

U.S. Trademark Application No. 87/605,407
Mark: **MAXIM**
Our Ref. No.: 3910.0030000

In an Office Action issued December 21, 2017, the Examining Attorney raised the following three issues that must be addressed before this application can be approved for publication: (1) a potential likelihood of confusion with (Applicant's) prior-filed application; (2) a likelihood of confusion with a prior registration; and (3) a requirement to amend the identification of goods. Applicant addresses these issues, in turn, below.

I. Applicant Claims Ownership of Application No. 87/348325

As a preliminary matter, Applicant notes that the Examining Attorney has cited Applicant's own mark **MAXIM GLASSWARE FULLY TEMPERED EXTRA DURABLE and Design**, Application No. 87/348,325, as a potential bar to registration of Applicant's mark MAXIM. Applicant notes that it is the owner of this prior filed application. Accordingly, Applicant respectfully requests that 1) the ownership be made of record as necessary and 2) the Examining Attorney withdraw the refusal.

II. There is no likelihood of confusion with the cited registration.

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

Mark: MAXAM
Registration No. 0885723
Registered: February 10, 1970
Owner: B. & F. System, Inc.
Goods: Steel cookware- namely, pots, pans, and other household cooking utensils in Class 21.

Applicant submits that there is no likelihood of confusion with the cited registration for the reasons detailed below. In sum, consumers will readily recognize the differences between Applicant's mark MAXIM and the cited mark MAXAM because (A) the marks are distinguishable based on their distinct meanings and commercial impressions; (B) due to a plethora of MAX-formative and composite marks on the Federal Register, and presumably in the marketplace, for goods/services that are identical or closely related to the registrant's, consumers have a heightened ability to distinguish between the marks based upon even subtle differences; and (C) the PTO previously allowed Applicant's prior-filed application for the mark MAXIM FULLY TEMPERED EXTRA DURABLE and Design, Application No. 87/348,325, (allowed January 9, 2018), indicating that the PTO has taken the position that MAX-formative and composite marks could and can coexist without marketplace confusion.

A. Applicant's mark differs sufficiently in overall meaning and connotation from the cited mark as to avoid a likelihood of confusion.

Concluding the marks are likely to be confused, the Examining Attorney has overlooked the strong distinct meanings and commercial impressions of each of the marks. In determining a likelihood of confusion, the Examining Attorney must consider all the relevant factors, including the dissimilarities of the meanings and commercial impressions of the marks.

It is well settled that if marks imparts a different commercial impression, then there is no marketplace confusion. TMEP § 1207.01(b)(ii). Consumers will readily apply a different commercial meaning to Applicant's mark MAXIM and the cited registration. Applicant's mark creates a distinct commercial impression when applied to the specific goods such that consumers will not confuse it with the cited mark or believe they emanate from the same source. In determining likelihood of confusion, the Office must evaluate the marks in relation to the goods and/or services. 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 they might (incorrectly) 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 entireties.

As indicated by the attached online dictionary evidence from <http://www.dictionary.com/browse/maxim?s=t>, Applicant's mark is defined as "an expression of a general truth or principle, especially an aphoristic or sententious one" or as "a principle or rule of conduct." When heard or seen in connection with Applicant's houseware goods, including cookware, tabletop dishes, and serving utensils, Applicant's mark MAXIM connotes that Applicant's goods are fundamental to how one conducts oneself in a home, i.e., cooks, sets tables, hosts dinners, etc.

In stark contrast, the registered mark has no significance other than as a surname. See attached evidence from <https://www.myheritage.com/research?formId=master&formMode=1&action=query&exactSearch=1&useTranslation=0&qname=Name+In.maxam+fnmo.1+Inmo.3&rlmode=1> and indicating and <https://www.houseofnames.com/maxam-family-crest>.

Applicant submits that the different connotations and commercial impressions of the marks and the public's heightened ability to discern between MAX-formative/composite marks based upon even subtle differences should be sufficient as to render confusion unlikely.

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

In determining whether there is a likelihood of confusion, the PTO must consider the strength of the cited marks; strength of the cited marks dictates the scope of protection. As detailed below,

the PTO has registered or approved numerous marks containing the term or prefix MAX, including for housewares. The coexistence of MAX- formative marks for similar and related goods/services, means that consumers will distinguish other marks from Applicant's mark and/or the cited marks based upon even subtle differences between the marks, goods or services. See *Washington Nat'l Ins. Co. v. Blue Cross and Blue Shield United of Wisconsin*, 14 U.S.P.Q.2d 1307, 1311 (N.D. Ill. 1990) ("The fact that ADVANTAGE is used so extensively by other companies to identify their products is reflective of the mark's weakness."); *Ashe v. Pepsico, Inc.*, 205 U.S.P.Q. 451, 456 (S.D.N.Y. 1979) ("The frequent usage of [ADVANTAGE] to identify different products and services is a good indication that the mark is a weak one."), as explained in *Baf Industries v. Pro-Specialties, Inc.*, 206 U.S.P.Q. 166 (T.T.A.B. 1980)). 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, numerous marks comprised in part or whole of the term MAX or MAXIMUM that are owned by different parties.

Applicant notes the following published or registered MAX -composite marks as a representative sample of the numerous coexisting MAX-composite marks that have been examined and were registered or published, despite the similar goods/services:

- **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;
- **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;
- **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;

- **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;
- **MAXROCK and Design**, 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;
- **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;

Copies of information regarding the aforementioned registered and published marks downloaded from the PTO’s Trademark Status and Document Retrieval system (TSDR) database are attached.

The PTO has evidently taken the position that these MAX-composite marks could and can coexist without marketplace confusion.

III. Identification of Goods

The Examining Attorney has required that the description of goods be amended to specify the nature of the goods. Applicant requests that the description of goods be amended as indicated below in **bold**:

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; 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; **baking baked goods** tins, dishes, trays and containers; baking utensils, **namely, baking dishes, baking mats, silicone cupcake and muffin baking liners, hand-**

operated flour sifters for household use, strainers, spatulas, 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 Class 21.

In view of the foregoing, and pursuant to the amendment to the identification of goods as requested above and as also submitted in the TEAS form electronically, Applicant respectfully requests that the refusal based on a likelihood of confusion be withdrawn, and that the application be approved for publication.