

ESTTA Tracking number: **ESTTA529777**

Filing date: **04/01/2013**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Petition for Cancellation

Notice is hereby given that the following party requests to cancel indicated registration.

Petitioner Information

Name	Joyetech (Changzhou) Electronics Co., Ltd.		
Entity	Corporation	Citizenship	China
Address	No. 7 Feng Xiang Road, New District Changzhou, Jiangsu, CHINA		

Attorney information	Corey K. Cho Saliwanchik, Lloyd & Eisenschenk P.O. Box 142950 Gainesville, FL 32614 UNITED STATES ckc@slepatents.com Phone:352-375-8100
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Registration Subject to Cancellation

Registration No	3283706	Registration date	08/21/2007
Registrants	ASSOULINE, PINHAS 2182 NE 186 TERRACE MIAMI, FL 33179 UNITED STATES MALEK, SANDRA 2182 NE 186 TERRACE MIAMI, FL 33179 UNITED STATES		

Goods/Services Subject to Cancellation

Class 034. First Use: 2004/12/01 First Use In Commerce: 2005/04/01 All goods and services in the class are cancelled, namely: TOBACCO PRODUCTS, NAMELY CIGARS
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Grounds for Cancellation

Abandonment	Trademark Act section 14
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Attachments	EGO.pdf (36 pages)(2636851 bytes) EGO-T.pdf (36 pages)(2738282 bytes)
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Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/corey k cho/
Name	Corey K. Cho
Date	04/01/2013

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

Joyetech (Changzhou) Electronics Co., Ltd.)
Petitioner,)
v.)
Pinhas Assouline and Sandra Malek,)
Registrants.)
_____)

Cancellation No.: _____

PETITION FOR CANCELLATION

Petitioner, a corporation of China, with an address at No. 7 Feng Xiang Road, New District, Changzhou, Jiangsu, China, believes it will be damaged by the continued registration of Registration No. 3,283,706 for the mark EGO (the "Registration"), and hereby petitions to cancel the same.

As grounds therefor, Petitioner alleges as follows:

1. On October 20, 2011, Petitioner filed Application Serial No. 85/451,811 ("Petitioner's Application") for the mark eGo-C. A printout of this application from the TSDR database is attached hereto as Exhibit A.

2. In an Office Action dated February 14, 2012, the Examiner for Petitioner's Application cited the Registration as a bar to registration of Petitioner's mark. A copy of that Office Action is attached as Exhibit B. In a final Office Action dated October 4, 2012, the Examiner for Petitioner's Application maintained that citation. A copy of that Office Action is attached as Exhibit C.

3. Upon information and belief, Registrant has discontinued use of the mark in commerce shown in the Registration in connection with the goods covered by the Registration.

4. Upon information and belief, Registrant does not intend to resume use of the mark in commerce shown in the Registration in connection with the goods covered by the Registration.

5. Therefore, Registrant has abandoned the mark shown in the Registration.

6. By reason of the foregoing, Petitioner will be damaged by the continued registration of the mark shown in the Registration.

WHEREFORE, Petitioner respectfully requests that its Petition for Cancellation be sustained and that Registration No. 3,283,706 be cancelled.

Dated: Gainesville, FL
April 1, 2013

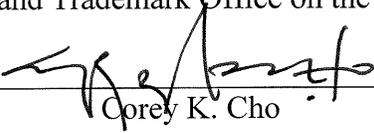
Respectfully submitted,



Corey K. Cho
Attorney for Petitioner
Saliwanchik, Lloyd & Eisenschenk
3107 SW Williston Road
Gainesville, FL 32608
Phone: (352) 375-8100
Fax: (352) 372-5800

CERTIFICATE OF TRANSMISSION

I hereby certify that this correspondence is being electronically transmitted to the United States Patent and Trademark Office on the date shown below.

By:  _____
Corey K. Cho

Date: 4/1/2013

CERTIFICATE OF SERVICE

I hereby certify that on this 1st day of April, 2013, I caused a copy of the PETITION FOR CANCELLATION to be served by prepaid, first-class mail upon Registrant's representative at the address below:

Pinhas Assouline
2182 NE 186 Terrace
Miami, FL 33179

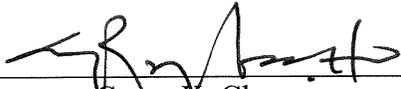
By: 
Corey K. Cho

EXHIBIT A

Trademark/Service Mark Application, Principal Register

Serial Number: 85451811

Filing Date: 10/20/2011

To the Commissioner for Trademarks:

MARK: eGo-C (Standard Characters, see mark)

The literal element of the mark consists of eGo-C.

The mark consists of standard characters, without claim to any particular font, style, size, or color.

The applicant, Joyetech (Changzhou) Electronics Co., Ltd., a corporation of China, having an address of
No. 7 Feng Xiang Road, New District
Changzhou, Jiangsu
China

requests registration of the trademark/service mark identified above in the United States Patent and Trademark Office on the Principal Register established by the Act of July 5, 1946 (15 U.S.C. Section 1051 et seq.), as amended, for the following:

International Class 010: Inhaler

Intent to Use: The applicant has a bona fide intention to use or use through the applicant's related company or licensee the mark in commerce on or in connection with the identified goods and/or services. (15 U.S.C. Section 1051(b)).

International Class 011: Apparatus for heating and vapor generating

Intent to Use: The applicant has a bona fide intention to use or use through the applicant's related company or licensee the mark in commerce on or in connection with the identified goods and/or services. (15 U.S.C. Section 1051(b)).

International Class 034: Electronic cigarettes, electronic nicotine inhalation devices, electronic cigarette cartridges, electronic cigarette atomizers, electronic cigarette cartomizers, liquid nicotine solutions

Intent to Use: The applicant has a bona fide intention to use or use through the applicant's related company or licensee the mark in commerce on or in connection with the identified goods and/or services. (15 U.S.C. Section 1051(b)).

The applicant's current Attorney Information:

Roger H Bora and Eric N. Heyer, Theodore D. Lienesch and Megan D. Dortenzo, Steven J. Elleman, David R. Jaglowski, John F. Kane, Mark P. Levy, Beverly A. Lyman, Jeffrey C. Metzcar, Michael J. Nieberding, Susan M. Oiler, Troy S. Prince, Thomas F. Zych, Louis K. Ebling, Carrie A. Shufflebarger of Thompson Hine LLP

2000 Courthouse Plaza NE
10 West Second Street

Dayton, Ohio 45402

United States

The attorney docket/reference number is 078741.000001.

The applicant's current Correspondence Information:

Roger H Bora

Thompson Hine LLP

2000 Courthouse Plaza NE

10 West Second Street

Dayton, Ohio 45402

937.443.6817(phone)

937.443.6635(fax)

trademarks@thompsonhine.com (authorized)

A fee payment in the amount of \$975 has been submitted with the application, representing payment for 3 class(es).

Declaration

The undersigned, being hereby warned that willful false statements and the like so made are punishable by fine or imprisonment, or both, under 18 U.S.C. Section 1001, and that such willful false statements, and the like, may jeopardize the validity of the application or any resulting registration, declares that he/she is properly authorized to execute this application on behalf of the applicant; he/she believes the applicant to be the owner of the trademark/service mark sought to be registered, or, if the application is being filed under 15 U.S.C. Section 1051(b), he/she believes applicant to be entitled to use such mark in commerce; to the best of his/her knowledge and belief no other person, firm, corporation, or association has the right to use the mark in commerce, either in the identical form thereof or in such near resemblance thereto as to be likely, when used on or in connection with the goods/services of such other person, to cause confusion, or to cause mistake, or to deceive; and that all statements made of his/her own knowledge are true; and that all statements made on information and belief are believed to be true.

Signature: /rhb/ Date Signed: 10/20/2011

Signatory's Name: Roger H Bora

Signatory's Position: Attorney of record, Ohio bar member

RAM Sale Number: 8398

RAM Accounting Date: 10/20/2011

Serial Number: 85451811

Internet Transmission Date: Thu Oct 20 11:12:02 EDT 2011

TEAS Stamp: USPTO/BAS-63.234.47.34-20111020111202088

021-85451811-4807426a8788248e9d03da14efe

fe3dd2f2-CC-8398-20111020105838483096

eGo-C

EXHIBIT B

To: Joyetech (Changzhou) Electronics Co., Lt ETC. (ckc@slepatents.com)
Subject: U.S. TRADEMARK APPLICATION NO. 85451811 - EGO-C - JOY.ITU4T
Sent: 2/14/2012 1:21:55 PM
Sent As: ECOM106@USPTO.GOV
Attachments: [Attachment - 1](#)
[Attachment - 2](#)
[Attachment - 3](#)
[Attachment - 4](#)
[Attachment - 5](#)
[Attachment - 6](#)
[Attachment - 7](#)
[Attachment - 8](#)
[Attachment - 9](#)
[Attachment - 10](#)
[Attachment - 11](#)
[Attachment - 12](#)
[Attachment - 13](#)
[Attachment - 14](#)
[Attachment - 15](#)
[Attachment - 16](#)

**UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)
OFFICE ACTION (OFFICIAL LETTER) ABOUT APPLICANT'S TRADEMARK APPLICATION**

APPLICATION SERIAL NO. 85451811

MARK: EGO-C

85451811

CORRESPONDENT ADDRESS:

Corey K. Cho
Saliwanchik, Lloyd & Eisenschenk
P.O. Box 142950
Gainesville FL 32614

CLICK HERE TO RESPOND TO THIS LETTER:
http://www.uspto.gov/trademarks/teas/response_forms.jsp

APPLICANT: Joyetech (Changzhou)
Electronics Co., Lt ETC.

