IN THE
UNITED STATES PATENT AND TRADEMARK OFFICE

In Re Appl. of	**:**	Iconic Ventures, Inc.	**Examiner**	**:**	Rachael Dickson
Filed	**:**	July 27, 2018	**Law Office**	**:**	125
Serial No.	**:**	88/056,391			
Mark	**:**	ILO	**Attorney Docket**	**:**	100-4001US

Commissioner for Trademarks
P.O. Box 1451
Alexandria, VA 22313-1451

RESPONSE TO OFFICE ACTION AND REQUEST FOR RECONSIDERATION

Applicant hereby responds to the Office Action dated July 25, 2019 (the "Action") and respectfully contends that the application is in condition for publication. Reconsideration and withdrawal of the Office's refusal are respectfully requested, as is a timely Notice of Publication.

I. The Office's Initial Refusal Under the CSA Should Be Withdrawn

The Examining Attorney has searched the Office records and has found no conflicting marks that would bar registration under the Trademark Act § 2(d), 15 U.S.C. § 1052(d). However, registration has been initially refused based on a mistaken perception that the items or activities to which the proposed mark will be applied are unlawful under the federal Controlled Substances Act (CSA), 21 U.S.C. §§ 801-971. Applicant respectfully traverses the refusal. Applicant's goods do not violate – or even fairly implicate – the CSA.

As discussed in more detail in the following section of this Response pertaining to the present amendment of the identification of goods, Applicant's goods listing reads "[v]aporizable substance storage devices sold empty, namely, porous bodies made of ceramic, sintered metal or other material for storing vaporizable substances and being heated in oral vaporizers . . . ." In other words, Applicant's goods are empty porous containers. The sale or offer for sale of empty ceramic

or metal containers is not, and has never been, unlawful under the CSA (or otherwise) and there is zero evidence of record to the contrary.

To be sure, the Office's proposition that the cited website excerpt somehow taints Applicant's goods as "drug paraphernalia" is nonsensical on its face and would not even be fathomable absent one's knowledge of the ongoing saga of federal trademark registrations versus the budding legal cannabis industry. But the cloud that hovers over certain cannabis mark applications is irrelevant here. Empty ceramic (or metal, etc.) storage devices with numerous different uses simply are not against the law.

Indeed, the Supreme Court of the United States has made clear that an item does not constitute "drug paraphernalia" under the CSA merely because it is physically capable of containing a controlled substance. *Mellouli v. Lynch*, 135 S. Ct. 1980, 1985 (2015) (Interpreting the CSA and holding "Nor does federal law define drug paraphernalia to include common household or ready-to-wear items like socks"). For present purposes, Applicant's goods are no different than the Adderall-containing sock at issue in *Mellouli* because, like a sock, Applicant's goods are capable of containing all sorts of perfectly legal substances including, but not limited to, vaporizable medications (e.g., for asthma treatments), liquid nicotine solutions (aka "e-juice") and, as another example, federally legal CBD oil.

Said another way, the Office's present CSA rejection is mistakenly premised on an erroneously overbroad interpretation of both the CSA and the website evidence cited by the Office. The Office's reliance on the website excerpt is respectfully misplaced because *Applicant's* goods do not include anything that violates the CSA; in other words, the website excerpt is not sufficient to support the Office's position because the excerpt pertains to a third party's implementation of Applicant's goods and the Office's reasoning fails to take into consideration both what *Applicant's* goods actually are (i.e., per the goods description) and the myriad of other implementations of those goods that fully comply with federal law. At most, the evidence cited by the Office suggests that Applicant markets its products to customers and potential customers in the cannabis industry. But the Office has not pointed to a single case or other authority suggesting that the mere advertising or sale of a perfectly legal ceramic storage device to someone in the cannabis industry is in any way unlawful under the CSA.

In other words, the Office's position boils down to the proposition that a container physically capable of holding a controlled substance – as well as a virtually limitless number of items that are not controlled substances – somehow becomes a *per se* violation of the CSA upon being advertised to or used by someone that might put marijuana in it. Such a position is not supported by any precedent of record. As demonstrated by the *Mellouli* decision, "capable of use in . . ." does not equate to "primarily intended or designed for use in . . . ."

Just like the Supreme Court in *Mellouli*, the TTAB has consistently rejected such a broad interpretation of the CSA. "[W]e will not sustain a claim of unlawful use unless either (1) a violation of federal law is indicated in the application record or other evidence, such as when a court or federal agency responsible for overseeing activity in which the applicant is involved . . . has issued a finding of noncompliance under the relevant statute or regulation or (2) when the applicant's application-related activities involve a *per se* violation of a federal law." *Shirley Plantation, LLC, et al. v. Stillhouse Vineyards, LLC*, Opposition Nos. 91215114, 91216395 & 91218094 (consolidated), 2018 TTAB LEXIS 483, at *97-98 (TTAB Nov. 7, 2018) (quoting and citing *In re Brown*, 119 USPQ2d 1350, 1351 (TTAB 2016)). Neither of those prerequisites exists here and, moreover, the present circumstances are readily distinguishable from those in cases like *In re Brown* because, unlike the applicant in *In re Brown*, the present Applicant is not engaged in the provision of marijuana.

For at least these reasons, the Office's CSA refusal is improper. Reconsideration and withdrawal of the CSA refusal are respectfully requested.

II. Identification of Goods

Although the Office has not required an amendment to Applicant's goods description or specifically requested additional information regarding Applicant's goods, Applicant has included certain information below should it be helpful to Examining Attorney and has amended its goods description herein in an earnest effort to further highlight the differences between Applicant's goods and anything that plausibly could be alleged to violate the CSA.

Applicant's goods comprise relatively small, rigid, porous bodies for receiving a substance in liquid form via tiny openings on the exterior surface of the body and storing the substance within internal pores until the substance is subsequently removed for use. The stored substance can, but need

not, remain in liquid form during storage and is typically removed from the goods by heating the goods (and substance) until the stored substance exits the device in the form of liquid or vapor. The goods are typically made from a proprietary ceramic material, but other materials are possible. Although the goods are chemically inert and pose little or no risk of harm if consumed, the goods are not intended for consumption. A scale photograph of an exemplary embodiment of the goods resting on a person's fingertip is set forth below:

Applicant's goods identified in the application comply with the Controlled Substances Act (CSA), 21 U.S.C. §§ 801-971. Applicant's goods are sold empty and do not include any oils, extracts, ingredients or derivatives from the plant Cannabis sativa L. Applicant is a registered establishment with the FDA and has been approved as a Small Business under the Medical Device User Fee Amendments (MDUFA) by the Center for Devices and Radiological Health (CDRH) for fiscal year 2020.

Please amend the identification of goods in the application to read as follows in its entirety:

> Smokers' oral vaporizer refill cartridges sold empty; smokers' oral vaporizer oil storage devices sold empty, namely, porous bodies made of ceramic, sintered metal or other material for storing vaporizable substances and being heated in oral vaporizers; smokers' articles, namely, vaporizable substance storage devices sold empty; smokers' articles, namely, porous devices sold empty for storing vaporizable substances and being heated

in oral vaporizers; smokers' articles, namely, absorbent pellets comprised of porous material sold empty for being heated in oral vaporizers.

III. Conclusion

In light of the above, Applicant respectfully requests that the refusal of registration be reconsidered and that the subject application be approved for publication. Applicant thanks the Examining Attorney for the time and effort on this file. If there are any questions or if any additional information is needed, Examining Attorney is invited to contact the undersigned attorney for Applicant at any time.

Respectfully submitted,

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