

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

U.S. Application Serial No.: 88/200,221  
Mark: AMARI  
Applicant: Amari LLC  
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To the Commissioner for Trademarks:

This filing responds to the Office Action, issued by the United States Patent and Trademark Office concerning the above-identified application.

**I. Likelihood of confusion with registered mark.**

The Examiner refused registration on the basis that the applied-for mark creates a likelihood of confusion with the mark in U.S. Registration No. 4,270,947. The owner of the 4,270,947 registration failed to timely renew the 4,270,947 registration during the renewal period or the grace period. Ex. 1 (mark registered January 8, 2013; Grace period ended July 8, 2019). The 4,270,947 registration is no longer valid and cannot be cited as a registered mark. Accordingly, the Applicant's mark does not conflict with any active registration.

**II. Disclaimer of AMARI.**

The Examiner requested the Applicant disclaim the word AMARI stating the word AMARI is not inherently distinctive, that it is merely descriptive. A mark is merely descriptive if it *immediately* conveys information concerning a quality or characteristic of the goods. *In re MBNA Am. Bank, N.A.*, 340 F.3d 1328, 1332 (Fed. Cir. 2003). Thus, a mark is merely descriptive if the ultimate consumers *immediately* associate it with a quality or characteristic of the goods. *Id.*

The Examiner states, “[t]he attached evidence from CollinsDictionary.com shows the term AMARI is the plural form of the word AMARO, a type of herbal beverage.” However, the

CollinsDictionary.com entry does not show that AMARI is the plural of AMARO. The CollinsDictionary.com entry does not include the words “plural” or “AMARI.”<sup>1</sup> The closest words are “amarico” and “amarsi.” Moreover, the CollinsDictionary.com entry does not define AMARO as an “herbal beverage.” It defines AMARO as “bitter,” “without sugar,” or “unhappy.” This definition is supported by Google Translate. Ex. 2 (“Amaro” means “bitter” in Italian). Google Translate indicates that AMARI means “not really” in Japanese. Ex. 3.

The Examiner contends that “[w]hile most amari are in the nature of aperitifs and digestifs, people familiar with the term would automatically recognize applicant’s goods to be a non-alcoholic version of the same.” But there is no evidence in the record supporting this contention. Given that AMARI means “not really” in Japanese and AMARO (not AMARI) means “bitter,” “without sugar,” or “unhappy” in Italian, there is no evidence supporting the contention that consumers “would automatically recognize applicant’s goods to be a non-alcoholic” drink. To the contrary, consumers must use some imagination, thought, or perception to determine if AMARI is Japanese or possibly Italian. *See In re George Weston Ltd.*, 228 USPQ 57 (TTAB 1985) (a suggestive term differs from a descriptive term, which *immediately* tells something about the goods or services). Consumers are as likely or more likely to associate a Japanese or Asian word with an herbal beverage than with an Italian word. Ex. 4.

Finally, the cited registration for AMARI (Reg. No. 4,270,947<sup>2</sup>) included “shakes” and “drinks” and does not include a disclaimer of the word AMARI (or a claim of acquired distinctiveness). Exhibit 1 at 5-6 . The absence of a disclaimer in the registration is strong evidence that AMARI is distinctive, not descriptive, for drinks. *Champions Golf Club, Inc. v. The Champions Golf Club, Inc.*, 78 F.3d 1111 (6th Cir. 1996) (“[T]he fact that a mark is registered on the principal register creates a presumption that the mark is not descriptive.”); *Am. Online, Inc. v. AT & T Corp.*, 243 F.3d 812, 818 (4th Cir. 2001) (“through the certificate of registration, the Commissioner introduces his [or her] opinion that the application of the registrant was sufficient to demonstrate a valid [inherently distinctive] mark”).

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<sup>1</sup> The Wikipedia entry for AMARO included by the Examiner does not state that AMARI is the plural of AMARO.

<sup>2</sup> Now expired.

In summary, there is no evidence in the record that AMARI means liqueur in Italian. Even if there was evidence of this meaning, consumers must still use imagination, thought, or perception to determine whether to translate AMARI into Japanese or Italian. Then they must employ further imagination, thought, or perception to determine whether the Applicant's goods are a non-alcoholic version of an Italian liqueur. Accordingly, there is insufficient evidence to demonstrate that consumers would *immediately* associate AMARI with a quality or characteristic of the Applicant's goods. This conclusion is consistent with the Commissioner's decision to previously register AMARI for drinks, without a disclaimer. Finally, if there is any doubt as to the meaning or descriptiveness of a mark, the doubt "is resolved in favor of the applicant, that is to say, in favor of publication for opposition." *In Re Atavio Inc.* No. 74/055,292, 25 U.S.P.Q.2d 1361 (Trademark Tr. & App. Bd. 1992).

The Applicant respectfully requests the Examiner withdraw their request for a disclaimer of AMARI and approve the Application for publication.

### **III. Clarification of Class 005 goods.**

The Examiner requests the Applicant clarify the description of its goods. The Applicant hereby amends its application to seek registration in Class 005 for the following goods:

Herbal drinks used to aid in sleep and relaxation; Herbal supplements; Herbal supplements for sleeping problems; Herbal supplements for muscle recovery; Herbal supplements for *muscles, joints, tendons, legs, back, shoulders, arms, neck, and feet*; Herbal supplements for *inflammation, muscle soreness, joint discomfort, anxiety, stress, sleeplessness, nausea, and low energy*; Powdered nutritional supplement concentrate; Powdered nutritional supplement drink mix; Powdered nutritional supplement drink mix and concentrate; Powdered nutritional supplement drink mix containing adaptogenic herbs; Dietary beverage supplements for human consumption in liquid and dry mix form for therapeutic purposes; Dietary supplement beverage for muscle recovery; Dietary supplement beverage for *muscles, joints, tendons, legs, back, shoulders, arms, neck, and feet*; Dietary supplement beverage for *inflammation, muscle soreness, joint discomfort, anxiety, stress, sleeplessness, nausea, and low energy*; Natural herbal supplements; Nutritional supplements in the form of powder.

### **IV. Conclusion**

For these reasons, the Applicant respectfully requests the Examiner accept the Applicant's arguments and allow the mark to proceed to publication.

Respectfully submitted this 18th day of July 2019.

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