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Subject: U.S. TRADEMARK APPLICATION NO. 85969016 - VAPOR CUP - VC-1 - EXAMINER BRIEF

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UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)

U.S. APPLICATION SERIAL NO. 85969016

MARK: VAPOR CUP



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GENERAL TRADEMARK INFORMATION:

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

TTAB INFORMATION:

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

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VC-1

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EXAMINING ATTORNEY'S APPEAL BRIEF

The applicant appeals the refusal to register the proposed mark VAPOR CUP for “electrically-powered handheld vaporizers for vaporizing vaporizable constituents of herbal and plant matter for creating an aroma” pursuant to Trademark Act §2(e)(1), 15 U.S.C. §1052(e)(1) where the evidence shows that the

goods produce vapor and look like a cup. An additional ground for refusal is applicant's failure to properly respond to requirements for information pursuant to 37 C.F.R. §2.61(b); TMEP §814.¹

EVIDENCE OBJECTION

The applicant submitted a *list* of alleged third party registrations in the April 4, 2014, response. However, the applicant never made the alleged registrations of record prior to appeal even though the applicant was advised in footnote No. 1 of the April 24, 2014, final Office action, that to make third party registrations part of the record, an applicant must submit copies of the registrations, or the complete electronic equivalent from the USPTO's automated systems, prior to appeal. Because the applicant did not make the registrations properly of record prior to appeal, the examining attorney objects to consideration of the applicant's alleged registration evidence.

STATEMENT OF FACTS

The applicant filed an intent-to-use based application on June 25, 2013, seeking to register the proposed mark VAPOR CUP for "electrically-powered handheld vaporizers for vaporizing vaporizable constituents of herbal and plant matter for creating an aroma." The examining attorney, the applicant, and the applicant's attorney discussed the issues on October 10, 2013. The examining attorney subsequently issued an Office action on October 10, 2013, refusing the proposed mark under Trademark Act Section

¹ The applicant has a companion application Serial No. 85971474 for the proposed mark WEVAPS VAPOR CUP for the same goods which is also under appeal; the applicant appeals the disclaimer of VAPOR CUP and the information requirement in the companion application.

2(e)(1), 15 U.S.C. §1052(e)(1), and requiring information pursuant to 37 C.F.R. §2.61(b). The applicant's April 4, 2014, response argued against the refusal, but did not provide all of the information required. The examining attorney issued a final Office action regarding the refusal and information requirements on April 24, 2014, because the applicant's vaporizers produce a vapor, look like a cup, and the applicant did not provide all of the information required. The applicant initiated the appeal process on October 22, 2014. The Trademark Trial and Appeal Board (TTAB) remanded the case to the examining attorney for submission of the examining attorney's brief. However, the examining attorney noted a request in a footnote in the applicant's brief to which the TTAB was alerted. The TTAB subsequently remanded the application to the examining attorney on January 8, 2015, for consideration of the applicant's information and arguments. The examining attorney denied the applicant's request for reconsideration on January 29, 2015, because the applicant's arguments and evidence did not obviate the issues. The applicant submitted a reply brief on March 20, 2015. The TTAB subsequently remanded the application to the examining attorney for submission of the examining attorney's brief. The Section 2(e)(1) refusal and information requirements are the only issues on appeal.

ISSUES ON APPEAL

1. Is the applicant's failure to provide information reasonably necessary to the examination of the intent-to-use application pursuant to 37 C.F.R. §2.61(b) sufficient cause to deny registration of the entire mark on this basis alone where the information requested will have a direct bearing on the Section 2(e)(1) refusal?

2. Is the wording VAPOR CUP merely descriptive of the goods listed as “electrically-powered handheld vaporizers for vaporizing vaporizable constituents of herbal and plant matter for creating an aroma,” where the applicant previously agreed to enter a disclaimer of the term VAPOR, the goods produce vapor, the applicant’s website uses the wording VAPOR CUP in a merely descriptive manner, and the goods look like a cup?

ARGUMENT

1. Information requirement pursuant to 37 C.F.R. §2.61(b).

The applicant did not fully comply with the reasonably necessary information requirement made pursuant 37 C.F.R. §2.61(b) and/or the information submitted was evasive or otherwise insufficient. As the TTAB is well aware, the examining attorney may request literature, exhibits, affidavits or declarations, and general information concerning circumstances surrounding the mark, as well as, if applicable, its use or intended use. *See* 37 C.F.R. §2.61(b)²; TMEP §814.

