

IN THE UNITED STATES PATENT & TRADEMARK OFFICE

In re word mark: CHERRYCREAM

Serial No. 88-429,508

Applicant Plata Wine Partner, LLC's ("Applicant") hereby responds to the Office Action dated June 20, 2019 ("Office Action") with regard to proposed compound mark CHERRYCREAM ("Applicant's Mark") for "Alcoholic beverages except beers; wines" in Class 33. Registration has been refused under Trademark Act Section 2(e)(1) on the grounds that the applied-for mark is "merely descriptive."

Applicant respectfully submits that the refusal of CHERRYCREAM was premised upon a number of erroneous grounds. These include the improper dissection and examination of the separate words "CHERRY" and "CREAM" in violation of the anti-dissection rule. Regardless of whether each discrete word component of this compound mark on its own could be deemed descriptive of the goods, the joining of the words "CHERRY" and "CREAM," in a particular order and without a space between them, gives CHERRYCREAM the requisite distinctive character (based on such an unusual combination of words resulting in a new, fanciful term) for purposes of approval. Cream does not come from cherries, nor do cherries contain a cream-like substance.

Moreover, USPTO records show that CHERRY-formative compound marks in Classes 32 and 33 are consistently approved without a descriptiveness refusal. For the reasons set forth herein, Applicant respectfully requests that the refusal of CHERRYCREAM be withdrawn, and that Applicant's Mark be approved for registration on the Principal Register.

1. The Office Action Failed to Consider Numerous Registrations for CHERRY-Formative Compound Marks in Classes 33 and 32 for Alcoholic Beverages that Were not Refused for Descriptiveness.

There are at least 8 live CHERRY-formative compound trademarks registered on the Principal Register in Class 33 or related beverage Class 32, owned by 7 different parties, where "CHERRY" is joined with another word without a space between the words. Critically, none of these marks were required to include a disclaimer for "CHERRY" or the other word joined by the hyphen, nor were any of these marks refused for being merely descriptive: CHERRYBLOCK (U.S. Reg. No. 1,859,925), CHERRYVALE (U.S. Reg. No. 5,713,205), CHERRYSHINE (U.S. Reg. No. 4,827,429), CHERRYBUBLY (U.S. Reg. No. 5,622,873), CHERRYPURE (U.S. Reg. No. 5,304,315), CHERRYHEAD (U.S. Reg. No. 5,156,333), CHERRYHEAD (U.S. Reg. No. 4,519,282) and CHERRYACTIVE (U.S. Reg. No. 3,768,565). *See Exhibit A*, which are true and correct printouts from the USPTO's Trademark Status and Document Retrieval (TSDR) database

for each of these marks. If applicants and potential applicants cannot review the USPTO's TESS and TSDR databases and the Official Gazette to see what marks have been passed for registration and deduce that their proposed marks would be reviewed in the same way, then one of the most advertised benefits of our registration system is nonexistent. Accordingly, Applicant respectfully submits that the refusal of the CHERRYCREAM mark should be withdrawn

2. The Office Action's Analysis of "CHERRY" and "CREAM" in Applicant's CHERRYCREAM Mark, in Reaching its Conclusory Assessment, Violated the Anti-Dissection Rule.

Under the anti-dissection rule, a mark is tested for its validity and distinctiveness by looking at it as a whole, rather than dissecting it into its component parts. "The commercial impression of a trademark is derived from it as a whole, not from its elements separated and considered in detail. For this reason it should be considered in its entirety." See *California Cooler, Inc. v. Loretto Winery, Ltd.*, 774 F.2d 1451, 1455, 227 USPQ 808, 810 (9th Cir. 1985) (The mark CALIFORNIA COOLER "is a composite term and its validity is not judged by an examination of its parts. Rather, the validity of a trademark is to be determined by viewing the trademark as a whole... the composite may become a distinguishing mark even though its component parts individually cannot."). A mark should not be "dissected and considered piecemeal; rather, it must be considered as a whole..." *Massey Jr. Coll., Inc. v. Fashion Inst. of Tech.*, 492 F.2d 1399, 1402, 181 USPQ 272, 273 (C.C.P.A. 1974).

The Office Action asserts a conclusory and essentially tautological argument that combining the two words "CHERRY" and "CREAM" into the single word CHERRYCREAM does not alter the commercial impression of this term because the individual words "CHERRY" and "CREAM" retain their original meaning and that no additional meaning is created by their combination. Applicant respectfully disagrees with this conclusory assessment, and the analysis therefore which violates the anti-dissection rule. Applicant respectfully submits that, as shown below, the combination of these terms creates a new meaning which is fanciful and incongruous in relation to Applicant's goods. Nonetheless, the Office Action is premised on a violation of the anti-dissection rule and should be withdrawn on that basis alone.

