

This Opinion is not a  
Precedent of the TTAB

Mailed: September 10, 2015

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board  
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*In re Michael Starr*  
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Serial Nos. 85969016 and 85971474  
—

Howard David Leib of Howard Leib PC,  
for Michael Starr.

Brian Pino, Trademark Examining Attorney, Law Office 114,  
K. Margaret Le, Managing Attorney.

—  
Before Cataldo, Wellington and Lykos,  
Administrative Trademark Judges.

Opinion by Cataldo, Administrative Trademark Judge:

Michael Starr (“Applicant”) seeks registration on the Principal Register of the marks VAPOR CUP<sup>1</sup> and WEVAPS VAPOR CUP<sup>2</sup> (both in standard characters) identifying the following goods:

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<sup>1</sup> Application Serial No. 85969016 was filed on June 25, 2013, based upon Applicant’s allegation of a *bona fide* intention to use the mark in commerce under Section 1(b) of the Trademark Act.

<sup>2</sup> Application Serial No. 85971474 was filed on June 27, 2013, based upon Applicant’s allegation of a *bona fide* intention to use the mark in commerce under Section 1(b) of the Trademark Act.

Electrically-powered handheld vaporizers for vaporizing vaporizable constituents of herbal and plant matter for creating an aroma in International Class 11.

The Trademark Examining Attorney has refused registration of Applicant's VAPOR CUP mark under Trademark Act Section 2(e)(1), 15 U.S.C. § 1052(e)(1), on the ground that Applicant's mark merely describes a function, feature or characteristic of the identified goods.

The Examining Attorney has refused registration of Applicant's WEVAPS VAPOR CUP mark in the absence of a disclaimer of VAPOR CUP under Trademark Act Section 6(a), 15 U.S.C. § 1056(a), because this wording merely describes a function, feature or characteristic of the identified goods and constitutes an unregistrable component of the mark.

In both applications, the Examining Attorney required Applicant under Trademark Rule 2.61(b), 37 CFR § 2.61(b), to provide additional information about the terms VAPOR and CUP, and the identified goods. Applicant's asserted failure to comply with this requirement is an additional basis for refusal of registration.

When the refusals were made final, Applicant appealed and requested remand. After the Board granted Applicant's requests for remand and the Examining Attorney was not persuaded thereby to withdraw the refusals of registration, the appeals were resumed.<sup>3</sup>

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<sup>3</sup> On March 20, 2015, prior to the filing of the Examining Attorney's appeal brief, Applicant filed a paper titled "Applicant's Reply to Examiner's Denial of Reconsideration" rearguing points raised in his original request for remand. Inasmuch as there is no provision in the Trademark Rules for the filing of such a paper, and also because the arguments therein are essentially repeated in Applicant's reply brief, the March 20, 2015 communication will be given no consideration.

## I. Proceedings Consolidated

When, as here, Applicant has filed *ex parte* appeals to the Board in two co-pending applications, and the cases involve common issues of law or fact, the Board, upon request by the Applicant or Examining Attorney or upon its own initiative, may order the consolidation of the appeals for purposes of briefing, oral hearing, or final decision. *See, e.g., In re Anderson*, 101 USPQ2d 1912, 1915 (TTAB 2012) (Board *sua sponte* consolidated two appeals); *In re Country Music Association, Inc.*, 100 USPQ2d 1824, 1827 (TTAB 2011) (same); *In re Bacardi & Co. Ltd.*, 48 USPQ2d 1031, 1033 (TTAB 1997) (Board *sua sponte* considered appeals in five applications in a single opinion). *See also* TBMP § 1214 (2015) and authorities cited therein.

In this case, the involved applications present closely related marks and identical goods, refusals of registration directed toward the same wording in both marks, and highly similar records. Accordingly, the Board consolidates these appeals. References to the briefs and record refer to Application Serial No. 85969016 unless otherwise indicated.<sup>4</sup>

## II. Evidentiary Issue

Before proceeding to the merits of the refusals to register, we address an evidentiary matter in both applications. In his brief, the Examining Attorney raises the following objection to evidence submitted by Applicant:

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

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<sup>4</sup> Evidence cited in this decision was introduced into the record in both involved applications.

