

Attorney Docket No. 47226-K077US (9)
Mark: AMETHYST PREMIER COLLECTION & Design

Serial No. 90/097,980 – Arguments in Response to Office Action dated December 8, 2020

AMENDMENTS AND RESPONSE TO OFFICE ACTION

In response to the Office Action dated December 8, 2020, Applicant respectfully submits the following amendments and remarks:

AMENDMENT

Please amend the above-identified trademark application as follows:

Recitation of Goods

Please **delete** the identification of the goods in Class 003 in its entirety and **replace** it with the following amended identification of the goods:

Tanning creams, lotions and gels; tanning skin creams, tanning lotions and tanning gels for accelerating, enhancing, intensifying and extending tans; after tanning gels; body and facial bronzers; all the foregoing containing amethyst in Class 35

Description of Mark

Please **delete** the description of the mark in its entirety and **replace** it with the following amended description:

The mark consists of the word “AMETHYST” in stylized lettering written vertically above a palm tree design with the right side of the trunk circling above the palm tree to the left of the words ”PREMIER COLLECTION”

Prior Filed Application

The Examiner had referenced a pending application with a filing date preceding Applicant’s filing date as possible bar to registration of Applicant’s mark due to likelihood of confusion between the two marks. The referenced mark, Serial No. 90/012,561 for Amethyst By Violeta, was abandoned on March 24, 2021, according to the Trademark Status & Document Retrieval (TSDR). A copy of a printout from the TSDR is attached herein as evidence of

abandonment of the referenced application, which Applicant respectfully notes should deem this refusal moot.

Remarks in Response to Examiner's Requirement for a Disclaimer

The Office Action states that the Applicant must disclaim the wording "AMETHYST PREMIER COLLECTION" because it is merely descriptive of an ingredient, quality, characteristic, function, feature, purpose, or use of applicant's goods, thus, describing describes a feature or characteristic of applicant's goods in that the goods may" contain AMETHYST" or it "may describe the color of the goods." To support this contention, the Examiner provides screen shots from various vendors utilizing products that use wording may be intended to describe or indicate the color or shade of the goods. Furthermore, the Examiner has provided definitions from the American Heritage Dictionary of the words "AMETHYST," "PREMIER" and "COLLECTION", noting that the latter two terms serve to purport the "supposed superior quality of the goods which are aggregated into a group of items available for purchase," and also defines Amethyst as a "clear purple or bluish-violet variety of crystallized quartz that is often used as a jeweler's stone."

The intent of a disclaimer is to protect the competitive needs of others by ensuring that descriptive words and phrases are left free for public use. *Concurrent Technologies Inc. v Concurrent Technologies Corp.*, 12 USP2d 1054, 1058 (TTAB 1989).

Wherein the Examining Attorney has required a disclaimer of the word "AMETHYST" in Applicant's Mark because "it is not inherently distinctive." Applicant therefore requests that the following disclaimer be entered into the record:

"No claim is made to the exclusive right to use "AMETHYST" apart from the mark as shown."

Alternatively however, Applicant submits that in this particular case, the public does not need protection from competition by others with regard to Applicant's goods, as Applicant uses "PREMIER COLLECTION" within a specific, unitary context and the public would not be deprived of the use of these terms, beyond the use they are already deprived of based on Applicant's consistent and continued use of the mark "PREMIER COLLECTION" for their skin care line of products, sold exclusively in their corporate and franchise stores since 2015. Applicant respectfully submits that its use of "PREMIER COLLECTION", either together or in combination with other words, has acquired distinctiveness through substantially exclusive and

continuous use in commerce for those specific goods in Class 003, namely *tanning creams, lotions and gels; tanning skin creams, tanning lotions and tanning gels for accelerating, enhancing, intensifying and extending tans; after tanning gels; body and facial bronzers* for at least the 5 years immediately prior to the date of the attached Declaration.

Applicant submits that its long term use of “PREMIER COLLECTION” for the specified goods has not only served to identify Applicant as the source of such goods, but has also caused Applicant to become well-recognized in the relevant tanning industry as the source of the same or closely related goods to those included in the subject application.

As evidence of the acquired distinctiveness of the word mark, Applicant submits a Declaration in Support of Section 2(f) Claim of Acquired Distinctiveness, which is attached in the Evidence section filed in the TEAS response. With the submission of this Declaration proving substantial use of the mark and based on the remarks set out within this response, Applicant believes that they have sufficiently proved that consumers will not view the “PREMIER COLLECTION” portion of the instant mark as a separate source identifier or element of the mark, which removes the necessity for a disclaimer. Accordingly, Applicant respectfully seeks removal of the disclaimer requirement for the terms “PREMIER COLLECTION”, and requests registration on the Principal Register with a Section 2(f) Claim and that the application be approved for publication.

Conclusion

In response to the Office Action, Applicant submits that the arguments included with this response to the Office Action serve to satisfy all requirements and address all issues raised by the Examining Attorney. Applicant has amended the description of the goods and the description of the mark. Applicant has further provided evidence that the pending application referenced by the Examiner as a possible barrier to the registration of Applicant’s mark has been abandoned, effective March 24, 2021, deeming a likelihood of confusion refusal moot. Finally, Applicant has requested a disclaimer of the term “AMETHYST” from this application, while subsequently asserting that no disclaimer is necessary for the terms “PREMIER COLLECTION” because the words “PREMIER COLLECTION” have been proven to have acquired distinctiveness through submission of a Declaration in Support of Section 2(f) Claim of Acquired Distinctiveness executed by the Applicant. Therefore, the Examining Attorney is respectfully requested to withdraw the disclaimer requirement and approve the application for publication.

It is believed that no other fees are due in connection with this response, however, if any fee is required or incurred in connection herewith, please charge any amounts due or refund any credits to Winstead PC Deposit Account No. 23-2426.