IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

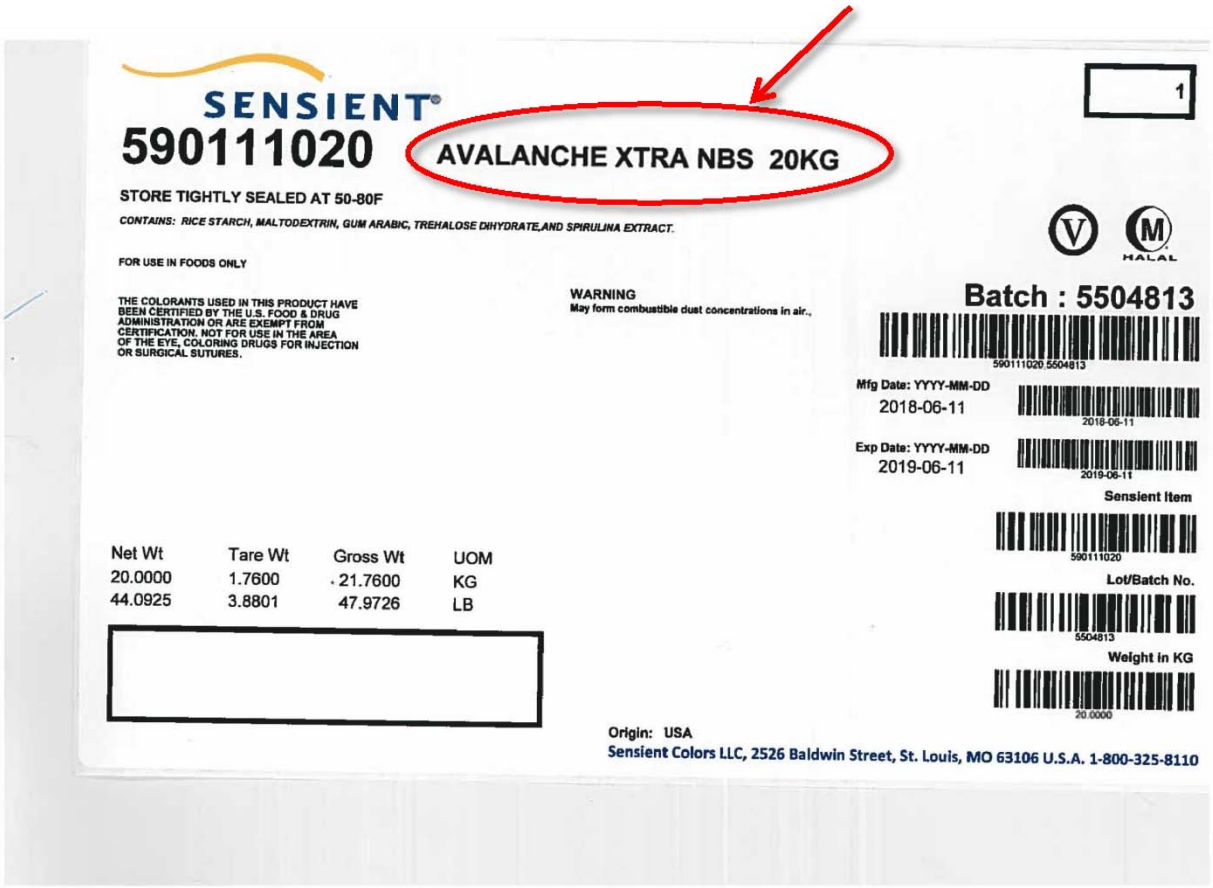
Serial No.:	88/344,355
Mark:	AVALANCHE
International Class:	002
Applicant:	Sensient Colors LLC
Filing Date:	March 18, 2019
Mailing Date of Office Action:	May 30, 2019
Examining Attorney:	Daniel F. Capshaw Law Office 110
Applicant's Attorney of Record:	Brianna M. Schonenberg

RESPONSE

The Applicant has filed an application for registration of the mark AVALANCHE (the "Applicant's Mark") with the U.S. Patent and Trademark Office for use on or in connection with *colorants for use in the manufacture of food and beverage products; food coloring* in International Class 2 ("Applicant's Goods").

The Examining Attorney refused registration of the Applicant's Mark because the Examining Attorney alleges "the specimen does not show the mark in the drawing in use in commerce in International Class[] 2" because the drawing displays the mark as AVALANCHE, while "the specimen displays the mark as AVALANCHE XTRA." Specifically, the Examining Attorney alleges that the drawing must include the term "XTRA." Applicant respectfully disagrees.

The specimen filed with the present application is reproduced below. As shown, the specimen is a product label for a specific color variety and package weight ("AVALANCHE XTRA NBS 20KG") of Applicant's AVALANCHE line of colorants. By the Examining Attorney's reasoning, Applicant's drawing would also require the term "NBS," and even "20KG" because these terms appear alongside AVALANCHE in the product label.



