

**FILED ELECTRONICALLY**  
**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Application No.: 88/469,996  
Applicant: Australian Gold, LLC  
Filing Date: June 12, 2019  
Law Office: 105  
Examiner: Elizabeth A. O'Brien  
Attorney Docket No.: 008183-001823  
Mark: VARI BEAUTY

**RESPONSE AFTER OFFICE ACTION**

BOX RESPONSE NO FEE  
Commissioner for Trademarks  
P.O. Box 1451  
Arlington, VA 22313-1451

Dear Sir:

In response to the Office Action emailed September 5, 2019, reconsideration is respectfully requested in view of the enclosed amendment, consent agreement and remarks.

**AMENDMENTS**

*Please enter the following disclaimer:*

“No claim is made to the exclusive right to use ‘beauty’ apart from the mark as shown.”

**REMARKS**

**Disclaimer**

Applicant has entered a disclaimer of the word “beauty” as requested in the Office Action.

**Likelihood of Confusion**

The Office Action rejects the present application for VARI BEAUTY under §2(d), alleging that there is a likelihood of confusion between the application and Registration No. 2,618,922 on VARI-GONE for “skin care cream and body lotion.” The Office Action also provisionally cites Application No. 88468423 on the mark AVARI BEAUTY for “cosmetics,” among other goods in class 3. Applicant respectfully submits that the marks VARI BEAUTY, VARI-GONE and AVARI BEAUTY are sufficiently different such that there is no likelihood of confusion between the respective marks. Applicant further submits a Consent Agreement between Applicant and the owner of the AVARI BEAUTY application. Applicant submits that there is no likelihood of confusion between any of the marks and requests the refusal to register be withdrawn.

**The VARI-GONE Registration**


The word portion “VARI” being common to both marks is not, by itself, sufficient to conclude that there is a likelihood of confusion. The *du Pont* factors include “The number and nature of similar marks in use on similar goods.” *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361 (CCPA 1973). There is a crowded field of VARI-formative marks. The USPTO has allowed multiple VARI-formative marks for even identical cosmetic and skin care goods in class 3.<sup>1</sup>

TM/AN/RN	Status/Key Dates	Full Goods/Services	Owner
<a href="#">VARI-GONE</a> RN: 2618922 SN: 76233915	Renewed September 10, 2012	(Int'l Class: 03) <b>skin care cream and body lotion</b>	Nature's Sunshine Products, Inc. (Utah Corp.)

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<sup>1</sup> Registration certificates or USPTO records for these marks are submitted herewith.

TM/AN/RN	Status/Key Dates	Full Goods/Services	Owner
<a href="#">VARIHOPE</a> RN: 5854430 SN: 87916795	Registered September 10, 2019	(Int'l Class: 03) Eye pencils; Eye liner; Foundation; Compacts containing make-up; Mask pack for cosmetic purposes; <b>Beauty packs consisting of cosmetics</b> ; Eye shadow; Non-medicated <b>balms for use on hair, skin, and lips</b> ; <b>Cosmetics</b>	Lighthousecosmetics Corporation (Republic of Korea Corp.)
<a href="#">VARIKOSETTE</a> SN: 88539781	Published November 12, 2019	(Int'l Class: 03) <b>Balms, other than for medical purposes, namely, non-medicated body and skin balms</b> ; petroleum jelly for cosmetic purposes; creams for leather; massage gels, other than for medical purposes; <b>cosmetic creams</b> ; <b>non-medicated creams for varicose veins</b> ; non-medicated foot creams; skin whitening creams; <b>lotions for cosmetic purposes</b> ; beauty masks; oils for cosmetic purposes; cleansing milk for toilet purposes; tissues impregnated with cosmetic lotions; astringents for cosmetic purposes; cosmetic preparations for skin care; <b>cosmetics</b> ; non-medicated toiletry preparations; phytocosmetic preparations; topical herbal extracts for cosmetic purposes; extracts of flowers being perfumes	Hendel LLC (Russian Federation Limited Liability Company)
<a href="#">VARIPOWDER</a> RN: 5955654 SN: 88545214	Registered January 7, 2020	(Int'l Class: 03) Air fragrance reed diffusers; Air fragrancing preparations; <b>Almond soap</b> ; <b>Almond soaps</b> ; <b>Aromatic essential oils</b> ; <b>Aromatic oils</b> ; <b>Bergamot oil</b> ; <b>Essential oils</b> ; Essential oils as perfume for laundry purposes; Essential oils for household use; <b>Essential oils for personal use</b> ; Essential oils for use in aromatherapy; Essential oils of cedarwood; Essential oils of lemon; Ethereal essences; Ethereal oils; Extracts of flowers being perfumes; Fumigating incenses (Kunko); Jasmine oil for personal use; Lavender oil; Lavender sachets; Lavender water; Lipstick; Mint essence being essential oil; Mint for perfumery; Musk being perfumery; Oils for cleaning purposes; <b>Oils for cosmetic purposes</b> ; Oils for perfumes and scents; Perfumery; Perfumes; <b>Rose oil for cosmetic purposes</b> ; <b>Shower gels</b> ; Washing soda, for cleaning; Cake flavourings being essential oils; Food flavoring, being essential oils; Natural essential oils; Perfumery, essential oils	Richao Yan (China Citizen)
<a href="#">VARISI</a> RN: 5599930 SN: 87827479	Registered November 6,	(Int'l Class: 03) non-medicated liquid or spray preparations used for cleaning, sanitizing and deodorant purposes <b>for</b>	Alva Jade Enterprises, Inc. (Florida Corp.)