If the applicant does not comply with the examining attorney’s request for information, or submits an evasive or otherwise insufficient response, the requirement should be repeated and, if appropriate, made final. *See In re AOP LLC*, 107 USPQ2d 1644 (TTAB 2013); *In re DTI P’ship LLP*, 67 USPQ2d 1699 (TTAB 2003); *In re SPX Corp.*, 63 USPQ2d 1592 (TTAB 2002); *In re Page*, 51 USPQ2d 1660 (TTAB 1999); *In*

² Trademark Rule 2.61(b) states: “The Office may require the applicant to furnish such information, exhibits, affidavits or declarations, and such additional specimens as may be reasonably necessary to the proper examination of the application.”

re Babies Beat Inc., 13 USPQ2d 1729, 1731 (TTAB 1990); *In re Air Prods. & Chems., Inc.*, 192 USPQ 157, 158 (TTAB 1976) (“[Trademark Rule 2.61(b)] has the effect of law.”); TMEP §814.

The applicant has two options when faced with an information requirement made pursuant to 37 C.F.R. §2.61(b). The applicant’s options are as follows:

1. The applicant may comply with the request; or
2. The applicant may dispute the legitimacy of the request.

See In re SPX Corporation, supra, 63 USPQ2d at 1597.

However, the TTAB has expressly stated that the applicant may *not* ignore the information requirement.

In re SPX Corporation, supra, 63 USPQ2d at 1597.

The information requirement in the first Office action of October 10, 2013, is listed below and consists of thirteen (13) specific requirements:

INFORMATION ABOUT GOODS/SERVICES REQUIRED

An applicant can be required to provide more information if it is necessary for proper examination of the application. 37 C.F.R. §2.61(b); TMEP §§814, 1402.01(e); *see In re DTI P'ship LLP*, 67 USPQ2d 1699, 1701-02 (TTAB 2003).

The information requested below is necessary to the examination of the application because it will provide a more in-depth understanding of the mark and/or issue(s) at hand.

Failure to respond to a request for information can be grounds for refusing registration. TMEP §814; see *In re Cheezwhse.com, Inc.*, 85 USPQ2d 1917, 1919 (TTAB 2008); *In re DTI P'ship LLP*, 67 USPQ2d 1699, 1701-02 (TTAB 2003). Merely stating that information about the goods or services is available on applicant's website is an inappropriate response to a request for additional information, and is insufficient to make the relevant information of record. See *In re Planalytics, Inc.*, 70 USPQ2d 1453, 1457-58 (TTAB 2004).

The applicant must *directly* answer the following question(s) and/or provide the information requested:

1. Does VAPOR, CUP, or VAPOR CUP have any significance as applied to the goods and/or services other than trademark and/or service mark significance?
2. Does VAPOR, CUP, or VAPOR CUP have any significance in the relevant trade or industry other than trademark and/or service mark significance?
3. If available, the applicant will provide a website address at which the goods and/or services are offered and/or the mark is used. If no website is available, then the applicant will state this fact for the record.
4. [NOTE: Providing a website address or patent information does not obviate this requirement.] To permit proper examination of the application, applicant must submit additional product information about the goods. See 37 C.F.R. §2.61(b); *In re DTI P'ship LLP*, 67 USPQ2d 1699, 1701-02 (TTAB 2003); TMEP §814. The requested product information should include fact sheets, instruction manuals, and/or advertisements. If these materials are unavailable, applicant should submit similar documentation for goods of the same type, explaining how its own product will differ. If the goods feature new technology and no competing goods are available, applicant must provide a detailed description of the goods.

The submitted factual information must make clear how the goods operate, their salient features, and their prospective customers and channels of trade. Conclusory statements regarding the goods will not satisfy this requirement.

5. Applicant must provide copies of any patent and/or patent application documentation relating to the goods.
6. Will the goods look like or be shaped like a cup?
7. Will the goods function as a cup?
8. Will the goods incorporate a cup or be used with a cup?
9. Will the goods produce vapor?

10. Will the goods regulate or process vapor?
11. Will the goods deliver vapor to the user?
12. IS [sic] VAPOR CUP the apt name for the goods?
13. Is vaporcup.com shown in the attached evidence the applicant's website?