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.<sup>5</sup>

Applicant's list of asserted registrations includes the registration numbers, marks, goods and, where applicable, disclaimers of terms comprising the marks.<sup>6</sup> The list also includes screenshots from Internet websites showing photographs of certain goods, purportedly showing use of the marks in the listed registrations.<sup>7</sup> As the Examining Attorney made clear in his April 24, 2014 Office Action,<sup>8</sup> to make a third-party registration of record, a copy of the registration, either a copy of the paper USPTO record, or a copy taken from the electronic records of the Office, should be submitted. *See In re Jump Designs LLC*, 80 USPQ2d 1370, 1372-73 (TTAB 2006); *In re Duofold Inc.*, 184 USPQ 638 (TTAB 1974). *See also generally* Trademark Board Manual of Procedure ("TBMP") § 1208.02 (2015) and authorities cited therein. Applicant did not provide copies of the listed registrations as instructed. Inasmuch as Applicant was warned of the evidentiary failing at a time when he could correct the deficiency, and still failed to correct it, the list of

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<sup>5</sup> 11 TTABVUE 3. Record citations are to TTABVUE, the Trademark Trial and Appeal Board's publically available docket history system. *See Turdin v. Trilobite, Ltd.*, 109 USPQ2d 1473, 1476 n.6 (TTAB 2014).

Citations to the examination record refer to the Trademark Office's online Trademark Status and Document Retrieval system (TSDR), by date and page number.

<sup>6</sup> Applicant's April 4, 2014 communication p. 6-10.

<sup>7</sup> *Id.* at 12-19.

<sup>8</sup> April 24, 2014 Office Action at 7, FN 1.

registrations will not be considered. The screenshots of photographs of goods accompanying Applicant's list of registrations will be considered for such probative value as they may possess.

We observe nonetheless that even if we had considered the list, our decision would be the same inasmuch as the goods in the listed registrations are dissimilar from the ones at issue herein and none of the involved marks include both the terms "vapor" and "cup." Further, any expired registrations among those asserted are also of no value. *See Action Temporary Services Inc. v. Labor Force Inc.*, 870 F.2d 1563, 10 USPQ2d 1307, 1309 (Fed. Cir. 1989) ("[A] cancelled registration does not provide constructive notice of anything.").

### III. Requirement for Additional Information

The Examining Attorney required Applicant to submit the following information about the goods in his first Office Action:<sup>9</sup>

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.

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<sup>9</sup> October 10, 2013 Office Action at 4-5.

The Examining Attorney issued an identical requirement for additional information in application Serial No. 85971474 with the exception of question 12 below which was omitted. We observe that request for information No. 12 appears to be inappropriate inasmuch as it calls for a legal conclusion rather than information regarding the nature of the mark or goods.

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 VAPOR CUP the apt name for the goods?

13. Is vaporcup.com shown in the attached evidence the applicant's website?

In response, Applicant submitted the following statements:<sup>10</sup>

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

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<sup>10</sup> Applicant's April 4, 2014 communication at 7-8, 10.

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.

To answer the other 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<sup>3</sup>, 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.<sup>4</sup> 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 applicant. The materials attached to the Office Action are not applicant’s, but were created, presumably, by a prior owner of the domain. I am advised by 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,” If anything, from the usage “VaporCup,” as a single word with two capital letters, seems that the now abandoned effort that previously owned the domain name also viewed this as a mark, not a description. This 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 evidence of anything, let alone that the mark is descriptive or, as the examiner has alluded to, generic.

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<sup>3</sup> The drawings from applicant’s design patent application are annexed hereto.

<sup>4</sup> In view of the inapplicability of the other definitions, it is unclear what the definition “a cup like object” would mean in this context. Further, the Examiner is incorrect in is statement that applicant and his counsel agree that the term “Cup” is merely descriptive of the goods.

Applicant submitted with his response drawings from his design patent application.

The following drawing is illustrative:<sup>11</sup>

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<sup>11</sup> *Id.* at 20-24.

**FIG. 1**



The Examining Attorney addressed Applicant's response and required further information about the goods in his final Office Action:<sup>12</sup>

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

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<sup>12</sup> April 24, 2014 Office Action at 5.



Register. As a consequence, the information requirement is maintained and made FINAL. ...

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?

Applicant did not file a request for reconsideration other than the request for remand submitted as part of his appeal brief. In his brief, Applicant argues as follows:

The examiner also stated that the applications were refused for the requirement of information, but 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.<sup>13</sup>

Applicant further argues that he “also submitted a copy of his patent application relating to goods to be sold under the “Vapor Cup” and “WeVaps Vapor Cup” marks.”<sup>14</sup>

In his brief, the Examining Attorney argues as follows:

[T]he 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. 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 vapor or deliver vapor to the user.<sup>15</sup>

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 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

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<sup>13</sup> 4 TTABVUE 2, FN 1.

<sup>14</sup> *Id.* at 11.

<sup>15</sup> 11 TTABVUE 11.

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.<sup>16</sup>

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.<sup>17</sup>

The Examining Attorney also makes the following acknowledgment:

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.<sup>18</sup>

In his reply brief, Applicant argues as follows:

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

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<sup>16</sup> *Id.* at 11-12.

