
To: NORIT Americas Inc. (trademarks@pgfm.com)
Subject: TRADEMARK APPLICATION NO. 78236792 - VAPURE - 1426-2-5
Sent: 1/31/2005 10:24:31 AM
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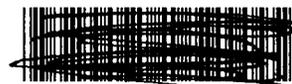
[Important Email Information]
UNITED STATES PATENT AND TRADEMARK OFFICE

SERIAL NO: 78/236792

APPLICANT: NORIT Americas Inc.

CORRESPONDENT ADDRESS:

Jason A. Bernstein
Powell Goldstein Frazer & Murphy LLP
Sixteenth Floor
191 Peachtree Street, N.E.
Atlanta GA 30303-1736



RETURN ADDRESS:

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

MARK: VAPURE

CORRESPONDENT'S REFERENCE/DOCKET NO: 1426-2-5

Please provide in all correspondence:

CORRESPONDENT EMAIL ADDRESS:

1. Filing date, serial number, mark and applicant's name.

trademarks@pgfm.com

2. Date of this Office Action.
3. Examining Attorney's name and Law Office number.
4. Your telephone number and e-mail address.

OFFICE ACTION

TO AVOID ABANDONMENT, WE MUST RECEIVE A PROPER RESPONSE TO THIS OFFICE ACTION WITHIN 6 MONTHS OF OUR MAILING OR E-MAILING DATE.

Serial Number 78/236792

This letter responds to the communication filed on March 25, 2004; the Commissioner for Trademarks revived the abandoned application. Please note that all issues not discussed in this office action have been resolved. This letter is a FINAL office action.

The examining attorney previously refused registration under Trademark Act Section 2(d), 15 U.S.C. §1052(d), because the applicant's mark, when used on or in connection with the identified goods, so resembles the marks in U.S. Registration Nos. 1794226 and 2348015 as to be likely to cause confusion, to cause mistake, or to deceive. TMEP §§1207.01 *et seq.* The examining attorney has carefully considered the applicant's arguments but has found them unpersuasive. For the reasons set forth below, the refusal(s) under Section 2(d) is maintained and made FINAL.

Likelihood of Confusion

The examining attorney must analyze each case in two steps to determine whether there is a likelihood of confusion. First, the examining attorney must look at the marks themselves for similarities in appearance, sound, connotation, and commercial impression. *In re E. I. DuPont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (C.C.P.A. 1973). Second, the examining attorney must compare the goods or services to determine if they are related or if the activities surrounding their marketing are such that confusion as to origin is likely. *In re August Storck KG*, 218 USPQ 823 (TTAB 1983); *In re International Telephone and Telegraph Corp.*, 197 USPQ 910 (TTAB 1978); *Guardian Products Co., v. Scott Paper Co.*, 200 USPQ 738 (TTAB 1978). TMEP §§1207.01 *et seq.* The overriding concern is to prevent buyer confusion as to the source of the goods and/or services. *Miss Universe, Inc. v. Miss Teen U.S.A., Inc.*, 209 USPQ 698 (N.D. Ga. 1980).

Therefore, any doubt as to the existence of a likelihood of confusion must be resolved in favor of the registrant. *Lone Star Mfg. Co. v. Bill Beasley, Inc.*, 498 F.2d 906, 182 USPQ 368 (C.C.P.A. 1974).

Registration No. 1794226

A. Analysis of the Marks

There is a likelihood of confusion between the applicant's mark VAPURE and the registrant's mark VAPURE based upon the sound, connotation, and appearance of the respective marks. In fact, the respective marks are identical in all respects. Thus, consumers are likely to become confused as to the source of the respective goods and/or services when encountering the identical marks in the same trade channels.

