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Subject: U.S. TRADEMARK APPLICATION NO. 86805477 - BLENDER - 1481-019.701 - EXAMINER BRIEF

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UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)

U.S. APPLICATION SERIAL NO. 86805477

MARK: BLENDER



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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>

APPLICANT: Vaporous Technologies, LLC

CORRESPONDENT'S REFERENCE/DOCKET NO:

1481-019.701

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EXAMINING ATTORNEY'S APPEAL BRIEF

Applicant appealed the trademark examining attorney's final refusal to register the mark "BLENDER" in standard character form for use with "Portable electric oral vaporizers that simultaneously vaporize a wax medium and a liquid medium for smoking purposes; Reusable portable electric oral vaporizers that enable users to load multiple types of vaporizing media for smoking purposes" in International Class 034.

The examining attorney refused registration under Trademark Act Section 2(d), 15 U.S.C. 1052(d), upon

finding a likelihood of confusion with the mark and goods in U.S. Registration No. 4713461, “BACKYARD BLENDER” in standard character form, registered on the Principal Register for “Chemical flavorings in liquid form used to refill electronic cigarette cartridges” in International Class 030 and “Cigarette tubes; electric cigarettes; electronic cigarette refill cartridges sold empty; electronic cigars; electronic hookahs; hookah parts, namely, tube, charcoal, and hose; hookah tobacco; hookahs; smokeless cigarette vaporizer pipe; smokers' articles, namely, hookah charcoal” in International Class 034.

I. FACTS

Applicant applied for registration on the Principal Register of the mark “BLENDER” for “Portable electric oral vaporizers that simultaneously vaporize a wax medium and a liquid medium for smoking purposes; Reusable portable electric oral vaporizers that enable users to load multiple types of vaporizing media for smoking purposes” in International Class 034. The examining attorney issued a final refusal under Section 2(d), 15 U.S.C. 1052(d), after finding a likelihood of confusion with U.S. Registration No. 4713461, “BACKYARD BLENDER” registered on the Principal Register for “Chemical flavorings in liquid form used to refill electronic cigarette cartridges” in International Class 030 and “Cigarette tubes; electric cigarettes; electronic cigarette refill cartridges sold empty; electronic cigars; electronic hookahs; hookah parts, namely, tube, charcoal, and hose; hookah tobacco; hookahs; smokeless cigarette vaporizer pipe; smokers' articles, namely, hookah charcoal” in International Class 034. The examining attorney found applicant’s mark, when used in connection with the applied for goods, likely to cause confusion or mistake as to the mark and goods of registrant. This appeals follows the examining attorney’s final refusal under Section 2(d).

II. ARGUMENTS

A. Applicant's Mark and Registrant's Mark Are Confusingly Similar In Overall Commercial Impression, and the Goods of Applicant and Registrant Are Related Such that there Exists a Likelihood Of Confusion As to the Source Of these Goods Under Section 2(d) of the Trademark Act.

Trademark Act Section 2(d) bars registration of an applied-for mark that so resembles a registered mark that it is likely a potential consumer would be confused, mistaken, or deceived as to the source of the goods of the applicant and registrant. See 15 U.S.C. §1052(d). A determination of likelihood of confusion under Section 2(d) is made on a case-by-case basis and the factors set forth in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563, 567 (C.C.P.A. 1973) aid in this determination. *Citigroup Inc. v. Capital City Bank Grp., Inc.*, 637 F.3d 1344, 1349, 98 USPQ2d 1253, 1256 (Fed. Cir. 2011) (citing *On-Line Careline, Inc. v. Am. Online, Inc.*, 229 F.3d 1080, 1085, 56 USPQ2d 1471, 1474 (Fed. Cir. 2000)). Not all the *du Pont* factors, however, are necessarily relevant or of equal weight, and any one of the factors may control in a given case, depending upon the evidence of record. *Citigroup Inc. v. Capital City Bank Grp., Inc.*, 637 F.3d at 1355, 98 USPQ2d at 1260; *In re Majestic Distilling Co.*, 315 F.3d 1311, 1315, 65 USPQ2d 1201, 1204 (Fed. Cir. 2003); see *In re E. I. du Pont de Nemours & Co.*, 476 F.2d at 1361-62, 177 USPQ at 567.