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

JOY.ITU4T

CORRESPONDENT E-MAIL ADDRESS:
ckc@slepatents.com

OFFICE ACTION

STRICT DEADLINE TO RESPOND TO THIS LETTER

TO AVOID ABANDONMENT OF APPLICANT'S TRADEMARK APPLICATION, THE USPTO MUST RECEIVE APPLICANT'S COMPLETE RESPONSE TO THIS LETTER **WITHIN 6 MONTHS** OF THE ISSUE/MAILING DATE BELOW.

ISSUE/MAILING DATE: 2/14/2012

The referenced application has been reviewed by the assigned trademark examining attorney. Applicant must respond timely and completely to the issue(s) below. 15 U.S.C. §1062(b); 37 C.F.R. §§2.62(a), 2.65(a); TMEP §§711, 718.03.

EARLIER-FILED PENDING APPLICATION

The filing date of pending Application Serial No. 85381434 precedes applicant's filing date. See attached referenced application. If the mark in the referenced application registers, applicant's mark may be refused registration under Trademark Act Section 2(d) because of a likelihood of confusion between the two marks. See 15 U.S.C. §1052(d); 37 C.F.R. §2.83; TMEP §§1208 *et seq.* Therefore, upon receipt of applicant's response to this Office action, action on this application may be suspended pending final disposition of the earlier-filed referenced application.

In response to this Office action, applicant may present arguments in support of registration by addressing the issue of the potential conflict between applicant's mark and the mark in the referenced application. Applicant's election not to submit arguments at this time in no way limits applicant's right to address this issue later if a refusal under Section 2(d) issues.

ADDITIONAL REFUSAL(S) AND/OR REQUIREMENT(S)

Upon receipt of applicant's response resolving the following requirement(s), action on this application will be suspended pending the disposition of Application Serial No(s). 85381434. 37 C.F.R. §2.83(c); TMEP §§716.02(c), 1208.02(c).

SECTION 2(D) REFUSAL

Registration of the applied-for mark is refused because of a likelihood of confusion with the mark in U.S. Registration No. 3283706. Trademark Act Section 2(d), 15 U.S.C. §1052(d); see TMEP §§1207.01 *et seq.* See the enclosed registration.

Trademark Act Section 2(d) bars registration of an applied-for mark that so resembles a registered mark that it is likely that a potential consumer would be confused or mistaken or deceived as to the source of the goods and/or services of the applicant and registrant. See 15 U.S.C. §1052(d). The court in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (C.C.P.A. 1973) listed the principal factors to be considered when determining whether there is a likelihood of confusion under Section 2(d). See TMEP §1207.01. However, not all the factors are necessarily relevant or of equal weight, and any one factor may be dominant in a given case, depending upon the evidence of record. *Citigroup Inc. v. Capital City Bank Grp., Inc.*, 637 F.3d 1344, 1355, 98 USPQ2d 1253, 1260 (Fed. Cir. 2011); *In re Majestic Distilling Co.*, 315 F.3d 1311, 1315, 65 USPQ2d 1201, 1204 (Fed. Cir. 2003); see *In re E. I. du Pont*, 476 F.2d at 1361-62, 177 USPQ at 567.

In this case, the following factors are the most relevant: similarity of the marks, similarity of the goods

and/or services, and similarity of trade channels of the goods and/or services. *See In re Dakin's Miniatures Inc.*, 59 USPQ2d 1593 (TTAB 1999); TMEP §§1207.01 *et seq.*

The applicant has applied to register "EGO-C" for inhaler, in International Class 10; apparatus for heating and vapor generating, in International Class 11; and electronic cigarettes, electronic nicotine inhalation devices, electronic cigarette cartridges, electronic cigarette atomizers, electronic cigarette cartomizers, liquid nicotine solutions, in International Class 34.

The cited mark is "EGO" for tobacco products, namely cigars, in International Class 34.

In a likelihood of confusion determination, the marks are compared for similarities in their appearance, sound, meaning or connotation, and commercial impression. *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). Similarity in any one of these elements may be sufficient to find the marks confusingly similar. *In re White Swan Ltd.*, 8 USPQ2d 1534, 1535 (TTAB 1988); *see In re 1st USA Realty Prof'ls, Inc.*, 84 USPQ2d 1581, 1586 (TTAB 2007); TMEP §1207.01(b).

In this case, the marks of the parties are similar because they share the word "EGO". 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); *see also Mattel Inc. v. Funline Merch. Co.*, 81 USPQ2d 1372, 1374-75 (TTAB 2006); *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).

The mere addition of a term to a registered mark generally does not obviate the similarity between the marks nor does it overcome a likelihood of confusion under Trademark Act Section 2(d). *See In re Chatam Int'l Inc.*, 380 F.3d 1340, 71 USPQ2d 1944 (Fed. Cir. 2004) (GASPAR'S ALE and JOSE GASPAR GOLD); *Coca-Cola Bottling Co. v. Jos. E. Seagram & Sons, Inc.*, 526 F.2d 556, 188 USPQ 105 (C.C.P.A. 1975) (BENGAL and BENGAL LANCER); *Lilly Pulitzer, Inc. v. Lilli Ann Corp.*, 376 F.2d 324, 153 USPQ 406 (C.C.P.A. 1967) (THE LILLY and LILLI ANN); *In re Toshiba Med. Sys. Corp.*, 91 USPQ2d 1266 (TTAB 2009) (TITAN and VANTAGE TITAN); *In re El Torito Rests., Inc.*, 9 USPQ2d 2002 (TTAB 1988) (MACHO and MACHO COMBOS); *In re Corning Glass Works*, 229 USPQ 65 (TTAB 1985) (CONFIRM and CONFIRMCELLS); *In re U.S. Shoe Corp.*, 229 USPQ 707 (TTAB 1985) (CAREER IMAGE and CREST CAREER IMAGES); *In re Riddle*, 225 USPQ 630 (TTAB 1985) (ACCU TUNE and RICHARD PETTY'S ACCU TUNE); TMEP §1207.01(b)(iii).

The goods of the parties are closely related because they are both tobacco products. The goods and/or services of the parties need not be identical or directly competitive to find a likelihood of confusion. *See Safety-Kleen Corp. v. Dresser Indus., Inc.*, 518 F.2d 1399, 1404, 186 USPQ 476, 480 (C.C.P.A. 1975); TMEP §1207.01(a)(i). Rather, it is sufficient to show that because of the conditions surrounding their marketing, or because they are otherwise related in some manner, the goods and/or services would be encountered by the same consumers under circumstances such that offering the goods and/or services under confusingly similar marks would lead to the mistaken belief that they come from, or are in some way associated with, the same source. *In re Iolo Techs., LLC*, 95 USPQ2d 1498, 1499 (TTAB 2010); *see In re Martin's Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 1566-68, 223 USPQ 1289, 1290 (Fed. Cir. 1984); TMEP §1207.01(a)(i).

The trademark examining attorney has attached evidence from the USPTO's X-Search database consisting of a number of third-party marks registered for use in connection with the same or similar

goods and/or services as those of both applicant and registrant in this case. This evidence shows that the goods and/or services listed therein, namely “electronic cigarettes” and “cigars”, are of a kind that may emanate from a single source under a single mark. *See In re Davey Prods. Pty Ltd.*, 92 USPQ2d 1198, 1203 (TTAB 2009); *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783, 1785-86 (TTAB 1993); *In re Mucky Duck Mustard Co.*, 6 USPQ2d 1467, 1470 n.6 (TTAB 1988); TMEP §1207.01(d)(iii).

Although applicant’s mark has been refused registration, applicant may respond to the refusal(s) by submitting evidence and arguments in support of registration.

IDENTIFICATION OF GOODS

The identification of goods is indefinite and must be clarified. *See* TMEP §1402.01. Applicant must specify the common commercial or generic name for the goods. If there is no common commercial or generic name, applicant must describe the product and intended consumer as well as its main purpose and intended uses.

Further, the identification of goods must be clarified because it is too broad and could include goods in other international classes. *See* TMEP §§1402.01, 1402.03.

Applicant may adopt the following identification of goods, if accurate. *See* TMEP §1402.01. Bracketed wordings are suggested deletions and bolded wordings are suggested amendments.

International Class 10

Inhaler **for medical purposes sold empty; inhalers for therapeutic use sold empty**

International Class 11

Apparatus for heating and vapor generating, **namely, electric vaporizers**

International Class 21 (see below to add this class)

Inhalers, sold empty, not for medical or therapeutic use

International Class 34

~~[Electronic cigarettes, electronic nicotine inhalation devices, electronic cigarette cartridges, electronic cigarette atomizers, electronic cigarette cartomizers, liquid nicotine solutions];~~ **electronic cigarettes; electronic nicotine inhalation devices, namely, electronic cigarette refill cartridges, electronic cigarette atomizers, electronic cigarette cartomizers and refill liquid nicotine solutions**

An applicant may amend an identification of goods only to clarify or limit the goods; adding to or broadening the scope of the goods is not permitted. 37 C.F.R. §2.71(a); *see* TMEP §§1402.06 *et seq.*, 1402.07 *et seq.*

For assistance with identifying and classifying goods and/or services in trademark applications, please see the online searchable *Manual of Acceptable Identifications of Goods and Services* at <http://tess2.uspto.gov/netathtml/tidm.html>. *See* TMEP §1402.04.

ADDITIONAL CLASS – INTENT TO USE

For an application with more than one international class, called a “multiple-class application,” an applicant must meet all of the requirements below for those international classes based on an intent to use the mark in commerce under Trademark Act Section 1(b):

(1) LIST GOODS AND/OR SERVICES BY INTERNATIONAL CLASS: Applicant must list the goods and/or services by international class; and

(2) PROVIDE FEES FOR ALL INTERNATIONAL CLASSES: Applicant must submit an application filing fee for each international class of goods and/or services not covered by the fee(s) already paid (confirm current fee information at <http://www.uspto.gov>, click on “View Fee Schedule” under the column titled “Trademarks”).

