

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Tremark Development LLC
Mark: AMUN
Filing Date: March 15, 2019
Application Serial No.: 88/341,823
Docket No.: TM1115
Class: 033
Examining Attorney: Katherine Eissenstat

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

RESPONSE TO OFFICE ACTION

The Office Action of June 1, 2019, (the “Current Action”) has been reviewed, and the remarks of the Examining Attorney carefully considered. The only issue raised in the Current Action is the refusal under Section 2(d) of the Trademark Act alleging that U.S. Trademark Application Serial No. 88/341,823 for the word mark AMUN for “Distilled spirits” (the “Applied-for Mark”) is likely to cause confusion with the mark in U.S. Registration No. 5,638,937 for TEQUILA AMAN for “Distilled spirits” (the “Registered Mark”), by Gerardo Madrigal (the “Registrant”). For the reasons and evidence presented below, Applicant submits that this issue has been overcome, and Applicant respectfully requests that the Examining Attorney withdraw the refusal and approve the Applied-for Mark for publication in the Official Gazette.

REFUSAL UNDER SECTION 2(d) OF THE TRADEMARK ACT

In the Current Action, the Examining Attorney refused registration of the Applied-for Mark based on an alleged likelihood of confusion with the Registered Mark. A likelihood of confusion is determined based on the *du Pont* factors. See TMEP § 1207.01. The factors most relevant to the current analysis are: (1) the similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation, and commercial impression; (2) the conditions under which, and buyers to whom, sales are made; and (3) other factors that will affect a potential for confusion between the mark. See *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (C.C.P.A. 1973). Applicant submits that a careful analysis of all these factors results in the conclusion that confusion between the Applied-for Mark and the Registered Mark is not likely.

(1) THE APPLIED-FOR MARK AND THE REGISTERED MARK ARE DISSIMILAR IN APPEARANCE, SOUND, CONNOTATION, AND COMMERCIAL IMPRESSION

Applicant submits that the Examining Attorney has underestimated the degree to which the dissimilarities between the Applied-for Mark and the Registered Mark will help avoid confusion as to the source of the relevant goods. A key consideration in a likelihood of confusion analysis is the similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation, and commercial impression. TMEP § 1207.01; See, e.g., *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 1103, 192 USPQ 24, 29 (C.C.P.A. 1976); *In re Iolo Techs., LLC*, 95 USPQ2d 1498, 1499 (TTAB 2010); *In re Max Capital Grp. Ltd.*, 93 USPQ2d 1243, 1244 (TTAB 2010); *In re Thor Tech, Inc.*, 90 USPQ2d 1634, 1635 (TTAB 2009). Applicant submits that the dissimilarities between the Applied-for Mark and the Registered Mark in these regards are sufficient to avoid confusion, especially in light of the differences between the relevant goods.

i. Differences in Appearance

Apart from the unique design elements present in the Registered Mark, even the literal element of the Applied-for Mark, AMUN, is substantially different than the literal element of the Registered Mark, TEQUILA AMAN. The Registered Mark begins with the word TEQUILA, and although it is disclaimed, Applicant notes that “a disclaimer does not remove the disclaimed subject matter from the mark,” and that “the mark must still be regarded as a whole, including the disclaimed matter, in evaluating similarity to other marks.” See *In re Nat'l Data Corp.*, 753 F.2d 1056, 1059, 224 USPQ 749, 751 (Fed. Cir. 1985); *Specialty Brands, Inc. v. Coffee Bean Distribs., Inc.*, 748 F.2d 669, 672, 223 USPQ 1281, 1282 (Fed. Cir. 1984); *Giant Food, Inc. v. Nation's Foodservice, Inc.*, 710 F.2d 1565, 1570, 218 USPQ 390, 395 (Fed. Cir. 1983); *Schwarzkopf v. John H. Breck, Inc.*, 340 F.2d 978, 144 USPQ 433 (C.C.P.A. 1965); *In re MCI Commc'ns Corp.*, 21 USPQ2d 1534, 1538-39 (Comm'r Pats. 1991). The visual effect of beginning with the word TEQUILA is to create a much longer phrase that spans 2 words and 11 letters, versus the Registered Mark, which consists of only 1 word and 4 letters. Because of this visual effect, consumers will not be inclined to visually perceive that the two phrases are similar enough to cause confusion.

