

Date: 01-24-2020

Attention:

Lindsey H. Ben

Trademark Examining Attorney

Law Office 108

Phone: (571) 272-4239

Lindsey.Ben@uspto.gov

Dear Examiner Ben,

Please enter to record my response to the examiner's Office Action, dated January 23, 2020, application serial #88361111; VapeRx™, as follows:

SECTION 2(E)(1) REFUSAL – MERELY DESCRIPTIVE

“Registration is refused because the applied-for mark merely describes the intended use of applicant's goods and a feature of those goods, namely, they are for use in oral vaporizers for smokers and contain prescription strength ingredients. Trademark Act Section 2(e)(1), 15 U.S.C. §1052(e)(1); see TMEP §§1209.01(b), 1209.03 et seq.”

Applicants response:

* The applicant disagrees.

* The applicant is the present registered owner of the following Federal Registered “Rx” similar marks:

1> **CBDRx®** / a Service Mark in Class #35.

* Consulting services in the field of bringing together, for the HEALTH benefits of others, a variety of hemp-based goods enabling consumers to view and purchase the goods.

* Registration #: 4670450.

* Registered on the **PRINCIPAL** register.

2> **CBDRx®** / a Trademark in Class #05.

* Dietary and nutritional supplements containing CBD derived from Industrial Hemp.

* Registration #: 5269540.

* Registered on the **PRINCIPAL** register.

3> **HempRx®** / a Trademark in Class #05.

* Dietary and nutritional supplements containing industrial hemp.

* Registration #: 4716423.

* Registered on the **PRINCIPAL** register.

4> **MMJRx®** / a Service Mark in Class #35.

* Business consulting services in the field of Medical Marijuana and industrial hemp-based products; bringing together, for the health benefits of others, industrial hemp-based products thereby enabling consumers to be aware, view and purchase the goods.

* Registration #: 4721868.

* Registered on the **SUPPLEMENTAL** register.

* In addition, the applicant has several other “Rx” related brand names that were registered. He has sold them in recent years.

At this time, the applicant is not going to present a “MERELY DESCRIPTIVE” rebuttal for this application.

He wishes to simply amend this present application so as to seek registration on the Supplemental Register.

NOTE

*** If the applicant was to present a rebuttal to “MERELY DESCRIPTIVE” it would be as follows:**

The examiner asserts that applicant's mark "VAPERx" is merely descriptive as to the applied-for goods. Applicant respectfully traverses this contention and submits that applicant's mark is at most suggestive.

- Applicant's mark, used in the applied-for goods, is at most suggestive.

A suggestive mark is one for which “a consumer must use imagination or any type of multistage reasoning to understand the mark’s significance, ... the mark does not describe the product’s features, but suggests them.” *Entrepreneur Media, Inc. v. Smith*, 279 F. 3d 1135, 1142 (2002).

A descriptive term is one that names a characteristic of a particular product or service, where the use of imagination is not needed to come to the conclusion as to the nature of the goods. *H-D Michigan, Inc. v. Top Quality Service, Inc.*, 496 F.3d 755, 759 (2007); *Xtreme Lashes, LLC v. Xtended Beauty, Inc.*, 576 F.3d 221, 232 (2009).

A consumer must employ thought, imagination, and deduction to arrive at the exact nature of applicant's services. Applicant's mark is therefore at most suggestive as to applicant's offered goods.

Any doubt in the distinction between descriptiveness and suggestiveness must resolve in applicant's favor.

To the extent the examining attorney finds applicant's mark to fall within the "gray area" between obviously descriptive marks, on the one hand, and suggestive marks on the other, all doubts must be resolved in Applicant's favor. *In re Conductive Systems, Inc.*, 220 U.S.P.Q. 84, 86 (TTAB 1983) (where a single descriptive term creates a mark that might be either descriptive or suggestive, doubts are to be resolved in favor of applicants; refusal reversed); *In re Pennwalt Corp.*, 173 U.S.P.Q. 317, 319 (TTAB 1972) (DRI-FOOT not merely descriptive for antiperspirant foot deodorant; doubts to be resolved in favor of publication; refusal reversed). Accordingly, the examining attorney should withdraw the refusal under Section 2(e) (1).

Here, applicant has raised enough doubt as to the descriptiveness of applicant's mark as applied to applicant's offered goods. Any doubt as to the descriptiveness of applicant's mark should be resolved in applicant's favor.

The applicant wishes to simply amend his present application to seek registration on the **Supplemental** Register.

SUPPLEMENTAL REGISTER:

“The applied-for mark has been refused registration on the Principal Register. Applicant may respond to the refusal by submitting evidence and arguments in support of registration and/or by amending the application to seek registration on the Supplemental Register. See 15 U.S.C. §1091; 37 C.F.R. §§2.47, 2.75(a); TMEP §§801.02(b), 816. Amending to the Supplemental Register does not preclude applicant from submitting evidence and arguments against the refusal(s). TMEP §816.04.””

* Applicants response:

The applicant herein accepts the examiners suggestion and wishes to amend his present application to seek registration on the **Supplemental** Register.

IDENTIFICATION OF GOODS:

“The identification of goods is indefinite and must be clarified to specify that the “CBD industrial hemp oil” is to be used as electronic cigarette liquid in order to clearly be in Class 34. See 37 C.F.R. §2.32(a)(6); TMEP §1402.01.

*Applicant may adopt the following identification, if accurate. The wording that appears in **bold** and/or italics below represents the suggested changes. Any wording that is crossed out represents matter that must be deleted from the identification.”*

International Class 34: CBD industrial hemp oil for **use as** electronic cigarette liquid **also** containing a mixture of propylene glycol, vegetable glycerin, flavorings and terpenes used all, or in part, to refill electronic cigarette cartridges

Applicants response:

* **The applicant agrees with the examiner and herein adopts the suggested description.**

The applicant believes he has responded to all of the examiner’s points. Therefore, his present application should be AMENDED to seek registration on the **SUPPLEMENTAL** Register.

Thanks for your help with my application(s).
Kindest regards,
John D. Blue / applicant-owner

* * * * *