

This Opinion is not a
Precedent of the TTAB

Mailed: March 23, 2016

UNITED STATES PATENT AND TRADEMARK OFFICE

—
Trademark Trial and Appeal Board
—

In re The Art of the Vape, LLC
—

Serial No. 86542301
—

Gene Bolmarcich of Law Offices of Gene Bolmarcich,
for The Art of the Vape, LLC.

Lindsey Ben, Trademark Examining Attorney, Law Office 108,
Andrew Lawrence, Managing Attorney.

—
Before Taylor, Ritchie and Pologeorgis,
Administrative Trademark Judges.

Opinion by Taylor, Administrative Trademark Judge:

The Art of the Vape, LLC (“Applicant”) seeks registration on the Principal
Register of the mark shown below 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; 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 in International Class 35.¹



At the request of the Trademark Examining Attorney (“Examining Attorney”), Applicant disclaimed “VAPE” apart from the mark as shown. The application also includes the following description (as amended): “The mark consists of the wording ‘THE ART OF VAPE’, with an Omega within the letter “P” and two horizontal lines on top of and below the wording.”

The Examining Attorney has refused registration of Applicant’s mark under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), based on a likelihood of confusion between Applicant’s mark and the mark in U.S. Registration No. 4743056, THE ART OF VAPOR (in standard character format), for services identified as “[o]n-line retail store services featuring e-cigarette products; [and r]etail store services featuring e-cigarette products” in International Class 35.²

When the refusal was made final, Applicant appealed and requested reconsideration. After the Examining Attorney denied the request for reconsideration, the appeal was resumed. We affirm the refusal to register.

¹ Application Serial No. 86542301 was filed on February 23, 2015, based upon Applicant’s claim of first use anywhere and use in commerce since at least as early as April 4, 2014.

² Issued May 26, 2015 on the Principal Register.

Our determination under Section 2(d) is based on an analysis of all of the facts in evidence that are relevant to the factors bearing on the likelihood of confusion issue. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods and/or services. *See Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976).

We first address the *du Pont* factor concerning the relatedness of the services and compare Applicant's "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; [and] 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" with the services identified in the cited registration, i.e., "on-line retail store services featuring e-cigarette products; retail store services featuring e-cigarette products." As explained in the Wikipedia entry for an "electronic cigarette" made of record in the Examining Attorney's Final Office Action dated January 20, 2014 (emphasis deleted),³

³ http://en.wikipedia.org/wiki/Electronic_cigarette, 4 TSDR 33.

An electronic cigarette (or e-cigarette), electronic vaping device, personal vaporizer (PV), or electronic nicotine delivery system (ENDS) ... is a battery-powered device which simulates tobacco smoking. It generally uses a heating element that vaporizes a liquid solution. ... Many are designed to simulate smoking implements, such as cigarettes or cigars, in their use and/or appearance, which others are considerably different in appearance.

This definition demonstrates that Registrant's broadly worded on-line retail and retail store services featuring e-cigarette products encompass Applicant's more narrowly identified on-line retail and retail store services featuring high-end vaping products, namely, mechanical mods, juices, silica wicks, and drip-tips. Thus, for purposes of our likelihood of confusion analysis, we find the respective services in-part legally identical.⁴ *In re Jump Designs*, 80 USPQ2d 1370, 1374 (TTAB 2006) ("Registrant's furniture is not limited in any way as to nature, type, use or purpose and, thus, is broad enough to encompass the type of furniture sold by applicant. When construed as such, the goods are, in part, legally identical."). Moreover, because the parties' respective services are, in part, legally identical, and given the absence of legally effective restrictions in the application, we must presume that they would be offered in the same trade channels for such services, e.g., online and brick and mortar