Even comparing the Applied-for Mark to the second term of the Registered Mark, there are distinct visual differences. Notably, the second syllable of the Applied-for mark consists of the letters MUN. This letter combination rarely appears at the end of words in the English language, only appearing in the words MUN and YAMUN. *See* Exhibit A. As such, the eyes of a consumer would be drawn to this unique suffix, making it even more likely that the terms AMUN and AMAN are distinguished by consumers.

ii. Differences in Sound

The literal elements of the Applied-for Mark and the Registered Mark have substantially different pronunciations. The Applied-for Mark begins with the word TEQUILA, which spans the three syllables—“TEH” “KEE” and “LAH”—none of which are found in, or phonetically similar to, AMUN. Even comparing just the term AMAN with the term AMUN, there are distinct differences. As demonstrated in Registrant’s response to an Office action, the term AMAN means “to affirm” in Hebrew. *See* Exhibit B. As shown on the website Forvo, there is only one pronunciation for the word AMAN, “AHH” “MM-AHH-NN.”¹ Both of the letters “A” in AMAN are pronounced the same – as AHH. For most English words, the AHH pronunciation of the letter A typically occurs where the letter A is followed by an “R.” *See* Exhibit C. Here, the unique pronunciation of AMAN is a result of the unique pronunciations of the letter A that exist in the Hebrew language. There is no language spoken in the world where the letter “U” in the Applied-for Mark would be pronounced in the same way as the letter A is pronounced in the Registered Mark. Instead, the letters “MUN” will be pronounced as either “MUNN” or “MOON,” sounds not present in the Registered Mark.

Applicant submits that consumers are likely to differentiate these marks because of these additional syllables present in the Registered Mark, and the overall differences in the syllables in each Mark. As a result, confusion between the marks will be avoided.

iii. Differences in Connotation

Similarity in meaning or connotation is another factor in determining whether the marks are confusingly similar. *See In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563, 567 (C.C.P.A. 1973); *In re Cynosure, Inc.*, 90 USPQ2d 1644, 1645-46 (TTAB 2009). The focus is on the recollection of the average purchaser who normally retains a general, rather than specific, impression of trademarks. *In re Bay State Brewing Co.*, 117 USPQ2d 1958, 1960 (TTAB 2016) (citing *Spoons Rests, Inc. v. Morrison Inc.*, 23 USPQ2d 1735, 1741 (TTAB 1991), *aff’d per curiam*, 972 F.2d 1353 (Fed. Cir. 1992)); *In re C.H. Hanson Co.*, 116 USPQ2d 1351, 1353 (TTAB 2015) (citing *Joel Gott Wines LLC v. Rehoboth Von Gott Inc.*, 107 USPQ2d 1424, 1430 (TTAB 2013)); *see also San Fernando Elec. Mfg. Co. v. JFD Electronics Components Corp.*, 565 F.2d

¹ Forvo: Hebrew Pronunciation Dictionary - Pronunciation of the word “AMAN.” Available at <https://forvo.com/languages/he/>, last accessed July 9, 2019.

