

Request for Reconsideration after Final Action

The table below presents the data as entered.

Input Field	Entered
SERIAL NUMBER	86772769
LAW OFFICE ASSIGNED	LAW OFFICE 108
MARK SECTION	
MARK	http://tmng-al.uspto.gov/resting2/api/img/86772769/large
LITERAL ELEMENT	VAPECON
STANDARD CHARACTERS	YES
USPTO-GENERATED IMAGE	YES
MARK STATEMENT	The mark consists of standard characters, without claim to any particular font style, size or color.
ARGUMENT(S)	
Please see actual argument attached in the Evidence section.	
EVIDENCE SECTION	
EVIDENCE FILE NAME(S)	
ORIGINAL PDF FILE	evi_767924266-20160818212929355480 . Request for Reconsideration VAPECON.pdf
CONVERTED PDF FILE(S) (5 pages)	\\TICRS\EXPORT16\IMAGEOUT16\867\727\86772769\xml11\RFR0002.JPG
	\\TICRS\EXPORT16\IMAGEOUT16\867\727\86772769\xml11\RFR0003.JPG
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DESCRIPTION OF EVIDENCE FILE	actual argument text
CORRESPONDENCE SECTION	
ORIGINAL ADDRESS	ALEX PATEL Patel & Almeida P C 16830 Ventura Blvd Ste 360 Encino California US 91436-1711
NEW CORRESPONDENCE SECTION	
NAME	ALEX PATEL
FIRM NAME	Patel & Almeida P C
STREET	16830 Ventura Blvd Ste 360
CITY	Encino

STATE	California
ZIP/POSTAL CODE	91436-1711
COUNTRY	United States
PHONE	8183801900
EMAIL	Paulo@PatelAlmeida.com;alex@paiplaw.com; nikki@paiplaw.com; inbox@paiplaw.com; gregory@paiplaw.com
AUTHORIZED EMAIL COMMUNICATION	Yes
SIGNATURE SECTION	
RESPONSE SIGNATURE	/Alex Patel/
SIGNATORY'S NAME	Alex Patel
SIGNATORY'S POSITION	Attorney
SIGNATORY'S PHONE NUMBER	8183801900
DATE SIGNED	08/18/2016
AUTHORIZED SIGNATORY	YES
CONCURRENT APPEAL NOTICE FILED	YES
FILING INFORMATION SECTION	
SUBMIT DATE	Thu Aug 18 21:32:23 EDT 2016
TEAS STAMP	USPTO/RFR-XX.XX.XXX.XX-20 160818213223436517-867727 69-5506d5f288b7cf8c06ac6d 436a2c81ebbe2d38c1c748fc0 2f158c6b36dd9656-N/A-N/A- 20160818212929355480

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OMB No. 0651-0050 (Exp 07/31/2017)

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To the Commissioner for Trademarks:

Application serial no. **86772769** VAPECON(Standard Characters, see <http://tmng-al.uspto.gov/resting2/api/img/86772769/large>) has been amended as follows:

ARGUMENT(S)

In response to the substantive refusal(s), please note the following:

Please see actual argument attached in the Evidence section.

EVIDENCE

Evidence in the nature of actual argument text has been attached.

Original PDF file:

[evi_767924266-20160818212929355480_.. Request for Reconsideration VAPECON.pdf](#)

Converted PDF file(s) (5 pages)

[Evidence-1](#)

[Evidence-2](#)

[Evidence-3](#)

[Evidence-4](#)

[Evidence-5](#)

CORRESPONDENCE ADDRESS CHANGE

Applicant proposes to amend the following:

Current:

ALEX PATEL
Patel & Almeida P C
16830 Ventura Blvd Ste 360
Encino
California
US
91436-1711

Proposed:

ALEX PATEL of Patel & Almeida P C, having an address of
16830 Ventura Blvd Ste 360 Encino, California 91436-1711
United States
Paulo@PatelAlmeida.com;alex@paiplaw.com; nikki@paiplaw.com; inbox@paiplaw.com; gregory@paiplaw.com
8183801900

SIGNATURE(S)