As stated in the initial requirement, “[t]he information requested below is necessary to the examination of the application because it will provide a more in-depth understanding of the mark and/or issue(s) at hand.” Because the information required would provide a more in-depth understanding of the mark and issues, the request was reasonably necessary to the examination of the intent-to-use application.

The applicant's April 4, 2014, response at TICRS page 6 states:

To answer the questions put forth by the examiner, while the goods are not yet on the market, the initial product to be marketed under the “Vapor Cup” mark *has a physical resemblance to a cup*, but is not a cup and cannot be used as one. Indeed, the goods, as envisioned, fit none of the definitions of a cup set forth in the examiner’s third exhibit, as the device cannot be used to drink from nor is it a prize or trophy. The other definitions are inapplicable as well. *As a vaporizer, the goods are anticipated to transform a particular substance from solid to gas form for users to inhale*, however, the device does not regulate or process vapor.

The domain name “vaporcup.com” does belong to the applicant. The materials attached to the Office Action are not the applicant’s, but were created, presumably, by a prior owner of the domain. I am advised by the applicant that no product was ever created or marketed by such past owner. To reiterate, there is not nor has there ever been, to applicant’s knowledge, any marketed goods identified as a “vapor cup,”[sic] If anything, from the usage “VaporCup,” as a single word with two capital letters, seems that the now abandoned effort that previously owned domain also viewed this as a mark, not a description. The single use of the term “Vapor Cup,” which, as included by the examiner, is used in no context and describes no goods or services, can hardly be

conclusive of anything, let alone that the mark is descriptive or, as the examiner has alluded to, generic.

Emphasis added.

The applicant's April 4, 2014, response was deemed to have responded in whole or in part to several of the requirements in the first Office action information requirement. However, the applicant did not provide responses, or only provided a partial response, to many of the specific information requirements. Consequently, the information requirement was maintained and made final.

The information in the final Office action is listed below and consists of six (6) specific requirements:

INFORMATION ABOUT GOODS/SERVICES REQUIRED

To permit proper examination of the application, applicant must submit additional information about the goods. An applicant can be required to provide more information if it is necessary for proper examination of the application. 37 C.F.R. §2.61(b); TMEP §§814, 1402.01(e); see *In re AOP LLC*, 107 USPQ2d 1644, 1650-51 (TTAB 2013); *In re Cheezwhse.com, Inc.*, 85 USPQ2d 1917, 1919 (TTAB 2008); *In re DTI P'ship LLP*, 67 USPQ2d 1699, 1701-02 (TTAB 2003). The information requested below is necessary to the examination of the application because it will provide a more in-depth understanding of the mark and/or issue(s) at hand. The applicant's response seems to have ignored some of the questions and requirements presented. The applicant must directly respond to the questions posed and provide the required information. The applicant should also note that a partial submission of the patent information requested is not acceptable and does not meet the requirement for information; the applicant must provide all of the available patent information. Moreover, the information will help to determine whether the proposed mark is generic, generic as to certain terms, or allowable on the Supplemental Register. As a consequence, the information requirement is maintained and made FINAL.

Failure to comply with a request for information can be grounds for refusing registration. *In re AOP LLC*, 107 USPQ2d 1644, 1651 (TTAB 2013); *In re DTI P'ship LLP*, 67 USPQ2d 1699, 1701-02 (TTAB 2003); TMEP §814.

Merely stating that information about the goods or services is available on applicant's website is an inappropriate response to a request for additional information and is insufficient to make the relevant information of record. See *In re Planalytics, Inc.*, 70 USPQ2d 1453, 1457-58 (TTAB 2004).

The applicant must directly answer the following question(s) and/or provide the information requested:

1. Do VAPOR, CUP, or VAPOR CUP have any significance as applied to the goods and/or services other than trademark and/or service mark significance?
2. Do VAPOR, CUP, or VAPOR CUP have any significance in the relevant trade or industry other than trademark and/or service mark significance?
3. To permit proper examination of the application, applicant must submit additional product information about the goods. See 37 C.F.R. §2.61(b); *In re AOP LLC*, 107 USPQ2d 1644, 1650-51 (TTAB 2013); *In re Cheezwhse.com, Inc.*, 85 USPQ2d 1917, 1919 (TTAB 2008); *In re DTI P'ship LLP*, 67 USPQ2d 1699, 1701-02 (TTAB 2003); TMEP §814. The requested product information should include fact sheets, instruction manuals, and/or advertisements. If these materials are unavailable, applicant should submit similar documentation for goods of the same type, explaining how its own product will differ. If the goods feature new technology and no competing goods are available, applicant must provide a detailed description of the goods.