683, 196 USPQ 1, 2-3 (CCPA 1977) ("Obviously, the marks here are constructed of old linguistic elements, but they must be considered as wholes, and not on the basis of side-by-side comparison, and in the light of the fallibility of memory."); *Neutrogena Corp. v. Bristol-Myers Co.*, 410 F.2d 1391, 161 USPQ 687, 688 (CCPA 1969) (many consumers "may have but dim recollections from having previously seen or heard one or the other of the involved marks."). Applicant reiterates that the stated connotation of the second term of the Registered Mark is a Hebrew term meaning "to affirm." The Applied-for Mark bears no resemblance to a Hebrew word, and has no meaning relating to affirmation. Instead, the Applied-for Mark is either a fanciful term with no specific meaning or an arbitrary word with no meaning relating to Applicant's products.

iv. Differences in Commercial Impression

Applicant submits that the differences in appearance, sound, and connotation combine to give the Applied-for Mark a unique commercial impression. Also, Applicant submits that the term TEQUILA creates a unique commercial impression in the Applied-for Mark. Consumers looking for Registrant's products will be looking for the term TEQUILA, and will not confuse a product branded only with the term AMUN with a product branded with the full mark TEQUILA AMAN. Accordingly, consumers will internalize the differing commercial impression presented in the Applied-for Mark, lessening the likelihood of confusion between the marks.

(2) CONSUMERS OF CRAFT DISTILLED SPIRITS PRODUCTS ARE CAREFUL AND SOPHISTICATED

Circumstances suggesting care in purchasing may lead to minimize the likelihood of confusion. TMEP § 1207.01(d)(vii); *See, e.g., In re N.A.D., Inc.*, 754 F.2d 996, 999-1000, 224 USPQ 969, 971 (Fed. Cir. 1985) (concluding that, because only sophisticated purchasers exercising great care would purchase the relevant goods, there would be no likelihood of confusion merely because of the similarity between the marks NARCO and NARKOMED); *In re Homeland Vinyl Prods., Inc.*, 81 USPQ2d 1378, 1380, 1383 (TTAB 2006). Customers of craft alcoholic beverage products are likely be discerning, sophisticated consumers. *See Shipyard Brewing Company, LLC v. Logboat Brewing Company, LLC*, No. CV 2:17-CV-04079, Order on Def's Mot. For Summ. J. at § 5. (W.D. Mo. 25 June 2018). Applicant submits that a consumer who seeks out and pays a premium for a small batch tequila (or other distilled spirits product) is not only highly sophisticated, but will also use extra care to make sure that the wrong product is not purchased. For these reasons, Applicant submits that there is a much lower likelihood of confusion between the craft distilled spirits products sold under the Applied-for Mark, and the craft distilled spirits products sold under the Registered Mark.

(3) OTHER FACTORS THAT WILL REDUCE THE POTENTIAL FOR CONFUSION BETWEEN THE MARKS

There are numerous other real-world factors that exist within the highly regulated alcohol beverage industry that will help reduce confusion between goods sold with the Applied-for Mark and goods sold with the

Registered Mark (i.e., distilled spirits products). For instance, the US government requires that a brand on a spirits brand label be readily legible and appear on a contrasting background.² Accordingly, since the respective brands are required to be displayed in such a fashion as to minimize confusion between them, showing a readily legible “U” in AMUN (for the Applied-for Mark), rather than a readily legible “A” in “AMAN” (in the Registered Mark).

CONCLUSION

Applicant submits that the factors discussed above weigh against a finding that the Applied-for Mark is confusingly similar to the Registered Mark. Further, Applicant submits that if there is *any doubt* as to whether the Applied-for Mark is confusingly similar to the Registered Mark, such doubt should be resolved *in favor of Applicant*. *In re Yeley*, 85 USPQ2d 1150, 1151 (TTAB 2007); *In re Benthin Mgmt. GmbH*, 37 USPQ2d 1332, 1334 (TTAB 1995).

Based on the foregoing, Applicant respectfully requests that the Examining Attorney withdraw the refusal to register under Trademark Act § 2(d) and approve U.S. application serial no. 88/341,823 for publication in the Official Gazette.

Dated this 7/11/2019

Respectfully submitted,

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² United States Tax & Trade Bureau, Beverage Alcohol Manual - Spirits, Chapter 1, p. 1, accessible at <https://www.ttb.gov/spirits/bam/chapter1.pdf>, last accessed July 9, 2019.