In this case, the following factors are the most relevant: similarity of the marks, similarity and nature of the goods, and similarity of the trade channels of the goods. See *In re Viterra Inc.*, 671 F.3d 1358, 1361-62, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012); *In re Dakin's Miniatures Inc.*, 59 USPQ2d 1593, 1595-96 (TTAB 1999); TMEP §§1207.01 *et seq.*

B. Applicant's Mark and Registrant's Marks Are Confusingly Similar

Marks are compared in their entireties for similarities in appearance, sound, connotation, and commercial impression. *Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 1321, 110 USPQ2d 1157, 1160 (Fed. Cir. 2014) (quoting *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 396 F.3d 1369, 1371, 73 USPQ2d 1689, 1691 (Fed. Cir. 2005)); TMEP §1207.01(b)-(b)(v). “Similarity in any one of these elements may be sufficient to find the marks confusingly similar.” *In re Davia*, 110 USPQ2d 1810, 1812 (TTAB 2014) (citing *In re 1st USA Realty Prof’ls, Inc.*, 84 USPQ2d 1581, 1586 (TTAB 2007)); *In re White Swan Ltd.*, 8 USPQ2d 1534, 1535 (TTAB 1988)); TMEP §1207.01(b).

When comparing marks, the test is not whether the marks can be distinguished in a side-by-side comparison, but rather whether the marks are sufficiently similar in terms of their overall commercial impression that confusion as to the source of the goods offered under the respective marks is likely to result. *Midwestern Pet Foods, Inc. v. Societe des Produits Nestle S.A.*, 685 F.3d 1046, 1053, 103 USPQ2d 1435, 1440 (Fed. Cir. 2012); *In re Bay State Brewing Co.*, 117 USPQ2d 1958, 1960 (TTAB 2016) (quoting *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 1368, 101 USPQ2d 1713, 1721 (Fed. Cir. 2012)); TMEP §1207.01(b). The proper focus is on the recollection of the average purchaser, who retains a general rather than specific impression of trademarks. *In re Bay State Brewing Co.*, 117 USPQ2d at 1960 (citing *Spoons Rests. Inc. v. Morrison Inc.*, 23 USPQ2d 1735, 1741 (TTAB 1991), *aff’d per curiam*, 972 F.2d 1353 (Fed. Cir. 1992)); *In re C.H. Hanson Co.*, 116 USPQ2d 1351, 1353 (TTAB 2015) (citing *Joel Gott Wines LLC v. Rehoboth Von Gott Inc.*, 107 USPQ2d 1424, 1430 (TTAB 2013)); TMEP §1207.01(b).

Comparing the mark of applicant, “BLENDER”, to the mark of registrant, “BACKYARD BLENDER”, both marks share the term “BLENDER”. Marks may be confusingly similar in appearance where similar terms

or phrases or similar parts of terms or phrases appear in the compared marks and create a similar overall commercial impression. *See Crocker Nat'l Bank v. Canadian Imperial Bank of Commerce*, 228 USPQ 689, 690-91 (TTAB 1986), *aff'd sub nom. Canadian Imperial Bank of Commerce v. Wells Fargo Bank, Nat'l Ass'n*, 811 F.2d 1490, 1495, 1 USPQ2d 1813, 1817 (Fed. Cir. 1987) (finding COMMCASH and COMMUNICASH confusingly similar); *In re Corning Glass Works*, 229 USPQ 65, 66 (TTAB 1985) (finding CONFIRM and CONFIRMCELLS confusingly similar); *In re Pellerin Milnor Corp.*, 221 USPQ 558, 560 (TTAB 1983) (finding MILTRON and MILLTRONICS confusingly similar); TMEP §1207.01(b)(ii)-(iii). Both applicant and registrant use the term "BLENDER" for their highly related goods, and applicant's deletion of the word "BACKYARD" from the mark of registrant does not create a separate and distinguishable commercial impression aside from the mark of registrant. Applicant's mark does not create a distinct commercial impression because it contains the same common wording as the registered mark, and there is no other wording to distinguish it from the registered mark. Accordingly, these two marks create the same overall commercial impression. Additionally, applicant's appeal brief does not contest or argue against the similarity of these marks. On the totality of these arguments, applicant's mark and registrant's mark are confusingly similar for purposes of Section 2(d).

C. Applicant's Goods and Registrant's Goods Are Related, As They Travel in the Same Channels of Trade and Are Sold to the Same Classes of Consumers for a Common Purpose

Applicant seeks to register its mark for use with "Portable electric oral vaporizers that simultaneously vaporize a wax medium and a liquid medium for smoking purposes; Reusable portable electric oral vaporizers that enable users to load multiple types of vaporizing media for smoking purposes" in International Class 034.

The cited registration identifies the following goods, “Chemical flavorings in liquid form used to refill electronic cigarette cartridges” in International Class 030 and “Cigarette tubes; electric cigarettes; electronic cigarette refill cartridges sold empty; electronic cigars; electronic hookahs; hookah parts, namely, tube, charcoal, and hose; hookah tobacco; hookahs; smokeless cigarette vaporizer pipe; smokers' articles, namely, hookah charcoal” in International Class 034.