The submitted factual information must make clear how the goods operate, their salient features, and their prospective customers and channels of trade. Conclusory statements regarding the goods will not satisfy this requirement.

4. Applicant must provide copies of *any* (meaning all) patent and/or patent application documentation relating to the goods.
5. Will the goods produce vapor?
6. Will the goods deliver vapor to the user?

As stated in the final Office action regarding the information requirement:

The information requested below is necessary to the examination of the application because it will provide a more in-depth understanding of the mark and/or issue(s) at hand. The applicant's

response seems to have ignored some of the questions and requirements presented. The applicant must directly respond to the questions posed and provide the required information. The applicant should also note that a partial submission of the patent information requested is not acceptable and does not meet the requirement for information; the applicant must provide all of the available patent information. Moreover, the information will help to determine whether the proposed mark is generic, generic as to certain terms, or allowable on the Supplemental Register. As a consequence, the information requirement is maintained and made FINAL.

For example, the applicant never provided a response to whether the wording VAPOR or CUP, as individual terms, has any significance as applied to the goods other than trademark significance. The applicant never provided a response to whether the wording VAPOR or CUP, as individual terms, has any significance in the relevant trade or industry.³ Nor did the applicant provide additional product information about the goods even though the existence of the applicant's website makes it seem as though such information may be available. Furthermore, the applicant only submitted drawings for the applicant's patent information but did not submit the remainder of the patent information that presumably describes the claims in the patent (which may have a direct bearing on the merely descriptive refusal requirement if the patent claims describe a vapor function and/or cup feature or function). Nor did the applicant respond to the questions regarding whether the goods will produce vapor⁴ or deliver vapor to the user.

The aforementioned information is reasonably necessary to the examination of the intent-to-use application because it has a direct bearing on the merely descriptive refusal. For example, if the terms

³ The applicant's April 4, 2014, response at TIGRS page 3 does state that the wording VAPOR CUP has no significance as applied to the goods or in the relevant trade or industry. The examining attorney therefore withdraws the information requirement as in final information requirement questions Nos. 1 and 2 to the wording VAPOR CUP as a whole.

⁴ The applicant's March 20, 2015, Reply Brief does state "Applicant's brief is not predicated on some notion that our vaporizer does not produce vapor. We have acknowledged that it does." Applicant's Reply Brief at unnumbered page 4.

VAPOR and/or CUP have non-trademark significance as applied to the goods and/or in the relevant trade or industry, then that information will reinforce the refusal. Furthermore, the information will give additional information on which to consider whether the proposed mark is generic as a whole or whether certain parts of the proposed mark are generic. The same can be said of the additional information, particularly the applicant's patent information in which claims regarding the goods will be described.

The applicant's December 21, 2014, brief claims that the applicant “. . . submitted a copy of his patent application relating to goods to be sold under the “Vapor Cup” and “WeVaps Vapor Cup” marks” Applicant's Brief at 6. However, as noted above, and specifically noted in the final Office action, the applicant did not submit a *complete* copy of the applicant's patent application as required, but only submitted the drawings in the patent application. Therefore, the applicant's statement is not factually accurate as only the drawings in the patent application are of record in the instant case.

The applicant also states in footnote No. 1 of the December 21, 2014, Appeal Brief that “. . . all information requested in both the First and Second Office actions were responded to by Applicant in his response to the First Office Action and all documentation then available had already been supplied to the examiner.” As noted above, the applicant only provided the patent drawings and neglected to submit the entire patent application even though the final information requirement clearly stated that the patent drawing information alone was not sufficient. Moreover, the applicant's statement is inherently contradictory because it is impossible to respond to the final information requirement issued *after* the applicant's response – the

applicant's response is submitted prior to the issuance of the final Office action. As also noted above, the applicant did not respond to the final information requirement. Therefore, the applicant's statement is not accurate.

