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

Proceeding	85969016
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Applied for Mark	VAPOR CUP
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

Serial Nos. 85969016 and 85971474

Marks: VAPOR CUP and WEVAPS VAPOR CUP

Applicant: Michael Starr

Examining Attorney: Brian Pino

Law Office 114

EX PARTE APPEAL

APPLICANT'S REPLY BRIEF

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COMES NOW the Applicant, Michael Starr, by Counsel, and hereby respectfully replies to the brief of the Examining Attorney, concerning such Examiner's refusal to register the marks VAPOR CUP and WEVAPS VAPOR CUP in standard characters. Applicant responds in order to correct certain misinformation and refute certain points set out in the Examiner's Brief herein. Applicant shall not restate the facts and shall endeavor not to repeat arguments made in his initial brief.

A. EXAMINER'S OBJECTION TO APPLICANT'S EVIDENCE

The Examiner begins his Brief by objecting to much of Applicant's submitted evidence, specifically Applicant's list of identified marks that support Applicant's position herein. As the Examiner notes, Applicant has acknowledged that its submission of such lists was not done pursuant to accepted procedure. While applicant continues to believe that each of the marks identified and elaborated on in its response to the Examiner's First Office Action herein are probative of the validity of Applicant's position, none of those registrations has been relied upon in this appeal. Applicant has been able to rely solely upon the registrations cited by the Examiner to prove his case herein.

B. ARGUMENT

1. Information Requirement Pursuant to 37 C.F.R. Section 2.61(b)

Contrary to the statements made by the Examiner in his brief, Applicant has fully responded to each and every one of the information requirements demanded by the Examiner. Also contrary to the Examiner's statements, not all of these requirements demanded "reasonably necessary" information. As the information demanded in the Second Office Action are an identical subset of

the information demanded in the First Office Action, and as the omission of items from the First Office Action on the Second Office Action is a clear indication that even the Examiner deemed those items responded to, we will address only the demands identified in the Second Office Actions.

- a. Items 1 and 2, Significance of VAPOR, CUP or VAPOR CUP as applied to the goods and in the relevant trade or industry.

Although the Examiner listed this as a continuing demand in the Second Office Action, and lists it in his Brief in such a manner as to make it appear that these items were never responded to, the Examiner, hidden away in footnote 3 to his brief, acknowledges these were, in fact, responded to. The Examiner's repeating them in the Second Office Action was, therefore, an error on his part. For the avoidance of confusion, and to be abundantly clear, neither "Cup" nor "Vapor Cup" have any significance as applied to the goods or relevancy in the trade or industry. As has been repeatedly acknowledged, the Vapor Cup vaporizer does produce vapor.

- b. Item 3 - Additional Product Information about the Goods.

As was stated in Applicant's Initial Brief, any and all available information was submitted with the response to the First Office Action. As of April 4, 2014, there was no additional material to submit.

- c. Item 4 - Patent Application Information

This information was supplied. The Examiner's statements concerning potential negative impact based on a review of claims is disingenuous. As Examiner is aware, this item relates to a design patent application. The drawings submitted are the claims.

- d. Items 5 and 6 - "Will the goods produce vapor?" and "Will the goods deliver vapor to the

user?”

These items were fully responded to in Applicant’s response to the First Office Action.

In that response, the following two statements were made:

“The product is a device which converts herbs into a form in which they may be inhaled. The device is not made of vapor and does not, as its primary function, contain vapor. Its primary function is the conversion of solid to a gaseous form, and it is that function, not the gas itself, that the consumer will associate with the device.” Response to First Office Action at pages 7-8

and

“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.” Response to First Office Action at pages 10

These statements answer both questions. Further, the Examiner clearly has no doubt that, as Applicant has acknowledged, vapor is produced by the goods. His claim that his review of this application was in any way hindered by virtue of his belief that Applicant did not respond to items 5 and/or 6 is disingenuous.

e. Footnote 1 to Applicant’s Brief to the TTAB

The Examiner takes issue with Applicant’s statement in Footnote 1 to the Initial Brief herein, 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.” Applicant’s Initial Brief at Footnote 1, page 6. The Examiner states that the “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." Examiner's Brief at page 8.

