

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: OnePlus Technology (Shenzhen) Co., Ltd.

Serial No.88849019

Mark: Nord by OnePlus

Filing Date: March 26, 2020

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Trademark Attorney

Law Office 127

RESPONSE TO OFFICE ACTION

This is in response to the Office Action mailed on June 16, 2020.

Remarks

The application might be refused registration if pending Serial No. 88768969, 79274501, and 88208577 mature to registrations. The applicant decides to delete the goods in the application that might be related to the aforesaid three prior-filed applications. And after doing so, the applicant considers no likelihood of confusion exists between the application and prior-filed pending applications.

Identification of Goods

Please amend the Identification of Goods as following:

Class 09: ~~Encoded identification bracelets, magnetic~~; Tablet computers; Smartphones; Sleeves for laptops; Loudspeakers for mobile phones; Headphones for mobile phones; Electronic book readers; Smart television; Remote controls for televisions, excluding gaming apparatus; Electrical adapters; Battery chargers; Mobile telephone batteries; Internet-ready televisions; Smartwatches; all of the above goods do not include speakers related to home, except for wireless speakers; all of the above goods do not include speakers related to professional, marine or automotive use

Class 35: Advertising services; Online advertising on a computer network; Rental of advertising time on communication media; ~~Market research studies~~; ~~Providing commercial and business contact information~~; ~~Sales promotion for others~~; Provision of an online marketplace for buyers and sellers of goods and services; ~~Systemization of information into computer databases~~; ~~Updating and maintenance of data in computer databases~~; Rental of vending machines

~~Class 42: Technological research in the field of computer hardware systems; Research and development of new products for others; Industrial design; Packaging design; Computer software design; Computer virus protection services; Consulting services in the field of software as a service; Consulting services in the field of cloud computing; Electronic data storage; Off site data backup; Weather forecasting; Outsourced service providers in the field of information technology~~


Likelihood of confusion

● **Marks are not similar**

A. The applicant's marks clearly indicates the source of goods

The applicant would like to indicate that the wording "BY ONEPLUS" in the applicant's mark clearly indicates the source of the goods and services. That is, all the goods and services under the applicant's "NORD BY ONEPLUS" mark are provided by OnePlus.

The wording "ONEPLUS" itself, is a dominant part of the mark that should not be ignored. The wording "BY" used in the mark, makes the wording "ONEPLUS" stronger and enhance the customer's impression that the products and services under this mark are from ONEPLUS, not any other provider.

For "ONEPLUS" is applicant's company name, the applicant applies and uses a number of ONEPLUS-composite marks in the U.S. for the goods identical or highly related to the goods in the application, namely, **Oneplus**;  and **oneplus**. See printouts from the Office's TDSR database attached as Exhibit A.

Therefore, on seeing the applied-for mark, consumers are likely to assume that Nord by OnePlus is yet another mark in the ONEPLUS family, rather than mistakenly assume a connection with the cited NORD mark. The applicant has promoted quite a lot for its new launched ONE PLUS NORD brand since June 2020. Attach Exhibit B please find news articles about applicant's promotion about its ONEPLUS NORD brand. The promotions and advertisements make clear that the applied-for mark is Applicant's new member for its ONEPLUS smart phone family. That the applied-for mark is a prominent part of Applicant's well promoted new branding strategy also links the mark to Applicant and weighs against the likelihood that consumers will confuse the source of goods under the applied-for mark with the cited mark.

