

ESTTA Tracking number: **ESTTA846136**

Filing date: **09/15/2017**

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

Proceeding	86856716
Applicant	Vaporus Holdings Inc.
Applied for Mark	VAPORUS
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Submission	Appeal Brief
Attachments	VAPORUS_86856716_Appeal-Brief.pdf(222707 bytes )
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Date	09/15/2017

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

In re: Vaporus Holdings Inc. : Law Office 101  
: :  
For: VAPORUS : Examining Attorney  
: Katherine Weigle  
Serial No.: 86/856,716 : :  
: :  
Filed: December 22<sup>nd</sup>, 2015 : :

**APPLICANT’S APPEAL BRIEF**

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### Cases

*Giersch v. Scripps Networks, Inc.*, 90 USPQ2d 1020, 1026 (TTAB 2009);

*In re Interstellar Starship Servs. v. Epix, Inc.*, 125 F. Supp. 2d 1269, 1277–78 (D. Or. 2001);

*In re Box Solutions Corp.*, 79 USPQ2d 1953, 1957-58 (TTAB 2006);

*In re Cent. Soya Co.*, 220 USPQ 914, 916 (TTAB 1984);

*In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563, 567 (C.C.P.A. 1973);

*In re N.A.D., Inc.*, 754 F.2d 996, 999-1000, 224 USPQ 969, 971 (Fed. Cir. 1985);

*In re Viterra Inc.*, 671 F.3d 1358, 1362, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012);

*Juice Generation, Inc. v. GS Enters. LLC*, 794 F.3d 1334, 1338-39, 115 USPQ2d 1671, 1674 (Fed. Cir. 2015);

*Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée en 1772*, 396 F.3d 1369, 1373, 73 USPQ2d 1689, 1693 (Fed. Cir. 2005);

*Societe Anonyme, Etc. v. Julius Wile Sons & Co.*, 161 F. Supp. 545, 548 (S.D.N.Y. 1958);

### Statutes & Regulations

Trademark Act Section 2(d), 15 U.S.C. § 1052(d)

TMEP §1207.01(b)(ix)

TMEP §1207.01(b)-(b)(v)

TMEP §1207.01(d)(vii)

## APPLICANT'S APPEAL BRIEF

Applicant, Vaporus Holdings, Inc. (the “**Applicant**”), respectfully submits the subject brief in support of its appeal.

### I. ISSUE

The sole issue in this appeal is whether Applicant’s VAPORUS mark for the services claimed under Application Serial No. 86/856,716 is likely to be confused with VAPOROUS Registration No. 4802100 and VAPOROUS Registration No. 4802101<sup>1</sup>, both for “*Portable electric oral vaporizers for smoking purposes; Parts and accessories for portable electric oral vaporizers for smoking purposes, namely, atomizers and mouthpieces sold as a component of electric oral vaporizers; and travel cases specially adapted for portable electric oral vaporizers.*”, owned by Vaporous Technologies, LLC (the “**Registrant**”) so as to preclude registration of Applicant’s mark under section 2(d) of the Trademark Act.

### II. BACKGROUND

On December 22<sup>nd</sup>, 2015, Applicant filed Application Serial No. 86/856,716 to register VAPORUS on the Principal Register for the following services (as amended): “*Electronic cigarette boxes; Electronic cigarette cases; Electronic cigarette lanyards; Electronic cigarette lighters; Electronic cigarette liquid (e-liquid) comprised of flavorings in liquid form used to refill electronic cigarette cartridges; Electronic cigarette liquid (e-liquid) comprised of propylene glycol; Electronic cigarette liquid (e-liquid) comprised of vegetable glycerin;*

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The logo for VAPOROUS, featuring the word "VAPOROUS" in a bold, black, sans-serif font. The letter "V" is stylized with a diagonal line through it.