Because the applicant did not provide the reasonably necessary information, the applicant has robbed the Office of the opportunity to have pertinent information on which to maintain or withdraw the refusal and/or issue an additional refusal or requirement. As a result, the applicant's failure to provide the information requested should result in the refusal of the application as a whole on this basis alone. *See In re AOP LLC*, 107 USPQ2d 1644, 1651 (TTAB 2013) ("Failure to comply with a request for information is grounds for refusal," where applicant provided equivocal responses to the examining attorney's questions and did not address this issue in its brief); *In re DTI P'ship LLP*, 67 USPQ2d 1699 (TTAB 2003) (deeming §2(e)(1) refusal moot, since failure to comply with requirement for information is sufficient basis, in itself, for refusal); *In re SPX Corp.*, 63 USPQ2d 1592 (TTAB 2002) (finding registration properly refused where applicant ignored request for information); *In re Page*, 51 USPQ2d 1660 (TTAB 1999) (finding intent-to-use applicant's failure to comply with requirement for information as to the intended use of the mark constituted grounds for refusal); *In re Babies Beat Inc.*, 13 USPQ2d 1729, 1731 (TTAB 1990) (finding registration properly refused where applicant failed to comply with examining attorney's request for copies of patent applications and other patent information); *In re Air Prods. & Chems., Inc.*, 192 USPQ 157, 158 (TTAB 1976) ("[Trademark Rule 2.61(b)] has the effect of law."); *In re Barrel Assocs.*, 2013 TTAB LEXIS 240 (Trademark Trial & App. Bd. May 9, 2013) (The examining attorney was justified in inquiring whether or not the terms "H2O" and "BENT" separately carried any descriptive meaning, despite applicant's assertion that the combined term H2O BENT had only trademark significance) (not precedential); TMEP §814.

2. Section 2(e)(1) refusal.

The wording VAPOR CUP is merely descriptive of the applicant's "electrically-powered handheld vaporizers for vaporizing vaporizable constituents of herbal and plant matter for creating an aroma" because the applicant admits that the goods produce vapor, the applicant has previously agreed to enter a disclaimer of the term VAPOR which is an admission of the merely descriptive nature of the term, the goods look like a cup, the applicant's website states that the goods have a "coffee mug" design, and the evidence shows that the wording merely describes the goods. A mark is merely descriptive if it describes an ingredient, quality, characteristic, function, feature, purpose, or use of an applicant's goods and/or services. TMEP §1209.01(b); *see, e.g., DuoProSS Meditech Corp. v. Inviro Med. Devices, Ltd.*, 695 F.3d 1247, 1251, 103 USPQ2d 1753, 1755 (Fed. Cir. 2012) (quoting *In re Oppedahl & Larson LLP*, 373 F.3d 1171, 1173, 71 USPQ2d 1370, 1371 (Fed. Cir. 2004)); *In re Steelbuilding.com*, 415 F.3d 1293, 1297, 75 USPQ2d 1420, 1421 (Fed. Cir. 2005) (citing *Estate of P.D. Beckwith, Inc. v. Comm'r of Patents*, 252 U.S. 538, 543 (1920)).

Determining the descriptiveness of a mark is done in relation to an applicant's goods and/or services, the context in which the mark is being used, and the possible significance the mark would have to the average purchaser because of the manner of its use or intended use. *See In re The Chamber of Commerce of the U.S.*, 675 F.3d 1297, 1300, 102 USPQ2d 1217, 1219 (Fed. Cir. 2012) (citing *In re Bayer Aktiengesellschaft*, 488 F.3d 960, 963-64, 82 USPQ2d 1828, 1831 (Fed. Cir. 2007)); TMEP §1209.01(b). Descriptiveness of a mark is not considered in the abstract. *In re Bayer Aktiengesellschaft*, 488 F.3d at

963-64, 82 USPQ2d at 1831. “Whether consumers could guess what the product [or service] is from consideration of the mark alone is not the test.” *In re Am. Greetings Corp.*, 226 USPQ 365, 366 (TTAB 1985).