See 15 U.S.C. §§1051(b), 1112, 1126(e); 37 C.F.R. §§2.34(a)(2)-(3), 2.86(a); TMEP §§1403.01, 1403.02(c).

COMMUNICATION

If applicant has questions regarding this Office action, please telephone or e-mail the assigned trademark examining attorney. All relevant e-mail communications will be placed in the official application record; however, an e-mail communication will not be accepted as a response to this Office action and will not extend the deadline for filing a proper response. See 37 C.F.R. §2.191; TMEP §§304.01-.02, 709.04-.05. Further, although the trademark examining attorney may provide additional explanation pertaining to the refusal(s) and/or requirement(s) in this Office action, the trademark examining attorney may not provide legal advice or statements about applicant’s rights. See TMEP §§705.02, 709.06.

/Sophia S. Kim/
Sophia S. Kim, Esq.
Examining Attorney
USPTO Law 106
571-272-9178
sophia.kim@uspto.gov

TO RESPOND TO THIS LETTER: Go to http://www.uspto.gov/trademarks/teas/response_forms.jsp. Please wait 48-72 hours from the issue/ mailing date before using TEAS, to allow for necessary system updates of the application. For *technical* assistance with online forms, e-mail TEAS@uspto.gov. For questions about the Office action itself, please contact the assigned trademark examining attorney. **E-mail communications will not be accepted as responses to Office actions; therefore, do not respond to this Office action by e-mail.**

All informal e-mail communications relevant to this application will be placed in the official application record.

WHO MUST SIGN THE RESPONSE: It must be personally signed by an individual applicant or someone with legal authority to bind an applicant (i.e., a corporate officer, a general partner, all joint applicants). If an applicant is represented by an attorney, the attorney must sign the response.

PERIODICALLY CHECK THE STATUS OF THE APPLICATION: To ensure that applicant does not miss crucial deadlines or official notices, check the status of the application every three to four months using Trademark Applications and Registrations Retrieval (TARR) at <http://tarr.uspto.gov/>. Please keep a

copy of the complete TARR screen. If TARR shows no change for more than six months, call 1-800-786-9199. For more information on checking status, see <http://www.uspto.gov/trademarks/process/status/>.

TO UPDATE CORRESPONDENCE/E-MAIL ADDRESS: Use the TEAS form at <http://www.uspto.gov/teas/eTEASpageE.htm>.

Print: Feb 13, 2012

85381434

DESIGN MARK

Serial Number

85381434

Status

NON-FINAL ACTION - MAILED

Word Mark

EGO

Standard Character Mark

Yes

Type of Mark

TRADEMARK

Register

PRINCIPAL

Mark Drawing Code

(4) STANDARD CHARACTER MARK

Owner

Electronic Cigarettes Inc. CORPORATION NEW YORK PO Box 739 Binghamton
NEW YORK 13905

Goods/Services

Class Status -- ACTIVE. IC 034. US 002 008 009 017. G & S:
Electronic cigarettes for use as an alternative to traditional
cigarettes. First Use: 2009/12/01. First Use In Commerce:
2010/03/05.

Filing Date

2011/07/26

Examining Attorney

FINNEGAN, TIMOTHY

ego

Print: Feb 8, 2012

78708541

DESIGN MARK

Serial Number
78708541

Status
REGISTERED

Word Mark
EGO

Standard Character Mark
Yes

Registration Number
3283706

Date Registered
2007/08/21

Type of Mark
TRADEMARK

Register
PRINCIPAL

Mark Drawing Code
(4) STANDARD CHARACTER MARK

Owner
Omega Tobacco Distributors, Inc. CORPORATION FLORIDA 2182 NE 186
Terrace North Miami Beach FLORIDA 33179

Goods/Services
Class Status -- ACTIVE. IC 034. US 002 008 009 017. G & S: TOBACCO
PRODUCTS, NAMELY CIGARS. First Use: 2004/12/01. First Use In
Commerce: 2005/04/01.

Filing Date
2005/09/07

Examining Attorney
GUSTASON, ANNE E.

EGO

DESIGN MARK

Serial Number
77514632

Status
REGISTERED

Word Mark
FIFTY-ONE

Standard Character Mark
No

Registration Number
3762126

Date Registered
2010/03/23

Type of Mark
TRADEMARK

Register
PRINCIPAL

Mark Drawing Code
(3) DESIGN PLUS WORDS, LETTERS AND/OR NUMBERS

Owner
Smoke Anywhere, Inc. CORPORATION FLORIDA 2704 S. Park Road Pembroke
Park FLORIDA 33009

Goods/Services
Class Status -- ACTIVE. IC 034. US 002 008 009 017. G & S: Smoking
simulators, namely, electronic cigarettes, cigars, and pipes without
tobacco, not for medical use; tobacco; tobacco products, namely,
cigars, cigarettes, smoking tobacco, chewing tobacco, snuff tobacco;
tobacco substitutes not for medicinal purposes; smokers' articles,
namely, tobacco tins, cigar and cigarette holders, cigar and cigarette
cases, ashtrays, humidors, pipe stands, pipe cleaners, cigar cutters,
pipes, pipe bags, lighters, pocket equipment for rolling cigarettes,
cigarette papers, cigarette cases, cigarette filters; matches. First
Use: 2008/04/02. First Use In Commerce: 2008/04/22.

Description of Mark
The mark consists of the wording "FIFTY-ONE" in type face Monotype
Corsiva, placed between top and bottom horizontal etched looking
borders; the entire mark is in the color Gold; the color black appears
as background only and is not claimed as a feature of the mark.

Print: Feb 14, 2012

77514632

Colors Claimed

The color(s) Gold is/are claimed as a feature of the mark.

Filing Date

2008/07/03

Examining Attorney

SHIH, SALLY



Fifty-One



DESIGN MARK

Serial Number

77686064

Status

REGISTERED

Word Mark

BLUNTARILLO

Standard Character Mark

Yes

Registration Number

3759116

Date Registered

2010/03/09

Type of Mark

TRADEMARK

Register

PRINCIPAL

Mark Drawing Code

(4) STANDARD CHARACTER MARK

Owner

BEK Tobacco & Foods LLP DBA HBI International LIMITED PARTNERSHIP
ARIZONA 3315 W. Buckeye Rd., Ste. 4 Phoenix ARIZONA 85009

Goods/Services

Class Status -- ACTIVE. IC 034. US 002 008 009 017. G & S: Cigar tubes; Cigarette filters; Cigarette papers; Cigarette rolling papers; Cigarette-rolling machines; Cigarettes; Cigarillos; Electronic cigarettes for use as an alternative to traditional cigarettes; Filter-tipped cigarettes; Hand-rolling tobacco; Pocket appliances for rolling one's own cigarettes; Pocket devices for self-rolling of cigarettes; Roll your own tobacco; Rolling tobacco; Smokeless cigarette vaporizer pipe; Smoking tobacco; Tobacco; Tobacco pouches; Tobacco, cigars and cigarettes. First Use: 2009/06/11. First Use In Commerce: 2009/06/11.

Filing Date

2009/03/08

Examining Attorney

DELANEY, ZHALEH

BLUNTARILLO

DESIGN MARK

Serial Number

77811722

Status

REGISTERED

Word Mark

VEGAS STRIP CIGARS

Standard Character Mark

Yes

Registration Number

3930205

Date Registered

2011/03/08

Type of Mark

TRADEMARK

Register

SUPPLEMENTAL

Mark Drawing Code

(4) STANDARD CHARACTER MARK

Owner

Pallino, Gary A. INDIVIDUAL UNITED STATES 5675 W. Rochelle Ave. # 101
Las Vegas NEVADA 89103

Goods/Services

Class Status -- ACTIVE. IC 034. US 002 008 009 017. G & S: Cigar and cigarette boxes; Cigar and cigarette boxes not of precious metal; Cigar and cigarette boxes of precious metal; Cigar boxes; Cigar boxes not of precious metal; Cigar boxes of precious metal; Cigar cases; Cigar cases of precious metal; Cigar cutters; Cigar holders; Cigar holders of precious metal; Cigar humidifiers; Cigar lighters; Cigar tubes; Cigarette ash receptacles; Cigarette cases; Cigarette cases made of precious metal; Cigarette cases not of precious metal; Cigarette filters; Cigarette holders; Cigarette holders not of precious metal; Cigarette holders of precious metal; Cigarette lighter holder; Cigarette lighter holder not of precious metal; Cigarette lighters not for land vehicles; Cigarette lighters not of precious metal; Cigarette lighters of precious metal; Cigarette lights not of precious metal; Cigarette paper; Cigarette papers; Cigarette rolling machines; Cigarette rolling papers; Cigarette tubes; Cigarette-rolling machines; Cigarettes; Cigarettes containing tobacco substitutes not for medical purposes; Cigars; Clips for attaching cigarette lighters

onto objects; Electric cigarettes; Electronic cigarettes; Electronic cigarettes for use as an alternative to traditional cigarettes; Filter-tipped cigarettes; Filtered cigars and cigarettes; Hand-held machines for injecting tobacco into cigarette tubes; Holder for a cigarette pack and lighter; Holders for cigar and cigarette of precious metal; Holders for cigars and cigarettes; Holders of cigars and cigarettes of precious metal; Lighters for smokers; Liquefied gas cylinders for cigarette lighters; Machines allowing smokers to make cigarettes by themselves; Non-electric cigar lighters not of precious metal; Pocket apparatus for rolling cigarettes; Pocket apparatus for self-rolling cigarettes; Pocket appliances for rolling one's own cigarettes; Pocket devices for self-rolling of cigarettes; Pocket machines for rolling cigarettes; Pocket-size cigarette rolling machines; Smokeless cigarette vaporizer pipe; Smokers' articles, namely, cigar glue; Smokers' articles, namely, cigar relighting liquid solution; Smokers' articles, namely, cigar storage tubes; Smokers' articles, namely, containment clips used to keep a cigar from falling apart; Smokers' articles, namely, outdoor cigar and cigarette disposal units; Smokers' articles, namely, outdoor receptacles for cigar and cigarette ash and waste; Smoker's articles, namely, metal pocket-sized receptacles with lids for cigarette butts; Tobacco, cigars and cigarettes. First Use: 2010/11/26. First Use In Commerce: 2010/11/26.

