Argument: Response to Office Action for ONEDERLAND (Serial No. 88214685)

This Argument is submitted in response to the Office Action issued by the Examining Attorney on January 31, 2019 (the "Office Action"), in connection with the application to register ONEDERLAND (Serial No. 88214685) for: "floor mats; bath mats; door mats; pet feeding mats; carpets; indoor and outdoor rugs; non-textile wall hangings; wallpaper; decorative borders, namely, borders being wall decorations in the nature of wall coverings." ("Applicant's Trademark").

The Examining Attorney has based her initial refusal to register Applicant's Trademark on the grounds that there is a likelihood of confusion with the mark, ONEDER-FLOOR (Registration No. 4312614; "Registrant's Mark"). The Examining Attorney claims that, because both marks begin with the wording, "ONEDER," the marks are likely to confuse consumers as to the source of the goods of the Applicant and the Registrant.

Applicant respectfully submits that the Examining Attorney's conclusion that the two marks are likely to lead to confusion among consumers is incorrect. It is Applicant's position, supported by applicable law, that the marks are substantially differentiated in overall impression and, accordingly, are not likely to lead to consumer confusion.

Pursuant to Applicable Criteria, The Marks Do Not Give A Similar Overall Commercial Impression

As observed by McCarthy, "in making a comparison of the degree of identity between the conflicting marks of the parties . . . [t]he modern Restatement . . .recommends that the degree of resemblance . . . be analyzed by a comparison of: the overall impression created by the designations; pronunciation; translation of foreign words; and verbal translation of pictures; suggestions, connotations or meanings of the designations." 4 McCarthy on Trademarks § 23:21 (citations omitted).

In this case, the Examining Attorney contends that, because Applicant's Trademark and the Registrant's Mark both contain the wording, "ONEDER," the two marks create a likelihood of confusion. However, a comparison of the overall impression created by the marks belies this contention. First, Applicant's Trademark is a fanciful mark that gives no indication of the nature or type of goods covered by Applicant's Trademark. In contrast, the Registrant's Mark, ONEDER-FLOOR, is primarily descriptive of the goods it covers: floor coverings. Additionally, Applicant's Mark is a noun while the ONEDER portion of Registrant's Mark is an adjective describing the second component of the mark, FLOOR.

Moreover, for purposes of comparing marks for similarity or dissimilarity, "the analysis is based on the marks as depicted in the respective application and registration . . ." TMEP 1207.01(b). In this case, the application is for the single word, ONEDERLAND, a wholly fanciful word that has no inherent meaning. The Registrant's Mark is the hyphenated two words, "ONEDER-FLOOR." A comparison of the two makes it clear that the differences in overall commercial impression outweigh the similarity of the two marks. Accordingly, consumers see the two marks in their respective totalities—and they are strikingly different.

Applicant's Mark Is Wholly Distinguishable From "WINTER WONDERLAND"

The Examining Attorney has also indicated that if a pending mark, WINTER WONDERLAND (serial number 87757321), ripens into a registration, it will be a basis for refusing registration of Applicant's Mark because of a likelihood of confusion.

Applicant respectfully disagrees with the Examining Attorney. Applicant's Mark is wholly distinguishable from WINTER WONDERLAND. First, WINTER WONDERLAND is a design mark that creates an entirely different commercial impression than the word mark, ONEDERLAND. Second, unlike Applicant's Mark, WINTER WONDERLAND is evocative of a particular visual scene with which the public is familiar: a snowfall or a scenic image of fallen snow. Finally, there is no relationship between the goods covered by Applicant's Mark and the goods covered by WINTER WONDERLAND. The goods covered by WINTER WONDERLAND are **"**water globes; Christmas tree ornaments; ornament hooks for Christmas trees; artificial Christmas trees; Christmas stockings" in class 28; "artificial garlands; artificial Christmas wreaths' in class 26; "ceramic figurines" in class 20; "paper gift card holders for non-magnetically encoded gift cards; decals in the nature of static cling decals in a variety of shapes for attachment to windows, appliances, monitors and glass surfaces" in class 16; "electric holiday lights; electric night lights; candle lamps; battery operated electric candles" in class 11; and "led projectors, namely, holiday theme image projectors" in class 9. Applicant's Mark covers goods that are not identical or competitive with Registrant's goods. Where goods are different and not competitive, the likelihood of confusion "is more remote than when the articles are of like kind." *American Steel Foundries v. Robertson*, 269 U.S. 372, 382 (1926). And see 4 McCarthy on Trademarks § 24:22. Since the goods are not competitive, they must be shown to be sufficiently "related" to give rise to a likelihood of confusion. *Id.* Here, Registrant's goods are unrelated to the goods covered by Applicant's Mark.

Conclusion

In this case, and as demonstrated above, Applicant's Trademark, ONEDERLAND and Registrant's Mark, ONEDER-FLOOR, are different marks that give entirely distinct overall commercial impressions. As such, no consumer is likely to confuse the source of Applicant's Trademark with the source of Registrant's Mark. Moreover, even if WINTER WONDERLAND were to ripen into a registration, there is no likelihood of confusion between that mark and Applicant's Mark.

Accordingly, Applicant respectfully requests that the Examining Attorney withdraw her refusal to register and allow the Applicant's Trademark to proceed to registration.