<sup>17</sup> *Id.* at 13.

<sup>18</sup> *Id.* at 11, FN 3.

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 [sic] 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.<sup>19</sup>

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<sup>19</sup> 12 TTABVUE 5-7.

“The Office may require the applicant to furnish such information ... as may be reasonably necessary to the proper examination of the application.” Trademark Rule 2.61(b). As the Board noted recently:

Failure to comply with a request for information is grounds for refusal of registration. *In re Cheezwhse.com Inc.*, 85 USPQ2d 1917, 1919 (TTAB 2008); *In re DTI Partnership LLP*, 67 USPQ2d 1699, 1701 (TTAB 2003); TMEP § 814. In view of applicant’s equivocal responses (not to mention its complete silence on this point in its brief), we find that applicant has not complied with the requirement for more specific information.

*In re AOP LLC*, 107 USPQ2d 1644, 1651 (TTAB 2013).

A request for information must be clear, and the information requested must be “reasonably necessary” for examination, *see In re SPX Corp.*, 63 USPQ2d 1592, 1597 (TTAB 2002) (affirming requirement under Trademark Rule 2.61(b) “because ... the request for information was reasonable”). An examining attorney generally has considerable discretion in deciding whether and what information should be requested pursuant to Trademark Rule 2.61(b). An examining attorney’s ability to determine the registrability of a trademark is impaired without a clear understanding of the identified goods and services or of the meaning of the mark, and the applicant is often in the best position to supply that information. This is particularly the case where, as here, the applications at issue are based upon an assertion of a *bona fide* intent to use the mark in commerce, and there are no specimens of record or other evidence of use of the applied-for marks. Finally, it is settled that the failure to comply with a Trademark Rule 2.61(b) requirement is itself a proper ground for refusal of registration, even if it is the only outstanding

refusal or requirement. *In re DTI P'ship LLP*, 67 USPQ2d 1699 (TTAB 2003) (affirming refusal to register under Trademark Rule 2.61 without reaching refusal under Trademark Act § 2(e)(1)).

In this case, and as discussed above, the Examining Attorney has acknowledged that Applicant's responses in its April 4, 2014 communication are sufficient to answer the outstanding request Nos. 1 and 2 as to VAPOR CUP as a whole, and the Examining Attorney has withdrawn the information requirement with regard thereto.

While not explicitly stated, the requirement for information in request Nos. 1 and 2 appear to remain outstanding as to the individual terms VAPOR and CUP. The Examining Attorney's six outstanding requests for information – Nos. 1 and 2 as limited above and Nos. 3-6 – all deal with the terms VAPOR and/or CUP and their significance to the identified goods. Applicant was required to submit additional product information, if available, and “similar documentation” regarding related goods if not; provide copies of all “patent application documentation relating to the goods”; and answer whether VAPOR or CUP possess any significance as used in connection with the goods and in the relevant trade, and whether the goods produce vapor or deliver vapor to the user.

The information required by the Examining Attorney was “reasonably necessary to the proper examination of the application.” Trademark Rule 2.61(b). Product information and patent application documentation relating to the goods clearly assist the Examining Attorney in determining, *e.g.*, whether VAPOR CUP

was merely descriptive of some or all of the recited goods. Similarly, the questions regarding the significance of VAPOR and CUP as well as whether the goods produce vapor or deliver vapor to a user are directed toward the issue of whether the term VAPOR or CUP merely describes the goods.

In his brief and reply brief, Applicant asserts that all available product information was submitted with his April 4, 2014 communication. Also, in his reply brief, Applicant asserts that the drawings from his design patent application submitted with his April 4, 2014 communication comprise the entirety of his patent claims and that no other patent application materials are available. Applicant further asserts in his reply brief that “[a]s has been repeatedly acknowledged, the Vapor Cup vaporizer does produce vapor” and “[a]s a vaporizer, the goods are anticipated to transform a particular substance from solid to gas form for users to inhale.” Thus, Applicant argues that he has complied with all outstanding requests for information.