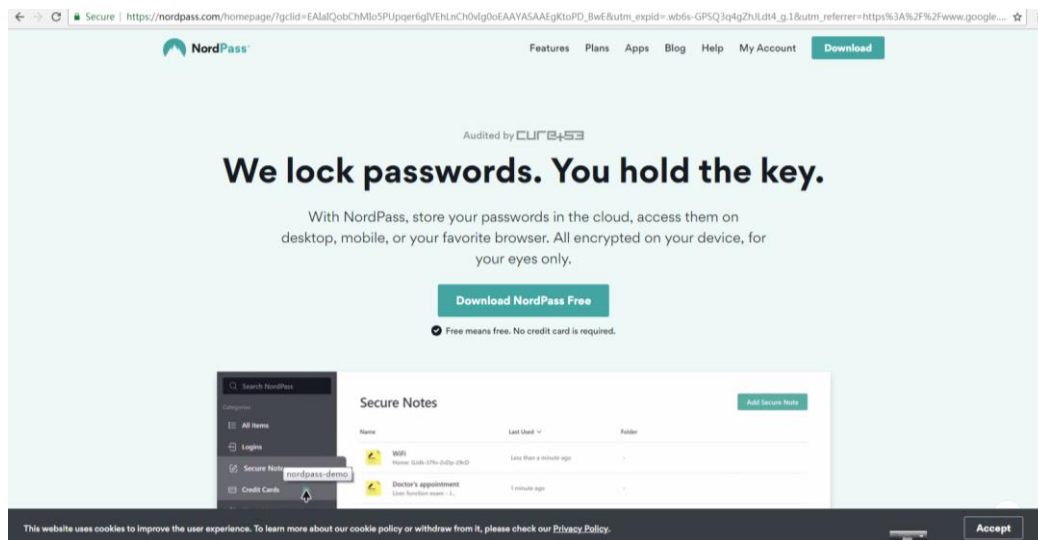
Therefore, it is quite unlikely that the application might cause any confusion in the market.

B. The marks should be considered in their entirety and the other part of the

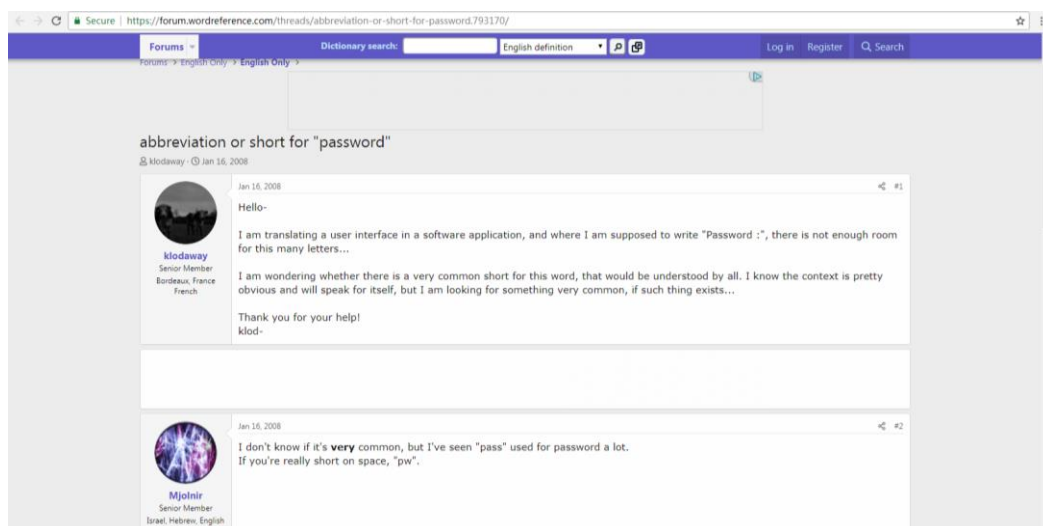
mark should not be ignored

Pending Serial No. 79274501 “NORDPASS”, when viewed as an entirety, has no actual meaning and should be considered as a coined wording. It is not appropriate to dissect the mark and consider “NORD” as an independent part of the mark.

In addition, when applies to the services related to “security and cryptography software” and other software and service related with protection of identification, implies that the password of the user are safe. Following is the screenshot from the owner’s website, proving that the wording “PASS”, probably implies “password” and thus contains a unique connotation.



Though not recognized in any formal dictionary, upon our research, we assume the wording “PASS” is kind of commonly used between relative professionals as short form for “PASSWORD” (Please refer to: <https://forum.wordreference.com/threads/abbreviation-or-short-for-password.793170/>)



Therefore, the “PASS” in Pending Serial No. 79274501 “NORDPASS” is important in delivering the commercial impression and create a special connotation and it is in appropriate to ignore the wording “PASS” when comparing the marks,

Similarly, pending Serial No.88208577 “NORD SENSE”, the wording SENSE should not be ignored because it is also de dominant part of the mark and deliver a unique commercial impression to the customer. When the wording “SENSE” applies to the “GPS; sensors; monitoring and detecting products”, delivers an impression of sensitive perception.

