

This Opinion is Not a
Precedent of the TTAB

Mailed: February 14, 2024

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re LIT Hookah LLC

Serial No. 87904603

Sevag Demirjian of Foundation Law Group LLP,
for LIT Hookah LLC.

Clare Cahill, Trademark Examining Attorney, Law Office 120,
Joshua Toy, Managing Attorney.

Before Wellington, Larkin, and Elgin,
Administrative Trademark Judges.

Opinion by Wellington, Administrative Trademark Judge:

LIT Hookah LLC (“Applicant”) seeks registration on the Principal Register of the mark, appearing below, for “On-line retail store services featuring handmade all-glass hookahs” in International Class 35:¹

¹ Application Serial No. 87904603, filed on May 2, 2018, under Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a), based on an allegation of first use of the mark anywhere and in commerce as of March 2018.

The logo consists of the lowercase letters 'l', 'i', and 't' in a serif font. The letter 'i' is replaced by a black silhouette of a hookah, showing the bowl, stem, and base.

The mark is described in the application as consisting “of the letter L, followed by an icon in the shape of an hourglass silhouette of a hookah, and ending with the letter T.”

The Examining Attorney refused registration of Applicant’s mark under Section 2(d) of the Trademark Act (“the Act”), 15 U.S.C. § 1052(d), based on a likelihood of confusion with the standard character mark LIT, registered on the Principal Register for “Electronic cigarettes and components and parts, namely, cartomisers, atomisers, and refill cartridges” in International Class 34.² Also, pursuant to Trademark Rule 2.37, 37 C.F.R. § 2.37, the Examining Attorney required Applicant to provide a more complete and accurate description of the mark.

The appeal has been fully briefed. For the reasons set forth below, we affirm the refusal to register and the requirement for a more complete description of the mark.

² Registration No. 4226939 issued on October 16, 2012; maintained. We note that the registration spells the words “cartomizers” and “atomizers” using the letter Z in place of the letter S.

I. Preliminary Evidentiary Matter

Applicant attached materials with its appeal brief.³ The Examining Attorney objected to Applicant's inclusion in these materials of "a copy of a Wikipedia webpage titled 'Hookah' that was not made of record prior to this appeal."⁴

Because the objected-to materials attached to Applicant's brief were not submitted prior to the appeal, they are untimely and are not considered. Trademark Rule 2.142(d), 37 C.F.R. § 2.142(d) (the record in the application should be complete prior to the filing of an appeal). *See In re Fiat Grp. Mktg. & Corp. Commc'ns S.p.A.*, 109 USPQ2d 1593, 1596 (TTAB 2014).

In the body of its reply brief, Applicant states:⁵

Should the Board deem the Wikipedia article on 'Hookah' as material evidence that could significantly impact the outcome of this appeal, yet find itself procedurally restricted from considering it due to its late submission, the Applicant respectfully requests a remand of this case back to the Examiner. The purpose of the remand would be to allow the Applicant to formally submit the evidence in question, thereby filling the procedural gaps that the Examiner is relying upon to object to the registration.

Such a request, made in the body of Applicant's reply brief, is inappropriate. *See* TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE (TBMP) § 1203.01

³ 22 TTABVUE (Supplemental Brief). After the appeal was filed (1 TTABVUE) and fully briefed, Applicant requested remand of the application file "so that [Applicant] may revise its class description to further narrow its scope" and amend the description of the mark. 15 TTABVUE. The Board granted Applicant's request and jurisdiction of the application was remanded to the Examining Attorney for consideration of Applicant's amendments. 16 TTABVUE. The Examining Attorney issued a subsequent Final Office Action (20 TTABVUE) and the appeal proceedings resumed. Applicant's supplemental brief (22 TTABVUE), the Examining Attorney's supplemental brief (24 TTABVUE), and Applicant's supplemental reply brief (26 TTABVUE) are the operational briefs on appeal.

⁴ 24 TTABVUE 3; referring to materials attached at 22 TTABVUE 45-73.

⁵ 25 TTABVUE 4.

