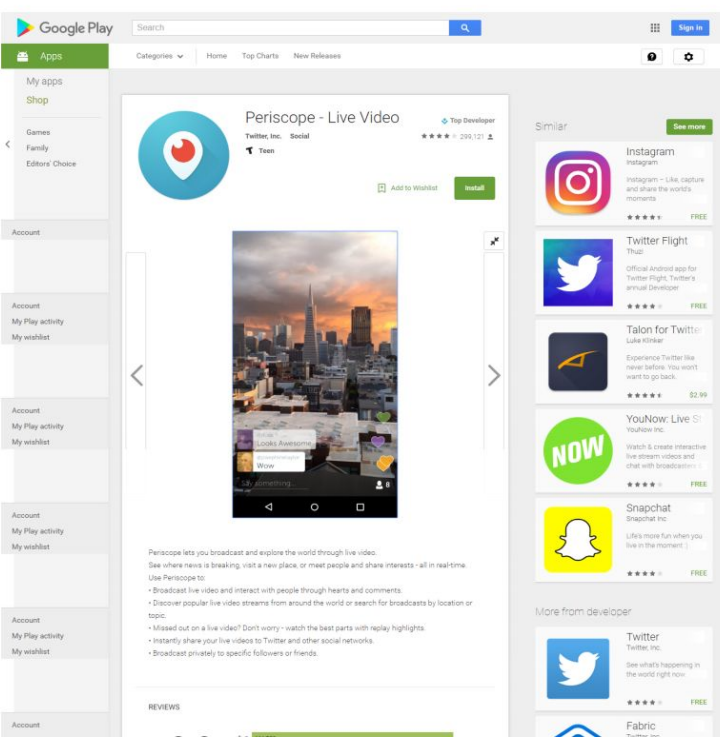


		<p>messaging services; web messaging; peer-to-peer photo sharing and video sharing services, namely, electronic transmission of digital photo files, videos, and audio visual content among users; providing access to global computer networks, electronic networks, and online computer databases; telecommunications services, namely, electronic transmission of data, messages, graphics, images, audio, video, and information; providing electronic bulletin board services; providing online forums for transmission of messages among computer users on topics of local interest and home security</p>	
5330681		<p><b>Class 38:</b> Peer-to-peer content-sharing services, namely, electronic transmission of digital photo files, videos, text messages, text files, and audio visual content among internet users; providing</p>	<p><a href="https://tsdr.uspto.gov/documentviewer?caselid=sn87078578&amp;docid=SOU20170819150936#docIndex=5&amp;page=1">https://tsdr.uspto.gov/documentviewer?caselid=sn87078578&amp;docid=SOU20170819150936#docIndex=5&amp;page=1</a></p>

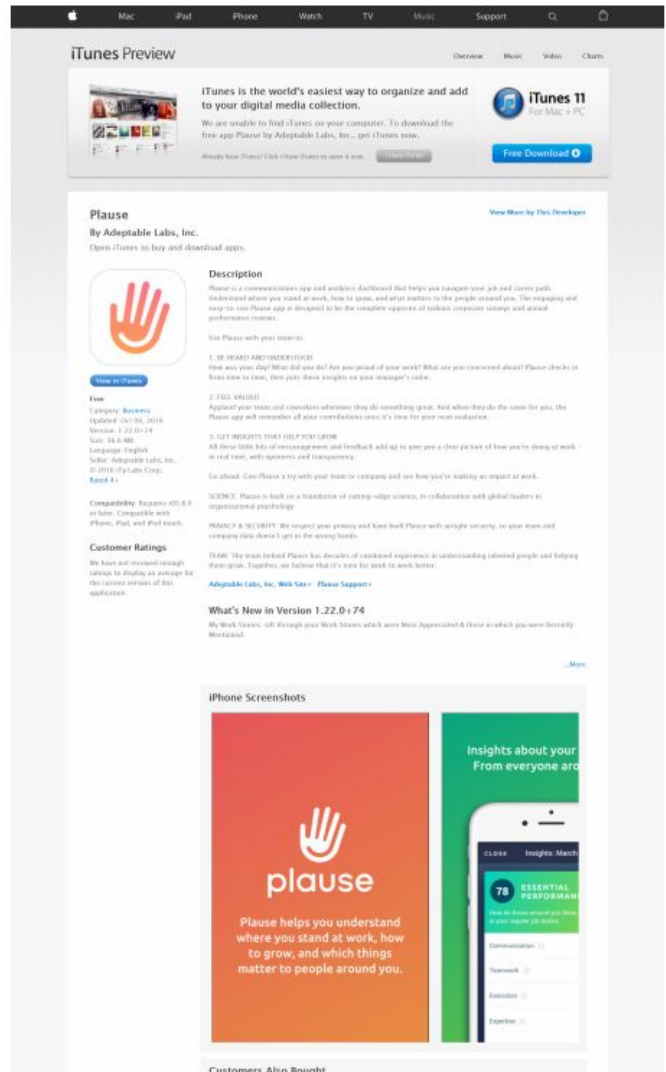
access to computer, electronic and online databases; telecommunications services, namely, electronic transmission of data, messages, graphics, images, audio, video and information; audio, text and video broadcasting services over the Internet or other communications networks featuring the uploaded, posted, displayed, modified, tagged, and electronically transmitted data, information, audio and video content of others; providing access to computer databases in the fields of social networking, entertainment and education; communication services, namely, providing access to an interactive computer database for electronic transmission of data and documents to facilitate users with common interests to communicate, meet and gather; providing a website and mobile applications for transmission of