We observe, however, that Applicant did not directly answer the six outstanding requests for information in their entirety during prosecution, but rather only answered them for the first time in his brief (No. 3) and reply brief (Nos. 4-6). With regard to request Nos. 1 and 2, Applicant provided partial responses as to VAPOR CUP during prosecution and CUP in his reply brief, and does not appear to have responded with regard to the term VAPOR. It would have been a simple matter to directly state during prosecution in response to information request Nos. 3 and 4 that no other documentation exists and that the drawings submitted comprised the

entirety of his design patent claims. Similarly, questions Nos. 1, 2, 5 and 6 appear to require little or nothing more than “yes” or “no” answers or at most, a very brief explanation. Nonetheless, Applicant never directly answered the Examining Attorney’s outstanding questions during prosecution of its involved applications, but rather only provided hints as to the answers thereto. We further observe that the information provided by Applicant during prosecution may have been sufficient to answer many of the Examining Attorney’s questions; however, the Examining Attorney was not obligated to so infer direct answers from Applicant’s responses when it would have been a simple matter for Applicant to directly answer the questions posed. It was within the Examining Attorney’s discretion to ask such questions and to refuse registration when the requirement went unsatisfied.

As a result, we find that Applicant failed to comply with the Examining Attorney’s information request Nos. 1-6 as posed in his final Office Action.

#### IV. Mere Descriptiveness of VAPOR CUP

An examining attorney may require an applicant to disclaim an unregistrable component of a mark otherwise registrable. Trademark Act Section 6(a), 15 U.S.C. § 1056(a). Merely descriptive terms are unregistrable, under Trademark Act Section 2(e)(1), 15 U.S.C. § 1052(e)(1) and, therefore, are subject to disclaimer if the mark is otherwise registrable. Failure to comply with a disclaimer requirement is grounds for refusal of registration. *See In re Omaha National Corp.*, 819 F.2d 1117, 2 USPQ2d 1859 (Fed. Cir. 1987); *In re Richardson Ink Co.*, 511 F.2d 559, 185 USPQ



46 (CCPA 1975); *In re National Presto Industries, Inc.*, 197 USPQ 188 (TTAB 1977); *In re Pendleton Tool Industries, Inc.*, 157 USPQ 114 (TTAB 1968).

A term is merely descriptive of goods (or services) within the meaning of Section 2(e)(1) if it forthwith conveys an immediate idea of an ingredient, quality, characteristic, feature, function, purpose or use thereof. *In re Chamber of Commerce of the U.S.*, 675 F.3d 1297, 102 USPQ2d 1217, 1219 (Fed. Cir. 2012). *See also, In re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987).

Whether a mark (or terms comprising part of a mark that are subject to a disclaimer requirement) is merely descriptive is determined in relation to the goods for which registration is sought and the context in which the term is used, not in the abstract or on the basis of guesswork. *In re Abcor Dev. Corp.*, 588 F.2d 811, 200 USPQ 215, 218 (CCPA 1978); *In re Remacle*, 66 USPQ2d 1222, 1224 (TTAB 2002). A term need not immediately convey an idea of each and every specific feature of the goods in order to be considered merely descriptive; it is enough if it describes one significant attribute, function or property of them. *See In re Gyulay*, 3 USPQ2d at 1010; *In re H.U.D.D.L.E.*, 216 USPQ 358 (TTAB 1982); *In re MBAssociates*, 180 USPQ 338 (TTAB 1973). This requires consideration of the context in which the mark is used or intended to be used in connection with those goods, and the possible significance that the mark would have to the average purchaser of the goods in the relevant marketplace. *See In re Chamber of Commerce of the U.S.*, 102 USPQ2d at 1219; *In re Bayer Aktiengesellschaft*, 488 F.3d 960, 82 USPQ2d 1828, 1831 (Fed. Cir.

2007); *In re Abcor Dev. Corp.*, 200 USPQ at 218; *In re Venture Lending Assocs.*, 226 USPQ 285 (TTAB 1985).

In other words, the question is whether someone who knows what the goods or services are will understand the mark to convey information about them. *DuoProSS Meditech Corp. v. Inviro Medical Devices, Ltd.*, 695 F.3d 1247, 103 USPQ2d 1753, 1757 (Fed. Cir. 2012); *In re Tower Tech, Inc.*, 64 USPQ2d 1314, 1316-17 (TTAB 2002); *In re Patent & Trademark Servs. Inc.*, 49 USPQ2d 1537, 1539 (TTAB 1998). “On the other hand, if one must exercise mature thought or follow a multi-stage reasoning process in order to determine what product or service characteristics the term indicates, the term is suggestive rather than merely descriptive.” *Coach Servs. Inc. v. Triumph Learning LLC*, 96 USPQ2d 1600, 1616 (TTAB 2010) (quoting *In re Tennis in the Round, Inc.*, 199 USPQ 496, 497 (TTAB 1978)), *vacated-in-part on other grounds*, 668 F.3d 1356, 101 USPQ2d 1713 (Fed. Cir. 2012).