Contrary to the Examiner's statements, the response in Footnote 1 is not inherently contradictory. The information requirements in the Second Office Action were identical to those already stated in the First Office Action and responded to, as set forth above, in the response thereto. The fact that they have been sent a second time does not mean they were not responded to previously.

2. Section 2(e)1 Refusal

a. Disclaimer of "Vapor"

Numerous times throughout his brief, the Examiner seeks to prove his position by stating that the Applicant agreed to disclaim the term "Vapor." This is a misstatement of the record. As the response to the First Office Action specifically states:

Applicant would be agreeable to disclaiming the term "Vapor" except as used in the mark, but believes that the compound mark "Vapor Cup" is, at best, suggestive as applied to the goods, i.e. vaporizers. If some exercise of imagination, thought or perception is required to reach a conclusion as to the nature of the goods or services, the mark is suggestive, not merely descriptive.

[Citation omitted] Response to First Office Action at page 11.

No impartial reading of that paragraph can see it as anything other than what it is, an offer to compromise with the Examiner, even as Applicant continues to disagree with the Examiner.

There is neither probative nor evidentiary value in the statement which did not, in fact, amend the

application to disclaim “Vapor.”

b. Examiners Evidence

The Examiner sets out eight items of so-called “evidence” that he, presumably, believes support his position that Applicant’s mark is merely descriptive. They do no such thing. We will address each of them in turn:

Examiner’s Item a - Dictionary Definitions

- i. Vapor - It is not disputed that Applicant’s goods produce vapor. For all the reasons set out in Applicant’s Initial Brief herein, this fact is not dispositive of the issue of descriptiveness. We will not repeat those reasons here, but rather refer the reader to Applicant’s discussion of the Examiners Exhibits B I a pgs 10-11 of the Initial Brief herein.
- ii. Cup - In his First Office Action, and as set out in the Initial Brief herein, the Examiner relied almost exclusively on his attached dictionary definition of “Cup.” The Examiner has stated that the applicable definition is that Applicant’s goods are “Cup-like.” In order to be “Cup-like,” the goods would need to be “like” one of the other definitions of “Cup” supplied by the Examiner. As fully set forth in the Initial Brief, the goods are is not. The Examiner never even attempts to state which of the other definitions of “cup” we are “like.”¹

¹ The Examiner has made reference to an inartfully written clause in Applicant’s Initial Brief where, in referring the Examiner to the drawings from Applicant’s patent application, Applicant uses the term “physical resemblance to a cup.” (Response to First Office Action at page 10). Applicant erroneously adopted the Examiner’s language in that statement. A more proper statement would have been “physical resemblance to a beverage container.” Not all beverage containers are cups and, as can be plainly seen from the materials submitted by both Applicant and the Examiner, Applicant’s goods do not meet any definition of “Cup that the

Examiner's Item b, c, and d - References to Applicant's statements indicating that the goods produce vapor.²

As stated above, it is not disputed that Applicant's goods produce vapor. For all the reasons set out in Applicant's Initial Brief herein, this fact is not dispositive of the issue of descriptiveness. We will not repeat those reasons here, but rather refer the reader to Applicant's discussion of the Examiners Exhibits B I a pgs 10-11 of the Initial Brief herein.

Examiner's item e - Applicant "agreed" to disclaim the wording "VAPOR"

As set out above at more length, this is a misstatement of the record. In the response to the First Office Action Applicant offered to compromise with the Examiner, even as Applicant continued to disagree with the Examiner. The application was never amended to disclaim "Vapor."

Examiner's item f - Items of Evidence submitted by the Examiner

Applicant has already submitted a detailed analysis of the Examiner's evidence, showing how it not only does not support the Examiner's conclusion herein, but, in fact, supports a grant of the registration to the Applicant. Applicant will not belabor the point here, but rather cites the reader to Applicant's Initial Brief, section B I.