“The variable element in Applicant's mark here (a state name or Puerto Rico), while geographically descriptive, alters the characteristics of the purported mark SHAPE XXXX, resulting in the **commercial impression** of multiple marks. The differences in the variable elements are more than minor variations or inconsequential modifications of the basic mark. For example, SHAPE MICHIGAN signifies educational services emanating from Michigan while SHAPE OHIO signifies educational services emanating from OHIO. The distinction is important in this case where geographic terms are capable of acquiring distinctiveness, which would further distinguish the marks. Compare *O-M Bread Inc. v. U.S. Olympic Comm.*, 65 F.2d 933, 36 USPQ2d 1041, 1045 (Fed. Cir. 1995) (OLYMPIC KIDS creates a **different commercial impression** than OLYMPIC, notwithstanding the disclaimer of KIDS and its lack of strong trademark significance); *Institut Nat'l des Appellations d'Origine v. Brown-Forman Corp.*, 47 USPQ2d 1875, 1895 (TTAB 1998) (for purposes of claim preclusion analysis, applicant's MIST AND COGNAC mark involved in a prior opposition is a different mark from CANADIAN MIST AND COGNAC because one mark includes the word “Canadian”); *Edison Bros. Stores, Inc. v. Brutting E.B. Sport-Int'l GmbH*, 230 USPQ 530, 534 (TTAB 1986) (for purposes of a prior registration affirmative defense, the Board held that EB is **materially different** than EB SPORT INTERNATIONAL) with *Citigroup Inc. v. Capital City Bank Grp. Inc.*, 94 USPQ2d 1645, 1656 (TTAB 2010) (CAPITAL

CITY BANK GROUP and CAPITAL CITY BANK engender the **same commercial impression** because “group” adds nothing to the origin-indicating significance of CAPITAL CITY BANK), aff’d, 637 F.3d 1344, 98 USPQ2d 1253 (Fed. Cir. 2011).” In Re Soc’y of Health & Physical Educators, 127 U.S.P.Q.2d 1584 (T.T.A.B. 2018)(emphasis added)

As a general matter, “[t]he basic principle in determining confusion between marks is that marks must be compared in their entirety It follows from that principle that likelihood of confusion cannot be predicated on dissection of a mark, that is, on only part of a mark.” TMEP § 1207.01(b) (quoting In re Nat’l Data Corp., 224 U.S.P.Q. 749, 750-51 (Fed. Cir.1985)). Marketplace consumers will encounter the parties’ respective marks in their entirety, and the impressions that are created will be derived from the marks’ overall presentations. See e.g., Keebler Co. v. Murray Bakery Products, 9 U.S.P.Q.2d 1736 (Fed. Cir. 1989) (holding no likelihood of confusion between PECAN SANDIES and PECAN SHORTIES both for cookies). The Court of Appeals for the Federal Circuit has repeatedly admonished that (a) trademarks should be viewed in their entirety as they are perceived by consumers, and (b) trademarks should not be dissected into fragments, with entire elements disregarded. For example in In re Hearst Corp., 25 U.S.P.Q.2d 1238 (Fed. Cir. 1992), the Federal Circuit held that there was no likelihood of confusion between VARGA GIRL and VARGAS, both for calendars. In reversing the Trademark Trial and Appeal Board, the Federal Circuit stated:

The Board erred in its analytic approach. Although undoubtedly "varga" and "vargas" are similar, the marks must be considered in the way they are used and perceived. Marks tend to be perceived in their entirety, and all components thereof must be given appropriate weight.

Accord, Juice Generation, Inc. v. GS Enterprises LLC, 115 U.S.P.Q.2d 1671 (Fed. Cir. 2015) (Reversing a TTAB ruling that a likelihood of confusion existed between PEACE & LOVE and PEACE LOVE AND JUICE and Design).