The goods of the parties need not be identical or even competitive to find a likelihood of confusion. See *On-line Careline Inc. v. Am. Online Inc.*, 229 F.3d 1080, 1086, 56 USPQ2d 1471, 1475 (Fed. Cir. 2000); *Recot, Inc. v. Becton*, 214 F.3d 1322, 1329, 54 USPQ2d 1894, 1898 (Fed. Cir. 2000) (“[E]ven if the goods in question are different from, and thus not related to, one another in kind, the same goods can be related in the mind of the consuming public as to the origin of the goods.”); TMEP §1207.01(a)(i).

The respective goods need only be “related in some manner and/or if the circumstances surrounding their marketing are such that they could give rise to the mistaken belief that [the goods] emanate from the same source.” *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 1369, 101 USPQ2d 1713, 1722 (Fed. Cir. 2012) (quoting *7-Eleven Inc. v. Wechsler*, 83 USPQ2d 1715, 1724 (TTAB 2007)); TMEP §1207.01(a)(i).

Comparing the goods of applicant and the goods of registrant, Applicant’s identification specifies that its goods for smoking purposes. Further, applicant’s goods are used for burning a “liquid medium for smoking purposes,” while registrant’s goods include “chemical flavorings in liquid form used to refill electronic cigarette cartridges.” Thus, registrant’s goods include liquids for smoking, while applicant’s

goods are devices for use in smoking liquids. Thus, these goods are complementary. Further, applicant's goods and registrant's goods are sold to the same class of purchases through the same channels of trade, for the same purposes. Applicant's goods feature oral vaporizers for use in burning wax and liquid mediums for smoking purposes. The evidence of record demonstrates the relatedness of applicant's goods and registrant's goods and includes the following:

- Images captured from applicant's own website demonstrating that its goods are for the purposes of smoking/vaping, or the inhalation of burned substances. (Denial of Request for Reconsideration dated June 13, 2017, hereafter "Recon. Denial," pp. 20-25.)
- The website of SMBVAPE.COM™ which sells starter kits for smokers, which contain liquid for smoking (a good registrant provides) and vaporizers (a good of applicant) under the same mark. (Recon. Denial, p. 117).
- The website of VAPORFI® which sells smoking liquids ("e-liquids") and vaporizers under the same mark. (Recon. Denial, p. 118).
- The website of JR CIGAR™, which discusses the "vaping and e-cigarette revolution," (Office Action, Feb. 24, 2016, pp. 14). This demonstrates the similarity of e- cigarettes (a good of registrant) and "vaping" devices, the good of applicant. The same page demonstrates "Vapes & E-Cigs" goods being sold together by a common retailer. This includes the sales of smoking liquids, like registrant's International Class 030 goods. (Office Action, Feb. 24, 2016, pp. 17).

- The website of SMOKERS OUTLET ONLINE™, which retails electronic cigarettes, modulators, and smoking liquids. (Office Action, Feb. 24, 2016, pp. 37-40).
- The website of VAPES™ which shows that it retails electronic cigarettes (“E-Cigs”) and smoking liquid (“E-Liquid”) under the same mark as it retails oral vaporizers that burn wax and liquid mediums. (Recon. Denial, pp. 9-18).

Further, the trademark examining attorney has attached evidence from the USPTO’s X-Search database consisting of a number of third-party marks registered for use in connection with the same or similar goods as those of both applicant and registrant in this case. This evidence shows that the goods listed therein, namely e-liquid and vaporizers, are of a kind that may emanate from a single source under a single mark. See *In re Aquamar, Inc.*, 115 USPQ2d 1122, 1126 n.5 (TTAB 2015) (citing *In re Mucky Duck Mustard Co.*, 6 USPQ2d 1467, 1470 n.6 (TTAB 1988)); *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783, 1785-86 (TTAB 1993); TMEP §1207.01(d)(iii). The third party registrations include the following:

- U.S. Reg. No. 4795374 contains “electronic cigarettes” as well as “e-vaporizers and smokeless cigarette vaporizer pipes” (Office Action, Feb. 24, 2016, pp. 89).
- U.S. Reg. No. 4898481 contains “combination electronic cigarette refill cartridges sold empty and atomizers, sold as a component of electronic cigarettes, cartridges sold filled with chemical flavorings in liquid form for electronic cigarettes, chemical flavorings in liquid form used to refill electronic cigarette cartridges; electronic cigarettes” as well as “oral vaporizers for smokers” and “oral vaporizers for smoking purposes.” (Office Action, Feb. 24, 2016, pp. 100).

