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Subject: U.S. TRADEMARK APPLICATION NO. 86542301 - THE ART OF VAPE - N/A - EXAMINER BRIEF

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**UNITED STATES PATENT AND TRADEMARK OFFICE  
(USPTO)**

**U.S. APPLICATION SERIAL NO.** 86542301

**MARK:** THE ART OF VAPE



**CORRESPONDENT ADDRESS:**

GENE BOLMARCICH

Law Offices Of Gene Bolmarcich

215 Sterling Dr

Newington, CT 06111-2261

**GENERAL TRADEMARK INFORMATION:**

<http://www.uspto.gov/trademarks/index.jsp>

**TTAB INFORMATION:**

<http://www.uspto.gov/trademarks/process/appeal/index.jsp>

**APPLICANT:** Art of Vape, LLC, The

**CORRESPONDENT'S REFERENCE/DOCKET NO:**

N/A

**CORRESPONDENT E-MAIL ADDRESS:**

gxbesq1@gmail.com

**EXAMINING ATTORNEY'S APPEAL BRIEF**

The Applicant, Art of Vape, LLC (hereinafter "Art of Vape" or "Applicant"), has appealed the Trademark Examining Attorney's final refusal to register the proposed trademark "THE ART OF VAPE" (with design) under Section 2(d) of the Trademark Act of 1946 (as amended), 15 U.S.C. §1052(d), based

on a likelihood of confusion between the Applicant's mark and U.S. Registration No. 4743056 for "THE ART OF VAPOR."

### **FACTS**

Art of Vape, LLC filed an application under Trademark Act Section 1(a) to register the proposed mark "THE ART OF VAPE" (with design) on the Principal Register for "On-line retail store services featuring high-end vaping products, namely mechanical mods, juices, silica wicks, and drip-tips; On-line wholesale and retail store services featuring high-end vaping products, namely mechanical mods, juices, silica wicks, and drip-tips; The bringing together, for the benefit of others, of a variety of goods, enabling customers to conveniently view and purchase those goods in the field of high-end vaping products, namely mechanical mods, juices, silica wicks, and drip-tips; Retail store services featuring high-end vaping products, namely mechanical mods, juices, silica wicks, and drip-tips" in International Class 35. The examining attorney cited a prior pending application (U.S. Application Serial No. 86404621) as a potential bar to registration and required additional information pertaining to marijuana-related goods, a disclaimer of "VAPE," and an amendment to the mark description. The Applicant, in response, provided the requested information, a disclaimer of the term "VAPE," and an amendment to the mark description. At that time, the cited application had matured to a registration. Accordingly, the Examining Attorney refused registration pursuant to Trademark Act Section 2(d), citing likelihood of confusion between Applicant's mark and Registration No. 4743056 for "THE ART OF VAPOR" (standard character mark) for "On-line retail store services featuring e-cigarette products; Retail store services featuring e-cigarette products." The Applicant responded by traversing the Section 2(d) refusal. Unconvinced by the Applicant's arguments, a Final Refusal under Section 2(d) was issued. The Applicant filed a Request for Reconsideration in conjunction with this appeal. The Request for Reconsideration was denied and the appeal continued.

## ISSUE

The sole issue on appeal is whether the Applicant's mark, "THE ART OF VAPE" (with design), so resembles the registered mark "THE ART OF VAPOR" (standard character form), when used in connection with their respective identified services, as to be likely to cause confusion, to cause mistake, or to deceive. Trademark Act §2(d).

## ARGUMENT

The marks of both parties share the dominant wording "THE ART OF" as well as the highly similar terms "VAPE/VAPOR," and the services described in the application and registration are very highly related, such that confusion as to source is likely under Section 2(d) of the Trademark Act.