Moreover, the applicant's failure to completely respond to the information requirement, which is the case here, allows the presumption that had applicant responded to the requirement, the response would have been unfavorable to the applicant. *See In re AOP LLC*, 107 USPQ2d at 1651 (noting because applicant had failed to comply with the examining attorney’s information requirement, “to the extent there is any ambiguity regarding the origin and certification of applicant’s goods we address both [merely descriptive and deceptively misdescriptive] refusals in the alternative based on the presumption that had applicant directly and fully responded to the examining attorney’s inquiries, the responses would have been unfavorable,”); *In re Cheezwhse.com, Inc.*, 85 USPQ2d 1917, 1919 (TTAB 2008) (making factual presumptions unfavorable to the applicant in considering alternative statutory refusals under §§2(e)(2) and 2(e)(3), in view of the applicant’s failure to comply with the examining attorney’s requirement for information as to the geographic origin of the goods); TMEP §814.

When considered in relation to the identified goods, the wording VAPOR CUP immediately describes a feature and/or purpose of the goods as is shown by the following:

- a. The dictionary definitions of record define VAPOR as “[b]arely visible or cloudy diffused matter, such as mist, fumes, or smoke, suspended in the air” and CUP as “[a] cuplike object.” October 10, 2013, Office action at TIGRS pages 2 – 6.

- b. The applicant's April 4, 2014, response at TICRS page 6 states that “[a]s a vaporizer the goods are anticipated to transform a particular substance from a solid to gas form for users to inhale”
- c. The applicant's identification also states that the goods are for vaporizing which means that the goods create a vapor.
- d. As noted above, the applicant’s Reply Brief also states the goods produce vapor. Applicant's March 20, 2015, Reply Brief at unnumbered page 4. *See also* January 29, 2015, request for reconsideration denied evidence at TICRS page 2 (applicant’s website using the term VAPOR in a merely descriptive manner in relation to the goods).
- e. The applicant also previously agreed to disclaim the wording VAPOR. Applicant’s April 4, 2014, response at TICRS page 7.
- f. The evidence of record also shows that the wording VAPOR is merely descriptive of the applicant’s electrically-powered handheld vaporizers. October 10, 2013, Office action at TICRS pages 7 – 22 (internet evidence), 23 – 27 (third party registrations), and 28 – 31 (internet evidence from the website currently owned by the applicant); April 25, 2014, Office action at TICRS pages 2 – 19 (internet evidence), 20 – 28 (third party registrations), 29 – 31 (internet evidence); January 29, 2015, request for reconsideration denied, TICRS pages 2 – 6 (internet evidence from the applicant’s website).

g. The applicant's April 4, 2014, response at TICRS page 6 also states that the goods have a physical resemblance to a cup, a fact confirmed by the applicant's patent drawing information. Applicant's April 4, 2014, response at TICRS pages 16 – 20.

h. The evidence from the applicant's website shows that the applicant describes the goods as having “. . . a discreet coffee mug shape . . .” and “[d]iscreet “coffee mug” design with privacy sleeve.” January 29, 2015, request for reconsideration denied at TICRS pages 5 - 6.

In addition to the aforementioned evidence of record, the applicant's failure to respond to the final information requirement regarding the terms VAPOR and CUP individually, as well as failing to respond to the additional final information requirements, allows the presumption that had applicant responded to the requirement, the response would have been unfavorable to the applicant. *See In re AOP LLC*, 107 USPQ2d at 1651; *In re Cheezwhse.com, Inc.*, 85 USPQ2d 1917, 1919 (TTAB 2008); TMEP §814. For example, the applicant's failure to state whether the term CUP has any non-trademark significance as applied to the goods and/or in the relevant trade or industry allows one to presume that the wording CUP does have non-trademark significance, e.g., merely descriptive significance as applied to the goods and/or in the relevant trade or industry.

Consequently, when the evidence of record is considered, and in light of the presumption against the applicant created by the applicant's failure to provide the information requested, the wording

VAPOR CUP is clearly merely descriptive of the applicant's vaporizer goods. Thus, the proposed mark VAPOR CUP should not be registered on the Principal Register.