(2023) (“The content of the brief should not include a ... request for remand”). Applicant has also not demonstrated the necessary good cause for a second remand (see Note 3). See *In re Adlon Brand GmbH & Co.*, 120 USPQ2d 1717, 1725 (TTAB 2016) (applicant’s request for remand, included in applicant’s brief, was denied, and the Board explained that the proper procedure “was to file with the Board, after the filing of the appeal but before briefing, a request for remand with a showing of good cause.”); *In re Luxuria s.r.o.*, 100 USPQ2d 1146, 1147 (TTAB 2011) (applicant’s request for remand denied for failure to show good cause); *In re Big Wrangler Steak House, Inc.*, 230 USPQ 634, 635 n.4 (TTAB 1986); *In re Bercut-Vandervoort & Co.*, 229 USPQ 763, 764 (TTAB 1986); *In re Chung, Jeanne & Kim Co.*, 226 USPQ 938, 940 n.6 (TTAB 1985); *In re Mayer-Beaton Corp.*, 223 USPQ 1347, 1348 (TTAB 1984). For these reasons, the request for remand is denied.

We further point out that it was unnecessary for Applicant to resubmit materials with its supplemental brief even if the materials were timely-submitted by Applicant with its response to an Office Action during prosecution. The Board discourages such practice as it is a waste of time and resources, and a burden on the Board. *In re Michalko*, 110 USPQ2d 1949, 1950 (TTAB 2014); see also *In re Allegiance Staffing*, 115 USPQ2d 1319, 1323 (TTAB 2015) (practice of attaching to appeal brief copies of the same exhibits submitted with responses is discouraged); *In re Thor Tech Inc.*, 85 USPQ2d 1474, 1475 n.3 (TTAB 2007) (“[t]o the extent the material may simply be duplicative of matter submitted during examination, it is already of record as part of the application file, and its submission with the briefs was unnecessary”). The Board

recommends that applicants simply cite to the prosecution record evidence relied upon for statements and arguments made in briefs.

II. Requirement for Amendment to the Description of the Mark

As noted, the mark is currently described in the application as:

The mark consists of the letter L, followed by an icon in the shape of an hourglass silhouette of a hookah, and ending with the letter T.

During prosecution, the Examining Attorney, pursuant to Trademark Rule 2.37, 37 C.F.R. § 2.37, required Applicant to submit an amended description of the mark because the current one is incomplete and does not describe all the significant aspects of the mark. Specifically, the Examining Attorney contends that description of the mark fails to state that the mark spells out the word LIT and suggested the following amended description of the mark:⁶

The mark consists of the word LIT in a stylized font with the letter I formed an icon in the shape of an hourglass silhouette of a hookah.

Applicant did not address this requirement directly in its appeal brief, but argues that “the word LIT is inferred by the design that places a silhouette of a hookah-shaped object, [hookah design element] placed between the letters ‘l’ and ‘t,’ and it’s important for the analysis to take into account that the design is the subject of the application – rather than the word ‘lit’ on its own.”⁷

Applications for marks that are not in standard characters require a description of the mark. Trademark Rule 2.37; *see also* TRADEMARK MANUAL OF EXAMINING

⁶ Office Action issued May 26, 2023.

⁷ 22 TTABVUE 3.

PROCEDURE (TMEP) § 808 (Description of Mark) (Nov. 2023). The description “should state clearly and accurately what the mark comprises, and should not create a misleading impression by either positive statement or omission.” TMEP § 808.02.

Here, we find the current description accurately describes some elements of the proposed mark, but omits a key element, i.e., that it forms the word LIT, with the hookah silhouette design representing the letter I. We do not disagree with Applicant that any analysis of its mark should “take into account” the design element of its mark. However, because the description will be published in the Trademark Official Gazette and included on the certificate of registration, it is necessary to include in the description of the mark that it forms the word LIT. *Id.* at § 808.03(c). Thus, the requirement is appropriate.

Applicant’s failure to comply with the requirement is a sufficient basis, in itself, for affirming the refusal of registration of Applicant’s mark, and deeming moot the refusal of registration under Trademark Act Section 2(d). *In re DTI P’ship, LLP*, 67 USPQ2d 1699, 1701-02 (TTAB 2003). For the sake of completeness, however, we exercise our discretion to determine below the merits of the Section 2(d) refusal of registration.

III. Likelihood of Confusion

Our determination under Section 2(d) of the Act is based on an analysis of all of the probative evidence of record bearing on the likelihood of confusion. *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973) (setting forth *DuPont* factors to be considered); *see also In re Majestic Distilling Co.*, 315 F.3d

1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the services and/or goods. *See Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976) (“The fundamental inquiry mandated by § 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks.”). We consider the likelihood of confusion factors about which there is evidence and argument. *See In re Guild Mortg. Co.*, 912 F.3d 1376, 129 USPQ2d 1160, 1162-63 (Fed. Cir. 2019).