Trademark Act Section 2(d) bars registration of an applied-for mark that so resembles a registered mark that it is likely a potential consumer would be confused, mistaken, or deceived as to the source of the services of the applicant and registrant. See 15 U.S.C. §1052(d). A determination of likelihood of confusion under Section 2(d) is made on a case-by case basis and the factors set forth in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563, 567 (C.C.P.A. 1973) aid in this determination. *Citigroup Inc. v. Capital City Bank Grp., Inc.*, 637 F.3d 1344, 1349, 98 USPQ2d 1253, 1256 (Fed. Cir. 2011) (citing *On-Line Careline, Inc. v. Am. Online, Inc.*, 229 F.3d 1080, 1085, 56 USPQ2d 1471, 1474 (Fed. Cir. 2000)). Not all the *du Pont* factors, however, are necessarily relevant or of equal weight, and any one of the factors may control in a given case, depending upon the evidence of record. *Citigroup Inc. v. Capital City Bank Grp., Inc.*, 637 F.3d at 1355, 98 USPQ2d at 1260; *In re Majestic Distilling Co.*, 315 F.3d 1311, 1315, 65 USPQ2d 1201, 1204 (Fed. Cir. 2003); see *In re E. I. du Pont de Nemours & Co.*, 476 F.2d at 1361-62, 177 USPQ at 567. In any likelihood of confusion determination, two key considerations are similarity of the marks and similarity or relatedness of the services. *In re Aquamar, Inc.*, 115 USPQ2d 1122, 1126 (TTAB 2015) (citing *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); see TMEP §1207.01. That is, the marks are compared in their entireties for similarities in appearance, sound, connotation, and commercial impression. *In re Viterra Inc.*, 671 F.3d 1358, 1362, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012) (quoting *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563, 567 (C.C.P.A. 1973)); TMEP §1207.01(b)-(b)(v). Additionally, the services are compared to determine whether they are similar or commercially related or travel in the same trade channels. See *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 1369-71, 101 USPQ2d 1713, 1722-23 (Fed. Cir. 2012); *Herbko Int'l, Inc. v. Kappa Books, Inc.*, 308 F.3d 1156, 1165, 64 USPQ2d 1375, 1381 (Fed. Cir. 2002); TMEP §1207.01, (a)(vi).

In this case, the following factors are the most relevant: similarity of the word portions of the marks, the very high degree of relatedness of the services, and similarity of the trade channels of the services. See *In re Viterra Inc.*, 671 F.3d 1358, 1361-62, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012); *In re Dakin's Miniatures Inc.*, 59 USPQ2d 1593, 1595-96 (TTAB 1999); TMEP §§1207.01 *et seq.*

1. The Dominant Portions of the Marks of Both Parties are Virtually Identical

Marks are compared in their entireties for similarities in appearance, sound, connotation, and commercial impression. *Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 1321, 110 USPQ2d 1157, 1160 (Fed. Cir. 2014) (quoting *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 1371, 73 USPQ2d 1689, 1691 (Fed. Cir. 2005)); TMEP §1207.01(b)-(b)(v). "Similarity in any one of these elements may be sufficient to find the marks confusingly similar." *In re Davia*, 110 USPQ2d 1810, 1812 (TTAB 2014) (citing *In re 1st USA Realty Prof'ls, Inc.*, 84 USPQ2d 1581, 1586 (TTAB 2007)); *In re White Swan Ltd.*, 8 USPQ2d 1534, 1535 (TTAB 1988)); TMEP §1207.01(b). Marks may be confusingly similar in appearance where similar terms or phrases or similar parts of terms or phrases appear in the compared marks and create a similar overall commercial impression. See