The applicant argues that the wording VAPOR CUP for the applicant's "electrically-powered handheld vaporizers for vaporizing vaporizable constituents of herbal and plant matter for creating an aroma" is suggestive even in light of the applicant's admission that the goods produce vapor, the applicant's agreement to enter a disclaimer of VAPOR, the applicant's admission that the goods have a physical resemblance to a cup, and the fact that the applicant's website describes the goods as having a "coffee mug" design. The applicant first argues that the evidence of record does not support the refusal. Applicant's Appeal Brief at 10. The applicant is of the opinion that third party registrations that disclaim the term VAPOR for the same or similar goods is not sufficient evidence to show that the term VAPOR, which the applicant has previously agreed to disclaim, is not merely descriptive of the term VAPOR in the applicant's proposed mark. The applicant seems to overlook the case law that plainly states that third-party registrations featuring goods and/or services the same as or similar to applicant's goods and/or services are probative evidence on the issue of descriptiveness where the relevant word or term is disclaimed, registered under Trademark Act Section 2(f) based on acquired distinctiveness, or registered on the Supplemental Register. See *Inst. Nat'l des Appellations D'Origine v. Vintners Int'l Co.*, 958 F.2d 1574, 1581-82, 22 USPQ2d 1190, 1196 (Fed. Cir. 1992); *In re Box Solutions Corp.*, 79 USPQ2d 1953, 1955 (TTAB 2006); *In re Finisar Corp.*, 78 USPQ2d 1618, 1621 (TTAB 2006). As the third party registrations have disclaimed the term VAPOR, the third party registration evidence is directly on point and proves that the term VAPOR is merely descriptive of the applicant's goods that produce vapor as admitted by the applicant.

The applicant also argues that a list of series of third party registrations submitted by the applicant obviates the refusal. However, the applicant never made the alleged registrations of record even though the applicant was advised in footnote No. 1 of the April 24, 2014, final Office action, that to make third party registrations part of the record, an applicant must submit copies of the registrations, or the complete electronic equivalent from the USPTO's automated systems, prior to appeal. Because the applicant did not make the registrations properly of record prior to appeal, the examining attorney renews his objection to consideration of the applicant's registration evidence.⁵

The applicant next argues that the only evidence that shows that the term CUP is merely descriptive of the applicant's goods, that the applicant admits has the physical resemblance of a cup and describes at its website as having a "coffee mug" design, is the dictionary definition of the term CUP. Applicant's Appeal Brief at 11. Even if the dictionary definition was the only piece of evidence of record, which it is not, the dictionary definition alone would be sufficient evidence in light of the applicant's patent drawings showing a cup design, the applicant's statements regarding the goods have a cup like resemblance, and the applicant's website that describes the goods as having a "coffee mug" design. The applicant then seeks to argue, even though the applicant admits that the goods have a physical

⁵ If the TTAB admits the applicant's registration evidence for consideration, then, and only then, the examining attorney argues that the third party registration evidence submitted by the applicant does not disprove the merely descriptive refusal. The fact that third-party registrations exist for marks allegedly similar to applicant's mark is not conclusive on the issue of descriptiveness. *See In re Scholastic Testing Serv., Inc.*, 196 USPQ 517, 519 (TTAB 1977); TMEP §1209.03(a). An applied-for mark that is merely descriptive does not become registrable simply because other seemingly similar marks appear on the register. *In re Scholastic Testing Serv., Inc.*, 196 USPQ at 519; TMEP §1209.03(a). It is well settled that each case must be decided on its own facts and the Trademark Trial and Appeal Board is not bound by prior decisions involving different records. *See In re Nett Designs, Inc.*, 236 F.3d 1339, 1342, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001); *In re Datapipe, Inc.*, 111 USPQ2d 1330, 1336 (TTAB 2014); TMEP §1209.03(a). The question of whether a mark is merely descriptive is determined based on the evidence of record at the time each registration is sought. *In re theDot Commc'ns Network LLC*, 101 USPQ2d 1062, 1064 (TTAB 2011); TMEP §1209.03(a); *see In re Nett Designs, Inc.*, 236 F.3d at 1342, 57 USPQ2d at 1566.

resemblance to a cup and have a “coffee mug” design, that because the goods do not hold liquid, the customer will not perceive the term CUP as being merely descriptive of the goods. Applicant’s Appeal Brief at 12. The applicant’s argument is specious in light of the facts of record. The customer will immediately see the merely descriptive nature of the term CUP in relation to the goods that have the physical resemblance of a cup and are described by the applicant’s website as having a “coffee mug” design. The additional evidence of record noted above, plainly shows cups having the same or similar design as the applicant’s goods.

