

## **RESPONSE AND AMENDMENT**

Re: BIOMAX, Serial No. 88/466,592

This Amendment and Response is being filed in response to the Non Final Office Action issued on September 6, 2019. In the Office Action, the Examining Attorney found the Applicant's mark to be confusingly similar to the mark BIO-MAX, Reg. No. 2648957, and has required that the Applicant amend the identification of goods to be definite.

### **AMENDMENT**

Applicant requests that the following amendment of the goods in Class 3 be entered:

"Cosmetics; Cleansing foam for personal use; Make-up; Beauty masks; Massage cream; Sun-block lotions; Hand creams; Hair colorants; Hair conditioners; Shampoos; Essences, namely, ethereal essences, mint essence being essential oil; Cleansing cream; Face powder; Cosmetic creams for skin care; Lip brighteners, namely, non-medicated cosmetic lightening cream for lips; Make-up removing preparations; Body cleanser; Sunscreen creams; Neutralizers for permanent waving being permanent wave preparations; Hair gel." In Class 3

#### **I. RESPONSE**

**A. APPLICANT'S MARK IS NOT LIKELY TO CAUSE CONFUSION WITH THE CITED REFERENCE DUE TO DIFFERENCES IN THE GOODS SOLD BY THE TWO COMPANIES, DIFFERENCES IN THE CHANNELS OF TRADE FOR THOSE GOODS, AND CIRCUMSTANCES SURROUNDING THE MARKETING OF THOSE GOODS AND SERVICES, AND THE MARKS THEMSELVES.**

In the Office Action, the Examining Attorney has refused registration of the Applicant's mark for BIOMAX re cosmetics and personal care products, as likely to cause confusion with a registration for the mark BIO-MAX, Reg. No. 2,648,957 for "vitamin, mineral, and nutritional dietary supplements in tablet form exclusively for human consumption."

Applicant's goods, and the goods sold by the owner of the cited registration, are actually quite distinct. Applicant's goods are products applied to the skin and are not intended for ingestion by human beings. In fact, in the identification of goods, the cited registration makes clear that the registered vitamin mineral and dietary supplements consist of "tablets" "exclusively for human consumption."

The evidence provided in the Office Action to demonstrate that the Applicant's goods and the registered goods are related consists of four third-party registrations registered for use in connection with the same or similar goods as those of both the Applicant and the Registrant. As the Trademark Trial and Appeal Board (TTAB) has repeatedly stated, third party registrations are not evidence that the marks in the third party registrations are in use or that the public is familiar with them. It would appear that the registrations are intended to imply that when different products are listed in the same registration, those products emanate from a single source.

Certainly, the Federal Register is replete with countless examples of third-party registrations owned by different entities for the same or similar marks where each entity has registered its mark for one of the goods at issue in this matter. As a very small example, Applicant respectfully notes the following directly applicable registrations:

BIOTRIM, Reg. No. 4654058, owned by Filltech USA, for "beauty balm creams; beauty creams; beauty creams for body care; body cream; body creams; cosmetic creams; cosmetic creams for skin care; cosmetic nourishing creams; cosmetic preparations, namely, firming creams; creams for cellulite reduction; face and body beauty creams; face and body creams; moisturizing creams; non-medicated skin care creams and lotions; non-medicated skin care preparations, namely, creams, lotions, gels, toners, cleaners and peels; non-medicated skin creams; skin and body topical lotions, creams and oils for cosmetic use; skin cream; skin creams; skin creams in liquid and in solid form; skin creams in liquid and solid; skin creams in liquid and solid form. Exhibit A.

BIOTRIM, Reg. No. 1967319, owned by MBI Distributing, Inc., for "dietary food supplements in the form of tablets and powdered meal replacements for use in a weight control program. Exhibit B.

BIORECOVERY, Reg. No. 4989360, owned by Cutlan, LLC, for "cosmetic preparations for body care; cosmetic preparations for skin care; deodorant for personal use; douching preparations for personal sanitary or deodorant purposes; facial cleansers; non-medicated cleansers for personal use, namely, face, body, hair

and scalp cleansers; non-medicated skin care preparations, namely, cleansers, creams, lotions, serums, toners, gels, powders, sprays; wipes impregnated with a skin cleanser”; Exhibit C.

BIO-RECOVERY INCORPORATED, Reg. No. 2345662, owned by Bio-Recovery, Inc., for “vitamins and dietary supplements”; Exhibit D.

NATURE’S SPIRIT, Reg. No. 5449879, owned by Fisk Industries, Inc., for “facial and body soaps; hair care products, namely, shampoo, non-medicated hair treatment preparations for cosmetic purposes; hair style fixative in the nature of hair wax; non-medicated skin care preparations, namely, creams, lotions, gels, toners, cleaners and peels”; Exhibit E.