A. Weakness of Term LIT

Before analyzing the similarity or dissimilarity of the marks, we address Applicant’s argument that the “the term ‘lit’ is highly suggestive or descriptive in relation to the referenced goods and services, and should be afforded only narrow protection.”⁸ In support, Applicant relies upon a definition showing that LIT is the “past tense and past participle of [the verb] light,” and also may be used “to designate someone who is drunk or ‘affected by alcohol’ when used as an adjective.”⁹ Applicant further posits that “[i]t is also commonly used in American culture as a laudatory term to mean being hot, fun, or exciting,” relying upon an “urban dictionary” listing for the term.¹⁰

⁸ 22 TTABVUE 10.

⁹ 22 TTABVUE 10; definitions attached to Applicant’s response filed February 23, 2019.

¹⁰ 22 TTABVUE 10; printouts from website www.urbandictionary.com attached to Applicant’s response filed February 23, 2019.

In conjunction with the first meaning as the past tense of lighting something on fire, Applicant asserts that this meaning is relevant “especially with a flame/lighter and in relation to smoking” and “[a]s such, it is suggestive or descriptive of a feature or characteristic of the relevant goods and services, smoking related goods and services that must be ‘lit’ to enjoy, namely the hookahs which are used to smoke tobacco by lighting the tobacco with a flame.”¹¹

Applicant also submitted lists and copies of applications and registrations for marks containing the term LIT in Classes 34, 35 and 41,¹² including copies of the following existing registrations:



- *Keep it lit* (Reg. No. 5214858; wording in smaller print at bottom of mark states “Keep it lit”) for “smoking pipes” in Class 34;¹³ and
- LIT (Reg. No. 5421091) for “Night clubs” in Class 41.¹⁴

Applicant refers to several cancelled registrations, including one previously cited by the Examining Attorney against the involved application, and relies on the fact

¹¹ 22 TTABVUE 10.

¹² Attached to Applicant’s response filed February 23, 2019 as Exhibits C1-C2.

¹³ Attached to Applicant’s response filed February 23, 2019 as Exhibit D.

¹⁴ Attached to Applicant’s response filed February 23, 2019 as Exhibit F.

that they once co-existed on the Principal Register.¹⁵ Applicant claims that the “voluminous evidence of marks that share the same similarities as Applicant’s mark were all allowed without conflict, clearly due to the descriptive nature of the term ‘LIT’ in these related fields of smoking goods and bar/lounge services.”¹⁶

Under the fifth and sixth *DuPont* factors, we consider the strength of the cited registered mark, and the extent to which that strength may be attenuated by “[t]he number and nature of similar marks in use on similar goods [and services].” *DuPont*, 177 USPQ at 567; *Primrose Ret. Cmtys., LLC v. Edward Rose Senior Living, LLC*, 122 USPQ2d 1030, 1033 (TTAB 2016). Under the fifth factor, we generally treat the strength of the cited registered mark as neutral, and do so here, because the Examining Attorney is not expected to submit evidence of its fame. *In re Mr. Recipe, LLC*, 118 USPQ2d 1084, 1086-88 (TTAB 2016). Under the sixth factor, though, an applicant may submit evidence of third parties’ registration and use of similar marks to show weakness of the registered mark in two ways: conceptually and commercially. *Spireon, Inc. v. Flex Ltd.*, 71 F.4th 1355, 2023 USPQ2d 737, at *4 (Fed. Cir. 2023); *In re Chippendales USA, Inc.*, 622 F.3d 1346, 96 USPQ2d 1681, 1686 (Fed. Cir. 2010) (“A mark’s strength is measured both by its conceptual strength (distinctiveness) and its marketplace strength...”), *quoted in Made in Nature, LLC v. Pharmavite LLC*, 2022 USPQ2d 557, at *21 (TTAB 2022).

¹⁵ Reg. No. 5425731 (LIT HOOKAH LOUNGE & BAR) for “Hookah lounge services” was cancelled on November 1, 2021, after having been cited as a bar to registration of Applicant’s mark.

¹⁶ 22 TTABVUE 14-15.

Evidence showing that a mark, or a segment of a mark, is commonly adopted by many different registrants may indicate that the common element has some significance and this undermines the mark's conceptual strength as an indicator of a single source. *Jack Wolfskin Ausrüstung Fur Draussen GmbH & Co. KGAA v. New Millennium Sports, S.L.U.*, 797 F.3d 1363, 116 USPQ2d 1129, 1136 (Fed. Cir. 2015) (“[E]vidence of third-party registrations is relevant to show the sense in which a mark is used in ordinary parlance ... that is, some segment that is common to both parties' marks may have ‘a normally understood and well-recognized descriptive or suggestive meaning, leading to the conclusion that that segment is relatively weak’”) (internal citation and punctuation omitted).