Disclaimer Statement

NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "CIGARS" APART FROM THE MARK AS SHOWN.

Filing Date

2009/08/24

Amended Register Date

2010/12/04

Examining Attorney

FATHY, JESSICA

Vegas Strip Cigars

DESIGN MARK

Serial Number
78627638

Status
REGISTERED

Word Mark
GENGHIS KHAN

Standard Character Mark
Yes

Registration Number
3152224

Date Registered
2006/10/03

Type of Mark
TRADEMARK

Register
PRINCIPAL

Mark Drawing Code
(4) STANDARD CHARACTER MARK

Owner
K. Hansotia & Co., Inc. CORPORATION FLORIDA 3705 N.W. 115 Avenue, Bay
#5 Miami FLORIDA 33178

Goods/Services
Class Status -- ACTIVE. IC 034. US 002 008 009 017. G & S: [Tobacco, cigarettes,] cigars [; articles for smokers not of precious metal, namely, non-electric cigarette lighters, cigarette cases, cigar cases, cigarette holders and cigar holders]. First Use: 2005/02/10. First Use In Commerce: 2005/02/10.

Filing Date
2005/05/11

Examining Attorney
THOMAS, RAY

Attorney of Record
Pablo Meles

GENGHIS KHAN

DESIGN MARK

Serial Number
85268503

Status
REGISTERED

Word Mark
THE GOLD STANDARD OF E-CIGARETTES

Standard Character Mark
Yes

Registration Number
4062663

Date Registered
2011/11/29

Type of Mark
TRADEMARK

Register
PRINCIPAL

Mark Drawing Code
(4) STANDARD CHARACTER MARK

Owner
Hansen, Tyler M INDIVIDUAL UNITED STATES 511 Bailey Ave New Hampton
IOWA 50659

Goods/Services
Class Status -- ACTIVE. IC 034. US 002 008 009 017. G & S: Cigar
and cigarette boxes; Cigar and cigarette boxes not of precious metal;
Cigarette filters; Cigarette holders; Electric cigarettes; Electronic
cigarettes; Electronic cigarettes for use as an alternative to
traditional cigarettes; Smokeless cigarette vaporizer pipe; Tobacco,
cigars and cigarettes. First Use: 2007/05/15. First Use In Commerce:
2010/02/10.

Disclaimer Statement
NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "E-CIGARETTES" APART
FROM THE MARK AS SHOWN.

Filing Date
2011/03/16

Examining Attorney
EVANKO, PATRICIA

THE GOLD STANDARD OF E-CIGARETTES

EXHIBIT C

To: Joyetech (Changzhou) Electronics Co., Lt ETC. (ckc@slepatents.com)
Subject: U.S. TRADEMARK APPLICATION NO. 85451811 - EGO-C - JOY.ITU4T
Sent: 10/4/2012 1:55:25 PM
Sent As: ECOM106@USPTO.GOV
Attachments:

**UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)
OFFICE ACTION (OFFICIAL LETTER) ABOUT APPLICANT'S TRADEMARK APPLICATION**

APPLICATION SERIAL NO. 85451811

MARK: EGO-C

85451811

CORRESPONDENT ADDRESS:

Corey K. Cho
Saliwanchik, Lloyd & Eisenschenk
P.O. Box 142950
Gainesville FL 32614

CLICK HERE TO RESPOND
<http://www.uspto.gov/trademarks/te>

APPLICANT: Joyetech (Changzhou) Electronics Co., Lt ETC.

CORRESPONDENT'S REFERENCE/DOCKET NO :

JOY.ITU4T

CORRESPONDENT E-MAIL ADDRESS:

ckc@slepatents.com

OFFICE ACTION

STRICT DEADLINE TO RESPOND TO THIS LETTER

TO AVOID ABANDONMENT OF APPLICANT'S TRADEMARK APPLICATION, THE USPTO MUST RECEIVE APPLICANT'S COMPLETE RESPONSE TO THIS LETTER **WITHIN 6 MONTHS** OF THE ISSUE/MAILING DATE BELOW.

ISSUE/MAILING DATE: 10/4/2012

THIS IS A FINAL ACTION.

This Office action is in response to applicant's communication filed on July 27, 2012. The applicant has responded to the following refusal(s) and/or requirement(s). See 37 C.F.R. §2.64(a).

- (1) Potential Section 2(d) refusal – withdrawn; Trademark Ser. No. 85381434 has abandoned
- (2) Section 2(d) refusal citing Reg. No. 3283706 – unacceptable

(3) Identification of goods - acceptable

SECTION 2(D) – FINAL REFUSAL

For the reasons set forth below, the refusal under Trademark Act Section 2(d) is now made FINAL with respect to U.S. Registration No(s). 3283706. *See* 15 U.S.C. §1052(d); 37 C.F.R. §2.64(a).

The applicant has applied to register “EGO-C” for apparatus for heating and vapor generating, namely, electric vaporizers, in International Class 11; inhalers, sold empty, not for medical or therapeutic use, in International Class 21; and electronic cigarettes; electronic nicotine inhalation devices, namely electronic cigarettes and electronic cigarette cartridges, electronic cigarette atomizers, electronic cigarette cartomizers and refill liquid nicotine solutions, in International Class 34.

The cited mark is “EGO” for tobacco products, namely, cigars, in International Class 34.

The applicant has not responded to this refusal. In this case, the marks of the parties are similar because they share the word “EGO”. 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 Fondee En 1772*, 396 F. 3d 1369, 1372, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005); *see also Mattel Inc. v. Funline Merch. Co.*, 81 USPQ2d 1372, 1374-75 (TTAB 2006); *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).

The mere addition of a term to a registered mark generally does not obviate the similarity between the marks nor does it overcome a likelihood of confusion under Trademark Act Section 2(d). *See In re Chatam Int’l Inc.*, 380 F.3d 1340, 71 USPQ2d 1944 (Fed. Cir. 2004) (GASPAR’S ALE and JOSE GASPAR GOLD); *Coca-Cola Bottling Co. v. Jos. E. Seagram & Sons, Inc.*, 526 F.2d 556, 188 USPQ 105 (C.C.P.A. 1975) (BENGAL and BENGAL LANCER); *Lilly Pulitzer, Inc. v. Lilli Ann Corp.*, 376 F.2d 324, 153 USPQ 406 (C.C.P.A. 1967) (THE LILLY and LILLI ANN); *In re Toshiba Med. Sys. Corp.*, 91 USPQ2d 1266 (TTAB 2009) (TITAN and VANTAGE TITAN); *In re El Torito Rests., Inc.*, 9 USPQ2d 2002 (TTAB 1988) (MACHO and MACHO COMBOS); *In re Corning Glass Works*, 229 USPQ 65 (TTAB 1985) (CONFIRM and CONFIRMCELLS); *In re U.S. Shoe Corp.*, 229 USPQ 707 (TTAB 1985) (CAREER IMAGE and CREST CAREER IMAGES); *In re Riddle*, 225 USPQ 630 (TTAB 1985) (ACCUTUNE and RICHARD PETTY’S ACCU TUNE); TMEP §1207.01(b)(iii).

The goods of the parties are closely related because they are both tobacco-related products. The goods and/or services of the parties need not be identical or directly competitive to find a likelihood of confusion. *See Safety-Kleen Corp. v. Dresser Indus., Inc.*, 518 F.2d 1399, 1404, 186 USPQ 476, 480 (C.C.P.A. 1975); TMEP §1207.01(a)(i). Rather, it is sufficient to show that because of the conditions surrounding their marketing, or because they are otherwise related in some manner, the goods and/or services would be encountered by the same consumers under circumstances such that offering the goods and/or services under confusingly similar marks would lead to the mistaken belief that they come from, or are in some way associated with, the same source. *In re Iolo Techs., LLC*, 95 USPQ2d 1498, 1499 (TTAB 2010); *see In re Martin’s Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 1566-68, 223 USPQ 1289, 1290 (Fed. Cir. 1984); TMEP §1207.01(a)(i). In this case, while the goods of the parties are not identical, they are related options or substitute products, such a smoker may smoke cigars or electric cigarettes.

For these reasons, the refusal is continued and made FINAL.

PROPER RESPONSE TO FINAL OFFICE ACTION

If applicant does not respond within six months of the date of issuance of this final Office action, the application will be abandoned. 15 U.S.C. §1062(b); 37 C.F.R. §2.65(a). Applicant may respond to this

final Office action by:

- (1) Submitting a response that fully satisfies all outstanding requirements, if feasible; and/or
- (2) Filing an appeal to the Trademark Trial and Appeal Board, with an appeal fee of \$100 per class.