NATURE SPIRITS, Reg. No. 4680862, owned by Maison Fleurette, LLC, for “herbal supplements”; Exhibit F.

NATURE WONDER, Reg. No. 4989913, owned by H J America, Inc., for “aloe vera gel for cosmetic purposes; cosmetic creams for skin care; face creams for cosmetic use; gels for cosmetic purposes; lotions for cosmetic purposes; oils for cosmetic purposes”; Exhibit G.

NATURE’S WONDER, Reg. No. 1069719, owned by California Life Science Laboratories, LLC for “dietary food supplements”; Exhibit H.

VIA NATURE, Reg. No. 4522996, owned by Universal Beauty Products, Inc., for “cleaning preparations; cleaning preparations for body and hands; cleansing creams; cosmetic hand creams; cosmetic preparations; cosmetic preparations for body care; cosmetic preparations for skin care; cosmetic soaps; cosmetics and cosmetic preparations; hair care preparations; hair colorants; hair coloring preparations; hair conditioner; hair dye; hair shampoo; hair sheen spray; hair styling gel; hair styling preparations; hair styling spray; hand cleaning preparations; lotions for cosmetic purposes; skin and body topical lotions, creams and oils for cosmetic use; skin cleansing cream”; Exhibit I.

HEALTHVIANATURE, Reg. No. 4708752, owned by Myherbar Jiang Zhang, for “calcium supplements; calcium-based nutrient supplements for live coral for use in aquariums; casein dietary supplements; dietary and nutritional supplements; dietary and nutritional supplements containing fish oil; dietary and nutritional supplements for endurance sports; dietary and nutritional supplements used for weight loss; dietary beverage supplements for human consumption in liquid and dry mix form for therapeutic purposes; dietary food supplements; dietary pet supplements in the form of pet treats; dietary supplement drink mixes; dietary supplement for eliminating toxins from the intestinal tract; dietary supplemental drinks; dietary supplemental drinks in the nature of vitamin and mineral beverages; dietary supplements; dietary supplements for animals; dietary supplements for controlling cholesterol; dietary supplements for human consumption; dietary supplements for pets; dietary supplements for pets in the nature of a powdered drink mix; dietary supplements for urinary health; dietary supplements in the nature of weight loss powders; enzyme dietary supplements; enzyme food supplements; flaxseed dietary supplements; flaxseed oil dietary supplements; food supplements; food supplements, namely, anti-oxidants; glucose dietary supplements; ground flaxseed fiber for use as a dietary supplement; health food supplements; herbal supplements; herbal supplements for sleeping problems; lecithin for use as a dietary supplement; linseed dietary supplements; linseed oil dietary supplements; liquid nutritional supplement; liquid protein supplements; liquid vitamin supplements; medicated supplements for foodstuffs for animals; medicated supplements for foodstuffs for babies; mineral food supplements; mineral nutritional supplements; mineral supplements; natural dietary supplements for treatment of claustrophobia; natural herbal supplements; natural supplements for treating candida; natural supplements for treating depression and anxiety. natural supplements for treating erectile dysfunction; non-medicated additives for animal feed for use as nutritional supplements; nutraceuticals for use as a dietary supplement; nutritional and dietary supplements formed and packaged as bars; nutritional supplement energy bars; nutritional supplement for eliminating toxins from the body; nutritional supplement for eliminating toxins from the intestinal tract; nutritional supplement in the nature of a nutrient-dense, protein-based drink mix; nutritional supplement shakes; nutritional supplements; nutritional

supplements in capsule form for dogs; nutritional supplements in lotion form sold as a component of nutritional skin care products; nutritional supplements in the nature of nutritionally fortified soft chews; nutritional supplements, namely, carbohydrates in powdered form; nutritional supplements, namely, probiotic compositions; pollen dietary supplements; powdered fruit-flavored dietary supplement drink mix; powdered nutritional supplement concentrate; powdered nutritional supplement drink mix; powdered nutritional supplement drink mix and concentrate; propolis dietary supplements; protein dietary supplements; protein supplement shakes; protein supplement shakes for weight gain purposes; protein supplements; protein supplements for animals; royal jelly dietary supplements; soy protein for use as a nutritional supplement in various powdered and ready-to-drink beverages; vegan liquid protein supplements; vegan protein for use as a nutritional supplement in ready-to-drink beverages; vitamin and mineral supplements; vitamin supplement in tablet form for use in making an effervescent beverage when added to water; vitamin supplements; vitamins and dietary food supplements for animals; weight management supplements; wheat for use as a dietary supplement; wheat germ dietary supplements; whey protein supplements; yeast dietary supplements; zinc supplement lozenges.” Exhibit J.