Where marks are comprised of multiple words, it is generally held that if the individual components of a mark retain their descriptive meaning in relation to the goods, the combination results in a composite mark that is itself descriptive and not registrable. *In re Phoseon Tech., Inc.*, 103 USPQ2d 1822, 1823 (TTAB 2012). *See also, e.g., In re King Koil Licensing Co.*, 79 USPQ2d 1048, 1052 (TTAB 2006) (holding THE BREATHABLE MATTRESS merely descriptive of beds, mattresses, box springs, and pillows where the evidence showed that the term “BREATHABLE” retained its ordinary dictionary meaning when combined with the term “MATTRESS” and the resulting combination was used in the relevant industry in a

descriptive sense); *In re Associated Theatre Clubs Co.*, 9 USPQ2d 1660, 1663 (TTAB 1988) (holding GROUP SALES BOX OFFICE merely descriptive of theater ticket sales services, because such wording “is nothing more than a combination of the two common descriptive terms most applicable to applicant’s services which in combination achieve no different status but remain a common descriptive compound expression”).

Only where the combination of descriptive terms creates a unitary mark with a unique, incongruous, or otherwise nondescriptive meaning in relation to the goods is the combined mark registrable. *See In re Colonial Stores, Inc.*, 394 F.2d 549, 551, 157 USPQ 382, 384 (CCPA 1968); *In re Positec Grp. Ltd.*, 108 USPQ2d 1161, 1162-63 (TTAB 2013).

In support of the refusal to register, the Examining Attorney made of record with his October 10, 2013 Office Action, the following definitions of the terms “vapor” and “cup” provided by Houghton Mifflin from the Internet website [education.yahoo.com/reference/dictionary](http://education.yahoo.com/reference/dictionary) (2009):

vapor – barely visible or cloudy diffused matter, such as mist, fumes, or smoke, suspended in the air;

the vaporized form of a substance for use in industrial, military, or medical processes;

cup – a small open container, usually with a flat bottom and a handle, used for drinking;

such a container and its contents;

a cuplike object.


In addition, the Examining Attorney made of record with his October 10, 2013 Office Action the following definition from the same reference source:

vaporizer – one that vaporizes, especially a device used to vaporize medicine for inhalation. In the same Office Action, the Examining Attorney made of record copies of pages from informational and commercial Internet websites displaying various herbal vaporizers. The following examples are illustrative:

[Bongs & Water Pipes](#) | **Vaporizers** | [Papers & Blunts](#) | [Smoking Accessories](#) | [Lifestyle](#) | [Smoking Paraphenalia](#) | [Brands](#) | [Deals & offers](#)

Home » Online Shop » **Vaporizers** » Standard Vaporisers » **Vapor Herbal & Aromatherapy Vaporizer**

**Vapor Herbal & Aromatherapy Vaporizer**



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Ref: **VP-102**

This **Vapor Vaporizer** features a digital display and a handy draw to store your accoutrements.

**Vaporizers** offer the safest and healthiest way to smoke your favourite legal herbs or tobacco.

**SPECS.** | **RETURNS**

Voltage: 240v

Note.: A Step Up/Down Converter may be required for our overseas customers

Weight: 900g

(bingj.com/vaporizer+herbal+vapor);



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Vaporizers

Portable Vaporizers

Standard Vaporisers

Deluxe Vaporizers

Extreme Q Vaporizer

RooR Vaporizer

Verdamper Vaporizer

Volcano Vaporizers

Alivi8 Vaporizer

Da Buddha Vaporizer

Digital Vaporizers

Eagle Bill Vapourizer Pipe

Glass Vaporizers

HerbalAire Vaporizer - Series H2.1

Herborizer Vaporizer

Hot Box Vaporizer

Iolite Vaporiser

Magic Flight Launch

[Home » Online Shop » Vaporizers](#)

## Vaporizers









Vaporizers and the art of Vaporization is the healthy way to obtain the active ingredients out of your preferred herbal blends. There are many vaporizers on the market today with many applications and slightly different ways of delivering the vapor. The Volcano Vaporizers for instance are digital Vaps designed to deliver a very specific and controlled vapor for use by medical patients in their home.