		<p>mes-sages among com-puter and mobile de-vice users with varied common interests to assist these users and groups in coordinat-ing meetings and ac-tivities via electronic and optical commu-nications networks; providing online chat rooms for transmis-sion of messages among computer and mobile device users with varied common interests to assist these users and groups in coordinat-ing meetings and ac-tivities via electronic and optical commu-nications networks; providing online fo-rums for transmission of messages among computer and mobile device users concern-ing a wide variety of subjects</p>	
5166474		<p>Class 38:  <b>telecommunicatio n services, namely, transmission and streaming of voice, data, images, audio, video, real-time news,</b>  entertainment content, and information by means of</p>	<p><a href="https://tsdr.uspto.gov/documentviewer?caselid=sn87166953&amp;docId=RFA20160913090434#docIndex=12&amp;page=1">https://tsdr.uspto.gov/documentviewer?caselid=sn87166953&amp;docId=RFA20160913090434#docIndex=12&amp;page=1</a></p>

		<p>telecommunications networks, wireless communication networks, and the internet; providing an online community forum for users to share and stream information, audio, video, real-time news, entertainment content, or information, to form virtual communities, and to engage in social networking</p>	
5160562	PLAUSE	<p><u>Class 38:</u>  <b>Telecommunications services, namely, data transmission and reception services via telecommunication networks; electronic exchange of voice, data, audio, video, text and graphics via computer and telecommunications networks;</b>  instant messaging services; computer services, namely, providing online facilities for real-time interaction with other computer users concerning topics of general</p>	<p><a href="https://tsdr.uspto.gov/documentviewer?caselid=sn87126277&amp;docid=AAU20161025173829#docIndex=12&amp;page=1">https://tsdr.uspto.gov/documentviewer?caselid=sn87126277&amp;docid=AAU20161025173829#docIndex=12&amp;page=1</a></p>

inter-est; telecommunica-tion s services, name-ly, transmission of electronic data and information, includ-ing on-line commu-nication, internal messaging and mes-sage receiving, using an on-line and intra-net workplace social platform



See **Exhibit D** for copies of the TSDR status records for the registrations referenced above.

As demonstrated by the examples above, the PTO has routinely accepted specimens of use comprised of Google Play, iTunes, or App Store pages showing the applied-for marks in connection with apps and descriptions thereof, for Class 38 services, including overlapping services as *Telecommunication services, namely, transmission of voice, data, images, audio and video by means of tele-communications networks.* In addition, Registration Nos. 6043197 and 5330681 specifically identify *peer-to-peer photo sharing and video sharing services, namely, electronic*

*transmission of digital photo files, videos, and audio visual content among users and peer-to-peer sharing services, namely, electronic transmission of digital photo files, videos, text messages, text files, and audio visual content among internet users, respectively, further demonstrating that the PTO considers transmission via the Internet to be a subset of sharing services. Similarly, the PTO should accept Applicant's Specimens to demonstrate use in commerce of Applicant's Mark in connection with Applicant's Class 38 Services.*

### **CONCLUSION**

In view of the foregoing, Applicant respectfully requests that the Examining Attorney withdraw the refusal of registration for failure to submit an adequate Class 38 specimen of use and allow Applicant's Application No. 88657194 to proceed toward registration on the Principal Register.