*Crocker Nat'l Bank v. Canadian Imperial Bank of Commerce*, 228 USPQ 689, 690-91 (TTAB 1986), *aff'd sub nom. Canadian Imperial Bank of Commerce v. Wells Fargo Bank, Nat'l Ass'n*, 811 F.2d 1490, 1495, 1 USPQ2d 1813, 1817 (Fed. Cir. 1987) (finding COMMCASH and COMMUNICASH confusingly similar); *In re Corning Glass Works*, 229 USPQ 65, 66 (TTAB 1985) (finding CONFIRM and CONFIRMCELLS confusingly similar); *In re Pellerin Milnor Corp.*, 221 USPQ 558, 560 (TTAB 1983) (finding MILTRON and MILLTRONICS confusingly similar); TMEP §1207.01(b)(ii)-(iii). Additionally, consumers are generally more inclined to focus on the first word, prefix, or syllable in any trademark or service mark. *See Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F. 3d 1369, 1372, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005); *Presto Prods., Inc. v. Nice-Pak Prods., Inc.*, 9 USPQ2d 1895, 1897 (TTAB 1988) (“it is often the first part of a mark which is most likely to be impressed upon the mind of a purchaser and remembered” when making purchasing decisions).

In the instant case, the marks of both parties share the distinctive first three terms “THE ART OF,” with the Applicant adding the disclaimed term “VAPE” and the Registrant adding the highly similar and descriptive term “VAPOR.” Although marks are compared in their entireties, one feature of a mark may be more significant or dominant in creating a commercial impression. *See In re Viterra Inc.*, 671 F.3d 1358, 1362, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012); *In re Nat'l Data Corp.*, 753 F.2d 1056, 1058, 224 USPQ 749, 751 (Fed. Cir. 1985); TMEP §1207.01(b)(viii), (c)(ii). Disclaimed matter, and matter that is descriptive of a party's services, is typically less significant or less dominant when comparing marks. *See In re Dixie Rests., Inc.*, 105 F.3d 1405, 1407, 41 USPQ2d 1531, 1533-34 (Fed. Cir. 1997); *In re Nat'l Data Corp.*, 753 F.2d at 1060, 224 USPQ at 752; TMEP §1207.01(b)(viii), (c)(ii).

The Applicant's mark also contains stylized wording with an Omega inside of the letter “P” in “VAPE.” However, it is well established that when a mark consists of a word portion and a design portion, the word portion may be more likely to be impressed upon a purchaser's memory and to be

used when requesting the services. *Joel Gott Wines, LLC v. Rehoboth Von Gott, Inc.*, 107 USPQ2d 1424, 1431 (TTAB 2013) (citing *In re Dakin's Miniatures, Inc.*, 59 USPQ2d 1593, 1596 (TTAB 1999)); TMEP §1207.01(c)(ii); see *In re Viterra Inc.*, 671 F.3d 1358, 1362, 101 USPQ2d 1905, 1908, 1911 (Fed. Cir. 2012) (citing *CBS Inc. v. Morrow*, 708 F.2d 1579, 1581-82, 218 USPQ 198, 200 (Fed. Cir 1983)). Thus, although such marks must be compared in their entireties, the word portion is often considered the dominant feature and is accorded greater weight in determining whether marks are confusingly similar, even where the word portion has been disclaimed. *In re Viterra Inc.*, 671 F.3d at 1366, 101 USPQ2d at 1911 (Fed. Cir. 2012) (citing *Giant Food, Inc. v. Nation's Foodservice, Inc.*, 710 F.2d 1565, 1570-71, 218 USPQ2d 390, 395 (Fed. Cir. 1983)). Likewise, a mark in standard characters, like the Registrant's, may be displayed in any lettering style; the rights reside in the wording or other literal element and not in any particular display or rendition. See *In re Viterra Inc.*, 671 F.3d 1358, 1363, 101 USPQ2d 1905, 1909 (Fed. Cir. 2012); *In re Mighty Leaf Tea*, 601 F.3d 1342, 1348, 94 USPQ2d 1257, 1260 (Fed. Cir. 2010); 37 C.F.R. §2.52(a); TMEP §1207.01(c)(iii). Thus, a mark presented in stylized characters and/or with a design element generally will not avoid likelihood of confusion with a mark in standard characters because the marks could be presented in the same manner of display. See, e.g., *In re Viterra Inc.*, 671 F.3d at 1363, 101 USPQ2d at 1909; *Squirtco v. Tomy Corp.*, 697 F.2d 1038, 1041, 216 USPQ 937, 939 (Fed. Cir. 1983) (stating that "the argument concerning a difference in type style is not viable where one party asserts rights in no particular display").