Similarly, evidence showing that a mark, or a segment of a mark, is used extensively in commerce by a number of third parties may undermine its commercial strength, as the consuming public may have become accustomed to encountering the marks and are able to distinguish them based on minor differences. *Juice Generation, Inc. v. GS Enters. LLC*, 794 F.3d 1334, 115 USPQ2d 1671, 1674 (Fed. Cir. 2015).

Before addressing Applicant's evidence as to weakness of the registered mark and term LIT, we point out that Registrant's mark is inherently distinctive in connection with goods identified in the registration, i.e., electronic cigarettes and parts therefor. “It is registered on the Principal Register without a claim of acquired distinctiveness, and is therefore presumed distinctive.” *Advance Mag. Publishers, Inc. v. Fashion Elecs., Inc.*, 2023 USPQ2d 753, at *15 (TTAB 2023). Thus, any argument from Applicant that the cited mark is descriptive is unavailing.

There are several shortcomings as to the probative value of Applicant's evidence. First, the lists of applications and registrations only identify the mark and classes of goods or services, without specifying the actual goods or services covered. A mere listing of marks that include some variant of term LIT without showing the goods or services and other relevant information "has no probative value." *See Nat'l Fidelity Life Ins. v. Nat'l Ins. Trust*, 199 USPQ 691, 694 n.5 (TTAB 1978); *In re Peace Love World Live, LLC*, 127 USPQ2d 1400, 1405 n.17 (TTAB 2018) ("[T]he list does not include enough information to be probative. The list includes only the serial number, registration number, mark, and status (live or dead) of the applications or registrations. Because the goods are not listed, we do not know whether the listed registrations are relevant."). The marks may in fact involve goods or services that are very different from electronic cigarettes or retail services involving hookahs.

As to any reliance on trademark applications, these have "no probative value other than as evidence that the applications [were] filed." *Edwards Lifesciences Corp. v. VigiLanz Corp.*, 94 USPQ2d 1399, 1403 n.4 (TTAB 2010) (quoting *In re Phillips-Van Heusen Corp.*, 63 USPQ2d 1047, 1049 n.4 (TTAB 2002)). Also, with respect to cancelled registrations, these are not evidence of any existing rights in the marks. *See Action Temp. Servs. v. Labor Force, Inc.*, 870 F.2d 1563, 10 USPQ2d 1307, 1309 (Fed. Cir. 1989). An expired or cancelled registration is evidence of nothing but the fact that it once issued. *Sunnen Prods. Co. v. Sunex Int'l Inc.*, 1 USPQ2d 1744, 1747 (TTAB 1987).

Nevertheless, despite the aforementioned deficiencies in the evidence Applicant seeks to rely upon, we agree that the term LIT may be understood by consumers, in the context of both hookahs and e-cigarettes, as having multiple suggestive meanings. One such meaning, a slang reference to something “cool and exciting” may connote that the hookahs or e-cigarettes project this image. There is also some suggestive value in the term to the extent that it infers “lighting” an e-cigarette, despite those goods not requiring a light or fire. To the extent that there is a double entendre, implicating both the “cool” and past tense of “light” meanings, however, this would be equally present in the two marks as applied to the involved goods and services, thus bringing the marks closer.

As to any commercial weakness, however, there is too little evidence of actual third-party use of the term LIT in marks in connection with goods or services involving e-cigarettes or hookahs. Applicant submitted printouts from the Facebook, Twitter, and Yelp sites for the owner of the now-cancelled LIT HOOKAH LOUNGE & BAR registration (*see* Note 15); however, there is no other evidence of actual use in commerce by others. Consequently, at most, there is evidence of one third-party user and that is insufficient to show that the cited mark is commercially weak.

Thus, while the cited registered mark may have some conceptual weakness, either as a laudatory term or as suggesting the “lighting” of an e-cigarette or hookah, the mark has not been demonstrated to be commercially weak. Even allowing for some weakness in the mark LIT, as we point out frequently, even weak marks are entitled to protection against a mark that is substantially similar in sight, sound, and

commercial impression and is used on or in connection with goods and services that are closely related. *See In re FabFitFun, Inc.*, 127 USPQ2d 1670, 1676 (TTAB 2018) (citing *China Healthways Inst., Inc. v. Wang*, 491 F.3d 1337, 83 USPQ2d 1123, 1125 (Fed. Cir. 2007)).