3. The Combination of "CHERRY" and "CREAM" in CHERRYCREAM Creates a New Term which is Fanciful and Incongruous in Relation to Applicant's Goods

The Examining Attorney bears the burden of showing that a term is merely descriptive of the relevant goods or services. *In re Merrill Lynch, Pierce, Fenner, and Smith Inc.*, 828 F.2d 1567, 4 USPQ2d 1141, 1143 (Fed. Cir. 1987). "If one must exercise mature thought or follow a multi-stage reasoning process in order to determine what characteristics the term identifies, the term is suggestive rather than merely descriptive." *In re Tennis in the Round, Inc.*, 199 USPQ 496, 497 (TTAB 1978). See *In re Shutts*, 217 USPQ at 364-365; *In re Universal Water Systems, Inc.*, 209

USPQ 165, 166 (TTAB 1980). There is a “thin line” between a suggestive mark and a merely descriptive one, leading to the difficulty of drawing such fine and absolute distinctions as a matter of course. See, e.g., *In re Atavio*, 25 USPQ2d 1361 (TTAB 1992); *In re TMS Corp. of the Americas*, 200 USPQ 57, 58 (TTAB 1978). The distinction “is often made on an intuitive basis rather than as a result of logical analysis susceptible of articulation.” See *In re George Weston Ltd.*, 228 USPQ 57, 58 (TTAB 1985). To the extent that there is any doubt, that doubt is resolved in favor of the applicant. *In re Box Solutions Corp.*, 79 USPQ2d 1953, 1955 (TTAB 2006); *In re The Stroh Brewery Co.*, 34 USPQ2d 1796, 1797 (TTAB 1994); see also *In re Merrill Lynch*, 4 USPQ2d at 1144 (citing *In re Gourmet Bakers, Inc.*, 173 USPQ 565 (TTAB 1972)).

In this case, when the terms “CHERRY” and “CREAM” are combined into the compound mark CHERRYCREAM without a space between the two separate words, the meaning of this fanciful term is no longer the same as “CHERRY CREAM.” “CHERRY CREAM” separated into two words could describe a cherry-flavored, dairy-based cream (based on the definitions of Cherry and Cream submitted with the Office Action). For “CHERRY CREAM,” the word “CHERRY” is an adjective modifying “CREAM.”

In contrast, CHERRYCREAM is a single noun, denoting a cherry-produced cream, carrying the connotation of an inherent source-dynamic from within the fruit. In other words, CHERRYCREAM is a fanciful name that denotes a fictitious, rich, milky substance that comes from the inside of a cherry. Thus, the single-word compound mark CHERRYCREAM is both fanciful and incongruous in relation to Applicant’s goods, particularly wine. The commercial impression of the mark on consumers would be that of a fictitious milky rich substance derived from cherry fruits, or perhaps an imaginative characterization of red wine as being a cream that comes from a cherry, as opposed to a mere description of cherry and cream flavors to be found in the wine.

Given that CHERRYCREAM requires a multi-stage reasoning process to see the characteristics that the term identifies in connection with wine, there is grounds for doubt as to the immediacy of an impression on consumers which would be descriptive of Applicant’s goods rather than suggestive. Consequently, resolution should favor the Applicant and the refusal of the CHERRYCREAM mark should be withdrawn. *In re Box Solutions Corp.*, 79 USPQ2d at 1955.

To support the claim that the terms “CHERRY” and “CREAM” are used in the alcoholic beverage industry to describe products, the Office Action listed examples which are exclusively limited to flavored liqueurs, spirits and cocktails. These are beverages which a consumer would reasonably expect to contain cherries or cream as ingredients or flavorings, whereas wine consumers would have no such expectation. Thus, they would be more likely to interpret the unified term CHERRYCREAM as a fanciful name rather than a description of ingredients or flavors contained in the wine.

4. **Response to Request for Information**

- (1) The materials described in this request are currently unavailable.
- (2) See **Exhibit B**, which is a true and correct copy of the Certification of Label Approval (COLA) for Applicant's COLONEL JAMES brand of Pinot Noir wine. Applicant's CHERRYCREAM brand of wine would also be a Pinot Noir varietal, and would differ only in the source and mixture of wine grapes used in production. The CHERRYCREAM brand of wine would not differ in its operation, salient features, prospective consumers or channels of trade.
- (3) Applicant responds to the Examining Attorney's questions as follows: Applicant's goods will not contain cherry and/or cream as ingredients or flavors; Applicant's goods will not be categorized under the cream category of alcoholic drinks; Applicant's competitors do not use the terms "cherry cream" to advertise similar goods; the typical consumer of Applicant's goods are alcoholic beverage consumers in the United States, particularly consumers of wine; Applicant's goods are typically purchased through online alcohol retailers such as Drizly.com or Bevmo.com, or brick-and-mortar store venues such as Beverages & More. See **Exhibit C** which are true and correct printouts of websites currently selling Applicant's COLONEL JAMES brand of Pinot Noir wine.

Conclusion

Based on the foregoing, Applicant respectfully requests that the refusal under Section 2(e)(1) be withdrawn, and that Applicant's Mark be approved for registration on the Principal Register.