37 C.F.R. §§2.6(a)(18), 2.64(a); TBMP ch. 1200; TMEP §714.04.

In certain rare circumstances, a petition to the Director may be filed pursuant to 37 C.F.R. §2.63(b)(2) to review a final Office action that is limited to procedural issues. 37 C.F.R. §2.64(a); TMEP §714.04; *see* 37 C.F.R. §2.146(b); TBMP §1201.05; TMEP §1704 (explaining petitionable matters). The petition fee is \$100. 37 C.F.R. §2.6(a)(15).

COMMUNICATION

If applicant has questions regarding this Office action, please telephone or e-mail the assigned trademark examining attorney. All relevant e-mail communications will be placed in the official application record; however, an e-mail communication will not be accepted as a response to this Office action and will not extend the deadline for filing a proper response. *See* 37 C.F.R. §2.191; TMEP §§304.01-.02, 709.04-.05. Further, although the trademark examining attorney may provide additional explanation pertaining to the refusal(s) and/or requirement(s) in this Office action, the trademark examining attorney may not provide legal advice or statements about applicant's rights. *See* TMEP §§705.02, 709.06.

/Sophia S. Kim/
Sophia S. Kim
Trademark Examining Attorney
Law Office 106
571-272-9178
sophia.kim@uspto.gov

TO RESPOND TO THIS LETTER: Go to http://www.uspto.gov/trademarks/teas/response_forms.jsp. Please wait 48-72 hours from the issue/ mailing date before using TEAS, to allow for necessary system updates of the application. For *technical* assistance with online forms, e-mail TEAS@uspto.gov. For questions about the Office action itself, please contact the assigned trademark examining attorney. **E-mail communications will not be accepted as responses to Office actions; therefore, do not respond to this Office action by e-mail.**

All informal e-mail communications relevant to this application will be placed in the official application record.

WHO MUST SIGN THE RESPONSE: It must be personally signed by an individual applicant or someone with legal authority to bind an applicant (i.e., a corporate officer, a general partner, all joint applicants). If an applicant is represented by an attorney, the attorney must sign the response.

PERIODICALLY CHECK THE STATUS OF THE APPLICATION: To ensure that applicant does

not miss crucial deadlines or official notices, check the status of the application every three to four months using Trademark Applications and Registrations Retrieval (TARR) at <http://tarr.uspto.gov/>. Please keep a copy of the complete TARR screen. If TARR shows no change for more than six months, call 1-800-786-9199. For more information on checking status, see <http://www.uspto.gov/trademarks/process/status/>.

TO UPDATE CORRESPONDENCE/E-MAIL ADDRESS: Use the TEAS form at <http://www.uspto.gov/teas/eTEASpageE.htm>.

WHEREFORE, Petitioner respectfully requests that its Petition for Cancellation be sustained and that Registration No. 3,283,706 be cancelled.

Dated: Gainesville, FL
April 1, 2013

Respectfully submitted,



Corey K. Cho
Attorney for Petitioner
Saliwanchik, Lloyd & Eisenschenk
3107 SW Williston Road
Gainesville, FL 32608
Phone: (352) 375-8100
Fax: (352) 372-5800

CERTIFICATE OF TRANSMISSION

I hereby certify that this correspondence is being electronically transmitted to the United States Patent and Trademark Office on the date shown below.

By: 
Corey K. Cho

Date: 4/1/2013

CERTIFICATE OF SERVICE

I hereby certify that on this 1st day of April, 2013, I caused a copy of the PETITION FOR CANCELLATION to be served by prepaid, first-class mail upon Registrant's representative at the address below:

Pinhas Assouline
2182 NE 186 Terrace
Miami, FL 33179

By: _____



Corey K. Cho

EXHIBIT A

Trademark/Service Mark Application, Principal Register

Serial Number: 85477422

Filing Date: 11/21/2011

To the Commissioner for Trademarks:

MARK: EGO-T (Standard Characters, see mark)

The literal element of the mark consists of EGO-T.

The mark consists of standard characters, without claim to any particular font, style, size, or color.

The applicant, Joyetech (Changzhou) Electronics Co., Ltd., a corporation of China, having an address of
New District,
No. 7 Feng Xiang Road
Changzhou, Jiangsu
China

requests registration of the trademark/service mark identified above in the United States Patent and Trademark Office on the Principal Register established by the Act of July 5, 1946 (15 U.S.C. Section 1051 et seq.), as amended, for the following:

International Class 010: Inhaler

Intent to Use: The applicant has a bona fide intention to use or use through the applicant's related company or licensee the mark in commerce on or in connection with the identified goods and/or services. (15 U.S.C. Section 1051(b)).

International Class 011: Apparatus for heating and vapor generating

Intent to Use: The applicant has a bona fide intention to use or use through the applicant's related company or licensee the mark in commerce on or in connection with the identified goods and/or services. (15 U.S.C. Section 1051(b)).

International Class 034: Electronic cigarettes; electronic nicotine inhalation devices, namely electronic cigarettes; electronic cigarette cartridges; electronic cigarette atomizers; electronic cigarette cartomizers; liquid nicotine solutions, namely liquid nicotine for use in electronic cigarettes

Intent to Use: The applicant has a bona fide intention to use or use through the applicant's related company or licensee the mark in commerce on or in connection with the identified goods and/or services. (15 U.S.C. Section 1051(b)).

The applicant's current Attorney Information:

Roger H Bora and Eric N. Heyer, Theodore D. Lienesch and Megan D. Dortenzo, Steven J. Elleman, David R. Jaglowski, John F. Kane, Mark P. Levy, Beverly A. Lyman, Jeffrey C. Metzcar, Michael J. Nieberding, Susan M. Oiler, Troy S. Prince, Thomas F. Zych, Louis K. Ebling, Carrie A. Shufflebarger of Thompson Hine LLP

Suite 400
10050 Innovation Drive
Dayton, Ohio 45342
United States

The attorney docket/reference number is 078741.00001.

The applicant's current Correspondence Information:

Roger H Bora
Thompson Hine LLP
Suite 400
10050 Innovation Drive
Dayton, Ohio 45342
937.443.6817(phone)
937.443.6635(fax)
trademarks@thompsonhine.com (authorized)

A fee payment in the amount of \$975 has been submitted with the application, representing payment for 3 class(es).

Declaration

The undersigned, being hereby warned that willful false statements and the like so made are punishable by fine or imprisonment, or both, under 18 U.S.C. Section 1001, and that such willful false statements, and the like, may jeopardize the validity of the application or any resulting registration, declares that he/she is properly authorized to execute this application on behalf of the applicant; he/she believes the applicant to be the owner of the trademark/service mark sought to be registered, or, if the application is being filed under 15 U.S.C. Section 1051(b), he/she believes applicant to be entitled to use such mark in commerce; to the best of his/her knowledge and belief no other person, firm, corporation, or association has the right to use the mark in commerce, either in the identical form thereof or in such near resemblance thereto as to be likely, when used on or in connection with the goods/services of such other person, to cause confusion, or to cause mistake, or to deceive; and that all statements made of his/her own knowledge are true; and that all statements made on information and belief are believed to be true.

Declaration Signature

Signature: /rhb/ Date: 11/21/2011
Signatory's Name: Roger H Bora
Signatory's Position: Attorney of record, Ohio bar member
RAM Sale Number: 8464
RAM Accounting Date: 11/21/2011

Serial Number: 85477422
Internet Transmission Date: Mon Nov 21 08:15:37 EST 2011
TEAS Stamp: USPTO/BAS-63.234.47.34-20111121081537772
701-85477422-4904450b411a41598f2c51af27c
ff32e14-CC-8464-20111121075819568115

EGO-T

EXHIBIT B

To: Joyetech (Changzhou) Electronics Co., Lt ETC. (ckc@slepatents.com)
Subject: U.S. TRADEMARK APPLICATION NO. 85477422 - EGO-T - JOY.ITU6T
Sent: 2/14/2012 1:24:13 PM
Sent As: ECOM106@USPTO.GOV
Attachments: [Attachment - 1](#)
[Attachment - 2](#)
[Attachment - 3](#)
[Attachment - 4](#)
[Attachment - 5](#)
[Attachment - 6](#)
[Attachment - 7](#)
[Attachment - 8](#)
[Attachment - 9](#)
[Attachment - 10](#)
[Attachment - 11](#)
[Attachment - 12](#)
[Attachment - 13](#)
[Attachment - 14](#)
[Attachment - 15](#)
[Attachment - 16](#)

**UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)
OFFICE ACTION (OFFICIAL LETTER) ABOUT APPLICANT'S TRADEMARK APPLICATION**

APPLICATION SERIAL NO. 85477422

MARK: EGO-T

85477422

CORRESPONDENT ADDRESS:

Corey K. Cho
Saliwanchik, Lloyd & Eisenschenk
P.O. Box 142950
Gainesville FL 32614

CLICK HERE TO RESPOND TO THIS LETTER:
http://www.uspto.gov/trademarks/teas/response_forms.jsp

APPLICANT: Joyetech (Changzhou)
Electronics Co., Lt ETC.

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

JOY.ITU6T
CORRESPONDENT E-MAIL ADDRESS:
ckc@slepatents.com

OFFICE ACTION

STRICT DEADLINE TO RESPOND TO THIS LETTER

TO AVOID ABANDONMENT OF APPLICANT'S TRADEMARK APPLICATION, THE USPTO MUST RECEIVE APPLICANT'S COMPLETE RESPONSE TO THIS LETTER **WITHIN 6 MONTHS** OF THE ISSUE/MAILING DATE BELOW.

ISSUE/MAILING DATE: 2/14/2012

The referenced application has been reviewed by the assigned trademark examining attorney. Applicant must respond timely and completely to the issue(s) below. 15 U.S.C. §1062(b); 37 C.F.R. §§2.62(a), 2.65(a); TMEP §§711, 718.03.