B. Analysis of the Channels of Trade

The respective goods and/or services are related. It is well settled that the issue of likelihood of confusion between marks must be determined on the basis of the goods and/or services as they are identified in the application and the registration. *Canadian Imperial Bank of Commerce v. Wells Fargo Bank*, 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987); *Paula Payne Products Co. v. Johnson Publishing Co., Inc.*, 473 F.2d 901, 177 USPQ 76 (C.C.P.A. 1973). Moreover, the goods and/or services of the parties need not be identical or directly competitive to find a likelihood of confusion. They need only be related in some manner, or the conditions surrounding their marketing be such, that they could be encountered by the same purchasers under circumstances that could give rise to the mistaken belief that the goods/services come from a common source. *In re Martin's Famous Pastry*

Shoppe, Inc., 748 F.2d 1565, 223 USPQ 1289 (Fed. Cir. 1984); *In re Corning Glass Works*, 229 USPQ 65 (TTAB 1985); *In re Rexel Inc.*, 223 USPQ 830 (TTAB 1984); *Guardian Products Co., Inc. v. Scott Paper Co.*, 200 USPQ 738 (TTAB 1978); *In re International Telephone & Telegraph Corp.*, 197 USPQ 910 (TTAB 1978). TMEP §1207.01(a)(i).

Additionally, the respective marks are identical in sound, connotation, and appearance. Therefore, the relationship between the goods or services of the respective parties need not be as close to support a finding of likelihood of confusion as might apply where differences exist between the marks. *Amtcor, Inc. v. Amtcor Industries, Inc.*, 210 USPQ 70 (TTAB 1981).

The attached evidence shows that the applicant's activated carbon is used with the registrant's goods. See the attached evidence, including evidence from the applicant's own web page that shows that it offers its goods to customers in the water treatment industry. Moreover, the evidence shows that the respective goods are offered in the same channels of trade and to the same potential customers. Consequently, it is clear that the goods are highly related.

The applicant argues that there is no likelihood of confusion between the respective marks because the applicant's goods are used in treating gases, while the registrant's goods are for treating fluids and extracting water therefrom. The applicant's argument is not persuasive because it does not use the correct legal standard. The fact that the goods of the parties differ is not controlling in determining likelihood of confusion. The issue is not likelihood of confusion between particular goods, but likelihood of confusion as to the source of those goods. See *In re Rexel Inc.*, 223 USPQ 830, 831 (TTAB 1984), and cases cited therein; TMEP §§1207.01 *et seq.* The evidence shows that the respective goods are offered in the same trade channels to the same potential customers. Therefore, the goods are related and customers are likely to confuse the source of the goods when viewing the identical marks.

The applicant also seeks to buttress its argument with "evidence" from the registrant's web page. An applicant may not restrict the scope of the goods covered in the registration by extrinsic evidence, such as submitting web pages or catalogs that show the registrant is not using the mark for certain goods. See, e.g., *In re Bercut-Vandervoort & Co.*, 229 USPQ 763, 764 (TTAB 1986). Section 7(b) of the Trademark Act, 15 U.S.C. §1057(b), provides that a certificate of registration on the Principal Register shall be *prima facie* evidence of the validity of the registration, of the registrant's ownership of the mark and of the registrant's exclusive right to use the mark in commerce in connection with the goods or services specified in the certificate. During *ex parte* prosecution, an applicant will not be heard on matters that constitute a collateral attack on the cited registration (e.g., a registrant's nonuse of the mark). See *In re Dixie Restaurants*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997); *Cosmetically Yours, Inc. v. Clairol Inc.*, 424 F.2d 1385, 1387, 165 USPQ 515, 517 (C.C.P.A. 1970); *In re Peebles Inc.* 23 USPQ2d 1795, 1797 n. 5 (TTAB 1992); *In re Pollio Dairy Products Corp.*, 8 USPQ2d 2012, 2014-15 (TTAB 1988).

