

Request for Reconsideration of Final Refusal to Register the mark MAXIM

In the Final Office Action mailed July 16, 2018, the Examining Attorney has finally refused registration of Applicant's mark MAXIM based on an alleged likelihood of confusion with a prior registered mark. Additionally, the Examining Attorney has maintained and made final the requirement to amend the description of goods.

Below, Applicant has amended the description of goods as required by the Examining Attorney, or as allowed according to the Trademark Manual of Identification of Goods and Services, and requests that the Examining Attorney accept the amendments and withdraw this requirement.

With respect to the likelihood of confusion refusal, Applicant respectfully disagrees that consumers are likely to be confused as to the source of the goods for the reasons discussed below and requests that the Examining Attorney reconsider and withdraw the refusal. Applicant additionally preserves its right to appeal.

I. Amendment to Identification of Goods

Applicant requests that the identification of goods be amended as shown below in **bold and underline**:

Cookware, namely, broilers and roasters; non-electric cookware namely, steamers, roasting pans, pots and pans, waffle irons; cooking pots, pans and dishes; cooking pot sets; non-electric cooking utensils, **namely, grills, grill covers, griddles, basting spoons, wire baskets**; Dutch ovens; non-electric autoclaves for cooking, non-electric pressure cookers; non-electric slow cookers; non-electric stockpots; non-electric deep fryers; non-electric woks; frying pans; griddles, non-electric cooking utensils; grills, cooking utensils; thermally insulated containers for food; bakeware; baked good tins sold empty for domestic use, dishes, trays and containers; baking utensils, namely, baking dishes, baking mats, silicone cupcake and muffin baking liners, hand-operated flour sifters for household use, **cooking** strainers, spatulas for kitchen use, whisks, cupcake molds; drinking glasses; glass tumblers; glass mugs; glass cups; glass tea cups and saucers; glass tea sets; glass bowls; glass plates; glass dishes; glass jars for household use; glass jugs; glass flasks; glass decanters; glass stemware; wine glasses; glass containers for household use; glass pots; tempered glass, not for building in International Class 21.

II. There is **no** likelihood of confusion with the registered mark.

The Examining Attorney has finally refused registration of Applicant's mark MAXIM under Section 2(d), 15 U.S.C. § 1052(d), based upon an alleged likelihood of confusion with the following prior registered mark:

Registration No. 0885723

Mark: **MAXAM**

Owner: B. & F. SYSTEM, INC.

Goods: Steel cookware-namely, pots, pans, and other household cooking utensils in Class 21.

As the Examining Attorney knows, a likelihood of confusion determination under Section 2(d) is based on an analysis of all the probative facts in evidence that are relevant to the thirteen factors set forth in *In re E.I. Du Pont DeNemours & Co.*, 177 U.S.P.Q. 563, 567 (CCPA 1973). In this case, the most relevant *Du Pont* factors are (1) the differences in the connotation and overall commercial impression of the marks and (2) the number and nature of similar marks in use for similar goods. When the relevant *Du Pont* factors are considered in relation to Applicant's MAXIM mark, each weighs in favor of registration, particularly the number of similar third party MAX-formative and MAX-composite marks. When considered cumulatively, the factors tip heavily towards allowing Applicant's distinguishable mark to register.

A. Applicant's MAXIM mark differs sufficiently in overall meaning and commercial impression from the registered mark as to avoid a likelihood of confusion.

Applicant's MAXIM mark differs significantly from the cited mark MAXAM in overall meaning and commercial impression. As evidenced in Applicant's Response to the First Office Action, Applicant's mark MAXIM means a principle or a rule of conduct. When encountering this mark in connection with Applicant's goods, consumers will infer the mark refers to how one operates or conducts oneself in their home, i.e., cooks, bakes, serves foods, sets tables, etc.

In stark contrast, the registered mark has no known meaning or significance other than as a surname (according to the 2010 U.S. Census database, there are approximately 32562 people in the U.S. with the last name of MAXAM, see: https://www.census.gov/topics/population/genealogy/data/2010_surnames.html).

Even consumers who encounter the MAXAM mark on the goods and are unfamiliar with its surname significance, are likely to pronounce this non-word as MAX-AM or "MAX A.M." and speculate that the mark is suggestive as to how a consumer of these goods will maximize or make the most of their mornings or "A.M." by utilizing these goods.