### Portable Vaporizers

From \$13.49



[See All 17 Products](#)

### RooR Vaporizer

### Standard Vaporisers

From \$44.93



[See All 8 Products](#)

### Verdamper Vaporizer

### Deluxe Vaporizers

From \$89.93



[See All 35 Products](#)

### Volcano Vaporizers

### Extreme Q Vaporizer

From \$299.99



[See All 1 Products](#)

### Alivi8 Vaporizer

(everyonedoesit.com/online\_headshop/vaporisers)


- Magic Flight Launch Box Vaporizer
- Puffit Vaporizer
- Silver Surfer Vaporizer
- Smoke Bubble Vaporiser
- Space Case Globe
- U.K & E.U. Vaporisers
- U.S.A Vaporizers
- V-Tower Vaporizer
- Vapir Vaporizers
- Vapman Vaporizers and Accessories
- Vapolution Vaporiser
- Vaporiser Gifts
- Vapomatic Deluxe Digital Vaporizer
- Vapourstar

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- Online Headshop
- Latest Additions
- 360° Images
- Videos
- Competitions

### Herb Vaporizer


From \$652.50



See All 2 Products

### Vaporizer


From \$562.49



See All 2 Products

### Vaporizers


From \$2.99



See All 14 Products

### Mini Vaporizer


From \$82.43



See All 1 Products

### Da Buddha Vaporizer


From \$215.99



See All 2 Products

### Digital Vaporizers


From \$149.93



See All 4 Products

### Eagle Bill Vapourizer Pipe


From \$19.49



See All 1 Products

### Glass Vaporizers


From \$10.49



See All 13 Products

### HerbalAire Vaporizer - 2100


From \$315.00



See All 1 Products

### Herborizer Vaporizer


From \$330.93



See All 2 Products

### Hot Box Vaporizer


From \$202.50



See All 10 Products

### Iolite Vaporiser

From \$0.09



See All 7 Products

(Id.);



The screenshot shows the homepage of TheVaporShop.com. At the top, there's a banner with a woman using a vaporizer, the website name, a phone number (877-511-8916), and a '100% Secure Shopping | Order Online Now!' message. A search bar is on the right. The left sidebar contains navigation links for Categories (Portable Herbal Vaporizers, Analog Hands-Free Vaporizers, Digital Hands-Free Vaporizers, Vaporizer Accessories), Site Information (About Us, Contact Us, Frequently Asked Questions, Privacy Policy, Shipping/Returns), and a free guide offer. The main content area displays the 'Vape or Smoke Herbal Portable Vaporizer - Ninja Edition' with a price of \$139.95 and an 'Add To Cart' button. Below the product image are tabs for Overview, Reviews, and Tell a Friend. The right sidebar shows a login/register section and a shopping cart summary.

This screenshot shows the detailed product page for 'The Tool - Vape or Smoke Pipe'. The left sidebar has a contact form with fields for Name and Email, a Submit button, and links for privacy policy and email marketing services. The main content area is titled 'The Tool - Vape or Smoke Pipe' and describes the device as a portable smoking device. It includes sections for 'Vaporize or Smoke' and 'Materials'. The right sidebar features the Authorize.Net logo and a link to the Online Payment System.

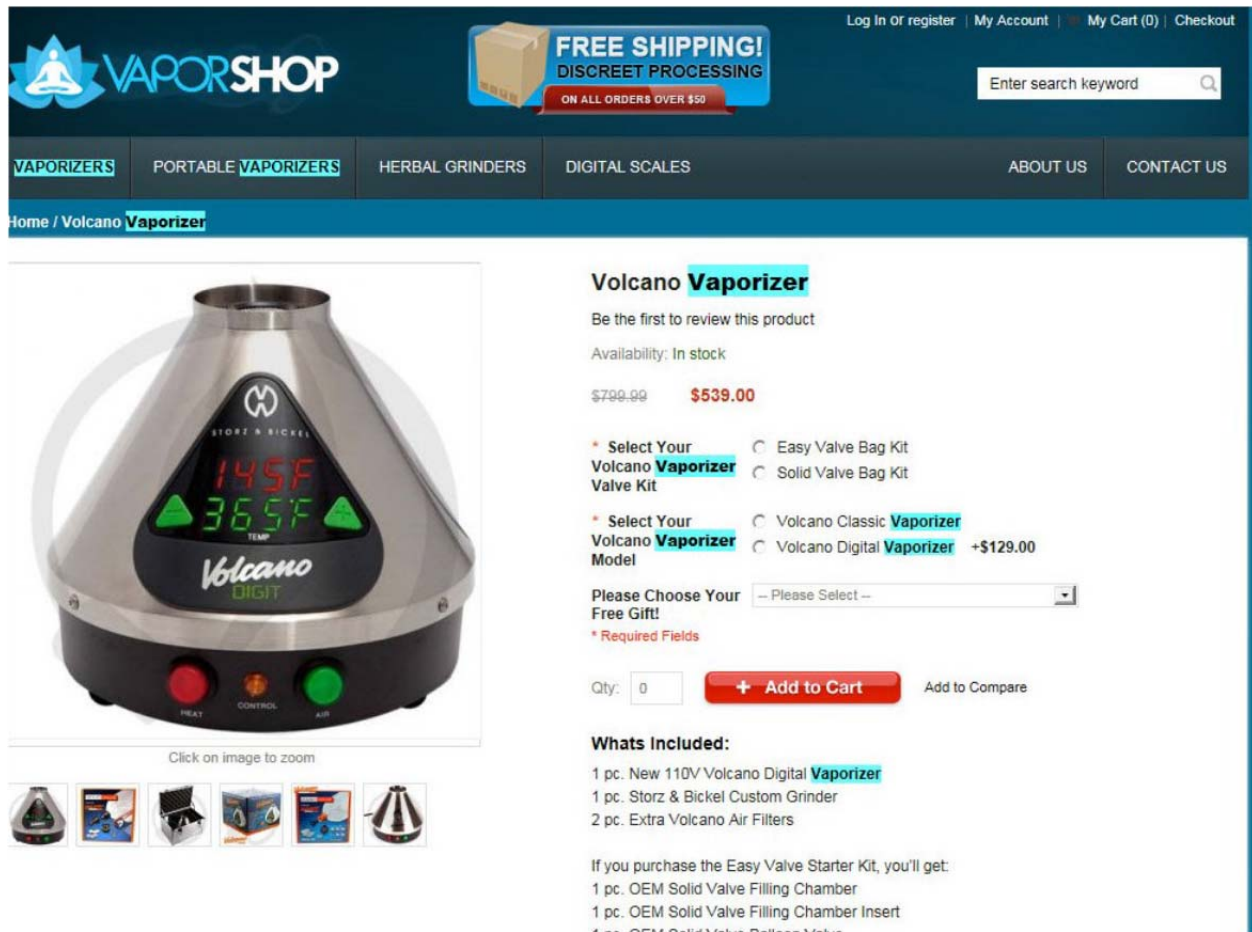
(thevaporshop.com/vape-or-smoke).