- U.S. Reg. No. 4900761 provides retail store services featuring “electronic cigarettes,” a good of registrant, and “vaporizers,” a good of applicant. (Office Action, Feb. 24, 2016, pp. 97).
- U.S. Reg. No. 4485695 includes “electric cigarettes” and “electric vaporizers.” (Office Action, Feb. 24, 2016, pp. 92).
- U.S. Reg. No. 4795374 includes “electronic cigarettes” and “e-vaporizers.” (Office Action, Feb. 24, 2016, pp. 89).
- U.S. Reg. No. 4754085 includes “electronic cigarette starter kits comprised of smokeless cigarette vaporizer pipes, electronic cigarettes,” and “regulated power vaporizers.” (Final Office Action, Sept. 26, 2016, pp. 30).
- U.S. Reg. No. 4818664 includes “electronic cigarettes” and “electronic smoking vaporizers, namely, electronic cigarettes.” Further, this registration also includes smoking liquid, namely, “tobacco substitutes in liquid solution form other than for medical purposes for electronic cigarettes.” (Final Office Action, Sept. 26, 2016, pp. 32-33).

Applicant argues that the owner of the cited registration only uses its mark on a single good and has constructively abandoned use for the other goods in the registration due to nonuse. (Response to Office Action, Aug. 26, 2016). However, a trademark registration on the Principal Register is prima facie evidence of the validity of the registration and the registrant’s exclusive right to use the mark in commerce in connection with the specified goods. *See* 15 U.S.C. §1057(b); TMEP §1207.01(d)(iv). Thus, evidence and arguments that constitute a collateral attack on a cited registration, such as information or

statements regarding a registrant's nonuse of its mark, are not relevant during ex parte prosecution. See *In re Dixie Rests.*, 105 F.3d 1405, 1408, 41 USPQ2d 1531, 1534-35 (Fed. Cir. 1997); *In re Peebles Inc.*, 23 USPQ2d 1795, 1797 n.5 (TTAB 1992); TMEP §1207.01(d)(iv). Such evidence and arguments may, however, be pertinent to a formal proceeding before the Trademark Trial and Appeal Board to cancel the cited registration.

Additionally, applicant argues that "applicant's goods are quite different than the goods associated with [registrant's mark], are used for different purposes and are purchased by a different class of purchasers." (Request for Reconsideration, Mar. 28, 2017). The fact that the goods of the parties differ is not controlling in determining likelihood of confusion. The issue is not likelihood of confusion between particular goods, but likelihood of confusion as to the source or sponsorship of those goods. *In re Majestic Distilling Co.*, 315 F.3d 1311, 1316, 65 USPQ2d 1201, 1205 (Fed. Cir. 2003); *In re Shell Oil Co.*, 992 F.2d 1204, 1208, 26 USPQ2d 1687, 1689 (Fed. Cir. 1993); TMEP §1207.01. Additionally, applicant has put forth no evidence to support its assertion of the increased sophistication of its users. Its assertion is also contrary to the evidence previously discussing the common purpose and use of applicant's goods and registrant's goods, both of which are used for smoking. Finally, with respect to applicant's and registrant's goods, the question of likelihood of confusion is determined based on the description of the goods stated in the application and registration at issue, not on extrinsic evidence of actual use. See *Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 1323, 110 USPQ2d 1157, 1162 (Fed. Cir. 2014) (quoting *Octocom Sys. Inc. v. Hous. Computers Servs. Inc.*, 918 F.2d 937, 942, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990)). Also, absent restrictions in an application and/or registration, the identified goods are "presumed to travel in the same channels of trade to the same class of purchasers." *In re Viterra Inc.*, 671 F.3d 1358, 1362, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012) (quoting *Hewlett-Packard Co. v. Packard Press, Inc.*, 281 F.3d 1261, 1268, 62 USPQ2d 1001, 1005 (Fed. Cir. 2002)).

Unrestricted and broad identifications are presumed to encompass all goods of the type described. See *In re Jump Designs, LLC*, 80 USPQ2d 1370, 1374 (TTAB 2006) (citing *In re Elbaum*, 211 USPQ 639, 640 (TTAB 1981)); *In re Linkvest S.A.*, 24 USPQ2d 1716, 1716 (TTAB 1992). Thus, because the cited registration does not exclude electric cigarettes or smokeless cigarette vaporizer pipes for use in smoking wax mediums or limit the goods to only liquid smoking mediums, the goods are presumed to include all purposes, including for purposes of smoking wax mediums. Further, applicant's goods specify that they are also for purposes of smoking a liquid medium, so applicant's goods and registrant's goods both serve this express purpose.

Based on the above, applicant's goods and registrant's goods are related for purposes of Section 2(d) analysis.

III. CONCLUSION

Upon consideration of the similarity of applicant's mark to the mark of registrant and the relatedness of applicant's and registrant's respective goods, a likelihood of confusion exists whereby consumers encountering applicant's and registrant's goods are likely to conclude they emanate from a common or related source. Accordingly, the examining attorney properly refused registration of applicant's mark under Section 2(d), and said refusal should be affirmed.

Respectfully submitted,

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