B. Similarity of the Marks

We turn now to the first *DuPont* factor focusing on the similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression. *DuPont*, 177 USPQ at 567. “Similarity in any one of these elements may be sufficient to find the marks confusingly similar.” *In re Inn at St. John’s, LLC*, 126 USPQ2d 1742, 1746 (TTAB 2018) (quoting *In re Davia*, 110 USPQ2d 1810, 1812 (TTAB 2014)), *aff’d mem.*, 777 F. App’x 516 (Fed. Cir. 2019); *accord Krim-Ko Corp. v. Coca-Cola Bottling 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.”) (citation omitted).

At the outset, we observe that the term LIT, which is the entirety of Registrant’s mark, appears in Applicant’s mark:



Although the letter I in Applicant’s mark is represented in the shape or design of a hookah, consumers will immediately perceive the word LIT in this mark. Indeed, in

addition to placing its mark on the goods, Applicant describes them on its website as a “Lit glass hookah.”¹⁷ Thus, when speaking of Applicant’s services or Registrant’s goods, the marks will be pronounced identically as “lit.”

Because Registrant’s LIT mark is registered in standard characters, we must take into account that it “may be used in ‘any particular font style, size, or color,’” including “the same font, size and color as the literal portions of [Applicant’s] mark.” *In re Aquitaine Wine USA, LLC*, 126 USPQ2d 1181, 1186 (TTAB 2018) (quoting Trademark Rule 2.52(a), 37 C.F.R. § 2.52(a)); *see also In re Viterra*, 671 F.3d 1358, 101 USPQ2d 1905, 1909 (Fed. Cir. 2012). In other words, even without having the having the design, the registered mark may appear in the same or similar font as

used by Applicant, e.g., **lit**.

As to the hourglass or hookah silhouette design in Applicant’s mark, we cannot and do not disregard this element of Applicant’s mark and that it represents a point of difference between the marks. Applicant contends that the hookah silhouette is “visually dominant” in its mark and a hookah is “of cultural significance and appeals to a distinct market by singling out different and specific class of consumers.”¹⁸ Applicant also asserts that the “commercial impression [of its mark is] distinct to the degree that consumers are unlikely to be confused by the Cited Mark.”¹⁹ In support,

¹⁷ Applicant’s specimen of use filed with application.

¹⁸ 22 TTABVUE 7, 9-10.

¹⁹ 22 TTABVUE 10.

Applicant cites to two Board decisions: *In re Covalinski*, 113 USPQ2d 1166 (TTAB 2014) and *In re White Rock Distilleries, Inc.*, 92 USPQ2d 1282 (TTAB 2009).

Although we agree that the hookah silhouette helps form the overall commercial impression of Applicant's mark, we do not find it visually dominant or so unique as to overcome the similarity with the cited registered mark LIT. As to the two Board decisions that Applicant relies upon, the circumstances in those cases were vastly different from those in this case. That is, the design elements in those cases were significantly more prominent in the marks. In *Covalinski*, the two compared marks at issue were: the cited standard-character mark RACEGIRL and the applicant's mark



and the Board determined these marks could be distinguished because the latter mark includes “the very large, prominently displayed letters RR ... filled with a checkerboard pattern resembling a racing flag” and that these “graphic devices serve not only to draw attention to the RR letters apart from the wording, but also make the letters that form the ‘a-c-e’ of the word RACEGIRL difficult to notice.” *Covalinski*, 113 USPQ2d at 1168.

Similarly, in *White Rock Distilleries*, the Board compared the applicant's standard-character mark VOLTA with the following cited mark:



The Board described the above cited mark as having a “prominent design feature” and that the “term TERZA clearly dominates over the term VOLTA.” *White Rock Distilleries*, 92 USPQ2d at 1284.

Here, the presence and impact of the hookah silhouette design in Applicant’s mark pales in comparison to the design elements in the two aforementioned decision. Again, we find consumers will have no problem and will immediately understand Applicant’s mark as forming the word LIT. To the extent consumers do place some attention on the hookah silhouette, it is not unusual and serves primarily to reinforce in the consumer’s mind the type of goods being offered for sale by Applicant.