*Electronic cigarette refill cartridges sold empty; Electronic cigarettes; Electronic cigarettes for use as an alternative to traditional cigarettes; Boxes for electronic cigarettes and electronic cigarette accessories; Cartomizers, namely, 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; Cartridges sold filled with propylene glycol for electronic cigarettes; Cartridges sold filled with vegetable glycerin for electronic cigarettes; Cases for electronic cigarettes and electronic cigarette accessories; Chemical flavorings in liquid form used to refill electronic cigarette cartridges; Electric cigarettes; Flavorings, other than essential oils, for use in electronic cigarettes; Flavourings, other than essential oils, for use in electronic cigarettes; Liquid nicotine solutions for use in electronic cigarettes; Mechanical electronic cigarettes; Smokers' mouthpieces for use in association with electronic cigarettes”.*

In the first Office Action issued on April 13<sup>th</sup>, 2016, the examining Trademark Attorney initially refused the registration of the subject mark based on likelihood of confusion under Section 2(d) of the Lanham Act, citing VAPOROUS Registration No. 4802100 and VAPOROUS Registration No. 4802101 both for “*Portable electric oral vaporizers for smoking purposes; Parts and accessories for portable electric oral vaporizers for smoking purposes, namely, atomizers and mouthpieces sold as a component of electric oral vaporizers; and travel cases specially adapted for portable electric oral vaporizers.*”, owned by Registrant.

On October 14<sup>th</sup>, 2016, the Applicant filed, along with a Petition to Revive Abandoned Application, a response to the first Office Action, in which Applicant submitted that no likelihood of confusion existed based on the significant distinctions in the overall commercial

impressions of the parties' marks due to dissimilarity between the marks and the relatively weak nature of the term VAPOROUS, being descriptive of the goods and services Registrant offers.

On November 18<sup>th</sup>, 2016, the examining Trademark Attorney issued a Final Office Action maintaining his objections under Section 2(d). The examining Trademark Attorney argued that the VAPORUS is merely a misspelling of the term VAPOROUS. The examining Trademark Attorney noted "*The applicant is correct in its assertion that there are many "vapor" marks on the register for electronic cigarettes and vaporizers*". However, the examining Trademark Attorney further argued that the Applicant and the Registrant have created a different word by adding a suffix to "vapor". Finally, the examining Trademark Attorney argued that electronic cigarettes, electronic cigarette lighters, e-liquid and liquid nicotine, electronic cigarette cartridges sold empty, cartomizers and oral vaporizers, are of a kind that may emanate from a single source under a single mark.

On February 28<sup>th</sup>, 2017, Applicant filed a Request for Reconsideration, submitting that Applicant's and Registrant's consumers are highly sophisticated consumers and evidence in support thereof. Applicant further submitted that the marks and their respective goods and services were sufficiently dissimilar so as to avoid any likelihood confusion. Finally, Applicant submitted evidence to the effect that trade channels for Applicant's and Registrant's goods were highly dissimilar, in part owed to the fact that Registrant operates in the highly regulated industry of medicinal marijuana while the Applicant does not.

### **III. ARGUMENT**

Applicant's VAPORUS mark should be approved for publication because: (1) improperly assessed the Applicant's mark and granted an unduly large scope of protection to otherwise relatively weak trademarks; (2) failed to consider the marks in their entirety and placed undue

weight on the shared feature of the marks despite the numerous dissimilarities and the weak nature of the cited marks; and (3) the examining Trademark Attorney has not afforded sufficient weight to the sophistication of the relevant consuming public and the normal circumstances of purchase of electronic cigarettes and oral vaporizers.

### **1. Scope of Protection**

As argued in the Response to an Office Action of October 14<sup>th</sup>, 2016, Applicant's mark is a distinctive coined word while Registrant's marks are descriptive of the goods and services offered by the Registrant. The scope of protection granted to a trademark shall be proportional to the inherent or acquired distinctiveness of such trademark.