Examiner has managed to supply. In the response to the Office Action, Applicant clearly disagreed with the Examiner's characterization of his goods as "cup-like," and the Examiner clearly understood that Applicant was not conceding that point, as it is not mentioned in the Second Office Action as having been conceded. Applicant apologizes for the erroneous statement and withdraws it.

² Curiously, the Examiner states that Applicant did not respond to his information demand as to whether the goods produce vapor, but then cites Applicant's response to prove that Applicant has stated that the goods produce vapor.

Specifically with regards to Examiner's reference to pages "28-31 (internet evidence from the website currently owned by the applicant," the Examiner is being misleading. As phrased, the Examiner seeks to leave the impression that this exhibit contains material created by Applicant, although he cleverly does not actually say so. As the Examiner is aware, while the domain name from which this material is culled is now owned by Applicant, at the time the submitted material was on the website, the domain was owned by an unrelated third party.

Examiner's item g - Resemblance to a Cup

Applicant refers the reader to Footnote 1. Further, the Examiner states that the patent information forwarded supports his contention that Applicant's goods show that such goods are cup-like. They plainly do no such thing. The Examiner refuses to acknowledge or accept that it is he who established the definition of "cup," and that Applicant's goods do not meet any of those definitions. We are left with the argument that Applicant's goods resemble a cup simply because the Examiner, in the face of his own contradictory evidence, arbitrarily says they do.

Examiner's item h - Discreet Coffee Mug shape/Discreet Coffee Mug Design

As stated previously, not all beverage containers are cups. The fact that Applicant has described its goods using the phrase "coffee mug," has no bearing on this matter absent evidence that a mug and a cup are the same thing. The record is devoid of such evidence which, in fact, would not be true. In his zeal to deny this application, the Examiner is looking at apples and calling them oranges. Both are fruits, that does not make them interchangeable.

Even if Applicant had described his goods, on his website as a "cup," which he did not, the undisputed fact remains that the Examiner provided a definition of what constitutes a cup and

Applicant's goods do not meet that definition. A misused work, on a website or in a response to an office action, is not determinative of how the public perceives the goods. As the Examiner himself has pointed out, dictionary definitions are long accepted evidence of such public perception.

c. "Clearly merely descriptive"

The Examiner's refers to Applicant's mark as "clearly merely descriptive." Examiner's Brief at page 12. It is not clear is how the Examiner can have such confidence in his own abilities to make such judgements without hesitation or doubt, in light of all the evidence that doubt does exist, even within the halls of the PTO. Once the Examiner's evidence has been properly reviewed, his argument comes down to the point that "Vapor Cup" is descriptive merely because he believes it to be.

This has been true since the Examiner first reviewed this application. The Examiner makes no attempt to contradict or refute Applicant's statements that, during his conversation with Applicant's counsel, the Examiner stated that the only issue he had any uncertainty about was whether the mark at issue was generic or merely descriptive, or that he advised Applicant's counsel not to even raise the issue that the mark was only suggestive, as he would not consider it.

The fact is, the Examiner was not open to new evidence or consideration of new theories. He has had his mind made up concerning this registration since it landed on his desk. This, in large measure, is why applicant chose to appeal the Examiner's determination rather than respond to the Second Office Action. It was clear that it would be an exercise in futility, as the Examiner had already made his decision.

The Examiner's decision was not based on the evidence, but rather on his own subjective

beliefs, beliefs which are contradicted by the evidence he himself has put forth. It is a decision contradicted by his fellow Trademark Examiner when faced with virtually identical facts. Nothing the Examiner has submitted change the fact that he finds “Vapor Cup” to be merely descriptive, simply because his subjective belief is that it is so.

d. Third Party Registrations as Probative Evidence on the Issue of Descriptiveness

Substantively, we have addressed this issue in our detailed analysis of the marks cited by the Examiner and how they do not support his position. We do, however, draw the Board’s attention to the fact that, while the Examiner places no probative weight upon the Vapocup application, he does feel that third party registrations are “probative evidence” when he believes they support his point.

e. Does Applicant’s Evidence Obviate the Refusal

The Examiner states that “[t]he applicant also argues that a list of series (sic) of third party registrations submitted by Applicant obviates the refusal.” Examiner’s Brief at page 12. This is patently false. While the Applicant does, in fact, substantively believe that the registrations set forth in the list included in its response to the First Office Action would be “probative evidence” of the correctness of his position, Applicant has not made such an argument to this Board. Applicant, in view of its submission of only a list of registrations and not the registrations themselves, has relied only on the registrations submitted into evidence by the Examiner.