The Applicant argues that the wording "THE ART OF" is a very common formative in trademarks for retail services, such that consumers would not judge the marks of these two parties to be similar based on their shared use of "THE ART OF."<sup>1</sup> However, the marks also share the highly similar terms "VAPE" and "VAPOR," which have the same commercial connotation, namely, they refer to devices for

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<sup>1</sup> See Applicant's Brief at 3.

converting water or medicated liquid into a vapor for inhalation, i.e., e-cigarettes and vaporizers.<sup>2</sup> The result is that the word portions of both marks give virtually identical commercial impressions in appearance, sound, and connotation, such that the addition of a design element does not obviate the similarity of the marks in this case. See *In re Shell Oil Co.*, 992 F.2d 1204, 1206, 26 USPQ2d 1687, 1688 (Fed. Cir. 1993); TMEP §1207.01(c)(ii). Furthermore, the weakness or dilution of a particular mark is generally determined in the context of the number and nature of similar marks in use in the marketplace in connection with similar services. See *Nat'l Cable Tel. Ass'n, Inc. v. Am. Cinema Editors, Inc.*, 937 F.2d 1572, 1579-80, 19 USPQ2d 1424, 1430 (Fed. Cir. 1991); *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563, 567 (C.C.P.A. 1973). Although many other marks in the retail services field may use the wording "THE ART OF," the Applicant and the Registrant are the only two entities combining that wording with the terms "VAPE"/"VAPOR," thus making it difficult for consumers to distinguish the very slight difference in wording between the marks. Consumer confusion has been held likely for marks that do not physically sound or look alike but that convey the same idea, stimulate the same mental reaction, or may have the same overall meaning. *Proctor & Gamble Co. v. Conway*, 419 F.2d 1332, 1336, 164 USPQ 301, 304 (C.C.P.A. 1970) (holding MISTER STAIN likely to be confused with MR. CLEAN on competing cleaning products); see *In re M. Serman & Co.*, 223 USPQ 52, 53 (TTAB 1984) (holding CITY WOMAN for ladies' blouses likely to be confused with CITY GIRL for a variety of female clothing); *H. Sichel Sohne, GmbH v. John Gross & Co.*, 204 USPQ 257, 260-61 (TTAB 1979) (holding BLUE NUN for wines likely to be confused with BLUE CHAPEL for the same goods); *Ralston Purina Co. v. Old Ranchers Canning Co.*, 199 USPQ 125, 128 (TTAB 1978) (holding TUNA O' THE FARM for canned chicken likely to be confused with CHICKEN OF THE SEA for canned tuna); *Downtowner Corp. v. Uptowner Inns, Inc.*, 178 USPQ 105, 109 (TTAB 1973) (holding UPTOWNER for motor inn and restaurant services likely to

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<sup>2</sup> See Outgoing Office Actions of July 9, 2015 and August 18, 2015.

be confused with DOWNTOWNER for the same services); TMEP §1207.01(b). However, in this case, not only do the marks look and sound alike, they have virtually identical meanings.