In addition, as we often point out with design elements within a mark, “the words are normally accorded greater weight because they are likely to make a greater impression upon purchasers, to be remembered by them, and to be used by them to request the goods.” *In re Aquitaine*, 126 USPQ2d at 1184 (citing *In re Viterra Inc.*, 101 USPQ2 at 1908); *CBS Inc. v. Morrow*, 708 F.2d 1579, 218 USPQ 198, 200 (Fed. Cir. 1983)); *see also L.C. Licensing, Inc. v. Berman*, 86 USPQ2d 1883, 1887 (TTAB 2008) (“it is well settled that if a mark comprises both a word and a design, then the

word is normally accorded greater weight because it would be used by purchasers to request the goods”). Consumers articulating Applicant’s mark and referring to its services are likely to rely on the literal portion of the mark and use the word LIT.

In sum, we find the marks are overall very similar and this *DuPont* factor weighs in favor of finding a likelihood of confusion.

C. Relatedness of the Goods and Services; Trade Channels

We turn now to the second and third *DuPont* factors, which respectively consider “[t]he similarity or dissimilarity and nature of the goods or services as described in an application or registration,” and “the similarity or dissimilarity of established, likely-to-continue trade channels.” *In re Detroit Athletic Co.*, 903 F.3d 1297, 128 USPQ2d 1047, 1051-52 (Fed. Cir. 2018) (quoting *DuPont*, 177 USPQ at 567); *Sabhnani v. Mirage Brands, LLC*, 2021 USPQ2d 1241, at *19 (TTAB 2021).

We must base our comparisons under the second and third *DuPont* factors on the Applicant’s recitation of services and the identification of goods in cited registration. *In re Charger Ventures LLC*, 64 F.4th 1375, 2023 USPQ2d 451, at *6 (Fed. Cir. 2023) (“The relevant inquiry in an ex parte proceeding focuses on the goods and services described in the application and registration.”); *Stone Lion Cap. Partners, L.P. v. Lion Cap. LLC*, 746 F.3d 1317, 110 USPQ2d 1157, 1162 (Fed. Cir. 2014); *In re Dixie Rests., Inc.*, 105 F.3d 1405, 41 USPQ2d 1531, 1534 (Fed. Cir. 1997); *Octocom Sys., Inc. v. Hous. Comput. Servs. Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990).

Again, Applicant renders “on-line retail store services featuring handmade all-glass hookahs,”²⁰ and the Registrant’s goods are “electronic cigarettes and components and parts, namely, cartomisers, atomisers, and refill cartridges.”

The Examining Attorney argues that “Applicant’s services are related to Registrant’s goods because the relevant goods and services are sold or provided through the same trade channels and used by the same classes of consumers in the same fields of use.” In support, the Examining Attorney submitted screenshots from third-party websites showing glass hookahs and e-cigarettes being sold together at the same place.²¹ To wit:

²⁰ Although it may be common knowledge, we take notice of the definition of “hookah” as “a kind of water pipe associated with the Middle East, with a long flexible tube for drawing the smoke through water in a vase or bowl and cooling it.” WEBSTER’S NEW WORLD COLLEGE DICTIONARY (4th Ed. 2010). The Board may take judicial notice of dictionary definitions, *Univ. of Notre Dame du Lac v. J.C. Gourmet Food Imp. Co.*, 213 USPQ 594 (TTAB 1982), *aff’d*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983).

²¹ Attached to August 23, 2018 Office Action. Some of the evidence identifies “vaporizers” or “vaping devices.” We take judicial notice of the U.S. National Institutes of Health website explaining that “Vaping Devices (Electronic Cigarettes) ... are battery-operated devices that people use to inhale an aerosol, which typically contains nicotine (though not always), flavorings, and other chemicals.” (<https://nida.nih.gov/publications/drugfacts/vaping-devices-electronic-cigarettes>).

SHISHA LOUNGE
BLOW & TELL

Home Shisha Lounge Products Flavors Gallery Contact Shopping Cart Terms of Use

Buy Products The Shisha Lounge Smoking Wholesale Gallery

360 Degree View Below!

For Reservations & Event Details Call:
916-486-2569

Welcome to Blow and Tell Shisha lounge.

We are a full service hookah/smoke shop located at 14 Fulton Ave. Sacramento, CA & 4552 Auburn Blvd Sacramento, CA.

Our ultimate locations cater all smoking accessories including: Hookah's, glass pipes, e-cigarettes, vaporizers, flavored tobacco along with a mass inventory of smoking essentials. We pride ourselves in being the best smoke shop around in the town of Sacramento, CA.

Stop by at one of our locations and check out our inventory or relax in our lounge and have a good time. Shop online for a variety of products in our online store at your convenience. We are open 7 Days a week. Hours of operations are located below.