Should this Board, in the interests of justice and a complete record, choose to review the registrations contained in Applicant’s response to the First Office Action, Applicant believes they will support his position. None the less, Applicant does not believe such a review is required in

order to reverse the Examiner's decision.

Further, in his footnote 5, the Examiner now switches from finding third party registrations to be "probative evidence" to their being "not conclusive." Both are correct, however the examiner's actions again show that he is seeking to justify a his own preconceived notion rather than giving Applicant a fair and impartial hearing as to its mark.

f. The Examiner's Dictionary Definition is Sufficient to Justify the Refusal of Registration

The Examiner states that "[e]ven if the dictionary definition was the only piece of evidence of record, which it is not, the dictionary definition alone would be sufficient evidence..." (Examiner's Brief at page 19). This statement flies in the face of the record. The Examiner does not even attempt to identify which of the definitions of "cup" Applicant's goods are "like" in order to be "cup-like," the definition on which he relies. In essence, Examiner says Applicant's goods are a cup because he says they are a cup, but has produced no evidence in support of that position.

g. Vapor Cup is a Unitary Mark

The Examiner makes no substantive argument against the position that "Vapor Cup" is unitary mark. He makes the non-substantive statement that Applicant raise the point for the first time in his brief, and then again makes the erroneous claim that Applicant agreed to enter a disclaimer of the term "vapor." These are the only issues the Examiner raises, other than to state that the fact that applicant is the first and only user does NOT NECESSARILY render a word or term incongruous. While this may be true, Examiner offers no argument that would indicate the unitary mark Vapor Cup is NOT incongruous.

The Examiner's arguments are not availing. As has been set out more than once already,

Applicant never agreed to disclaim “vapor,” and never amended his application to do so. As to the unitary mark argument itself, Applicant is always within its rights to argue in the alternative to this Board. See TBMP Section 1215 Alternative Positions (“Just as the Trademark Examining Attorney may refuse registration on alternative grounds, ... so, too, the applicant may, in appropriate cases, take alternative positions with respect to a refusal to register.”)

h. The VAPOCUP Application

Rather than present a cogent argument why Applicant’s mark and goods are substantively different from the mark and goods related to the Vapocup application, the Examiner is, instead, simply dismissive of the argument. Notwithstanding his belief that third party marks are “probative evidence” when he believes they support his claim, here he states that they have “little probative value.” Examiner’s Brief at page 14.

The Examiner is willing to make numerous assumptions about and allowances for the Vapocup mark. The Examiner takes the position that “Vapo” is not the same as “Vapor.” He makes the unsupported allegation that “VAPO does not immediately describe the term VAPOR, but merely hints at the term VAPOR” Examiner’s Brief at page 14. He makes these assertions despite the pseudomark notification filed by the examiner in that matter identifying “Vapo” and “Vapor” as being functionally identical.

In his footnote 6, the Examiner adds “This argument assumes that the term VAPO is suggestive and that no evidence exists [sic] that shows the term VAPO means vapor.” Examiners Brief at Footnote 6, page 16. Would but that the examiner had been so broad minded and liberal when reviewing the instant application. The fact remains that the Vapocup examiner found the mark and goods so similar to those of Applicant that the Vapocup application was suspended

pending the outcome here.