Request for Reconsideration Signature

Signature: /Alex Patel/ Date: 08/18/2016

Signatory's Name: Alex Patel

Signatory's Position: Attorney

Signatory's Phone Number: 8183801900

The signatory has confirmed that he/she is an attorney who is a member in good standing of the bar of the highest court of a U.S. state, which includes the District of Columbia, Puerto Rico, and other federal territories and possessions; and he/she is currently the owner's/holder's attorney or an associate thereof; and to the best of his/her knowledge, if prior to his/her appointment another U.S. attorney or a Canadian attorney/agent not currently associated with his/her company/firm previously represented the owner/holder in this matter: (1) the owner/holder has filed or is concurrently filing a signed revocation of or substitute power of attorney with the USPTO; (2) the USPTO has granted the request of the prior representative to withdraw; (3) the owner/holder has filed a power of attorney appointing him/her in this matter; or (4) the owner's/holder's appointed U.S. attorney or Canadian attorney/agent has filed a power of attorney appointing him/her as an associate attorney in this matter.

The applicant is filing a Notice of Appeal in conjunction with this Request for Reconsideration.

Mailing Address: ALEX PATEL

Patel & Almeida P C
16830 Ventura Blvd Ste 360
Encino, California 91436-1711

Serial Number: 86772769

Internet Transmission Date: Thu Aug 18 21:32:23 EDT 2016

TEAS Stamp: USPTO/RFR-XX.XX.XXX.XX-20160818213223436

517-86772769-5506d5f288b7cf8c06ac6d436a2

c81ebbe2d38c1c748fc02f158c6b36dd9656-N/A

-N/A-20160818212929355480

REQUEST FOR RECONSIDERATION

Applicant's mark is VAPECON, U.S. Trademark Application Serial No. 86/772,769, for use in connection with "Arranging and conducting trade show exhibitions and conventions in the field of vaping, vape culture, electronic cigarettes, and smoker's articles and accessories; Organization of exhibitions for musical entertainment; organization of fashion shows and beauty pageants for entertainment purposes; Arranging and conducting competitions for entertainment purposes; providing entertainment and educational information in the field of vaping, vape culture, electronic cigarettes, and smoker's articles and accessories" in International Class 41 ("Applicant's Mark").

Registration of Applicant's Mark was initially refused under Section 2(e)(1), based on a finding that "the applied-for mark merely describes a feature, characteristic or purpose of applicant's services." Office Action Dated February 22, 2016. The Examining Attorney found that "[t]he term 'Vape' means the use of electronic cigarettes or oral smokeless vaporizer devices. It also refers to the devices themselves as well as the accessories therefor, such as the liquid used in such devices" and "[t]he term 'Con' is a commonly used abbreviation for the word 'Convention.'" *Id.* The Examining Attorney concluded that "[i]n this case, both the individual components and the composite result are descriptive of applicant's services and do not create a unique, incongruous, or nondescriptive meaning in relation to the services. Specifically, the combination of VAPE and CON in applicant's mark immediately describes the purpose or subject matter of applicant's convention and trade show." *Id.*

Applicant argued against the Section 2(e)(1) refusal, but the Examining Attorney maintained the refusal and issued a Final Action. Applicant submits this Request for Reconsideration based on the following additional arguments.

I. THE MARK IS NOT MERELY DESCRIPTIVE

A term is merely descriptive if it **immediately** conveys knowledge of a quality, feature, function, or characteristic of the goods or services with which it is used." *In re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009, 1009 (Fed. Cir. 1987). Whether a particular term is merely descriptive is determined in relation to the goods or services for which registration is sought and the context in which the term is used, not in the abstract or on the basis of guesswork. *In re Abcor Development Corp.*, 588 F.2d 811, 200 USPQ 215, 218 (CCPA 1978); *In re Remacle*, 66 USPQ2d 1222, 1224 (TTAB 2002). If the mark suggests information about the goods in a way that requires imagination, thought, or perception to reach a conclusion as to the nature of the goods, it may be registered on the Principal Register. *In re George Weston Ltd.*, 228 USPQ 57 (TTAB 1985).

A. VAPECON is a Unitary Mark with a Bizarre or Incongruous Meaning

The Examining Attorney concedes that Applicant's Mark is unitary. Final Action dated May 6, 2016 ("Applicant has argued that the mark is unitary. On this point the examining attorney is in full agreement."). However, the Examining Attorney disagreed that the unitary mark creates a bizarre or incongruous mark and instead found that the mark is "merely descriptive in the entire unit." Applicant disagrees.