⁴ In addition, all of the services identified in the application are classified in International Class 35. As such, the Examining Attorney need not prove, and we need not find, similarity as to each and every service listed in Applicant's recitation of services. It is sufficient for a refusal based on likelihood of confusion that relatedness is established for any service encompassed by the recitation of services in a particular class. *Tuxedo Monopoly, Inc. v. General Mills Fun Group*, 648 F.2d 1335, 209 USPQ 986, 988 (CCPA 1981); *Inter IKEA Sys. B.V. v. Akea, LLC*, 110 USPQ2d 1734, 1745 (TTAB 2014); *General Mills Inc. v. Fage Dairy Processing Industry SA*, 100 USPQ2d 1584, 1588 n.1 (TTAB 2011), *judgment set aside on other grounds*, 2014 WL 343267 (TTAB Jan. 22, 2014); *Apple Computer v. TVNET.Net, Inc.*, 90 USPQ2d 1393, 1397 (TTAB 2007).

establishments, and to the same classes of purchasers, including ordinary consumers that use vapor implements. *See In re Yawata Iron & Steel Co.*, 403 F.2d 752, 159 USPQ 721, 723 (CCPA 1968) (where there are legally identical goods, the channels of trade and classes of purchasers are considered to be the same); *American Lebanese Syrian Associated Charities Inc. v. Child Health Research Institute*, 101 USPQ2d 1022, 1028 (TTAB 2011). *See also In re Viterra Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012) (even though there was no evidence regarding channels of trade and classes of consumers, the Board was entitled to rely on this legal presumption in determining likelihood of confusion).

The in-part identity of Applicant's and Registrants' services, as well as the presumed overlap in trade channels and purchasers, are factors that weigh heavily in favor of finding a likelihood of confusion. We note that Applicant did not dispute this conclusion. Indeed, it did not even address the relatedness of the services, channels of trade or classes of purchasers in its appeal briefing.

We now turn to the *du Pont* likelihood of confusion factor focusing on the similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression. *E. I. du Pont de Nemours*, 177 USPQ at 567. In a particular case, "two marks may be found to be confusingly similar if there are sufficient similarities in terms of sound *or* visual appearance *or* connotation." *Kabushiki Kaisha Hattori Seiko v. Satellite Int'l, Ltd.*, 29 USPQ2d 1317, 1318 (TTAB 1991, *aff'd without opinion*, 979 F.2d 216 (Fed. Cir. 1992) (emphasis in the original; citation omitted). *See also Eveready Battery Co. v. Green Planet Inc.*, 91 USPQ2d

1511, 1519 (TTAB 2009), *citing Krim-Ko Corp. v. The Coca-Cola Co.*, 390 F.2d 728, 156 USPQ 523, 526 (CCPA 1968) (“It is sufficient if the similarity in either form, spelling or sound alone is likely to cause confusion.”).

In comparing the marks, we are mindful that where, as here, the services are identical in part, the degree of similarity necessary to find likelihood of confusion need not be as great as where there is a recognizable disparity between the services. *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1721 (Fed. Cir. 2012); *Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992); *Jansen Enterprises Inc. v. Rind*, 85 USPQ2d 1104, 1108 (TTAB 2007); *Schering-Plough HealthCare Products Inc. v. Ing-Jing Huang*, 84 USPQ2d 1323, 1325 (TTAB 2007).

“The proper test is not a side-by-side comparison of the marks, but instead ‘whether the marks are sufficiently similar in terms of their commercial impression’ such that persons who encounter the marks would be likely to assume a connection between the parties.” *Coach Servs. Inc. v. Triumph Learning LLC*, 101 USPQ2d at 1721. *See also San Fernando Electric Mfg. Co. v. JFD Electronics Components Corp.*, 565 F.2d 683, 196 USPQ 1, 3 (CCPA 1977); *Spoons Restaurants Inc. v. Morrison Inc.*, 23 USPQ2d 1735, 1741 (TTAB 1991), *aff’d mem.*, 972 F.2d 1353 (Fed. Cir. June 5, 1992). The proper focus is on the recollection of the average customer, who retains a general rather than specific impression of the marks. *L’Oreal S.A. v. Marcon*, 102 USPQ2d 1434, 1438 (TTAB 2012); *Winnebago Industries, Inc. v. Oliver & Winston*,

Inc., 207 USPQ 335, 344 (TTAB 1980); *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106, 108 (TTAB 1975).