The Examiner misunderstands the nature of Applicant's argument. Let us assume the Examiner reached his subjective conclusion the "Vapor Cup" mark is merely descriptive in good faith. Nonetheless this is, as it must be, a subjective determination. The issue for which Applicant raises the Vapocup application is not to show that the examiner in that matter is right and Mr. Pino is wrong. Indeed, in a matter this subjective, right and wrong have no absolute meaning. Applicant's point is to show not only is there room for doubt, but actual doubt exists, concerning the registrability of the Vapor Cup/Vapocup marks. As was stated more fully in Applicant's Initial Brief, should any such doubt exist, then Applicant is entitled to his registration. It is inexplicable to Applicant that, faced with these two contemporaneous and functionally identical applications, the Examiner finds no reason to doubt the absolute certainty of his determination.

Further, the Examiner does not even address the untenable situation that a denial of registration would put Applicant in. As more fully set forth in Applicant's Initial Brief, denial of his application will likely result in the issuance of a registration for Vapocup. Applicant, the first to apply and, it is believed, the first to use the mark may well find itself subject to an infringement action. This is not mere speculation. Since Applicant last communicated with this Board, he has, through his attorney, received a letter from the Vapocup applicant, who relies on the actions of the Examiner to justify the continued use of the Vapocup mark. Indeed, the Vapocup applicant relies on the actions of the two examiners in taking the position that "Vapor Cup" is merely descriptive while the functionally identical "Vapocup" is not. That letter is annexed hereto as Exhibit A.

We ask this Board, in the interests of fairness and justice, to recognize that doubt exists in the halls of the PTO as to the descriptiveness of Vapor Cup/Vapocup, and to allow registration on that basis.

CONCLUSION

The Examining Attorney has failed to meet his burden to demonstrate the Applicant's Vapor Cup mark and the "Vapor Cup" aspect of the "WeVaps Vapor Cup" mark are merely descriptive. The actions of the Trademark Office in regards to application no. 86226640 show that, at the very least, there is serious doubt as to the "merely descriptive" refusal assessment. To the extent there exists any doubt in the "merely descriptive" refusal assessment after weighing relevant factors, the Board must resolve any such doubt in favor of Applicant.

In light of the above, Applicant respectfully requests that the Board grant this Ex Parte Appeal and direct publication for opposition of both the Vapor Cup and WeVaps Vapor Cup marks.

Dated : June 10, 2015

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April 22, 2015

By e-mail and Regular Mail

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Re: **VapoCup™ - Trademark Application No.: 86/226,640**

Dear Mr. Lieb:

This office represents Products 2 Retail, Inc. ("P2R"), and I am writing in response to your April 13, 2015 "cease and desist" letter addressed to Michael A. Adler, Esq. of my office and in relation to the above-referenced trademark application. As a preliminary matter, please note that all correspondence related to P2R should be sent to my attention.

After carefully considering the statements in your letter, as well as the arguments set forth in your clients' briefs submitted to the Trademark Trial and Appeal Board ("TTAB"), please be advised that P2R rejects your argument that the **VapoCup** mark infringes upon any rights your clients may have in the "Vapor Cup" mark. As you are undoubtedly aware, the trademark office has consistently determined that the "Vapor Cup" mark is descriptive of your clients' goods and, therefore, "Vapor Cup" is not protectable as a trademark under either the Lanham Act or common law. Accordingly, P2R is not infringing any of your clients' protectable trademark right and is, therefore, under no obligation to cease and desist from using its **VapoCup** mark in connection with smoking devices in international class 034.

In that regard, P2R rejects your arguments that the **VapoCup** mark is descriptive. To the contrary, and unlike your clients' mark, the **VapoCup** mark is suggestive and fanciful. If your client remains steadfast in its desire to oppose the registration of the **VapoCup** mark, my client is prepared to submit these and other arguments to the trademark office following the TTAB's denial of your clients' otherwise meritless appeal..

Howard D. Lieb, Esq.

April 22, 2015

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Finally, please note that this letter is sent without waiver of any rights and/or defenses of P2R against Michael Starr, Perfect Technologies Inc. and/or any other third-party, all of which are expressly reserved.

Thank you for your attention to this matter. Please call me if you have any questions or comments.

Very truly yours,

A handwritten signature in blue ink, appearing to read "Andrew Paul Cooper", with a long horizontal flourish extending to the right.

Andrew Paul Cooper

APC/
None