Applicant submits that the different connotations and commercial impressions of the marks and the public's heightened ability to discern between MAX-formative or MAX-composite marks based upon even subtle differences should be sufficient as to render confusion unlikely. The marks are no more similar in appearance or sound than "bit" and "bat" or "rig" and "rag" or "letter" and "litter" – terms whose meaning and commercial impression differ significantly despite the differences in one vowel in the terms. It is well settled that if marks imparts a different commercial impression, then there is no marketplace confusion. TMEP § 1207.01(b)(ii).

When considering the similarity of the marks, "[a]ll relevant facts pertaining to the appearance and connotation must be considered." *Recot, Inc. v. M.C. Becton*, 214 F.3d 1322, 1329, 54 USPQ2d 1894, 1897 (Fed. Cir. 2000). These relevant factors include the number and nature of similar marks in use on similar goods and services. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (C.C.P.A. 1973)(Court of Customs and Patent Appeals). Applicant respectfully disagrees with the Examining Attorney's conclusion that the marks have similar meanings and/or commercial impressions simply because there is a remote chance they might be pronounced similarly. In determining a likelihood of confusion, the Examining Attorney must consider *all* the relevant factors, including the similarities in meaning and commercial impressions of the marks when considered in their entirety.

Applicant submits that the different connotations and commercial impressions of the marks and the public's heightened ability to discern between MAX marks, i.e., MAX-formative or MAX-

composite, marks based upon even subtle differences should be sufficient as to render confusion unlikely.

B. The PTO's treatment of MAX-composite and MAX-formative marks indicates that the cited mark should be entitled to a relatively narrow scope of protection.

Applicant respectfully submits, as discussed in Applicant's Response filed June 21, 2018, that the co-existence of a number of published and/or registered MAX-formative and MAX-composite marks, owned by various third parties, covering goods/services that are identical or closely related to those covered by the cited registration, indicates that the PTO's practice is and has been to allow MAX-formative and MAX-composite marks covering identical/similar goods to co-exist on the Register, and presumably in the marketplace, without any actual confusion as to the source of the goods.

The coexistence of MAX- formative and MAX-composite marks for similar and related goods and, means that consumers will distinguish other marks from Applicant's mark and/or the cited mark based upon even subtle differences between the marks and goods. Thus, the consuming public has a heightened capacity to discern between marks containing or comprised of the term MAX-, and/or those meant to be an abbreviation or coined term mean to suggest MAXIMUM, including for housewares, since they are frequently exposed to, and the Federal Register contains, an number of marks comprised in part or whole of the term MAX or MAXIMUM that are owned by different parties.

In Applicant's June 21, 2018 Response, Applicant submitted copies of Trademark Status and Document Retrieval system (TSDR) information regarding the following published or registered MAX- composite and MAX-formative marks. These represent only a sample of the numerous coexisting MAX- composite or MAX-formative marks that have been examined and were registered or published, despite the similar goods. In response to the Examining Attorney's argument that third party registrations are entitled to little weight because the registrations are "not evidence that the registered marks are actually in use," Applicant submits evidence that the registered marks are actually in use as indicated by the snapshots of webpages from the specified websites or, for those marks registered within the last year, from the PTO's TSDR records for the respective registration.

- **MAXROCK and Design**, Registration No. 5555071, (listed in Response as Application No. 87/775659, published June 19, 2018), for "Baking mats; Barware, namely, seltzer bottles; Containers for household use; Cooking spoons; Dinnerware; Drinking vessels; Egg cups; Grills in the nature of cooking utensils; Household utensils, namely, pot and pan scrapers, rolling pins, spatulas, turners, whisks, sieves, strainers; Kitchen urns; Kitchen utensil, namely, non-metal flexible lid designed for draining or pressing liquids from a food can; Kitchen utensils, namely, pouring and straining spouts; Kitchen utensils, namely, splatter screens; Non-electric griddles; Pie servers; Pie pans; Stew-pans; Woks; Cookery molds; Cookie molds; Dishers; Pancake molds; Pastry molds" in Class 21, owned by Maxrock Technology LLC, **registered September 4, 2018**;

See attached evidence specimen filed January 30, 2018 and accepted by PTO showing use of MAXROCK and Design mark in connection with goods.