With these principles in mind, we compare Applicant's mark  with the cited registered standard character mark, THE ART OF VAPOR and find them substantially similar in appearance, sound, connotation and commercial impression. Both marks consist of four words, the first three of which are the identical wording "THE ART OF" and the last word in each consisting of a formative of VAPE, i.e., VAPE/VAPOR. Although the terms VAPE and VAPOR differ in their endings, this difference may not be noticed, particularly when the two marks are not viewed next to one another. In any case, the slight difference in last terms does not serve to sufficiently distinguish the two marks in terms of appearance and sound, nor does it change the overall connotation of the marks when viewed in connection with in-part identical services. As demonstrated by the evidence of record, both the terms VAPE and VAPOR refer to electronic cigarettes and other vaping paraphernalia, such that the marks engender the same connotation and commercial impression related to retail sales of vaping products. While, as Applicant points out, the word VAPE has been disclaimed in Applicant's application, it nonetheless must be considered when comparing the marks as a whole for purposes likelihood of confusion. *See In re Shell Oil Co.*, 992 F.2d 1204, 26 USPQ2d 1687, 1689 (Fed. Cir. 1993) *citing In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 750-751 (Fed. Cir. 1985) ("The technicality of a disclaimer ... has no legal effect on the issue of likelihood of confusion.").

We also find the stylization of the lettering in Applicant's mark not to be distinguishing. Because the cited mark is presented in standard characters, Registrant is not limited to any particular depiction of its mark. Thus, Registrant is entitled to all depictions of its standard character mark regardless of the font style, size, or color; Registrant's mark could at any time be displayed in a manner similar to Applicant's mark, that is, the terminology THE ART OF VAPOR could be displayed in the same font style and size. *In re Viterra*, 101 USPQ2d at 1909-10; *Citigroup Inc. v. Capital City Bank Group, Inc.*, 637 F.3d 1344, 98 USPQ2d 1253, 1259 (Fed. Cir. 2011). *See Squirrtco v. Tomy Corp.*, 697 F.2d 1038, 216 USPQ 937, 939 (Fed. Cir. 1983) (rejecting argument that a mark in standard character format (typed) is distinct from a mark in a logo format; “[b]y presenting its mark in a typed drawing, a *difference* cannot legally be asserted by that party”) (emphasis in original).

With particular regard to the Greek letter omega, Ω, appearing within the letter “P” in the word VAPE in Applicant's mark, given its placement within the letter “P,” it does not appear to be dominant. Furthermore, it is settled that with a composite mark comprising a design and words, the word portion of the mark is usually the one most likely to indicate the origin of the services to which it is affixed. *CBS, Inc. v. Morrow*, 708 F.2d 1579, 218 USPQ 198, 200 (Fed. Cir. 1983); *In re Dakin's Miniatures, Inc.*, 59 USPQ2d 1593, 1596 (TTAB 2001) (“In the case of marks which consist of words and a design, words are normally accorded greater weight because they would be used by purchasers to request the goods [or services].”); *In re Nat'l Data Corp.*, 753

F.2d at 1056. Similarly, the horizontal lines at the top and bottom of Applicant's mark are unlikely to indicate the source of Applicant's services.

In sum, although we recognize that Applicant's mark and the cited mark have certain differences when viewed on a side-by-side basis, when we compare them in their entireties we find that, on the whole, they are similar in appearance, sound, meaning and commercial impression. Accordingly, the *du Pont* factor of the similarity of the marks favors a finding of likelihood of confusion.