The third party registrations provided above certainly rebuts any inference to be drawn that the goods of the two companies are closely related or emanate from the same source. *In re Ayurvedic Concepts, Ltd.*, 2008 TTAB Lexis 374 (2008).

Additionally, although the registration does not, on its face, limit the customers or channels of trade for the goods sold by the Registrant, the web site of the Registrant makes clear that the customers for its products are “wholistic health practitioners” and that its products can only be purchased from one source, namely, a company known as Emerson Ecologics. See Exhibits K, L, and M. In other words, it appears that the supplements sold by the Registrant are sold to, and used by, wholistic health professionals rather than the average consumer, and are actually sold in one channel of trade, in fact, through one company, to a narrow band of customers. Wholistic health professionals are sophisticated and knowledgeable purchasers who know precisely what they are seeking in food supplements. They, presumably, are as careful in their purchases of supplements as they are in which food products to ingest. It is respectfully not reasonable to consider these purchasers to be impulse buyers, who would confuse the Registrant’s products with those sold by the Applicant.

However, even *assuming arguendo*, that the Registrant did sell its products in big box retail outlets or pharmacies, big box stores today carry nearly every consumer product under

the sun. And, importantly, the goods sold by the two companies here would be in completely different departments or sections of the store. Cosmetics are commonly sold in their own, distinct, area of retail stores. Non medical personal skin care products are normally found in the health and beauty sections of stores. Vitamin, mineral, and nutritional supplements are found in the pharmacy sections. See Exhibits N, O, P, Q, and R.

Internet retailers and big box stores sell multitudes of various products. Clearly, the fact that internet and big box retailers might, at the same time, sell cosmetics, personal care products, and nutritional supplements, does not mean that confusion is likely. Sites such as AMAZON, and big box stores such as TARGET, sell countless items wholly unrelated to one another (e.g. cereal and lamps, beds and toys). The sale of those products under the same roof, even where the marks of those products share word elements does not mean that the consumer would believe that all of those goods could originate with a single source. As Professor McCarthy has suggested, “there is no such thing as an “under the same roof” rule. Merely because goods are commonly sold within one store under the same roof does not automatically mean that buyers are likely to be confused by similar marks on disparate goods as to source, connection or sponsorship.” *Lever Bros. Co. v. Winzer Co. of Dallas*, 51 C.C.P.A. 930, 326 F.2d 817, 140 U.S.P.Q. 247 (1964); *Hot Shot Quality Products, Inc. v. Sifers Chemicals, Inc.*, 452 F.2d 1080, 172 U.S.P.Q. 350 (10th Cir. 1971); *Lever Bros. Co. v. American Bakeries Co.*, 693 F.2d 251, 258, 216 U.S.P.Q. 177 (2d Cir. 1982) (No likely confusion between defendant's AUTUMN GRAIN for bread and plaintiff's AUTUMN margarine. “Here ... no side-by-side sales could possibly occur, since margarine must be placed in refrigerated compartments, and bread is not.”). As the Federal Circuit's predecessor court observed: “A wide variety of products, not only from different manufacturers within an industry but also from diverse industries, have been brought

together in the modern supermarket for the convenience of the consumer. The mere existence of such an environment should not foreclose further inquiry into the likelihood of confusion.”

*Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 1103, 192 U.S.P.Q. 24, 29 (C.C.P.A. 1976). *Accord: Recot, Inc. v. Becton*, 214 F.3d 1322, 1330, 54 U.S.P.Q.2d 1894 (Fed. Cir. 2000) on remand 56 U.S.P.Q.2d 1859 (T.T.A.B. 2000) (“[T]he law is that products should not be deemed related simply because they are sold in the same kind of establishments.” Citing *Federated Foods.*). *The Nestle Company Inc. v. Nash-Finch Co.*, 4 U.S.P.Q.2d 1085, 1090, 1987 WL 123836 (T.T.A.B. 1987). *Accord: The Irwin Auger Bit Company v. Irwin Corporation*, 134 U.S.P.Q. 37, 39, 1962 WL 8583 (T.T.A.B. 1962) (“It is common knowledge that there are sold in many hardware, grocery, variety and drug stores an almost unlimited variety of goods including tools, house wares, electrical appliances, seed, fertilizer, furniture and toys. The public being well aware of the diversity of goods to be found in such stores is not going to believe that all of those goods could originate with a single source of origin.”); *accord Hi-Country Foods Corp. v. Hi Country Beef Jerky*, 4 U.S.P.Q.2d 1169, 1987 WL 123839 (T.T.A.B. 1987) (all food products are not “related goods” merely because they are sold in the modern supermarket “with its enormous variety of food, cleaning, paper and other products”); *Zanella Ltd. Saroyan Lumber Company*, 2005 WL 1787248 (T.T.A.B. 2005), *aff’d*, 180 Fed. Appx. 968 (Fed. Cir. 2006 (Non-precedential) (“In any event, in the case of department stores, the fact that a wide range of goods may be sold under the same roof does not automatically mean that the goods are related or that buyers are likely to ascribe a common source to the goods.”)).