However, "[t]he mere fact that two or more elements form a composite mark does not necessarily mean that those elements are inseparable for registration purposes. TMEP § 807.12(d). It is well established that 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. TMEP § 807.12(d) (citing *In re Univ. of Miami*, 123 USPQ2d 1075, 1079 (TTAB 2017)); McCarthy on Trademarks and Unfair Competition, § 19:59 (5th Ed.); *In re Chemical Dynamics Inc.*, 839 F.2d 1569, 5 USPQ2d 1828 (Fed. Cir. 1988) (in considering whether a designation that appears with other matter is separately registrable, "'It all boils down to a judgment as to whether that designation for which registration is sought comprises a separate and distinct 'trademark' in and of itself."') (quoting McCarthy, Trademarks and Unfair Competition)). Once circumstance in which a portion of a composite mark

has been found to create a separate commercial impression is where the two components include a corporate name or house mark along with another trademark or a descriptive term. *In re Ai*, 2017 WL 6812283 (TTAB 2017) (regarding Serial No. 86/842,205, not precedential) (citing *In re Servel, Inc.*, 181 F.2d 192, 85 USPQ 257, 260 (CCPA 1950) (finding that the mark SERVEL functions as a mark apart from the descriptive term INKLINGS). Other circumstances in which a portion of a composite mark was found to create a separate commercial impression are where (i) the component is a non-descriptive element that is part of a phrase, or (ii) the other component is a part number. *In re Ai* (citing *In re Barry Wright Corp.*, 155 USPQ 671, 672 (TTAB 1967) (holding that the "notation '8-48' stands out as a distinguishable element separate and apart from the statement 'ANOTHER 8-48 FROM MATHATRONICS"') and *In re Raychem Corp.*, 12 USPQ2d 1399, 1400 (TTAB 1989) (finding TINEL-LOCK registrable, although displayed with TRO6AI-TINEL-LOCK-RING on the specimen since TRO6AI is a part number and RING is the name of the goods)).

In *In re WireCo WorldGroup Inc.*, 2018 WL 1603875(TTAB 2018) (regarding Serial No. 86/853,449, not precedential), the Board found that the mark in the applicant's drawing, TURBOLITE, creates a separate and distinct commercial impression as used in a shipping label specimen, despite the specimen shipping label's use of the mark in the phrases "TURBOLITE M" and "32MM TURBOLITE SEMI-HYBRID B ZZ (RL)." In particular, the Board noted that the applicant used the "TM" symbol with TURBOLITE in some of the examples, which "tends to suggest that the term creates a separate and distinct commercial impression." *Id.* (citing *In re Stones*, 590 F.3d 1282, 93 USPQ2d 1118, 1124 (Fed. Cir. 2009) ("Though not dispositive, the 'use of the designation 'TM'…lends a degree of visual prominence to the term.")). The Board also cited evidence (in the form of advertising materials) that the applicant offers a line of "TURBO-branded

products" with different suffixes, which "highlight[s] that TURBOLITE is one of several telescoped trademarks Applicant uses which feature the TURBO prefix." *Id.*

Here, the distinct commercial impression of Applicant's Mark (AVALANCHE), and the independent significance of the Applicant's Mark, is supported by Applicant's use of the term "AVALANCHE" without the term "XTRA" in its advertising materials. See ***Exhibit A***, showing Applicant's website. As in *In re WireCo WorldGroup Inc.*, Applicant's advertising materials use the term "AVALANCHE" in large letters followed by the "TM" symbol—thereby creating its own commercial impression. *See* ***Exhibit A***. Moreover, Applicant's advertising materials use the term "AVALANCHE" as a heading and set aside from the color variety names—further distinguishing the Applicant's Mark as having independent significance and its own commercial impression. Additionally, Applicant's advertising materials show that Applicant offers a line of AVALANCHE-branded products with different suffixes, in the same way that the applicant in *In re WireCo WorldGroup Inc.* offered a line of TURBO-branded products. *See* ***Exhibit A***. Specifically, Applicant's advertising materials show that Applicant sells a number of color varieties under the AVALANCHE-branded product line—including AVALANCHE FUSION, AVALANCHE XTRA, AVALANCHE XTRA CS, AVALANCHE ULTRA, and AVALANCHE MB.

In sum, Applicant's Mark comprises a separate and distinct trademark in and of itself. Applicant's Mark presents a separate and distinct commercial impression apart from any other matter with which the mark is or will be used on the specimen (such as the term "XTRA"). For at least these reasons, Applicant respectfully submits that the specimen shows the mark in the drawing in use in commerce in International Class 2.

Consequently, the Applicant respectfully requests that the Examining Attorney withdraw the refusal of record and approve Applicant's Mark for registration.