The Examining Attorney further made of record with his April 24, 2014 Office Action additional Internet webpages, of which the following are illustrative:



(bingj.comvapor+vaporizer); and





**VAPORSHOP** FREE SHIPPING! DISCREET PROCESSING ON ALL ORDERS OVER \$50

Log In Or register | My Account | My Cart (0) | Checkout

Enter search keyword

VAPORIZERS PORTABLE VAPORIZERS HERBAL GRINDERS DIGITAL SCALES ABOUT US CONTACT US

Home / Volcano Vaporizer

### Volcano Vaporizer

Be the first to review this product

Availability: In stock

~~\$799.99~~ **\$539.00**

\* Select Your Volcano Vaporizer Valve Kit

- ☐ Easy Valve Bag Kit
- ☐ Solid Valve Bag Kit

\* Select Your Volcano Vaporizer Model

- ☐ Volcano Classic Vaporizer
- ☐ Volcano Digital Vaporizer +\$129.00

Please Choose Your Free Gift!

\* Required Fields

Qty:  **+ Add to Cart** Add to Compare

**Whats Included:**

- 1 pc. New 110V Volcano Digital Vaporizer
- 1 pc. Storz & Bickel Custom Grinder
- 2 pc. Extra Volcano Air Filters

If you purchase the Easy Valve Starter Kit, you'll get:

- 1 pc. OEM Solid Valve Filling Chamber
- 1 pc. OEM Solid Valve Filling Chamber Insert
- 1 pc. OEM Solid Valve Balloon Valve

(Id.). With both Office Actions, the Examining Attorney also made of record copies of two third-party registrations consisting of marks including the term “vapor(s)” with said term disclaimed, and reciting various goods including vaporizers.

As noted above, the Examining Attorney’s evidence and Applicant’s acknowledgements establish, *inter alia*, the following:

a “cup” is a small container used for drinking or an object so shaped;

“vapor” is cloudy, diffused smoke or vaporized matter used for various purposes;

a “vaporizer” is a device that vaporizes substances for inhalation;

Applicant’s goods are shaped like a drinking cup;

Applicant’s goods produce vapor; and

Applicant's goods convert herbs into a form in which they may be inhaled.

Based upon the record evidence and acknowledgments, we find that VAPOR CUP merely describes a cup-shaped vaporizer that converts herbs into a vapor form in which they may be inhaled. As a result, we find that VAPOR CUP immediately describes a function, feature or characteristic of Applicant's electrically-powered handheld vaporizers for vaporizing vaporizable constituents of herbal and plant matter for creating an aroma. In other words, consumers familiar with Applicant's vaporizers will understand his mark to immediately convey, without the need for multi-stage reasoning, that VAPOR CUP is a vaporizer shaped like a cup that produces vapor for inhalation. *See, e.g., DuoProSS*, 103 USPQ2d at 1757. *Cf. Coach Servs.*, 96 USPQ2d at 1616. The individual terms VAPOR and CUP, when combined, retain their descriptive meaning in relation to Applicant's vaporizers, resulting in a composite mark, VAPOR CUP, which merely describes a function, feature or characteristic of Applicant's goods. *In re Phoseon Tech., Inc.*, 103 USPQ2d at 1823.