Applicant also argues the marks are not similar due to the weakness of the cited mark based on the descriptiveness of the respective terms VAPE and VAPOR, and that the wording "THE ART OF" is commonplace for trademarks associated with retail stores. Applicant, citing to *Juice Generation v. GS Enterprises LLC*, 115 USPQ2d 1671 (Fed. Cir. 2015), has made of record various use-based third-party registrations for marks that comprise the term "THE ART OF" in combination with other matter, arguing that that term is a very common formative in trademarks for retail services, and that alone is evidence that consumers would not judge two marks to be similar based on their shared use of "THE ART OF." These registrations include:⁵ Registration No. 4055637 (THE ART OF SCRAPBOOKING for retail services featuring supplies accessories for scrapbooking); Registration No. 4087736 (THE ART OF MARKETING SCIENCE for retail services featuring advertising and marketing services); Registration No. 4369434 (THE ART OF CONSCIOUS LIVING for, *inter*

⁵ Only the text of the stylized marks and/or those including a design element have been listed.

alia, retail services featuring products and services in the fields of holistic health, wellness, spa products, diet and lifestyle choices); Registration No. 4288118 (MASTERING THE ART OF INNOVATION for, *inter alia*, computerized on-line ordering services in the field of imprinted promotional products, apparel, signs, auto vinyl); Registration No. 4373741 (THE ART OF DELIGHT for, *inter alia*, on-line retail store services featuring clothes, furniture and bed and bath products); Registration No. 4433807 (THE ART OF WINNING for, *inter alia*, retail store services featuring eyewear); Registration No. 4376219 (THE ART OF HEALTHY EATING for retail grocery stores); Registration No. 4465357 (EARTH ELEMENTS THE ART OF TILE & STONE for, *inter alia*, retail store services featuring cabinets, sinks, faucets and hardware for kitchens and bathrooms, glass tile, ceramic tile for flooring); Registration No. 4477601 (THE ART OF SLOBOT for, *inter alia*, online retail store services featuring robot sculptures, robot art, robot toys, paintings and collectibles); Registration No. 4584119 (THE ART OF FRENCH LIVING for, *inter alia*, retail store services featuring French home furniture and furnishings); Registration No. 4597297 (MAISON DE FRANCE est. 1996 THE ART OF FRENCH LIVING for, *inter alia*, retail store services featuring French home furniture and furnishings);⁶ Registration No. 4555862 (EARTHEN ARTISIAN HOUSE NURTURING THE ART OF BEING UNIQUE for retail store services featuring gourmet food and beverages, kitchen and dining items, and interior design and home furnishings); Registration No. 4655384 (OLIVELLE THE ART OF FLAVOR for, *inter*

⁶ Registration Nos. 4584119 and 4597297 are owned by the same entity.

alia, retail store services featuring gifts, foodstuffs, kitchen utensils and ceramics); Registration No. 4747951 (THE ART OF SABRAGE for on-line retail store services featuring food and beverage tools); Registration No. 2108970⁷ (THE ART OF SHAVING for retail store services in the field of men's and women's grooming products); Registration No. 2531747 (THE ART OF FOOD for retail grocery store services); Registration No. 3421931 (TIME FOR ME DEDICATED TO THE ART OF WELL-BEING for, *inter alia*, direct response retail services by means of print advertisements in the fields of women's clothing and general merchandise); Registration No. 3814931 (THE ART OF LIVING GREEN for retail shop-at-home party services in the field of environmentally sensitive home care products); Registration No. 3724254 (THE ART OF PRECIOUS DIAMONDS for, *inter alia*, retail store services in the field of precious metals and their alloys, jewelry and imitation jewelry); Registration No. 3842380 (THE ART OF HISTORIC PHOTOS for, *inter alia*, retail store services featuring historic photographs and prints); Registration No. 3804165 (THE ART OF DISPENSING for, *inter alia*, online retail and retail store services featuring adhesive dispensing systems, products, machines and accessories); Registration No. 3676259 (BEAUTY COLLECTION CURATORS IN THE ART OF BEAUTIFUL for, *inter alia*, retail store services featuring cosmetic, health and beauty aids, accessories and tools, and perfumes); Registration No. 3887150 (THE ART OF PROTECTION for online retail store services featuring carrying cases for portable devices); Registration No. 3855471 (REFINING THE ART

⁷ Applicant submitted a duplicate copy of this registration; only one has been considered.