EARLIER-FILED PENDING APPLICATION

The filing date of pending Application Serial No. 85381434 precedes applicant's filing date. See attached referenced application. If the mark in the referenced application registers, applicant's mark may be refused registration under Trademark Act Section 2(d) because of a likelihood of confusion between the two marks. See 15 U.S.C. §1052(d); 37 C.F.R. §2.83; TMEP §§1208 *et seq.* Therefore, upon receipt of applicant's response to this Office action, action on this application may be suspended pending final disposition of the earlier-filed referenced application.

In response to this Office action, applicant may present arguments in support of registration by addressing the issue of the potential conflict between applicant's mark and the mark in the referenced application. Applicant's election not to submit arguments at this time in no way limits applicant's right to address this issue later if a refusal under Section 2(d) issues.

ADDITIONAL REFUSAL(S) AND/OR REQUIREMENT(S)

Upon receipt of applicant's response resolving the following requirement(s), action on this application will be suspended pending the disposition of Application Serial No(s). 85381434. 37 C.F.R. §2.83(c); TMEP §§716.02(c), 1208.02(c).

SECTION 2(D) REFUSAL

Registration of the applied-for mark is refused because of a likelihood of confusion with the mark in U.S. Registration No. 3283706. Trademark Act Section 2(d), 15 U.S.C. §1052(d); see TMEP §§1207.01 *et seq.* See the enclosed registration.

Trademark Act Section 2(d) bars registration of an applied-for mark that so resembles a registered mark that it is likely that a potential consumer would be confused or mistaken or deceived as to the source of the goods and/or services of the applicant and registrant. See 15 U.S.C. §1052(d). The court in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (C.C.P.A. 1973) listed the principal factors to be considered when determining whether there is a likelihood of confusion under Section 2(d). See TMEP §1207.01. However, not all the factors are necessarily relevant or of equal weight, and any one factor may be dominant in a given case, depending upon the evidence of record. *Citigroup Inc. v. Capital City Bank Grp., Inc.*, 637 F.3d 1344, 1355, 98 USPQ2d 1253, 1260 (Fed. Cir. 2011); *In re Majestic Distilling Co.*, 315 F.3d 1311, 1315, 65 USPQ2d 1201, 1204 (Fed. Cir. 2003); see *In re E. I. du Pont*, 476 F.2d at 1361-62, 177 USPQ at 567.

In this case, the following factors are the most relevant: similarity of the marks, similarity of the goods

and/or services, and similarity of trade channels of the goods and/or services. *See In re Dakin's Miniatures Inc.*, 59 USPQ2d 1593 (TTAB 1999); TMEP §§1207.01 *et seq.*

The applicant has applied to register “EGO-T” for inhaler, in International Class 10; apparatus for heating and vapor generating, in International Class 11; and electronic cigarettes, electronic nicotine inhalation devices, electronic cigarette cartridges, electronic cigarette atomizers, electronic cigarette cartomizers, liquid nicotine solutions, in International Class 34.

The cited mark is “EGO” for tobacco products, namely cigars, in International Class 34.

In a likelihood of confusion determination, the marks are compared for similarities in their appearance, sound, meaning or connotation, and commercial impression. *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). Similarity in any one of these elements may be sufficient to find the marks confusingly similar. *In re White Swan Ltd.*, 8 USPQ2d 1534, 1535 (TTAB 1988); *see In re 1st USA Realty Prof'ls, Inc.*, 84 USPQ2d 1581, 1586 (TTAB 2007); TMEP §1207.01(b).

In this case, the marks of the parties are similar because they share the word “EGO”. 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); *see also Mattel Inc. v. Funline Merch. Co.*, 81 USPQ2d 1372, 1374-75 (TTAB 2006); *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).

The mere addition of a term to a registered mark generally does not obviate the similarity between the marks nor does it overcome a likelihood of confusion under Trademark Act Section 2(d). *See In re Chatam Int'l Inc.*, 380 F.3d 1340, 71 USPQ2d 1944 (Fed. Cir. 2004) (GASPAR'S ALE and JOSE GASPAR GOLD); *Coca-Cola Bottling Co. v. Jos. E. Seagram & Sons, Inc.*, 526 F.2d 556, 188 USPQ 105 (C.C.P.A. 1975) (BENGAL and BENGAL LANCER); *Lilly Pulitzer, Inc. v. Lilli Ann Corp.*, 376 F.2d 324, 153 USPQ 406 (C.C.P.A. 1967) (THE LILLY and LILLI ANN); *In re Toshiba Med. Sys. Corp.*, 91 USPQ2d 1266 (TTAB 2009) (TITAN and VANTAGE TITAN); *In re El Torito Rests., Inc.*, 9 USPQ2d 2002 (TTAB 1988) (MACHO and MACHO COMBOS); *In re Corning Glass Works*, 229 USPQ 65 (TTAB 1985) (CONFIRM and CONFIRMCELLS); *In re U.S. Shoe Corp.*, 229 USPQ 707 (TTAB 1985) (CAREER IMAGE and CREST CAREER IMAGES); *In re Riddle*, 225 USPQ 630 (TTAB 1985) (ACCUTUNE and RICHARD PETTY'S ACCU TUNE); TMEP §1207.01(b)(iii).

The goods of the parties are closely related because they are both tobacco products. The goods and/or services of the parties need not be identical or directly competitive to find a likelihood of confusion. *See Safety-Kleen Corp. v. Dresser Indus., Inc.*, 518 F.2d 1399, 1404, 186 USPQ 476, 480 (C.C.P.A. 1975); TMEP §1207.01(a)(i). Rather, it is sufficient to show that because of the conditions surrounding their marketing, or because they are otherwise related in some manner, the goods and/or services would be encountered by the same consumers under circumstances such that offering the goods and/or services under confusingly similar marks would lead to the mistaken belief that they come from, or are in some way associated with, the same source. *In re Iolo Techs., LLC*, 95 USPQ2d 1498, 1499 (TTAB 2010); *see In re Martin's Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 1566-68, 223 USPQ 1289, 1290 (Fed. Cir. 1984); TMEP §1207.01(a)(i).

The trademark examining attorney has attached evidence from the USPTO's X-Search database consisting of a number of third-party marks registered for use in connection with the same or similar

goods and/or services as those of both applicant and registrant in this case. This evidence shows that the goods and/or services listed therein, namely “electronic cigarettes” and “cigars”, are of a kind that may emanate from a single source under a single mark. See *In re Davey Prods. Pty Ltd.*, 92 USPQ2d 1198, 1203 (TTAB 2009); *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783, 1785-86 (TTAB 1993); *In re Mucky Duck Mustard Co.*, 6 USPQ2d 1467, 1470 n.6 (TTAB 1988); TMEP §1207.01(d)(iii).

Although applicant’s mark has been refused registration, applicant may respond to the refusal(s) by submitting evidence and arguments in support of registration.

IDENTIFICATION OF GOODS

The identification of goods is indefinite and must be clarified. See TMEP §1402.01. Applicant must specify the common commercial or generic name for the goods. If there is no common commercial or generic name, applicant must describe the product and intended consumer as well as its main purpose and intended uses.

Further, the identification of goods must be clarified because it is too broad and could include goods in other international classes. See TMEP §§1402.01, 1402.03.

Applicant may adopt the following identification of goods, if accurate. See TMEP §1402.01. Bracketed wordings are suggested deletions and bolded wordings are suggested amendments.

International Class 10

Inhaler **for medical purposes sold empty; inhalers for therapeutic use sold empty**

International Class 11

Apparatus for heating and vapor generating, **namely, electric vaporizers**

International Class 21 (see below to add this class)

Inhalers, sold empty, not for medical or therapeutic use

International Class 34

~~[Electronic cigarettes, electronic nicotine inhalation devices, electronic cigarette cartridges, electronic cigarette atomizers, electronic cigarette cartomizers, liquid nicotine solutions];~~ **electronic cigarettes; electronic nicotine inhalation devices, namely, electronic cigarette refill cartridges, electronic cigarette atomizers, electronic cigarette cartomizers and refill liquid nicotine solutions**

An applicant may amend an identification of goods only to clarify or limit the goods; adding to or broadening the scope of the goods is not permitted. 37 C.F.R. §2.71(a); see TMEP §§1402.06 *et seq.*, 1402.07 *et seq.*

For assistance with identifying and classifying goods and/or services in trademark applications, please see the online searchable *Manual of Acceptable Identifications of Goods and Services* at <http://tess2.uspto.gov/netahhtml/tidm.html>. See TMEP §1402.04.

ADDITIONAL CLASS – INTENT TO USE

For an application with more than one international class, called a “multiple-class application,” an applicant must meet all of the requirements below for those international classes based on an intent to use the mark in commerce under Trademark Act Section 1(b):

(1) LIST GOODS AND/OR SERVICES BY INTERNATIONAL CLASS: Applicant must list the goods and/or services by international class; and

(2) PROVIDE FEES FOR ALL INTERNATIONAL CLASSES: Applicant must submit an application filing fee for each international class of goods and/or services not covered by the fee(s) already paid (confirm current fee information at <http://www.uspto.gov>, click on "View Fee Schedule" under the column titled "Trademarks").

See 15 U.S.C. §§1051(b), 1112, 1126(e); 37 C.F.R. §§2.34(a)(2)-(3), 2.86(a); TMEP §§1403.01, 1403.02(c).

COMMUNICATION

If applicant has questions regarding this Office action, please telephone or e-mail the assigned trademark examining attorney. All relevant e-mail communications will be placed in the official application record; however, an e-mail communication will not be accepted as a response to this Office action and will not extend the deadline for filing a proper response. See 37 C.F.R. §2.191; TMEP §§304.01-.02, 709.04-.05. Further, although the trademark examining attorney may provide additional explanation pertaining to the refusal(s) and/or requirement(s) in this Office action, the trademark examining attorney may not provide legal advice or statements about applicant's rights. See TMEP §§705.02, 709.06.