The applicant, for the first time of record, argues that the wording VAPOR CUP is unitary even though the applicant has previously agreed to enter a disclaimer of the term VAPOR. Applicant’s Brief at 13. To support this argument, the applicant then states that there is no such thing as a “vapor cup” in the field of vaporizers. As the TTAB is well aware, the fact that an applicant may be the first or only user of a merely descriptive designation does not necessarily render a word or term incongruous or distinctive; as in this case, the evidence shows that the wording VAPOR CUP is merely descriptive. *See In re Phoseon Tech., Inc.*, 103 USPQ2d 1822, 1826 (TTAB 2012); *In re Sun Microsystems, Inc.*, 59 USPQ2d 1084, 1087 (TTAB 2001); TMEP §1209.03(c). Because the applicant’s statements regarding the goods support the merely descriptive refusal, and the evidence bolsters the applicant’s admission, the applicant’s argument should not be persuasive. Moreover, the applicant’s unitary mark argument is plainly undercut by the applicant’s prior agreement to disclaim the term VAPOR from the applicant’s supposedly unitary mark. Applicant’s April 4, 2014, response at TICRS page 7.

The applicant next argues that because the proposed mark VAPOCUP was allowed by another examining attorney, that the proposed mark VAPOR CUP should also be allowed. Applicant’s Appeal Brief at 15;

Applicant's Reply Brief at unnumbered page 2. The TTAB well knows that prior decisions and actions of other trademark examining attorneys in registering other marks have little evidentiary value and are not binding upon the USPTO or the Trademark Trial and Appeal Board. TMEP §1207.01(d)(vi); see *In re Midwest Gaming & Entm't LLC*, 106 USPQ2d 1163, 1165 n.3 (TTAB 2013) (citing *In re Nett Designs, Inc.*, 236 F.3d 1339, 1342, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001)). Each case is decided on its own facts, and each mark stands on its own merits. See *AMF Inc. v. Am. Leisure Prods., Inc.*, 474 F.2d 1403, 1406, 177 USPQ 268, 269 (C.C.P.A. 1973); *In re Binion*, 93 USPQ2d 1531, 1536 (TTAB 2009). Even the applicant acknowledges that the decisions of other examining attorneys are not binding. Applicant's Appeal Brief at 8. Yet, the applicant persists in arguing that VAPOCUP mandates the same result to the wording VAPOR CUP. The applicant seems to ignore the fact that the wording VAPO in the VAPOCUP unitary mark is not the same as the wording VAPOR. For example, while the term VAPO suggests the term VAPOR; VAPO does not immediately describe the term VAPOR, but merely hints at the term VAPOR.⁶ In contrast, the term VAPOR is an English word with a well-known definition. More importantly, the term VAPOR immediately describes a feature and/or purpose of the applicant's vaporizer goods. As a result, the applicant's desire to equate the defined merely descriptive term VAPOR to the suggestive term VAPO is misguided and should not be compelling. Therefore, the respective wording VAPOR CUP and VAPOCUP are not functionally equivalent as espoused by the applicant and the applicant's argument should not be given serious consideration.

⁶ This argument assumes that the term VAPO is suggestive and that no evidence exists that shows that the term VAPO means vapor.

CONCLUSION

The applicant did not fully comply with the reasonably necessary information requirement made pursuant 37 C.F.R. §2.61(b) and/or the information submitted was evasive or otherwise insufficient. For example, the applicant did not provide the complete record of the applicant's patent application even when the applicant was advised that the applicant must provide the complete patent application and not merely the patent drawings. Furthermore, the applicant failed to answer questions about the individual terms that comprise the wording VAPOR CUP. The applicant's failure to provide information reasonably necessary to the examination of the application pursuant to 37 C.F.R. §2.61(b) is sufficient cause to deny registration of the entire mark on this basis alone, particularly where the information requested will have a direct bearing on the refusal and the evaluation for an additional refusal and/or requirement.

Additionally, the combination of terms VAPOR CUP is merely descriptive of the applicant's "electrically-powered handheld vaporizers for vaporizing vaporizable constituents of herbal and plant matter for creating an aroma" because the applicant admits that the goods produce vapor, the applicant has previously agreed to enter a disclaimer of the term VAPOR which is an admission of the merely descriptive nature of the term, the goods look like a cup, are described by the applicant as having a "coffee mug" design, and the evidence shows that the wording merely describes the goods. Based on the foregoing, the examining attorney respectfully requests that the TTAB affirm both the information requirement and Section 2(e)(1) refusal.

Respectfully submitted,

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