- **MAXCOOK**, Registration No. 5099730, for “Cooking forks; Cooking funnels; Cooking graters; Cooking pans; Cooking pot sets; Cooking pots; Cooking pots and pans; Cooking skewers; Cooking spoons; Cooking strainers; Cooking utensils, namely, wire baskets; Food steamers, non-electric; Metal cooking pans; Portable cooking kits for outdoor use; Rice cooking pots; Tea pots made of precious metals; Tea pots not of precious metal” in Class 21, owned by Maxway Imports Inc., registered December 13, 2016;

See attached evidence showing the mark **MAXCOOK** in use with the goods from the owner’s website at: <http://www.maxwaycookware.com/pot--pan.html>

- **MAXHOLD**, Registration No. 5463068, for “Baskets for household purposes; Battery-powered applicators for applying cosmetics to eyelashes; Bottles, sold empty; Bowls; Boxes for dispensing paper towels for household use; Brooms; Buckets; Buckets made of woven fabrics; Chopsticks; Containers for household or kitchen use; Containers for household use; **Crockery, namely, pots, dishes, drinking cups and saucers, bowls, serving bowls and trays; Cups; Decorative crystal prisms; Dish stands; Dishes; Drinking vessels;** Drying racks for laundry; Dustbins; Empty water bottles for bicycles; Flower pots; Garbage cans; Glass dishes; Gloves for household purposes; Heat-insulated containers for household use; Jugs; Kitchen containers; Kitchen utensils, namely, pouring and straining spouts; Microdermabrasion sponges for cosmetic use; Napkin holders; Pails; Pitchers; Plates; Pots; Serving trays; Soap containers; Soap dispensers; Soap holders; Soap dishes; Table plates; Tea services in the nature of tableware; Tea sets; Toilet brush holders; Toilet paper dispensers; Toilet paper holders; Toothbrush cases; Towel rails and rings; Vases; Washtubs; Waste paper baskets; Wine glasses; Wine jugs; Wine pourers; All purpose portable household containers; Bath brushes; Butter crocks; Cosmetic brushes; Dishes; Kitchen utensil crocks; Lockable non-metal household containers for food; Pet brushes; Toilet brushes; Washing brushes; Water bottles sold empty” in Class 21, owned by Xiamen Maxhold Ecommerce Co., registered May 8, 2018;

See attached evidence showing use of the mark **MAXHOLD** in connection with the goods as found on Amazon.com at https://www.amazon.com/MaxHold-No-Drilling-Suction-Soap-Basket/dp/B011KFIKJG?keywords=maxhold&qid=1547655180&rnid=1063498&s=Home+%26+Kitchen&sr=1-2&ref=sr_1_2.

- **MAXWARE and Design**, Registration No. 4835697, for goods in Classes 11 and 21, including “Cooking pots and pans; Cooking utensils, namely, wire baskets; Cookware, namely, pots and pans; Dish drying racks; Drain stoppers for sinks and drains; Frying pans; Household utensils, namely, kitchen tongs; Household utensils, namely, strainers; Household utensils, namely, sauce pot; Metal cooking pans; Metal pans; Non-electric griddles; Non-electric pressure cookers; Pans; Saucepans; Serving tongs; Strainers for household purposes; Tea kettles; Tea strainers; Whisks; Woks” in Class 21, owned by Maxware Trading Inc., registered October 20, 2015;

See attached evidence showing current use of the mark **MAXWARE and Design** in connection with tea strainers from: <https://www.amazon.com/Maxware-Stainless->

[Teaball-Strainer-Seasoning/dp/B00QVV9GAM](https://docplayer.net/63128254-Maxware-trading-inc-professional-quality-kitchenware-and-houseware-professional-quality-kitchenware-and-houseware.html) and downloadable catalog found at: <https://docplayer.net/63128254-Maxware-trading-inc-professional-quality-kitchenware-and-houseware-professional-quality-kitchenware-and-houseware.html>.

- **MAXIMO**, Registration No. 5161207, for goods “plastic containers for commercial use, namely, for storing and dispensing sauces; racks and stands to hold and elevate sauce dispensing containers” in Class 20 and “Manually actuated pump dispensers for attachment to containers for use in dispensing sauces” in Class 21, owned by Chocoladefabriken Lindt & Sprüngli AG, registered March 14, 2017;

See attached evidence showing use of the mark MAXIMO in connection with manually actuated pump dispensers from:

<http://kpcweb01.knepperpress.com/v5fmsnet/OECart/OeFrame.asp?PmSess1=36327&SXREF=1&CurPg=1&Action=OFFDET&OFFSEQ=17>. Applicant notes that this use is consistent with the specimens filed with and accepted by the PTO.