Likewise, the fact that the terms “VAPE” and “VAPOR” are highly descriptive of the services also does not obviate the similarity of the marks.<sup>3</sup> Marks must be considered in their entireties; therefore, a disclaimer does not remove the disclaimed portion from the mark for the purposes of comparing marks in a likelihood of confusion determination. *Midwestern Pet Foods, Inc. v. Societe des Produits Nestle S.A.*, 685 F.3d 1046, 1053, 103 USPQ2d 1435, 1440 (Fed. Cir. 2012); *In re Iolo Techs., LLC*, 95 USPQ2d 1498, 1499 (TTAB 2010). The public is generally not aware of disclaimers in trademark applications and registrations that reside only in the USPTO’s records. *See In re Nat’l Data Corp.*, 753 F.2d 1056, 1059, 224 USPQ 749, 751 (Fed. Cir. 1985). Marks must be considered in their entireties; therefore, a disclaimer does not remove the disclaimed portion from the mark for the purposes of comparing marks in a likelihood of confusion determination. *Midwestern Pet Foods, Inc. v. Societe des Produits Nestle S.A.*, 685 F.3d 1046, 1053, 103 USPQ2d 1435, 1440 (Fed. Cir. 2012); *In re Iolo Techs., LLC*, 95 USPQ2d 1498, 1499 (TTAB 2010). The public is generally not aware of disclaimers in trademark applications and registrations that reside only in the USPTO’s records. *See In re Nat’l Data Corp.*, 753 F.2d 1056, 1059, 224 USPQ 749, 751 (Fed. Cir. 1985).

The Applicant also argues that the latitude given to standard character marks in how they may be depicted is not broad enough to extend to its own stylized mark.<sup>4</sup> However, as previously stated, the rights in a standard character mark reside in the wording or other literal element and not in any particular display or rendition. *See In re Viterra Inc.*, 671 F.3d 1358, 1363, 101 USPQ2d 1905, 1909 (Fed. Cir. 2012); *In re Mighty Leaf Tea*, 601 F.3d 1342, 1348, 94 USPQ2d 1257, 1260 (Fed. Cir. 2010); 37 C.F.R. §2.52(a); TMEP §1207.01(c)(iii). Here, the Applicant’s mark is not so stylized that the wording itself is

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<sup>3</sup> See Applicant’s Brief at 4.

<sup>4</sup> *Id.*

unrecognizable as compared to the Registrant's standard characters mark, and the Applicant's use of an Omega in the letter "P" in "VAPE" does not hinder the consumer's ability to read and understand the wording in the mark. Additionally, the two horizontal lines in the Applicant's mark simply serve to frame the dominant wording "THE ART OF VAPE" and do not obviate the similarity between the marks. When comparing marks, the test is not whether the marks can be distinguished in a side-by-side comparison, but rather whether the marks are sufficiently similar in terms of their overall commercial impression that confusion as to the source of the services offered under the respective marks is likely to result. *Midwestern Pet Foods, Inc. v. Societe des Produits Nestle S.A.*, 685 F.3d 1046, 1053, 103 USPQ2d 1435, 1440 (Fed. Cir. 2012); *In re Davia*, 110 USPQ2d 1810, 1813 (TTAB 2014); TMEP §1207.01(b). The proper focus is on the recollection of the average purchaser, who retains a general rather than specific impression of trademarks. *United Global Media Grp., Inc. v. Tseng*, 112 USPQ2d 1039, 1049, (TTAB 2014); *L'Oreal S.A. v. Marcon*, 102 USPQ2d 1434, 1438 (TTAB 2012); TMEP §1207.01(b).

Finally, where the services of an applicant and registrant are "similar in kind and/or closely related," as discussed below, the degree of similarity between the marks required to support a finding of likelihood of confusion is not as great as in the case of diverse services. *In re J.M. Originals Inc.*, 6 USPQ2d 1393, 1394 (TTAB 1987); see *Shen Mfg. Co. v. Ritz Hotel Ltd.*, 393 F.3d 1238, 1242, 73 USPQ2d 1350, 1354 (Fed. Cir. 2004); TMEP §1207.01(b). Accordingly, the slight differences between the terms "VAPE" and "VAPOR," and the Applicant's addition of an Omega and two non-distinctive horizontal line designs are even less significant in affecting a likelihood of confusion by consumers.

