

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of :
and wander inc. :
U.S. Trademark Application No. : 79/274, 474 :
Mark: and wander (with design) : Examining Attorney: Sarah E. Kunkleman

RESPONSE

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

Dear Commissioner:

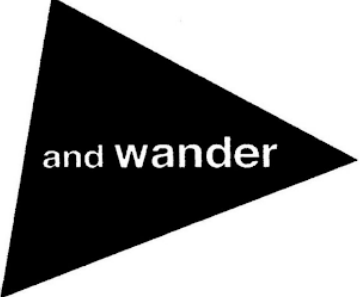

In response to the Non-Final Office Action mailed on February 27, 2020, with a reply being due August 27, 2020, please consider the following:

RESPONSE TO PARTIAL SECTION 2(d) REFUSALS

Applied-for mark was partially rejected under section 2(d) because of the alleged likelihood of confusion with the marks in U.S. Registration Nos. 5261807 (SEA + WANDER) and 4497571 (VEER & WANDER), owned by different registrants.

The refused services are limited as follows: “Retail store services and wholesale store services featuring clothing; retail store services and wholesale store services featuring footwear; retail store services and wholesale store services featuring handkerchiefs; retail store services and wholesale store services featuring sports goods; retail store services and wholesale store services featuring hairbands; retail store services and wholesale store services featuring unfitted vanity cases; retail store services and wholesale store services featuring medical supplies; retail store services and wholesale store services featuring cosmetics, toiletries, dentifrices, soaps and detergents.”

1. Likelihood of confusion with prior registration No. 5261807 (SEA + WANDER)

| Applied-for Mark | Prior registration No. 5261807 |
|---|--|
|  |  |

The Examining Attorney asserted that the mark in the cited registration No. 5261807 for “SEA + WANDER” (shown above) is confusingly similar to the applied-for mark. Regarding the similarity of the mark, the Examiner asserted that the only wording “and wander” in the applied-for mark has the same connotation and sound as the “+ WANDER” portion of the registered mark.”

Although the word portion is often considered the dominant feature and is accorded greater weight in determining whether marks are confusingly similar, marks

must be compared in their entireties. J. Thomas McCarthy, McCarthy on Unfair Competition and Trademarks at §23:41 citing the Anti-dissection rule. The anti-dissection rule finds its basis in the Supreme Court ruling on point which noted that "[t]he commercial impression of a trademark is derived from it as whole, not from its elements separated and considered in detail." Id. citing Estate of P.D. Beckwith, Inc., v. Commr' of Patents, 252 U.S. 538, 54-49 (1920). In this case the analysis must be conducted viewing the applied-for mark in its entirety as well as in view of the proper breadth and scope of protection afforded weak and diluted marks.

Under TMEP 1207.01(b)(iii), additions or deletions to marks may be sufficient to avoid a likelihood of confusion if: (1) the marks in their entireties convey significantly different commercial impressions; or (2) the matter common to the marks is not likely to be perceived by purchasers as distinguishing source because it is merely descriptive or diluted.

Further, TMEP 1207.01(b)(viii) says that when assessing the likelihood of confusion between compound word marks, one must determine whether there is a portion of the word mark that is dominant in terms of creating a commercial impression. Although there is no mechanical test to select a "dominant" element of a compound word mark, consumers would be more likely to perceive a fanciful or arbitrary term rather than a descriptive or generic term as the source-indicating feature of the mark.

In this respect, the applied-for mark is not confusingly similar over the cited registration No. 5261807 at least for the following reasons:

First, the appearance and impression of these marks are not similar. The most visually dominant feature in the applied-for mark is a tilted triangle filled with solid paint. The relatively small word portion is shown inside the tilted triangle. In contrast, the mark in the cited registration consists of a circle filled with solid paint containing drawings in thin white lines, and the word portion is shown outside the circler design. Therefore, the dominant shape of the mark and the layout of the word portion of these marks are dissimilar.

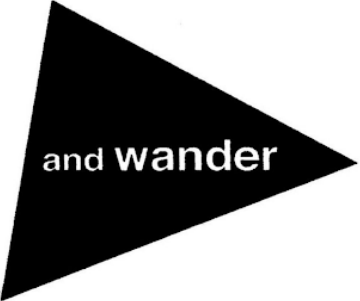
Second, the sound and the appearance of the words in these marks are not similar. The word portion in the applied-for mark consisting of two words “and wander” in all lowercase is shown in white in contrast with the solid paint in the triangle. In contrast, the word portion in the cited registration consists of two words “SEA” and “WANDER” in capital letters connected with a sign “+”. Because the sign “+” in the cited registration is often read as “plus” as well as “and”, the sound of “+” is not always the same as that of the applied-for mark. Also, “and” in the applied-for mark and “+” in the cited registration looks different because “and” is a three-letter word while “+” is a single sign, and a sign is usually shown smaller than the alphabetical letter.

Third, the connotation of these marks are not similar. The word portion “SEA + WANDER” in the cited registration has a suggestive meaning such as drifting in the ocean or exploring in the sea, because of the presence of “+” between “SEA” and “WANDER” functions to connect two words and constitutes a single meaningful term. In contrast, “and wander” in the applied-for mark does not form any meaningful term, because no word is meaningfully connected with “wander” by the preceding “and”.

When taken as whole, the sight, sound, and connotation of the two marks are dissimilar and the dissimilarities outweigh the limited similarity. In view of the dissimilarities between the applied-for mark and the cited registration, Applicant submits that there is no likelihood of confusion as to the applied-for mark.

As such, these features in the applied-for mark are creating distinguishing overall impression from that of the cited registration. Therefore, Applicant respectfully requests the Examining Attorney reconsider and withdraw the refusal in light of the arguments presented, and withdraw this refusal over the cited registration No. 5261807.

2. Likelihood of confusion with Registration No. 4497571 (VEER & WANDER)

| Applied-for Mark | Prior registration No. 4497571 |
|---|--------------------------------|
|  | VEER & WANDER |

The Examining Attorney asserted that the mark in the cited registration No. 4497571 (shown above) is confusingly similar to the applied-for mark. Regarding the similarity of the mark, the Examining Attorney asserted that the only wording “& WANDER” in the applied-for mark has the same connotation and sound as the “and wander” portion of the registered mark.”

The cited registration identifies “Retail store services featuring skincare, hair care, fragrances, cosmetics, bath and body products” under class 35, and “Beauty salon services” under class 44.

The Examining Attorney asserted that the following services in this application are confusingly similar to the cited registration: “retail store services and wholesale store services featuring hairbands; retail store services and wholesale store services featuring unfitted vanity cases; retail store services and wholesale store services featuring medical supplies; retail store services and wholesale store services featuring cosmetics, toiletries, dentifrices, soaps and detergents.”

In response, the above-identified services are deleted. Because the similarity in the services is no longer present in the applied-for application, Applicant submits that there is no likelihood of confusion as to the applied-for mark.

Applicant respectfully requests the Examining Attorney reconsider and withdraw the refusal in light of the arguments presented, and withdraw this refusal over the cited registration No. 4497571.

Conclusion

All refusals having been addressed, it is respectfully submitted that the present application should be in condition for allowance/publication and a Notice to that effect is earnestly solicited.

The Examining Attorney is invited to telephone the undersigned, Applicant's attorney of record, to facilitate advancement of the present application.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 07-1337 and please credit any excess fees to such deposit account.

Respectfully submitted,

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Date **June 24, 2020**