- **MAXI-COCINA**, Application No. 87/639751, published March 20, 2018, for “Pans; Frying pans(Based on Intent to Use) Non-electric pressure cookers” in Class 21, owned by an individual named Natividad R. Elias;

See attached evidence from: <http://www.publix.com/pd/maxi-cocina-sautee-pan-non-stick-8-inch/RIO-PCI-199666> showing use of mark MAXI-COCINA as used on pans.

Applicant submits the following **additional** registered or allowed MAX –formative and MAX-composite marks have also been allowed or registered by the PTO despite the similarity/identity of the goods. Applicant has included evidence that the registered marks are in use as noted.

- **MAXIM GLASSWARE FULLY TEMPERED EXTRA DURABLE and Design**, disclaiming “GLASSWARE FULLY TEMPERED EXTRA DURABLE”, Application No. 87/348325, for “drinking glasses; drinking glasses, namely, glass tumblers; glass mugs; glass cups; glass tea cups and saucers; glass tea sets; glass bowls; glass plates; glass dishes; glass jars for household use; glass jugs; glass flasks; containers for household use; glass decanters; glass stemware; wine glasses; glass containers for household use; glass pots; all of the forgoing featuring tempered glass; tempered glass, not for building” in Class 21, owned by Applicant of the subject application, PT Maspion, allowed January 9, 2018;
- **MAXISCRUB**, Registration No. 3380442, for “brooms; buckets; cleaning pads; dust pans; dusting or cleaning cloths; mops; non-electric carpet sweepers; scouring sponges; sponges for household purposes; squeegees; washing brushes; washing cloths” in Class 21, owned by Nexstep Commercial Products, LLC, registered February 12, 2008; **See attached evidence of current use of MAXISCRUB mark from:** <https://ocedarcommercial.com/products/mops-with-handles/maxiscrub-sponge-mop/>. Applicant also attaches excerpted evidence from TESS showing 1878 records for active marks with a 1A basis, covering Class 21 goods covered by this registration and the cited registration, indicating that the goods are in the same channels of trade.

- **MAXIMUM**, Registration No. 2147571, for “portable beverage dispensers, drinking vessels and thermal insulated fanny pack, waist pack and backpack style containers for drinking vessels and beverage dispensers” in Class 21, owned by CamelBak Products, LLC, registered March 31, 1998 and renewed as of March 16, 2018, showing mark is considered to be in use by PTO. As evidence that the cited goods are related to the goods covered by this registration, Applicant attaches excerpted evidence from TESS showing 185 records for active marks with a 1A basis, covering goods covered by both registrations:
- **MAXI NATURE KITCHENWARE and Design**, Registration No. 5483524, for “cake molds; cookery molds; pots; trivets; kitchen utensils, namely, cooking spoons, batter dispensers, rolling pins, turners, whisks, skimmers, graters, tongs, basting spoons, sieves, strainers, spatulas, and tart scoops” in Class 21, owned by Nuno Alexandre Da Silva Lopes Vieira (Individual), registered June 5, 2018. See attached evidence that mark is in use in connection with goods and goods are available for purchase on Amazon (evidence from):
https://www.amazon.com/stores/node/16000737011?_encoding=UTF8&field-lbr_brands_browse-bin=Maxi%20Nature%20Kitchenware&ref_=bl_dp_s_web_16000737011

Copies of information regarding the aforementioned registered marks downloaded from the PTO’s Trademark Electronic Search System (TESS) database are attached.

The PTO has evidently taken the position that MAX-formative and MAX-composite marks could and can coexist for identical/similar goods without marketplace confusion.

The term MAXAM is entitled to a narrow scope of protection based upon the significant number of MAX-formative and MAX-composite marks that coexist on the Federal Register for related goods/services.

In view of the foregoing, and given that Applicant has amended the identification of goods as required or acceptable in accordance with the Trademark Manual of Identification of Goods and Services, Applicant respectfully requests reconsideration, that the final refusal based on a likelihood of confusion be withdrawn, and that the application be approved for publication.