\$10.00 HOOKAH 7PM-11PM!
*18+ NON-NICOTINE
21+ WITH NICOTINE

Shisha HOOKAH
LOUNGE, SACRAMENTO

HOOKAH
Enjoy a massive selection of Hookah available at the bar!

BOOK A BOOTH
Large group? Why not call us and reserve yourselves one of our private booths?

REFRESHMENTS AWAY
Pick up with one of our delicious refreshments - or just a big old water!

GREAT MUSIC!
Get on your dancing shoes as wide selection of music rock your socks off all night!

FREE ENTRY

CHEAP DRINKS!

and

Home
All Items
Shopping Cart
Register Now!
Sign In
Contact Us
Search

Our Products
[Pyrex Glass Oil Burner](#)
[Glass Pipes](#)
[Water Pipes](#)
[SILICONE WATER BOWLS](#)
[Animal Pipes](#)
[Metal Pipes](#)
[Dugouts and Wood Pipes](#)
[Vaporizers and Electronic Pipes](#)
[Bubblers](#)
[CONCENTRATE UTENSILS](#)
[Steamrollers](#)
[Bats and Chillums](#)
[Bowls and Stems](#)
[Grinders](#)
[Digital Scales](#)
[Baggies and Stash Jars](#)
[Detox](#)
[Misc. Smoking Accessories](#)

SmokingWholesale.com
SMOKING IMPORTS/BLOW & TELL, LLC

PLEASE CHOOSE ONE OF THE FOLLOWING!
Verify Your AGE! | am over 21 | I am not over 21

Welcome to Smoking Wholesale

We are a supplier of wholesale glass pipes, bubblers, water pipes, wood pipes and dugouts, bowls and stems, digital scales, grinders, steamrollers, concentrate utensils, bats and chillums, baggies and stash jars, wholesale smoke shop supplies, and other wholesale smoking accessories.

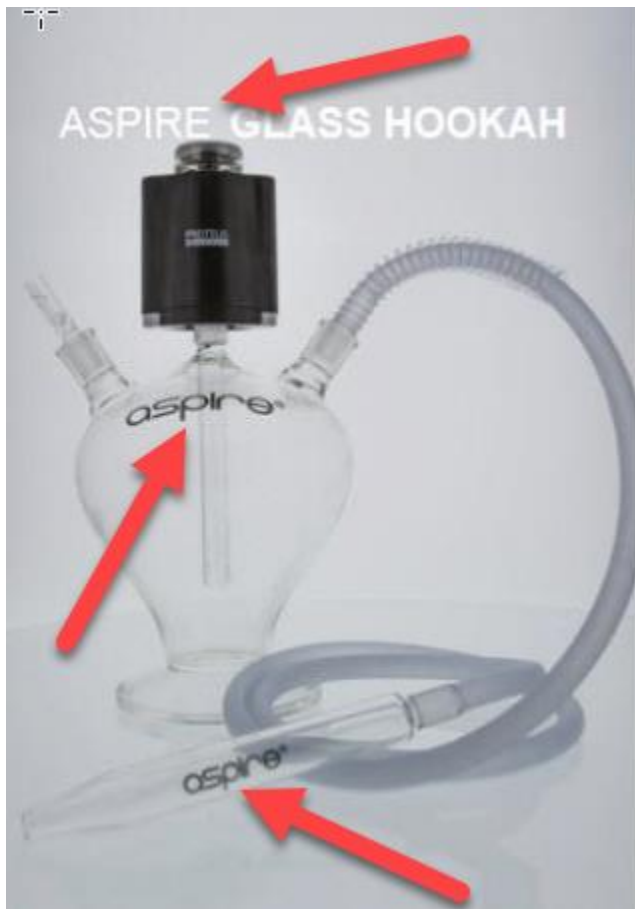
kizōa

and



One retailer, Aspire, offers both glass hookahs and vaping devices, under the same mark.²²

²² *Id.* at TSDR pp. 32-37.



Another retailer, 10th Street Discount Tobacco in Indianapolis, Indiana, touts itself as “Your One-Stop Shop for Hookah Products and Accessories,” while also offering “all the hookah and e-cigarettes related items you need, from pipes to

accessories.”²³ In another example, the same mark (“Zebra”) is used for retail store services featuring hookahs, including glass and e-hookahs, as well as on e-cigarettes.²⁴

The Internet evidence submitted by the Examining Attorney establishes that e-cigarettes and hookahs, including glass hookahs, which encompass the handmade glass hookahs described in Applicant’s identification of services, and electronic hookahs (“e-hookahs”), are closely related because they may be sold together by the same entity online and in physical stores. In essence, the channels of trade for these goods and services are the same and the goods and services will be encountered by the same classes of consumers, namely, anyone shopping for glass hookahs or e-cigarettes.