Based on the above, the applicant submits that it is not appropriate to consider “NORD BY ONEPLUS” similar to “NORD SENSE” “NORD” and “NORDPASS”, just because they both contains the same wording “NORD”.

● **Goods are not related**

The applicant’s goods and services, after deleting all the conflicting goods and services are as the following:

Class 09: Tablet computers; Smartphones; Sleeves for laptops; Loudspeakers for mobile phones; Headphones for mobile phones; Electronic book readers; Smart television; Remote controls for televisions, excluding gaming apparatus; Electrical adapters; Battery chargers; Mobile telephone batteries; Internet-ready televisions; Smartwatches; all of the above goods do not include speakers related to home, except

for wireless speakers; all of the above goods do not include speakers related to professional, marine or automotive use

Class 35: Advertising services; Online advertising on a computer network; Rental of advertising time on communication media; Provision of an online marketplace for buyers and sellers of goods and services; Rental of vending machines

Class 42: Industrial design; Packaging design; Weather forecasting.

Pending application No. 88768969, applies for “Internet security and safe browsing software and services” ~~are in Green Highlight~~ and “other software and network related products and services” .

It can be clearly seemed that Pending application No. 88768969 mainly applies for goods and services related with Internet Security and Browsing Safety, which has a different function and purpose from the Applicant’s goods and services. And the rest of the goods and services, like “downloadable computer software which facilitates the routing of communications and data; Downloadable Data processing software” though is kind of broad in nature, can be assumed that they will also be used in a way that is related with Internet Security and Browsing Safety. Even if viewed simply from the identification, these products and services are quite professional and are mostly provided by professional companies that specialize in the related field.

Moreover, the goods provided by pending application No. 88768969 are mostly downloadable software that would be ordered online. And these kind of downloadable software usually appear in some App store or the provider’s official website.

The applicant’s goods in Class 09, after amendment, are mainly ready-to-sale product that facing ordinary customers, namely, daily use electronic devices and accessories. The applicant’s goods will more likely to be sold in a store or on-line shopping platform like Amazon, Walmart.

It is quite likely that the applicant’s goods and the Pending application No. 88768969’s goods will not appear at the same time or travel through the same channel of trade. The targeted customer, of course, is also different.

The applicant’s services in Class 35 and 42, after the amendment, clearly have no relationship with Internet and computer software.

Therefore, the goods and services under the application are no longer related with pending application No. 88768969.

Pending Serial No. 79274501 “NORDPASS”, applies for “Internet security and safe browsing software and services” and “other software and network related

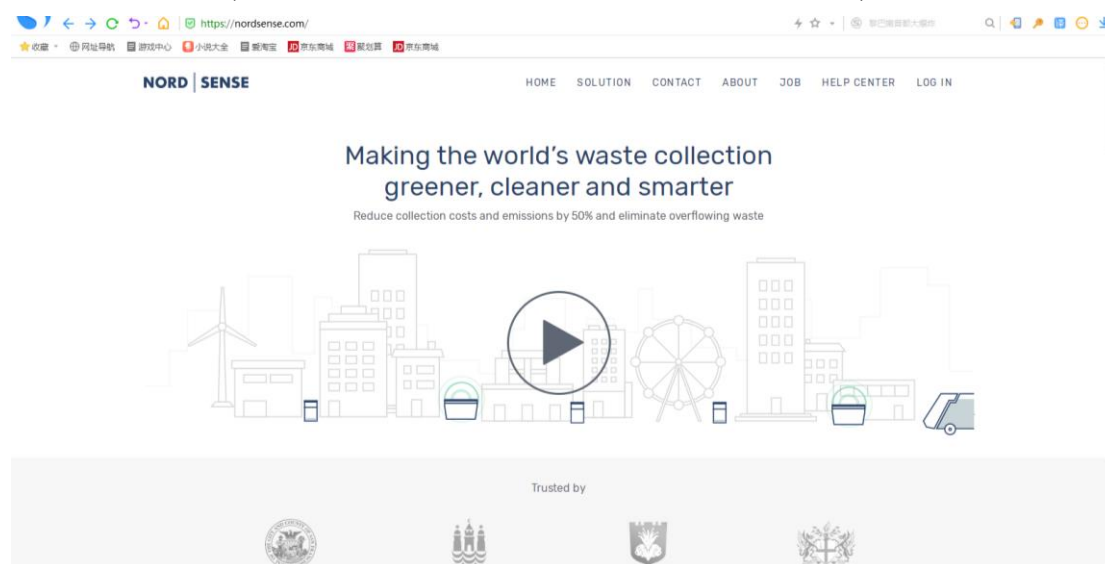
products and services”.