TM/AN/RN	Status/Key Dates	Full Goods/Services	Owner
	2018	<b>application to fingernails, toenails and surrounding skin areas</b> to attain clear and attractive nails	
<a href="#">VARIN (Stylized)</a>  RN: 5131473 SN: 86847823	Registered Principal Register - Sec. 2(F) January 31, 2017	(Int'l Class: 03) <b>make-up</b> (Int'l Class: 44) hair salon services	Varin Inc. (New York Corp.)

As an example of identical goods, the cited VARI-GONE registration lists “skin care cream and body lotion” and is used for products which treat varicose veins:

How it works

Nature’s Sunshine Vari-Gone Cream® combines horse chestnut, butcher’s broom, aloe vera, and yellow sweet clover into a cream that improves varicose vein appearance.

(Exhibit A) Coexisting, the VARIKOSETTE mark is also used for skin care creams and lotions to treat varicose veins, namely “cosmetic creams; non-medicated creams for varicose veins; ... lotions for cosmetic purposes.” As further examples of coexisting Vari-formative marks with goods identical and/or highly similar to the goods in the VARI-GONE registration, VARIHOPE is used for balms (e.g. skin care creams) and VARIPOWDER is used for “oils for cosmetic purposes” (e.g. skin care oils).

In a crowded field, even minimal facial differences in the marks and/or minimal differences in the services between such marks may be more important than the overlap of a common portion. The TTAB similarly found this single factor dispositive in *In re Hartz Hotel Services, Inc.*, 102 USPQ2d 1150, 1153-54 (TTAB 2012) (precedential) (finding GRAND HOTELS NYC not likely to cause confusion with the mark GRAND HOTEL for the same services in light of numerous uses of the wording “grand hotel,” inferring that the Trademark

Office has historically registered “grand hotel” marks “to different parties so long as there has been some difference, not necessarily created by a distinctive word, between the marks as a whole.”)

As relevant here, when comparing VARI BEAUTY and VARI-GONE, the overlap of the “Vari” portions should carry less weight than the differences between the overall commercial impressions of the respective marks. For instance, in evaluating the overall impression of VARI BEAUTY, the VARI is grammatically used as an adjective focusing the consumer’s impression on the term BEAUTY as a noun. BEAUTY convey the positive meaning of “a beautiful person or thing” or “a particularly graceful, ornamental, or excellent quality.” (Exhibit B) Further, VARI suggests multiple meanings in how it can modify the term BEAUTY, for example suggesting the impression of “very beautiful” or “various or varying beauty.”