The Court of Appeals for the Federal Circuit and the Trademark Trial and Appeal Board have recognized that merely descriptive and weak designations may be entitled to a narrower scope of protection than an entirely arbitrary or coined word. *See Juice Generation, Inc. v. GS Enters. LLC*, 794 F.3d 1334, 1338-39, 115 USPQ2d 1671, 1674 (Fed. Cir. 2015); *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée en 1772*, 396 F.3d 1369, 1373, 73 USPQ2d 1689, 1693 (Fed. Cir. 2005); *Giersch v. Scripps Networks, Inc.*, 90 USPQ2d 1020, 1026 (TTAB 2009); *In re Box Solutions Corp.*, 79 USPQ2d 1953, 1957-58 (TTAB 2006); *In re Cent. Soya Co.*, 220 USPQ 914, 916 (TTAB 1984).

Herein, the cited marks refer to a common word meaning “consisting or characteristic of vapor” or “producing vapor”. Considering the cited marks are registered in association with “*Portable electric oral vaporizers for smoking purposes*” and parts and accessories thereof, it is therefore apparent that Registrant's marks are descriptive of the goods and services with which they are associated and registered for.



While an *ex parte* proceeding is not the appropriate forum to contest the validity of the cited marks, the Applicant nonetheless raises the invalidity of the cited marks and argues that they shall not, on the basis of their non-distinctiveness, be granted a broad scope of protection. It is respectfully submitted that the examining Trademark Attorney erred by failing to consider the descriptiveness of the cited marks in its analysis. A merely descriptive mark is invalid and *should* be automatically refused registration on the Principal Register under §2(e)(1) of the Trademark Act, 15 U.S.C. §1052(e)(1). *A fortiori*, the same merely descriptive cited marks should not be granted a broad scope of protection. The only protection, if any, the cited marks may claim is from the use of an identical trademark for identical goods.

In the case at hand, and as explained below, the trademarks feature significant differences in sound, connotation and commercial impression which avoid any likelihood of confusion between the Applicant's mark and the cited marks.

## **2. Dissimilarities Between the Marks**

It is trite law that, in comparing trademarks for likelihood of confusion, marks should be compared in their entireties. In the Final Office Action of November 18<sup>th</sup>, 2016, the examining Trademark Attorney stated “*That is, the marks are compared in their entireties for similarities in appearance, sound, connotation, and commercial impression. In re Viterra Inc., 671 F.3d 1358, 1362, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012) (quoting In re E. I. du Pont de Nemours & Co., 476 F.2d 1357, 1361, 177 USPQ 563, 567 (C.C.P.A. 1973)); TMEP §1207.01(b)-(b)(v).*”.

In the instant matter, the examining Trademark Attorney has compared the allegedly conflicting marks by misanalysing the well-established criteria and rather focusing only on the similarity in appearance between Applicant's mark and the cited registrations.

The Applicant respectfully submits that the examining Trademark Attorney erred in its Final Office Action of November 18<sup>th</sup>, 2016 stating “[the Applicant’s mark] *is merely a misspelling of the term VAPOROUS, will be recognized as such and has the same connotation as the registrations*”.

A proper analysis of the respective marks shows that the marks clearly create different and distinct commercial impressions such that confusion in this case is unlikely. Applicant is seeking to register a distinctive coined term while the cited marks are literal, commonly used term. Coined terms inherently have a greater degree of distinctiveness. Confusion is less likely between coined terms and literal terms, as they leave different commercial impressions on even casual customers.

Moreover, the addition of the “O” in “VAPOROUS” creates a distinct sound when pronounced. The examining Trademark Attorney erred by not considering Applicant’s evidence to the effect that the word “VAPOROUS” and the term “VAPORUS” have phonetic differences.