Like Pending application No. 88768969, Pending Serial No. 79274501 also mainly applies goods and services related with Internet security and browsing safety. Even their goods and services that have a broad nature are the goods and services that provided by professional companies. And the downloadable software it provides is quite unlikely to appear at the same time with applicant’s ready-to-sell electronic products or travel through the same channel of trade.

Pending Serial No.88208577 “NORD SENSE”, applies for “software, products, components and services related with GPS, vehicle routing, measure and detecting positions, distance and locations” , “other computer related technology and services” and “business assistance services” .

The applicant submits that there is clearly no relationship between applicant’s ready-to-sale consumer electronic devices in Class 09 and “GPS and location, position and distance detecting goods and services” under Pending Serial No.88208577, which probably facing certain professional customers that has special needs in the field of outdoor detection and related outdoor activities.

Upon visting website of the Pending Serial No.88208577 “NORD SENSE”, it is clear the owner of the pending mark would mainly use “NORD SENSE” in relation with waste collection.(Please refer to : <https://nordsense.com/company/>)



It is quite possible that the “GPS and location, position and distance detecting goods and services” under Pending Serial No.88208577,will be used in connection to “SMART CONTAINERS”, “FLEET MANAGEMENT”, and “INTELLIGENT ROUTING” under the purpose of collect the waste in a more efficient and green way.

Even if taking reasonable business expend in consideration, we think it is quite unlikely that there would be any overlap between applicant's business of selling electronic devices and the accessories and the "NORD SENSE" business of waste collection.

So as the services in Class 42, after amendments, the remaining services under application are "Industrial design; Packaging design; Weather forecasting." And none of them have any relation with the IT and computer services in Class 42 under pending application No.88208577.

The channel of trade, potential customer and other nature of the goods and services are all very different.

As to services in Class 35, the applicant's business in class 35 is mainly "advertising services", "Provision of an online marketplace for buyers and sellers of goods and services" and "Rental of vending machines", the services under Pending Serial No.88208577 in class 35 is highly professional and skillful business assistance services.

The nature of applicant's advertising services are promotion of products for others. The nature of Pending Serial No.88208577's "business assistance services" is provide professional help to companies and business individuals to do the work that they cannot do for technical reason. This nature of the services is different and these kind of services are usually provided through the provider's official website, or their independent offices. It is quite unlikely that these services will appear at the same time in front of a customer.

For "rental services" and "the on-line Provision of an online marketplace for buyers and sellers of goods and services" of the applicant, they are too different from the services under Pending Serial No.88208577. No likelihood of confusion is likely.

The TMEP states that ". . . if the goods or services 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." § 1207.01(a)(i). The fundamental inquiry in the likelihood of confusion analysis goes to "the cumulative effect or differences in the essential characteristics of the goods and the differences in the marks." *Federated Foods, Inc. v. Fort Howard Paper Co.*, 192 U.S.P.Q. 24, 29 (C.C.P.A. 1976). Therefore, the proper analysis must look to the particular facts and circumstances presented. In *Interstate Brands Corp. v. Celestial Seasonings, Inc.*, 198 U.S.P.Q. 151 (C.C.P.A. 1978), the Court held that RED ZINGER for herbal tea was not confusingly similar to ZINGERS for snack cakes, because an analysis of the actual relationship of the goods based on their individual characteristics is always required.

Based on the above, the goods and services under the application are not related to goods and services under three pending applications.

Conclusion

All issues having now been addressed, applicant submits that no conflicting marks remains to be an obstacle to the application.