The nature and scope of a party's goods or services must be determined on the basis of the goods or services recited in the application or registration. See, e.g., *In re Shell Oil Co.*, 992 F.2d 1204, 26 USPQ2d 1687, 1690 n. 4 (Fed. Cir. 1993); *J & J Snack Foods Corp. v. McDonald's Corp.*, 932 F.2d 1460, 18 USPQ2d 1889 (Fed. Cir. 1991); *Octocom Systems Inc. v. Houston Computer Services Inc.*, 918 F.2d 937, 16 USPQ2d 1783 (Fed. Cir. 1990); *Canadian Imperial Bank of Commerce, N.A. v. Wells Fargo Bank*, 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987); *Paula Payne Products Co. v. Johnson Publishing Co.*, 473 F.2d 901, 177 USPQ 76 (C.C.P.A. 1973). Therefore, the applicant's alleged evidence cannot be considered in this *ex parte* proceeding because it impermissibly seeks to limit the scope of the registrant's goods and/or services.

The applicant also argues that its sophisticated customers will not confuse the source of the goods. The fact that purchasers are sophisticated or knowledgeable in a particular field does not necessarily mean that they are sophisticated or knowledgeable in the field of trademarks or immune from source confusion. See *In re Decombe*, 9 USPQ2d 1812 (TTAB 1988); *In re Pellerin Milnor Corp.*, 221 USPQ 558 (TTAB 1983); TMEP §1207.01(d)(vii). This is especially true when the goods are highly related and the marks are identical. Thus, the applicant's argument must fail.

Registration No. 2348015**A. Analysis of the Marks**

There is a likelihood of confusion between the applicant's mark VAPURE and the registrant's mark VAPURE based upon the sound, connotation, and appearance of the respective marks. In fact, the respective marks are identical in all respects. Thus, consumers are likely to become confused as to the source of the respective goods and/or services when encountering the identical marks in the same trade channels.

B. Analysis of the Channels of Trade

The respective goods and/or services are related. It is well settled that the issue of likelihood of confusion between marks must be determined on the basis of the goods and/or services as they are identified in the application and the registration. *Canadian Imperial Bank of Commerce v. Wells Fargo Bank*, 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987); *Paula Payne Products Co. v. Johnson Publishing Co., Inc.*, 473 F.2d 901, 177 USPQ 76 (C.C.P.A. 1973). Moreover, the goods and/or services of the parties need not be identical or directly competitive to find a likelihood of confusion. They need only be related in some manner, or the conditions surrounding their marketing be such, that they could be encountered by the same purchasers under circumstances that could give rise to the mistaken belief that the goods/services come from a common source. *In re Martin's Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 223 USPQ 1289 (Fed. Cir. 1984); *In re Corning Glass Works*, 229 USPQ 65 (TTAB 1985); *In re Rexel Inc.*, 223 USPQ 830 (TTAB 1984); *Guardian Products Co., Inc. v. Scott Paper Co.*, 200 USPQ 738 (TTAB 1978); *In re International Telephone & Telegraph Corp.*, 197 USPQ 910 (TTAB 1978). TMEP §1207.01(a)(i).

Additionally, the respective marks are identical in sound, connotation, and appearance. Therefore, the relationship between the goods or services of the respective parties need not be as close to support a finding of likelihood of confusion as might apply where differences exist between the marks. *Ancor, Inc. v. Ancor Industries, Inc.*, 210 USPQ 70 (TTAB 1981).

The same arguments that applied above, also apply here. The attached evidence shows that the respective goods are offered in the same trade channels to the same potential customers. Therefore, the goods are related. Consequently, the result is the same; there is a likelihood of confusion between the respective identical marks.

Based on the foregoing, the §2(d) refusals are maintained and made FINAL.