OF CAREGIVING for, *inter alia*, institutional retail pharmacy services); Registration No. 3077427 (THE ART OF PRECISION DESIGN for, *inter alia*, retail distributorship featuring jewelry); Registration No. 3008641 (THE ART OF ROCK & ROLL for, *inter alia*, retail gift shop services); Registration No. 3107800 (TIME FOR ME DEDICATED TO THE ART OF WELL-BEING for, *inter alia*, direct response retail services by means of print advertisements in the fields of vitamins and minerals supplements);⁸ Registration No. 3130888 (THE ART OF FRESHER FLOWERS for on-line retail store services featuring flowers, plants and bulbs and gourmet foods, gift baskets, wreathes, balloons, vases and stuffed animals); Registration No. 4000507 (TRIBU THE ART OF LEISURE for, *inter alia*, retail store services featuring indoor and outdoor furniture); Registration No. 4437966 (TORQUE THE ART OF MOVEMENT AND SUPPLY for, *inter alia*, services related to the processing of sales and purchase orders); Registration No. 3961008 (THE ART OF PERCEPTION for advertising and marketing related services); and Registration No. 4025766 (THE ART OF NOISE for retail store services featuring artwork and consumer electronics).

The above-listed third-party registrations, however, do not persuade us that the cited mark is so weak due to common usage of the phrase “THE ART OF” that confusion is not likely between it and Applicant’s mark. Despite the apparent common use of the wording “THE ART OF” in marks for “retail store services,” with its somewhat suggestive connotation, none of the recitations of services in those third-

⁸ Registration Nos. 3421931 and 3107800 are owned by the same entity.

party registrations are for retail store services featuring vaping or other related products. Nor are any of the third-party trademarks as similar to the cited mark as is Applicant's mark or, for that matter, are any of those registered marks similar to one another. Moreover, it is well established that third-party registrations do not justify the registration of a mark that is likely to cause confusion with a previously registered mark. *See In re Max Capital Group Ltd.*, 93 USPQ2d 1243, 1248 (TTAB 2010). As the Board stated in *In re Chica Inc.*, 84 USPQ2d 1845, 1849 (TTAB 2007):

[A]n applicant does not overcome a likelihood of confusion refusal by pointing to other registrations and arguing that they are as similar to the cited registration as applicant's mark. While third-party registrations may be used to demonstrate that a portion of a mark is suggestive or descriptive, they "cannot justify the registration of another confusingly similar mark." *In re J.M. Originals Inc.*, 6 USPQ2d 1393, 1394 (TTAB 1987), quoting *Plus Products v. Star-Kist Foods, Inc.*, 220 USPQ 541, 544 (TTAB 1983).

We note, too, that the Board is not bound by the prior decisions of examining attorneys in allowing marks for registration. It is well established that each case must be decided on its own facts. *See In re Nett Designs Inc.*, 236 F.3d 1339, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001) ("Even if some prior registrations had some characteristics similar to [applicant's] application, the PTO's allowance of such prior registrations does not bind the Board or this court."); *In re Merrill Lynch, Pierce, Fenner & Smith Inc.*, 828 F.2d 1567, 4 USPQ2d 1141, 1142 (Fed. Cir. 1987).

For the reasons discussed, we conclude that purchasers familiar with Registrant's THE ART OF VAPOR mark for "on-line retail store services featuring e-cigarette products; [and] retail store services featuring e-cigarette products" would be likely to

believe, upon encountering Applicant's mark  for the recited services, that such goods and services originate from or are sponsored by or are otherwise affiliated with the same source.

Decision: The refusal to register Applicant's mark  is affirmed.