In contrast, VARI-GONE conveys a drastically different impression. The impression of VARI-GONE uses VARI-as a prefix/adjective and focuses the consumer on the GONE portion of the mark, immediately conveying a negative command or status meaning that something is lost, ruined, dead or past. (Exhibit C) In the registrant’s context of use, the “VARI” portion is understood by consumers as an abbreviation of “varicose veins” and the product’s purpose is to remove or “make gone” the appearance of such varicose veins.

#### How it works

Nature’s Sunshine Vari-Gone Cream® combines horse chestnut, butcher’s broom, aloe vera, and yellow sweet clover into a cream that improves varicose vein appearance.

(Exhibit A)<sup>2</sup> In a double-entendre, the VARI-GONE mark also conveys a meaning that a result of using the products is that the varicose veins become “very gone.”

The two marks cited in the present Office Action also logically corroborate that there is no likelihood of confusion. The Office Action asserts, directly or provisionally that both the VARI-GONE and AVARI BEAUTY marks are confusingly similar to Applicant’s VARI BEAUTY mark. Therefore logically they should be considered confusingly similar to each other. However, the USPTO allowed the AVARI BEAUTY mark over the VARI-GONE mark undermining logic in the Office Action. Comparably, Applicant’s mark is not confusingly similar to the VARI-GONE mark for the same reasons that AVARI BEAUTY is not confusingly similar to VARI-GONE.

The USPTO’s approval of various VARI marks for identical goods in class 3 demonstrates that the VARI-GONE registration should be interpreted more narrowly than asserted in the present Office Action. When the respective marks are considered as a whole, the arguments and evidence advanced in the Office Action are insufficient to support a conclusion that there is a likelihood of confusion in this case. Instead, despite the overlap of the VARI portion, the differences between the cited registration and the present application are sufficient to conclude that there is no likelihood of confusion between the marks.

**The AVARI BEAUTY Application**

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<sup>2</sup> While not limiting the registration, extrinsic evidence of the Registrant’s actual use is probative of what the meaning understood by members of the trade is when they encounter the mark. *See, In re Mariola Burgers, LLC*, Serial No. 85131831 (TTAB Sept. 6, 2016) (Exhibit D) (“Registrant’s use of its mark is not limited by this extrinsic evidence of its actual use. Nevertheless, the evidence of record shows that the term RAIL admits of multiple meanings, meanings that the purchasing public may interpret quite differently based on other dissimilarities in the marks, such as a highly distinctive design.”)

The Office Action also provisionally cites pending trademark application Serial No. 88/468,423 on the mark AVARI BEAUTY for cosmetics and other goods in class 3. While this is not yet a formal rejection, as reflected in the consent agreement submitted herewith, the marks are significantly different and the goods are directed to different types of consumers such that there is no likelihood of confusion. As recognized by the TTAB, “there can be no better assurance” that there is not a likelihood of confusion than such an agreement between the parties:

there can be no better assurance of the absence of a likelihood of confusion, mistake, or deception than the parties' careful consideration of their commercial interests.

*Frisch's Restaurants, Inc. v. Big Boy Restaurants International, LLC*, Concurrent Use No. 94002189 \*9 (TTAB August 11, 2009).

Applicant respectfully submits that the Consent Agreement between the parties should be given great weight based on the uncontroverted evidence from those “on the firing line” after the parties have carefully considered their commercial interests. TMEP §1207.01(d)(viii), Withdrawal of the provisional citation is respectfully requested.

### **Conclusion**

In view of the remarks and the enclosed consent agreement, Applicant respectfully requests withdrawal of the rejections. Applicant accordingly submits that the application is in condition for publication and allowance, and action towards such is respectfully requested. If there are any questions with regard to the application or this response, the Examining Attorney is invited to telephone the undersigned to expedite this application.

Respectfully submitted

By: /Charles J. Meyer/

Charles J. Meyer

Woodard, Emhardt, Henry, Reeves & Wagner LLP

111 Monument Circle, Suite 3700

Indianapolis, Indiana 46204-5137

(317) 634-3456