

Applicant hereby responds to the Office Action issued on March 22, 2019. The only issue raised is a perceived likelihood of confusion with the mark MAX GREEN (stylized) depicted below (the “Cited Mark”).



The refusal is based on the inclusion of the term “max” in both marks, while discounting the other text and design features of the Cited Mark. Applicant respectfully submits that focusing solely on “max” to the exclusion of everything else is inappropriate in this case and that the marks are not likely to cause confusion. The term “max” is dilute in the timer field and only warrants narrow protection. Accordingly, differences between the marks are sufficient to avoid confusion. For this reason, the refusal should be withdrawn.

First, analyzing marks by their components and focusing on the purported “dominant” feature “has been held to be a violation of the anti-dissection rule.” 4 *McCarthy on Trademarks and Unfair Competition*, Section 23:42, citing *Massey Junior College, Inc. v. Fashion Institute of Technology*, 492 F.2d 1399, (CCPA 1974); *Franklin Mint Corp. v. Master Mfg. Co.* 667 F.2d 1005 (CCPA 1981). Moreover, there is no automatic rule that finds a junior mark confusingly similar because it contains *part* of a registered mark. See e.g., *Colgate-Palmolive Co. v. Carter-Wallace, Inc.* 432 F.2d 1400, (CCPA 1970) (PEAK PERIOD not confusingly similar to PEAK). It is improper to dissect marks and take only specific elements from each to find “a direct comparison between only that which remains.” *Id.* citing *Spice Islands, Co. v. Frank Tea & Spice Co.*, 505 F.2d 1293 (CCPA 1974); *Schering Corp. v. Alza Corp.*, 207 U.S.P.Q. 504 (TTAB 1980).

In the present matter, the Office Action dismisses the unique elements that distinguish the marks. Applicant respectfully asserts that when viewing the marks in their entirety, it is clear that Applicant's mark is distinctly different from the Cited Mark and is not likely to cause confusion.

### **The Term “max” is Weak for Timers**

The Board has repeatedly stated that “[e]vidence of widespread third-party use, in a particular field, of marks containing a certain shared term is competent to suggest that purchasers have been conditioned to look to the other elements of the marks as a means for distinguishing the source of the goods or services in the field.” *In re Broadway Chicken Inc.*, 38 USPQ2d 1559, 1566 (TTAB 1995), citing *EZ Loader Boat Trailers, Inc. v. Cox Trailers, Inc.*, 213 USPQ 597, 601 (TTAB 1982). The Board reiterated that in these situations, the scope of protection is narrower for that common term. This is the exact situation in this present case. Like *Broadway Chicken*, the overlapping element is so commonly used with timers that the consuming public has learned to look to other elements of the various marks or their goods to distinguish the numerous sources, even if those other elements are arguably minor.

A review of USPTO records reveals numerous third-party max-formative marks that are used with timers. The following chart summarizes relevant marks that are registered or have been allowed. TESS reports are attached as Exhibit 1 and evidence demonstrating actual use of many of these marks is attached as Exhibit 2.

Reg./App. No.	Mark	Relevant Goods
5830668	MAX BRAVE (stylized)	Egg timers, namely, sandglasses
5031909	MAXNON (stylized)	Self-timers
5327414	MAXXIMA	Timers
5380055	MAXBEAR	Self-timers
5433395	MAXAID	Electronic timers; kitchen timers; food timers; egg timers
5317051	MAXDOT	Timers
88333002	MAXEE	Kitchen timers
4206208	MAXIMIZE YOUR IMPACT	Electronic timers
4961944	LEOMAX (stylized)	Egg timers being sandglasses
4750106	KEMAX	Turbo timers
5432593	AIDMAX	Food timers; kitchen timers; countdown timers
5369198	PIDMAXWELL	Timers

A brief search for unregistered common law marks produced additional results, the most relevant examples of which are summarized in the following chart. Screenshots are attached as Exhibit 3.

Mark	Product	URL
TIMERMAX	Timer	<a href="https://www.amazon.com/St Stanley-38425-TimerMax-Digislim-Polarized/dp/B0020ML73K/ref=sr_1_26?keywords=max+timer&amp;qid=1565816077&amp;s=gateway&amp;sr=8-26">https://www.amazon.com/St Stanley-38425-TimerMax-Digislim-Polarized/dp/B0020ML73K/ref=sr_1_26?keywords=max+timer&amp;qid=1565816077&amp;s=gateway&amp;sr=8-26</a>
MINIMAX	Timer	<a href="https://www.amazon.com/Gymboss-miniMAX-Interval-Timer-Stopwatch/dp/B00C5RNBKC/ref=sr_1_7?keywords=max+timer&amp;qid=1565816237&amp;s=gateway&amp;sr=8-7">https://www.amazon.com/Gymboss-miniMAX-Interval-Timer-Stopwatch/dp/B00C5RNBKC/ref=sr_1_7?keywords=max+timer&amp;qid=1565816237&amp;s=gateway&amp;sr=8-7</a>
SHOTMAXX	Watch timer	<a href="https://www.doublealpha.biz/us/shotmaxx-2">https://www.doublealpha.biz/us/shotmaxx-2</a>
HARDCORE MAXX	Software timer	<a href="http://www.intervaltimer.com/timers/5351816-hardcore-maxx">http://www.intervaltimer.com/timers/5351816-hardcore-maxx</a>
MAXX COLD	Timer	<a href="https://www.amazon.com/MAXX-Cold-F0151C020-Maxx-Timer/dp/B06Y53H5XK">https://www.amazon.com/MAXX-Cold-F0151C020-Maxx-Timer/dp/B06Y53H5XK</a>

The Board has previously recognized the evidentiary value of third-party registrations and unregistered uses of marks containing a common term in evaluating the question of likelihood of confusion between two other marks that share that term in common. *See, e.g., Plus Products v. Medical Modalities Associates, Inc.*, 211 USPQ 1199, 1207-08 (TTAB. 1981) (holding that, given widespread use of a particular term in the relevant industry, the inclusion of that term in two marks was not a sufficient basis on which to hold them to be in conflict); *Broadway Chicken Inc.*, 38 USPQ2d at 1566 (telephone directory listings evidenced the overlapping terms were widely used in the industry).