Appropriate Responses

The applicant may respond to this final action by either: (1) submitting a timely response that fully satisfies any outstanding requirements, if feasible; (2) timely filing an appeal of this final action to the Trademark Trial and Appeal Board; or (3) timely filing a petition to the Director if permitted by 37 C.F.R. §2.63(b). 37 C.F.R. §2.64(a); TMEP §715.01. Regarding petitions to the Director, Sec 37 C.F.R. §2.146 and TMEP Chapter 1700. If applicant fails to respond within six months of the mailing date of this refusal, the application will be abandoned. 37 C.F.R. §2.65(a).

NOTICE: FEE CHANGE

Effective January 31, 2005 and pursuant to the Consolidated Appropriations Act, 2005, Pub. L. 108-447, the following are the fees that will be charged for filing a trademark application:

- (1) \$325 per international class if filed electronically using the Trademark Electronic Application System (TEAS); or
- (2) \$375 per international class if filed on paper

These fees will be charged not only when a new application is filed, but also when payments are made to add classes to an existing application. If such payments are submitted with a TEAS response, the fee will be \$325 per class, and if such payments are made with a paper response, the fee will be \$375 per

class.

The new fee requirements will apply to any fees filed on or after January 31, 2005.

NOTICE: TRADEMARK OPERATION RELOCATION

The Trademark Operation has relocated to Alexandria, Virginia. Effective October 4, 2004, all Trademark-related paper mail (except documents sent to the Assignment Services Division for recordation, certain documents filed under the Madrid Protocol, and requests for copies of trademark documents) must be sent to:

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

Applicants, attorneys and other Trademark customers are strongly encouraged to correspond with the USPTO online via the Trademark Electronic Application System (TEAS), at <http://www.uspto.gov/teas/index.html>.

/Brian J. Pino/
Examining Attorney
Law Office 114
571.272.9209
571.273.9114 Law Office Facsimile

How to respond to this Office Action:

You may respond formally using the Office's Trademark Electronic Application System (TEAS) Response to Office Action form (visit <http://eteas.uspto.gov/V2.0/oa242/WIZARD.htm> and follow the instructions therein, but you must wait until at least 72 hours after receipt if the office action issued via e-mail). PLEASE NOTE: Responses to Office Actions on applications filed under the Madrid Protocol (Section 66(a)) CANNOT currently be filed via TEAS.

To respond formally via regular mail, your response should be sent to the mailing Return Address listed above and include the serial number, law office and examining attorney's name on the upper right corner of each page of your response.

To check the status of your application at any time, visit the Office's Trademark Applications and Registrations Retrieval (TARR) system at <http://tarr.uspto.gov/>

For general and other useful information about trademarks, you are encouraged to visit the Office's web site at <http://www.uspto.gov/main/trademarks.htm>

FOR INQUIRIES OR QUESTIONS ABOUT THIS OFFICE ACTION, PLEASE CONTACT THE ASSIGNED EXAMINING ATTORNEY.

Note:

In order to avoid size limitation constraints on large e-mail messages, this Office Action has been split into 5 smaller e-mail messages. The Office Action in its entirety consists of this message as well as the following attachments that you will receive in separate messages:

Email 1 includes the following 8 attachments

1. 20040430-ooa0002
2. 20040430-ooa0003
3. 20040430-ooa0004
4. 20040430-ooa0005
5. 20040430-ooa0006
6. 20040430-ooa0007
7. 20040430-ooa0008
8. 20040430-ooa0009

Email 2 includes the following 1 attachment

1. 20040430-ooa0010

Email 3 includes the following 1 attachment

1. 20040430-ooa0011

Email 4 includes the following 8 attachments

1. 20040430-ooa0012
2. 20040430-ooa0013
3. 20040430-ooa0014
4. 20040430-ooa0015
5. 20040430-ooa0016
6. 20040430-ooa0017
7. 20040430-ooa0018
8. 20040430-ooa0019

Email 5 includes the following 3 attachments

1. 20040430-ooa0020
2. 20040430-ooa0021
3. 20040430-ooa0022

Please ensure that you receive all of the aforementioned attachments, and if you do not, please contact the assigned-examining attorney.