We further note that, in addition to the evidence discussed above, as a consequence of Applicant's failure to provide the required information, we may presume, unfavorably to Applicant, that VAPOR and CUP have significance as applied to his goods, and that his goods will produce vapor and deliver vapor to users thereof. *See In re Cheezwhse.com Inc.*, 85 USPQ2d 1917 (TTAB 2008). Such presumptions are consistent with the evidence made of record by the Examining Attorney and the acknowledgements made by Applicant in his briefs.

Applicant points to the absence of evidence in the record of third parties using VAPOR CUP to identify similar goods. However, even if Applicant is the first and/or presently the only user of the term VAPOR CUP in connection with vaporizers, it is well settled that such does not entitle Applicant to the registration thereof where, as here, the term has been shown to immediately convey only a merely descriptive significance in the context of Applicant's goods. *See, e.g., In re National Shooting Sports Foundation, Inc.*, 219 USPQ 1018, 1020 (TTAB 1983); *In re Mark A. Gould, M.D.*, 173 USPQ 243, 245 (TTAB 1972).

Applicant argues that his goods are not a cup, and cannot be used as one. However, there is no question on this record that Applicant's goods are shaped like a cup, i.e., a vaporizer placed in a housing that resembles a drinking cup which allows users to discretely inhale vaporized herbal and plant matter. Applicant further argues that the definitions of "cup" relied upon by the Examining Attorney are picked from among a dozen possible definitions. This argument similarly is unavailing. If a term has a primary significance that is descriptive in relation to at least one of the recited goods or services, and does not create any double entendre or incongruity, then the term is merely descriptive. The fact that VAPOR CUP or its component terms may have different meanings in different contexts is not controlling. *See In re RiseSmart Inc.*, 104 USPQ2d 1931, 1933 (TTAB 2012); *In re Chopper Indus.*, 222 USPQ 258, 259 (TTAB 1984); *In re Bright-Crest, Ltd.*, 204 USPQ 591, 593 (TTAB 1979).

Finally, Applicant vigorously argues that a third-party application for the mark VAPOCUP for Tobacco pipes; Tobacco cups; Smoking pipes; Smoking cups; Smoking paraphernalia, namely, smoking pipes and smoking cups for smoking tobacco and herbs, while suspended pending the outcome of the applications involved herein, was not subject to a refusal to register based upon mere descriptiveness.<sup>20</sup> However, we note that the goods identified in this third-party application include various smoking articles but do not include Applicant's goods, namely, vaporizers. Furthermore, as is often noted by the Board and the Courts, each case must be decided on its own merits. *See In re Nett Designs Inc.*, 236 F.3d 1339, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001). *See also, In re Kent-Gamebore Corp.*, 59 USPQ2d 1373 (TTAB 2001); *In re Wilson*, 57 USPQ2d 1863 (TTAB 2001). While consistent treatment of pending applications is a laudable goal, this tribunal is not bound by the actions of Examining Attorneys with regard to other applications.

In summary, based upon the totality of the evidence of record, including any evidence not specifically discussed herein, we find that VAPOR CUP merely describes a function, feature or characteristic of the recited goods.

**Decision:** The refusal to register Applicant's mark VAPOR CUP in application Serial No. 85696016, on the ground that the mark is merely descriptive of the goods under Trademark Act Section 2(e)(1), 15 U.S.C. § 1052(e)(1), is affirmed.

The refusal to register Applicant's mark WEVAPS VAPOR CUP in application Serial No. 85971474 in the absence of a disclaimer of VAPOR CUP, on the ground

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<sup>20</sup> Application Serial No. 86226640.

that VAPOR CUP is merely descriptive of the goods under Trademark Act Section 6(a), is affirmed.

The refusal to register the marks in both subject application Serial Nos. 85696016 and 85971474 as a consequence of Applicant's failure to directly respond to the Examining Attorney's request for information under Trademark Rule 2.61(b), 37 CFR §2.61(b), is affirmed.<sup>21</sup>

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<sup>21</sup> With regard to application Serial No. 85971474, because Applicant's failure to respond to the Examining Attorney's request for information is a second basis for refusal of registration, Applicant may not overcome the refusal to register under Section 2(e)(1) by providing a disclaimer of VAPOR CUP. *See generally* TBMP § 1218 (2015) and authorities cited therein.