Applicant does not challenge the amount or probative value of the Examining Attorney’s Internet evidence. Rather, Applicant relies on the different classification of the involved goods and services, particularly that “Applicant’s listed services are classified in International Class 35, which is markedly different than [] Registrant’s mark which is in class 34 for goods.”²⁵ Applicant contends that “[a]s Applicant’s Mark is associated with a different class than the Registrant, there is no likelihood of confusion.”²⁶

²³ *Id.* at TSDR pp. 37-40.

²⁴ *Id.* at TSDR pp.40-43 (screenshots from website www.zebrasmoke.com).

²⁵ 22 TTABVUE 5.

²⁶ 22 TTABVUE 6.

The classification of goods and services by the USPTO is a purely administrative determination and is irrelevant to whether the involved goods and services are related. *Detroit Athletic*, 128 USPQ2d at 1051 (“Classification is solely for the ‘convenience of Patent and Trademark Office administration,’ and ‘is wholly irrelevant to the issue of [likelihood of confusion].”). To the contrary, inasmuch as the evidence shows that online retailers of hookahs also sell e-cigarette devices, there is a complementary relationship between Applicant’s smoking-related services and Registrant’s smoking-related goods. This type of complementarity between services and goods “has long been recognized as a relevant consideration in determining a likelihood of confusion.” *In re Martin's Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 223 USPQ 1289, 1290 (Fed. Cir. 1984); *Wet Seal, Inc. v. FD Mgmt., Inc.*, 82 USPQ2d 1629, 1640 (TTAB 2007) (finding retail women's clothing store services and clothing related to cosmetics, including fragrances, based on evidence of third-parties using a single mark for clothing and retail store services featuring clothing and beauty care products and fragrances).

Accordingly, the second and third *DuPont* factors weigh in favor of finding a likelihood of confusion.

D. No Instances of Actual Confusion

Applicant argues that “the two Marks have been alleged to have been in continuous use since 2018, and there has been zero instances of overlap or actual confusion between the two marks that Applicant is aware of” and that it is “highly

unlikely that an online store offering hookahs would overlap with brand selling electronic cigarettes.”²⁷

Applicant’s contentions carry little weight. The evidence, discussed supra, directly contradicts the latter point and shows that online stores offering glass hookahs may also offer e-cigarettes. Moreover, the *DuPont* factor involving “[t]he length of time during and conditions under which there has been concurrent use without evidence of actual confusion,” *DuPont*, 177 USPQ at 567, requires us to look at actual market conditions, to the extent there is evidence of such conditions of record. Here, Applicant has not provided such evidence for us to determine the extent of contemporaneous use of the marks from which we can gauge the significance of this factor, and “[a]ttorney argument is no substitute for evidence.” *Cai v. Diamond Hong, Inc.*, 901 F.3d 1367, 127 USPQ2d 1797, 1799 (Fed. Cir. 2018) (quotation omitted). As the Federal Circuit has instructed:

With regard to the seventh *DuPont* factor, we agree with the Board that Majestic’s uncorroborated statements of no known instances of actual confusion are of little evidentiary value. *See In re Bissett-Berman Corp.*, 476 F.2d 640, 642, 177 USPQ 528, 529 (CCPA 1973) (stating that self-serving testimony of appellant’s corporate president’s unawareness of instances of actual confusion was not conclusive that actual confusion did not exist or that there was no likelihood of confusion). A showing of actual confusion would of course be highly probative, if not conclusive, of a high likelihood of confusion. The opposite is not true, however. The lack of evidence of actual confusion carries little weight, [citation omitted], especially in an ex parte context.

In re Majestic, 65 USPQ2d at 1205.

According, the eighth *DuPont* factor is neutral.

²⁷ 22 TTABVUE 15.

E. Likelihood of Confusion - Conclusion

Because the marks are overall very similar, and these marks are used on closely related goods and services that may be offered in the same trade channels to the same classes of consumers, we find confusion is likely.

Decision: The refusal to register Applicant's mark is affirmed on the basis of a likelihood of confusion, under Section 2(d); and based on Applicant's failure to comply with the requirement for a complete and accurate description of the mark, pursuant to Trademark Rule 2.37.