/Sophia S. Kim/
Sophia S. Kim, Esq.
Examining Attorney
USPTO Law 106
571-272-9178
sophia.kim@uspto.gov

TO RESPOND TO THIS LETTER: Go to http://www.uspto.gov/trademarks/teas/response_forms.jsp. Please wait 48-72 hours from the issue/ mailing date before using TEAS, to allow for necessary system updates of the application. For *technical* assistance with online forms, e-mail TEAS@uspto.gov. For questions about the Office action itself, please contact the assigned trademark examining attorney. **E-mail communications will not be accepted as responses to Office actions; therefore, do not respond to this Office action by e-mail.**

All informal e-mail communications relevant to this application will be placed in the official application record.

WHO MUST SIGN THE RESPONSE: It must be personally signed by an individual applicant or someone with legal authority to bind an applicant (i.e., a corporate officer, a general partner, all joint applicants). If an applicant is represented by an attorney, the attorney must sign the response.

PERIODICALLY CHECK THE STATUS OF THE APPLICATION: To ensure that applicant does not miss crucial deadlines or official notices, check the status of the application every three to four months using Trademark Applications and Registrations Retrieval (TARR) at <http://tarr.uspto.gov/>. Please keep a

copy of the complete TARR screen. If TARR shows no change for more than six months, call 1-800-786-9199. For more information on checking status, see <http://www.uspto.gov/trademarks/process/status/>.

TO UPDATE CORRESPONDENCE/E-MAIL ADDRESS: Use the TEAS form at <http://www.uspto.gov/teas/eTEASpageE.htm>.

DESIGN MARK

Serial Number

85381434

Status

NON-FINAL ACTION - MAILED

Word Mark

EGO

Standard Character Mark

Yes

Type of Mark

TRADEMARK

Register

PRINCIPAL

Mark Drawing Code

(4) STANDARD CHARACTER MARK

Owner

Electronic Cigarettes Inc. CORPORATION NEW YORK PO Box 739 Binghamton
NEW YORK 13905

Goods/Services

Class Status -- ACTIVE. IC 034. US 002 008 009 017. G & S:
Electronic cigarettes for use as an alternative to traditional
cigarettes. First Use: 2009/12/01. First Use In Commerce:
2010/03/05.

Filing Date

2011/07/26

Examining Attorney

FINNEGAN, TIMOTHY

ego

DESIGN MARK

Serial Number
78708541

Status
REGISTERED

Word Mark
EGO

Standard Character Mark
Yes

Registration Number
3283706

Date Registered
2007/08/21

Type of Mark
TRADEMARK

Register
PRINCIPAL

Mark Drawing Code
(4) STANDARD CHARACTER MARK

Owner
Omega Tobacco Distributors, Inc. CORPORATION FLORIDA 2182 NE 186
Terrace North Miami Beach FLORIDA 33179

Goods/Services
Class Status -- ACTIVE. IC 034. US 002 008 009 017. G & S: TOBACCO
PRODUCTS, NAMELY CIGARS. First Use: 2004/12/01. First Use In
Commerce: 2005/04/01.

Filing Date
2005/09/07

Examining Attorney
GUSTASON, ANNE E.

EGO

DESIGN MARK

Serial Number

77514632

Status

REGISTERED

Word Mark

FIFTY-ONE

Standard Character Mark

No

Registration Number

3762126

Date Registered

2010/03/23

Type of Mark

TRADEMARK

Register

PRINCIPAL

Mark Drawing Code

(3) DESIGN PLUS WORDS, LETTERS AND/OR NUMBERS

Owner

Smoke Anywhere, Inc. CORPORATION FLORIDA 2704 S. Park Road Pembroke Park FLORIDA 33009

Goods/Services

Class Status -- ACTIVE. IC 034. US 002 008 009 017. G & S: Smoking simulators, namely, electronic cigarettes, cigars, and pipes without tobacco, not for medical use; tobacco; tobacco products, namely, cigars, cigarettes, smoking tobacco, chewing tobacco, snuff tobacco; tobacco substitutes not for medicinal purposes; smokers' articles, namely, tobacco tins, cigar and cigarette holders, cigar and cigarette cases, ashtrays, humidors, pipe stands, pipe cleaners, cigar cutters, pipes, pipe bags, lighters, pocket equipment for rolling cigarettes, cigarette papers, cigarette cases, cigarette filters; matches. First Use: 2008/04/02. First Use In Commerce: 2008/04/22.

Description of Mark

The mark consists of the wording "FIFTY-ONE" in type face Monotype Corsiva, placed between top and bottom horizontal etched looking borders; the entire mark is in the color Gold; the color black appears as background only and is not claimed as a feature of the mark.

Print: Feb 14, 2012

77514632

Colors Claimed

The color(s) Gold is/are claimed as a feature of the mark.

Filing Date

2008/07/03

Examining Attorney

SHIH, SALLY



Fifty-One



DESIGN MARK

Serial Number
77686064

Status
REGISTERED

Word Mark
BLUNTARILLO

Standard Character Mark
Yes

Registration Number
3759116

Date Registered
2010/03/09

Type of Mark
TRADEMARK

Register
PRINCIPAL

Mark Drawing Code
(4) STANDARD CHARACTER MARK

Owner
BEK Tobacco & Foods LLP DBA HBI International LIMITED PARTNERSHIP
ARIZONA 3315 W. Buckeye Rd., Ste. 4 Phoenix ARIZONA 85009

Goods/Services
Class Status -- ACTIVE. IC 034. US 002 008 009 017. G & S: Cigar tubes; Cigarette filters; Cigarette papers; Cigarette rolling papers; Cigarette-rolling machines; Cigarettes; Cigarillos; Electronic cigarettes for use as an alternative to traditional cigarettes; Filter-tipped cigarettes; Hand-rolling tobacco; Pocket appliances for rolling one's own cigarettes; Pocket devices for self-rolling of cigarettes; Roll your own tobacco; Rolling tobacco; Smokeless cigarette vaporizer pipe; Smoking tobacco; Tobacco; Tobacco pouches; Tobacco, cigars and cigarettes. First Use: 2009/06/11. First Use In Commerce: 2009/06/11.

Filing Date
2009/03/08

Examining Attorney
DELANEY, ZHALEH

BLUNTARILLO

DESIGN MARK

Serial Number
77811722

Status
REGISTERED

Word Mark
VEGAS STRIP CIGARS

Standard Character Mark
Yes

Registration Number
3930205

Date Registered
2011/03/08

Type of Mark
TRADEMARK

Register
SUPPLEMENTAL

Mark Drawing Code
(4) STANDARD CHARACTER MARK

Owner
Pallino, Gary A. INDIVIDUAL UNITED STATES 5675 W. Rochelle Ave. # 101
Las Vegas NEVADA 89103

Goods/Services
Class Status -- ACTIVE. IC 034. US 002 008 009 017. G & S: Cigar and cigarette boxes; Cigar and cigarette boxes not of precious metal; Cigar and cigarette boxes of precious metal; Cigar boxes; Cigar boxes not of precious metal; Cigar boxes of precious metal; Cigar cases; Cigar cases of precious metal; Cigar cutters; Cigar holders; Cigar holders of precious metal; Cigar humidifiers; Cigar lighters; Cigar tubes; Cigarette ash receptacles; Cigarette cases; Cigarette cases made of precious metal; Cigarette cases not of precious metal; Cigarette filters; Cigarette holders; Cigarette holders not of precious metal; Cigarette holders of precious metal; Cigarette lighter holder; Cigarette lighter holder not of precious metal; Cigarette lighters not for land vehicles; Cigarette lighters not of precious metal; Cigarette lighters of precious metal; Cigarette lights not of precious metal; Cigarette paper; Cigarette papers; Cigarette rolling machines; Cigarette rolling papers; Cigarette tubes; Cigarette-rolling machines; Cigarettes; Cigarettes containing tobacco substitutes not for medical purposes; Cigars; Clips for attaching cigarette lighters

onto objects; Electric cigarettes; Electronic cigarettes; Electronic cigarettes for use as an alternative to traditional cigarettes; Filter-tipped cigarettes; Filtered cigars and cigarettes; Hand-held machines for injecting tobacco into cigarette tubes; Holder for a cigarette pack and lighter; Holders for cigar and cigarette of precious metal; Holders for cigars and cigarettes; Holders of cigars and cigarettes of precious metal; Lighters for smokers; Liquefied gas cylinders for cigarette lighters; Machines allowing smokers to make cigarettes by themselves; Non-electric cigar lighters not of precious metal; Pocket apparatus for rolling cigarettes; Pocket apparatus for self-rolling cigarettes; Pocket appliances for rolling one's own cigarettes; Pocket devices for self-rolling of cigarettes; Pocket machines for rolling cigarettes; Pocket-size cigarette rolling machines; Smokeless cigarette vaporizer pipe; Smokers' articles, namely, cigar glue; Smokers' articles, namely, cigar relighting liquid solution; Smokers' articles, namely, cigar storage tubes; Smokers' articles, namely, containment clips used to keep a cigar from falling apart; Smokers' articles, namely, outdoor cigar and cigarette disposal units; Smokers' articles, namely, outdoor receptacles for cigar and cigarette ash and waste; Smoker's articles, namely, metal pocket-sized receptacles with lids for cigarette butts; Tobacco, cigars and cigarettes. First Use: 2010/11/26. First Use In Commerce: 2010/11/26.

