



, Ser. No. 88125195

## Response to Office Action dated December 18, 2018


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The Examining Attorney has refused registration of the above-captioned mark under Trademark Act Sections 1 and 45, asserting that the mark on the specimen does not match the mark in the drawing. Applicant respectfully disagrees.

According to TMEP §§807.12(d), “The mere fact that two or more elements form a composite mark does not necessarily mean that those elements are inseparable for registration purposes. An applicant may apply to register any element of a composite mark if that element presents, or will present, a separate and distinct commercial impression apart from any other matter with which the mark is or will be used on the specimen.”


The Trademark Trial and Appeal Board (“TTAB”) has established that an applicant is entitled to register a single element of a composite mark if that element presents a separate and distinct commercial impression, i.e. a design element may be registered separately from a word element if it creates a commercial impression separate from the accompanying words. *In re Frankish Enters. Ltd.*, 113 USPQ2d 1964, 1974 (TTAB 2015). The TTAB has also held that the specimen can show the entire composite mark even if the drawing only shows the separable element that is sought to be registered. *Id.* See also *In re Big Pig Inc.*, 81 USPQ2d 1436 (TTAB 2006) (holding the word PSYCHO registrable apart from the accompanying words and designs in the specimen); *In re University of Miami*, 123 USPQ2d 1075 (TTAB 2017) (holding the design element registrable apart from the accompanying words and letters in the specimen); *In re*





*Sterno, Inc.*, 137 USPQ 328 (TTAB 1963) (holding the design element, , creates a commercial impression separate and apart from the word element as shown in the specimen,



); *In re National Institute for Automotive Service Excellence*, 218 USPQ 745 (TTAB

1983) (holding the design element, , creates “a visual impact separate and apart from

the words superimposed thereon”, ).

In the present application, Applicant has sought to register a composite mark consisting of the separable word mark TWISTY PETZ and the separable design element . Contrary to the Examining Attorney’s assertion, the word mark is separable from the design element. The word mark is displayed in a different color and size than the design element and is written in a distinct font, such that it stands out from the design element. *In re Big Pig Inc.*, 81 USPQ2d 1436 (TTAB 2006). The word mark is not integrated into the design element in a way that makes it inseparable. As such, Applicant submits that the design element creates a separate and distinct commercial impression apart from the word mark and serves to indicate the source of Applicant’s goods apart from the word mark. In fact, Applicant has already separately registered the word mark, U.S. Reg. No. 5514561. As such, and in line with the relevant precedents outlined above, Applicant respectfully asserts that the specimen it submitted showing the entire composite mark is acceptable, even though the drawing only shows the separable element that Applicant is seeking to register. *In re Frankish Enters. Ltd.*, 113 USPQ2d 1964, 1974 (TTAB 2015).