## 2. Applicant's Services are Highly Related and Similar to the Registrant's Services

The services of the parties need not be identical or even competitive to find a likelihood of confusion. See *On-line Careline Inc. v. Am. Online Inc.*, 229 F.3d 1080, 1086, 56 USPQ2d 1471, 1475 (Fed. Cir. 2000); *Recot, Inc. v. Becton*, 214 F.3d 1322, 1329, 54 USPQ2d 1894, 1898 (Fed. Cir. 2000) ("[E]ven if

the goods in question are different from, and thus not related to, one another in kind, the same goods can be related in the mind of the consuming public as to the origin of the goods.”); TMEP §1207.01(a)(i). The respective services need only be “related in some manner and/or if the circumstances surrounding their marketing [be] such that they could give rise to the mistaken belief that [the goods and/or services] emanate from the same source.” *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 1369, 101 USPQ2d 1713, 1722 (Fed. Cir. 2012) (quoting *7-Eleven Inc. v. Wechsler*, 83 USPQ2d 1715, 1724 (TTAB 2007)); TMEP §1207.01(a)(i).

Here, applicant’s services, namely, “On-line retail store services featuring high-end vaping products, namely, mechanical mods, juices, silica wicks, and drip-tips; On-line wholesale and retail store services featuring high-end vaping products, namely, mechanical mods, juices, silica wicks, and drip-tips; Retail store services featuring high-end vaping products, namely, mechanical mods, juices, silica wicks, and drip-tips; The bringing together, for the benefit of others, of a variety of goods, enabling customers to conveniently view and purchase those goods in the field of high-end vaping products, namely, mechanical mods, juices, silica wicks, and drip-tips” are highly related to the registrant’s services, namely, “On-line retail store services featuring e-cigarette products; Retail store services featuring e-cigarette products” because the services of both parties consist of retail store services in the field of electronic cigarettes and vaping products. Accordingly, the services of both parties travel in the same channels of trade to the same consumers, such that confusion as to source is likely.

Furthermore, with respect to applicant’s and registrant’s services, the question of likelihood of confusion is determined based on the description of the services stated in the application and registration at issue, not on extrinsic evidence of actual use. *See Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 1323, 110 USPQ2d 1157, 1162 (Fed. Cir. 2014) (quoting *Octocom Sys. Inc. v. Hous. Computers Servs. Inc.*, 918 F.2d 937, 942, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990)). Absent

restrictions in an application and/or registration, the identified services are “presumed to travel in the same channels of trade to the same class of purchasers.” *In re Viterra Inc.*, 671 F.3d 1358, 1362, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012) (quoting *Hewlett-Packard Co. v. Packard Press, Inc.*, 281 F.3d 1261, 1268, 62 USPQ2d 1001, 1005 (Fed. Cir. 2002)). Additionally, unrestricted and broad identifications are presumed to encompass all services of the type described. See *In re Jump Designs, LLC*, 80 USPQ2d 1370, 1374 (TTAB 2006) (citing *In re Elbaum*, 211 USPQ 639, 640 (TTAB 1981)); *In re Linkvest S.A.*, 24 USPQ2d 1716, 1716 (TTAB 1992).

In this case, the identification set forth in the application and registration has no restrictions as to nature, type, channels of trade, or classes of purchasers. Therefore, it is presumed that these services travel in all normal channels of trade, and are available to the same class of purchasers. Further, the registration uses broad wording to describe the type of “e-cigarette products” featured in its online retail stores and this wording is presumed to encompass all goods of the type described, including those in applicant’s more narrow identification of the types of e-cigarette/vaporizer-related goods featured in its stores.

The applicant has not made any arguments in its Appeal Brief or in either of its responses of July 26, 2015 and September 15, 2015 against the examining attorney’s finding that the services of both parties are highly similar.

#### **CONCLUSION**

For the foregoing reasons, Applicant’s mark is likely to cause confusion with the mark in U.S. Registration No. 4743056. Therefore, the Examining Attorney respectfully requests that the refusal to register under Trademark Act Section 2(d), 15 U.S.C. §1502(d), be affirmed.

Respectfully submitted,

/Lindsey H. Ben/

Lindsey H. Ben

Trademark Examining Attorney

Law Office 108

(571) 272-4239

Lindsey.Ben@uspto.gov

Andrew Lawrence

Managing Attorney

Law Office 108