In the present matter, the evidence demonstrates that the term “max” is dilute for timers. Though all of the attached third-party marks contain the term “max,” all are used with timers, and almost all are owned by unrelated entities, they all coexist in the marketplace without causing confusion (and many coexist on the USPTO’s register). Thus, both consumers and the USPTO have clearly given these terms a narrow scope of protection and recognize that even arguably minor differences between marks, goods, etc. are sufficient to avoid consumer confusion.

Indeed, if the Cited Mark MAX GREEN can coexist with, and be registered alongside, MAXEE, MAXNON, MAX BRAVE, MAXDOT, MAXAID, MAX BEAR and MAXXIMA, it can also coexist and be registered with Applicant’s mark MAX. At the least, Applicant submits that the registrations and trademarks identified above demonstrate that the term “max” has been afforded a very narrow scope of protection in connection with timers. The peaceful coexistence of these identical or overlapping marks, all providing timers, and almost all owned by unrelated entities, is strong evidence that the term MAX is highly dilute with regard to such goods and therefore not deserving of broad protection.

**The Marks are Dissimilar and the Only Overlapping Element is Weak and Dilute**

While Applicant appreciates that a highly diluted mark is still deserving of some level of protection against confusingly similar marks, when a mark or term is highly dilute, that level of protection is so low that only a virtually identical mark used with virtually identical goods or services is likely to cause confusion. Where the purported “dominant feature” of a mark is a commonly used term, any addition to this term will render the marks distinguishable. *In re Shawnee Milling Company*, 225 U.S.P.Q. 747 (TTAB 1986); citing *In re Christian Dior, S.A.*, 225 U.S.P.Q. 533 (TTAB 1985); *In re Farm Fresh Catfish Co.*, 231 U.S.P.Q. 495 (TTAB 1986) (emphasis added).

In the pending matter, usage of the term “max” is so common in the timer field that consumers will clearly look to other elements of the respective marks (or the absence thereof) to identify the sources of the goods and will not be confused. A comparison of the marks will prove useful.

Visually, the marks are quite different, with Applicant’s mark consisting solely of the term MAX. The Cited Mark, on the other hand, consist of the text MAX GREEN in a stylized format with specific colors and a bold black border. The Cited Mark consists of two separate

words totaling two syllables, whereas Applicant's mark is a single monosyllabic term. Aside from the weak and dilute term MAX, the marks share no similarities.

The sound of the marks are also dissimilar, with the dilute term MAX being the only shared element. Applicant's mark is simply pronounced MAX, whereas the Cited Mark would naturally be pronounced as MAX GREEN. Thus, when heard or spoken, the only shared element is weak and dilute.

Finally, the meaning and commercial impressions of the respective marks differ significantly. The Cited Mark consist of the phrase MAX GREEN, which conveys several potential meanings. It could be read as a man's full name. It could also be read as referring to the products being environmentally friendly. To the extent the term "green" was descriptive of the color of the products, it would also imply the boldness of that color. These are all specific potential meanings that are conveyed by the Cited Mark to consumers.

Applicant's mark, on the other hand, consists solely of the term "max" with no additional terms, context, or information. Accordingly, consumers will understand the plain meaning of the term: "max." This conveys a very different meaning from the Cited Mark.

These differences take on added significance when the only shared elements are weak. The Board in *In re Shawnee Milling Company*, clearly stated that "where there are some recognizable differences in the assertedly conflicting product marks or where the conflicting product marks are highly suggestive or merely descriptive or play upon commonly used registered terms, the addition of a house mark and/or other material to one of the marks has been held sufficient to register the marks as a whole distinguishable." *Id.*; *See, In re Christian Dior, S.A., supra citing, In re Cosvectic Laboratories, Inc.*, 202 U.S.P.Q. 842 (TTAB 1979); *In re Hill-Beehan Lumber Co.*, 201 U.S.P.Q. 246 (TTAB 1987).

When considered in light of *Broadway Chicken*, where the respective marks all shared a dilute term and the only differing elements had been disclaimed, Applicant's pending application is even less likely to cause confusion. The only common element among the marks is the dilute term "max", which is also used by numerous other entities selling timers. The Cited Mark, however, contains numerous distinguishing elements, including the term "green," the stylized lettering, and the design elements. Accordingly, because the shared elements of the marks are highly dilute, consumers will look to other elements (or their absence) to distinguish the marks.

Therefore, because the Cited Mark is extremely weak and deserving of narrow protection, only a virtually identical mark would be likely to cause confusion. In the present matter, there are significant differences between the marks with respect to sight, sound, and meaning. Consumers will look to these disparate and strong elements of the marks (additional text, design elements, etc.) to differentiate the marks and the sources they identify. Ultimately, the overlapping element is so weak and the marks are sufficiently dissimilar that confusion is not likely to occur.

Applicant respectfully asserts that this response resolves all outstanding issues and that the refusal should be withdrawn. Applicant thanks the Examining Attorney for his time and attention.