Finally, the examining Trademark Attorney erred by not appropriately weighting the meaning and connotation of the term “VAPOROUS” which sets Applicant’s mark apart from the generic and diluted term VAPOROUS and VAPOR. Indeed, the examining Trademark Attorney should have attributed more weight and importance Applicant’s careful choice of late 2011 to pick a name that sounded good in both French and English, but also complied with the provincial laws that require the business name to be in French. In addition, the meaning behind the creation of the term VAPORUS was a conceptual play on the “communal” aspect of the electronic cigarette industry by juxtaposing the words “VAPOR” and “US”. The electronic cigarette industry is characterized by its well-established community of highly involved consumers and proportionately active businesses. Such community was the object of considerable evidence

submitted by the Applicant in its Request for Reconsideration of February 28<sup>th</sup>, 2017, which was not addressed by the examining Trademark Attorney, in the Reconsideration Letter of March 13<sup>th</sup>, 2017.

### **3. The Relevant Public is Sophisticated**

The examining Trademark Attorney also failed to afford sufficient weight to the factor of purchaser sophistication, including the manner in which Applicant's electronic cigarettes and e-liquids or Registrant's CBD and marijuana oral vaporizers would normally be acquired by the relevant public.

The TMEP §1207.01(d)(vii) provides that, circumstances suggesting care in purchasing may tend to minimize the likelihood of confusion. See, e.g., *In re N.A.D., Inc.*, 754 F.2d 996, 999-1000, 224 USPQ 969, 971 (*Fed. Cir.* 1985).

In this case, confusion between the marks is made further unlikely given that the relevant public in this case is highly sophisticated. On one hand, consumers in the electronic cigarette industry are highly engaged and involve personal preferences for flavours. *In Interstellar Starship Servs. v. Epix, Inc.*, 125 F. Supp. 2d 1269, 1277–78 (D. Or. 2001) at 1278, it was found that hobbyists are grouped into the category of “expert” buyers for sophistication purposes.

*“Dr. Dreizen, [defendant's president] testified that hobbyists also purchase his products, but he was unable to quantify such customers. He conceded that most purchasers of his company's products work for research institutions and large companies. Given the high price of defendant's products and the sophistication of its customers, the court finds that customers of defendant are likely to exercise a high degree of care.”*

In *Societe Anonyme, Etc. v. Julius Wile Sons & Co.*, 161 F. Supp. 545, 548 (S.D.N.Y. 1958), at 547–48, it was found that goods which involve exercise of personal taste imply a greater degree of sophistication.

*“As distinguished from mass produced low priced articles, the selection and purchase of a creme de menthe cordial generally involves an exercise of personal taste and purchasers of such liqueurs are apt to buy with a greater degree of sophistication and care than might be true in their purchase of other merchandise. Such a consideration is always relevant in appraising the likelihood of confusion”*

On the other hand, people who purchases oral vaporizers for their medicinal marijuana needs will seek to obtain the appropriate device, inquire about the products, follow the advices of their health professional and purchase the devices from authorized retailers they have identified. The relevant public of Registrant’s goods and services interact in a highly regulated and sophisticated environment which promotes greater care during the purchase process.

This factor of care and diligence during the purchase was not afforded the weight it deserves by the examining Trademark Attorney; it underscores the absence of any likelihood of confusion between the parties’ different marks.

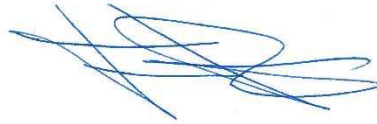
#### **IV. CONCLUSION**

In sum, the examining Trademark Attorney has improperly assessed the Applicant’s mark and the dissimilarity between Applicant’s mark and Registrant’s cited marks. The examining Trademark Attorney granted a broad scope of protection to Registrant’s weak and diluted cited

marks. In addition, the examining Trademark Attorney has not given proper weight to the dissimilarities in trade channels and the sophistication of the relevant consumers. As such, the examining Trademark Attorney's Section 2(d) refusal should be reversed and the application be passed to publication.

September 15th, 2017

Respectfully submitted,



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