Disclaimer Statement

NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "CIGARS" APART FROM THE MARK AS SHOWN.

Filing Date

2009/08/24

Amended Register Date

2010/12/04

Examining Attorney

FATHY, JESSICA

Vegas Strip Cigars

DESIGN MARK

Serial Number
78627638

Status
REGISTERED

Word Mark
GENGHIS KHAN

Standard Character Mark
Yes

Registration Number
3152224

Date Registered
2006/10/03

Type of Mark
TRADEMARK

Register
PRINCIPAL

Mark Drawing Code
(4) STANDARD CHARACTER MARK

Owner
K. Hansotia & Co., Inc. CORPORATION FLORIDA 3705 N.W. 115 Avenue, Bay
#5 Miami FLORIDA 33178

Goods/Services
Class Status -- ACTIVE. IC 034. US 002 008 009 017. G & S: [Tobacco, cigarettes,] cigars [; articles for smokers not of precious metal, namely, non-electric cigarette lighters, cigarette cases, cigar cases, cigarette holders and cigar holders]. First Use: 2005/02/10. First Use In Commerce: 2005/02/10.

Filing Date
2005/05/11

Examining Attorney
THOMAS, RAY

Attorney of Record
Pablo Meles

GENGHIS KHAN

DESIGN MARK

Serial Number

85268503

Status

REGISTERED

Word Mark

THE GOLD STANDARD OF E-CIGARETTES

Standard Character Mark

Yes

Registration Number

4062663

Date Registered

2011/11/29

Type of Mark

TRADEMARK

Register

PRINCIPAL

Mark Drawing Code

(4) STANDARD CHARACTER MARK

Owner

Hansen, Tyler M INDIVIDUAL UNITED STATES 511 Bailey Ave New Hampton
IOWA 50659

Goods/Services

Class Status -- ACTIVE. IC 034. US 002 008 009 017. G & S: Cigar and cigarette boxes; Cigar and cigarette boxes not of precious metal; Cigarette filters; Cigarette holders; Electric cigarettes; Electronic cigarettes; Electronic cigarettes for use as an alternative to traditional cigarettes; Smokeless cigarette vaporizer pipe; Tobacco, cigars and cigarettes. First Use: 2007/05/15. First Use In Commerce: 2010/02/10.

Disclaimer Statement

NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "E-CIGARETTES" APART FROM THE MARK AS SHOWN.

Filing Date

2011/03/16

Examining Attorney

EVANKO, PATRICIA

THE GOLD STANDARD OF E-CIGARETTES

EXHIBIT C

To: Joyetech (Changzhou) Electronics Co., Lt ETC. (ckc@slepatents.com)
Subject: U.S. TRADEMARK APPLICATION NO. 85477422 - EGO-T - JOY.ITU6T
Sent: 10/4/2012 1:56:48 PM
Sent As: ECOM106@USPTO.GOV
Attachments:

**UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)
OFFICE ACTION (OFFICIAL LETTER) ABOUT APPLICANT'S TRADEMARK APPLICATION**

APPLICATION SERIAL NO. 85477422

MARK: EGO-T

85477422

CORRESPONDENT ADDRESS:

Corey K. Cho
Saliwanchik, Lloyd & Eisenschenk
P.O. Box 142950
Gainesville FL 32614

CLICK HERE TO RESPOND
<http://www.uspto.gov/trademarks/te>

APPLICANT: Joyetech (Changzhou) Electronics Co., Lt ETC.

CORRESPONDENT'S REFERENCE/DOCKET NO :

JOY.ITU6T

CORRESPONDENT E-MAIL ADDRESS:

ckc@slepatents.com

OFFICE ACTION

STRICT DEADLINE TO RESPOND TO THIS LETTER

TO AVOID ABANDONMENT OF APPLICANT'S TRADEMARK APPLICATION, THE USPTO MUST RECEIVE APPLICANT'S COMPLETE RESPONSE TO THIS LETTER **WITHIN 6 MONTHS** OF THE ISSUE/MAILING DATE BELOW.

ISSUE/MAILING DATE: 10/4/2012

THIS IS A FINAL ACTION.

This Office action is in response to applicant's communication filed on July 27, 2012. The applicant has responded to the following refusal(s) and/or requirement(s). See 37 C.F.R. §2.64(a).

- (1) Potential Section 2(d) refusal – withdrawn; Trademark Ser. No. 85381434 has abandoned
- (2) Section 2(d) refusal citing Reg. No. 3283706 – unacceptable

(3) Identification of goods - acceptable

SECTION 2(D) – FINAL REFUSAL

For the reasons set forth below, the refusal under Trademark Act Section 2(d) is now made FINAL with respect to U.S. Registration No(s). 3283706. *See* 15 U.S.C. §1052(d); 37 C.F.R. §2.64(a).

The applicant has applied to register “EGO-T” for apparatus for heating and vapor generating, namely, electric vaporizers, in International Class 11; inhalers, sold empty, not for medical or therapeutic use, in International Class 21; and electronic cigarettes; electronic nicotine inhalation devices, namely electronic cigarettes and electronic cigarette cartridges, electronic cigarette atomizers, electronic cigarette cartomizers and refill liquid nicotine solutions, in International Class 34.

The cited mark is “EGO” for tobacco products, namely, cigars, in International Class 34.

The applicant has not responded to this refusal. In this case, the marks of the parties are similar because they share the word “EGO”. 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 Fondee En 1772*, 396 F. 3d 1369, 1372, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005); *see also Mattel Inc. v. Funline Merch. Co.*, 81 USPQ2d 1372, 1374-75 (TTAB 2006); *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).

The mere addition of a term to a registered mark generally does not obviate the similarity between the marks nor does it overcome a likelihood of confusion under Trademark Act Section 2(d). *See In re Chatam Int’l Inc.*, 380 F.3d 1340, 71 USPQ2d 1944 (Fed. Cir. 2004) (GASPAR’S ALE and JOSE GASPAR GOLD); *Coca-Cola Bottling Co. v. Jos. E. Seagram & Sons, Inc.*, 526 F.2d 556, 188 USPQ 105 (C.C.P.A. 1975) (BENGAL and BENGAL LANCER); *Lilly Pulitzer, Inc. v. Lilli Ann Corp.*, 376 F.2d 324, 153 USPQ 406 (C.C.P.A. 1967) (THE LILLY and LILLI ANN); *In re Toshiba Med. Sys. Corp.*, 91 USPQ2d 1266 (TTAB 2009) (TITAN and VANTAGE TITAN); *In re El Torito Rests., Inc.*, 9 USPQ2d 2002 (TTAB 1988) (MACHO and MACHO COMBOS); *In re Corning Glass Works*, 229 USPQ 65 (TTAB 1985) (CONFIRM and CONFIRMCELLS); *In re U.S. Shoe Corp.*, 229 USPQ 707 (TTAB 1985) (CAREER IMAGE and CREST CAREER IMAGES); *In re Riddle*, 225 USPQ 630 (TTAB 1985) (ACCUTUNE and RICHARD PETTY’S ACCU TUNE); TMEP §1207.01(b)(iii).

The goods of the parties are closely related because they are both tobacco-related products. The goods and/or services of the parties need not be identical or directly competitive to find a likelihood of confusion. *See Safety-Kleen Corp. v. Dresser Indus., Inc.*, 518 F.2d 1399, 1404, 186 USPQ 476, 480 (C.C.P.A. 1975); TMEP §1207.01(a)(i). Rather, it is sufficient to show that because of the conditions surrounding their marketing, or because they are otherwise related in some manner, the goods and/or services would be encountered by the same consumers under circumstances such that offering the goods and/or services under confusingly similar marks would lead to the mistaken belief that they come from, or are in some way associated with, the same source. *In re Iolo Techs., LLC*, 95 USPQ2d 1498, 1499 (TTAB 2010); *see In re Martin’s Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 1566-68, 223 USPQ 1289, 1290 (Fed. Cir. 1984); TMEP §1207.01(a)(i). In this case, while the goods of the parties are not identical, they are related options or substitute products, such a smoker may smoke cigars or electric cigarettes.

For these reasons, the refusal is continued and made FINAL.

PROPER RESPONSE TO FINAL OFFICE ACTION

If applicant does not respond within six months of the date of issuance of this final Office action, the application will be abandoned. 15 U.S.C. §1062(b); 37 C.F.R. §2.65(a). Applicant may respond to this

final Office action by:

- (1) Submitting a response that fully satisfies all outstanding requirements, if feasible; and/or
- (2) Filing an appeal to the Trademark Trial and Appeal Board, with an appeal fee of \$100 per class.

37 C.F.R. §§2.6(a)(18), 2.64(a); TBMP ch. 1200; TMEP §714.04.

In certain rare circumstances, a petition to the Director may be filed pursuant to 37 C.F.R. §2.63(b)(2) to review a final Office action that is limited to procedural issues. 37 C.F.R. §2.64(a); TMEP §714.04; *see* 37 C.F.R. §2.146(b); TBMP §1201.05; TMEP §1704 (explaining petitionable matters). The petition fee is \$100. 37 C.F.R. §2.6(a)(15).

COMMUNICATION

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/Sophia S. Kim/
Sophia S. Kim
Trademark Examining Attorney
Law Office 106
571-272-9178
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TO RESPOND TO THIS LETTER: Go to http://www.uspto.gov/trademarks/teas/response_forms.jsp. Please wait 48-72 hours from the issue/ mailing date before using TEAS, to allow for necessary system updates of the application. For *technical* assistance with online forms, e-mail TEAS@uspto.gov. For questions about the Office action itself, please contact the assigned trademark examining attorney. **E-mail communications will not be accepted as responses to Office actions; therefore, do not respond to this Office action by e-mail.**

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