The Board has *consistently* held that a mark comprising of a combination of merely descriptive components is registrable if the combination of terms creates a unitary mark with a unique, non-descriptive meaning, or if the composite has a bizarre or incongruous meaning as applied to the goods. *See In re Colonial Stores Inc.*, 394 F.2d 549, 157 USPQ 382 (C.C.P.A. 1968) (SUGAR & SPICE held not merely descriptive of bakery products); *In re Shutts*, 217 USPQ 363 (TTAB 1983) (SNO-RAKE held not merely descriptive of a snow removal hand

tool); *In re Vienna Sausage Mfg. Co.*, 156 USPQ 155, 156 (TTAB 1967) (FRANKWURST held not merely descriptive for wieners, the Board finding that although "frank" may be synonymous with "wiener," and "wurst" is synonymous with "sausage," the combination of the terms is incongruous and results in a mark that is no more than suggestive of the nature of the goods); *In re John H. Breck, Inc.*, 150 USPQ 397, 398 (TTAB 1966) (TINT TONE held suggestive for hair coloring, the Board finding that the words overlap in significance and their combination is somewhat incongruous or redundant and does not immediately convey the nature of the product); *cf. In re Getz Found.*, 227 USPQ 571, 572 (TTAB 1985) (MOUSE HOUSE held fanciful for museum services featuring mice figurines made up to appear as human beings, the Board finding that the only conceivable meaning of "mouse house," i.e., a building at a zoo in which live and/or stuffed mice are displayed, is incongruous). The Board has noted that the concept of mere descriptiveness "should not penalize coinage of hitherto unused and somewhat incongruous word combinations whose import would not be grasped without some measure of imagination and 'mental pause.'" *In re Shutts*, 217 USPQ at 364–5.

In the Final Action dated May 6, 2016, the Examining Attorney found that:

The "con" suffix does not transform it into a bizarre or incongruous mark. In this case the prefix or initial element is a highly descriptive term for the main subject matter of the trade show, namely, vape equipment and accessories.

However, as a uniquely coined and "hitherto unused" term, VAPECON would be considered a bizarre and incongruous combination to vaping enthusiasts. VAPECON is no less bizarre or incongruous than SNORAKE, TINT TONE, FRANKWURST, MOUSE HOUSE, and SUGAR & SPICE, all of which were held by the Board to be "unitary" marks with unique, nondescriptive meanings. Applicant's mark is not "VAPE CONVENTION" nor does it contain a space between

VAPE and CON. As a unitary, coined term containing no space, VAPECON takes on a unique, incongruous meaning in the context of vaping products.

B. The USPTO Routinely Allows Marks Containing CON Preceded by a Descriptive Term on the Principal Register

Applicant has submitted evidence showing no less than nine (9) registered marks¹ including CON preceded by descriptive terms – all of which were allowed on the Principal Register – but the Examining Attorney curiously disregards all nine (9) as “mistakes.” Final Action dated May 6, 2016 (“While applicant can no doubt point to a few exceptions, the fact that a few marks got registered without a showing of acquired distinctiveness or without a disclaimer of the word “con” does not justify perpetuating mistakes made by prior examiners.”). This argument strains credulity because the vast number of registrations (9) strongly suggests that these types of CON marks are regularly viewed as inherently distinctive by the USPTO and are routinely allowed on the Principal Register. This is not a case where only one or two CON marks were allowed by “mistake.” Tellingly, the USPTO only refused one of the CON marks, FITCON, Reg. No. 4914619, but quickly approved the application upon the applicant’s submission of brief argument on the issue.

The evidence shows these CON marks are considered by the USPTO to be at least suggestive, but not descriptive. For the sake of consistency of examination and fairness to the Applicant, Applicant’s Mark should be given the same consideration with respect to the descriptiveness issue, as was given to the other applicants (now registrants).

¹ **ROLLERCON** (Reg. No. 3989937); **GEEKGIRLCON** (Reg. No. 4209562); **COOKIECON** (Reg. No. 4371914); **MOBILECON** (Reg. No. 4485921); **CAMMING CON** (Reg. No. 4600861); **BEAUTYCON** (Reg. No. 4688453); **SALT LAKE GAMING CON** (Reg. No. 4858430); **STYLECON** (Reg. No. 4863174); **FITCON** (Reg. No. 4914619)

II. CONCLUSION

In light of the foregoing, Applicant submits that Applicant's Mark is not merely descriptive and should be allowed registration on the Principal Register.

WHEREFORE, Applicant respectfully requests that the Section 2(e)(1) refusal be withdrawn and that Applicant's Mark be published for opposition.