The two word elements that comprise the registered mark BIO-MAX, namely, BIO and MAX, can be seen to be descriptive in relation to vitamin, mineral and nutritional supplements. BIO is defined as a shortened form of BIOLOGY and MAX is the shortened form of

MAXIMUM. See Exhibits S and T. In relation to supplements, the mark clearly references a maximum dose of biological material. The fact that the registered mark is hyphenated, reinforces the separate, descriptive nature of the two word elements.

The combination of the terms is certainly not unique. In fact, the federal register contains numbers examples of registrations for a wide variety of goods, including at least one registration for food products obviously intended for human consumption, and one for supplements for animals, all shown below. If these marks can co-exist, it would be fundamentally unfair not to allow the Applicant's mark to register.

BIOMAX, Reg. No. 5520436, for "Dairy, namely, brinza cheese, cheese, cottage cheese, cream cheese, curd cheese, farmer cheese, feta cheese, fresh cheese, yogurt, kefir, drinkable yogurt, Greek yogurt, hard cheese, mozzarella cheese, pot cheese, soft cheese, sour cream, butter, butter in the nature of butter blend, milk, condensed whole milk; margarine; edible oils and fats, vegetable oil spread for food." Exhibit U.

BIO-MAX, Reg. No. 4107418, for "liquid nutritional supplements for plants." Exhibit V.

BIOMAXX, Reg. No. 4495466, for "Pharmaceutical research and development services for enhancing absorption of drug molecules and drug delivery solutions." Exhibit W.

BIO-MAX, Reg. No. 4689727, for "Cleaning preparations, namely, odor eliminators not for personal use." Exhibit X.

BIOMAX, Reg. No. 1770807, for "synthetic fibers for use in disposable absorbent applications; namely, diapers, incontinent pads, feminine hygiene products, industrial apparel, medical gowns, industrial and food service wipes and related articles." Exhibit Y.

BIOMAX, Reg. No. 5025679, for "Software for analysis and management of medical, clinical and biomedical data. Consultation in the field of analysis and management of clinical trials data, biomedical data, developing and maintaining of software used to analyze and manage medical, clinical and biomedical data." Exhibit Z.

BIOMAX, Reg. No. 5052211, for "Chemical recycling of waste products; chemical treatment of waste products; decontamination of biological waste; processing of waste materials; recycling of waste; recycling of waste and trash; reprocessing of agricultural waste and scrap materials; sorting of waste and recyclable material; treatment, in the nature of the reclamation of waste; treatment, namely, recycling of waste; treatment of waste; treatment of chemical waste; waste management services; waste processing; waste recycling services; waste treatment." Exhibit AA.

BIO-MAX, Reg. No. 3366310, for "chemical dechlorination tablets for wastewater treatment." Exhibit BB.

BIOMAX, Reg. No. 3864620, for "Air filtration products for industrial uses, namely, health facility air filters, power generation gas turbine intake air filters, paint booth air filters, aircraft cabin ventilation filters, agricultural engine filters, clean room filters, vehicle pollen filters, industrial heating, ventilation and air conditioning system filters." Exhibit CC.

AQUA BIOMAX, Reg. No. 4923076, for “pneumatic controls for industrial and municipal water, waste water and process water stream filtering and treatment equipment; electrical controls for industrial and municipal water, wastewater and process water stream filtering and treatment equipment; water, wastewater and process water stream treatment systems comprised of rotating biological contactor and cloth media tertiary filtration used in industrial and municipal water, wastewater and process water stream filtering and treatment equipment.” Exhibit DD.

As a result, the combination of the two word elements is diluted and weak and entitled to narrow protection. Weak marks are afforded a much narrower scope of protection than that afforded to “strong” marks. See *Sure-Fit Products Co. v. Saltzson Drapery Co.*, 254 F.2d 158, 117 USPQ 295 (C.C.P.A. 1958). See *King Candy Co. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (C.C.P.A. 1974) (confusion is unlikely if it is a weak mark); *J. B. Williams Co. v. Le Conte Cosmetics, Inc.*, 523 F.2d 187, 186 USPQ 317, 189 USPQ 10 (9th Cir. 1975), cert. denied, 424 U.S. 913, 47 L. Ed. 2d 317, 96 S. Ct. 1110, 188 USPQ 720 (1976) (strong mark entitled to a greater degree of protection); *Fotomat Corp. v. Cochran*, 437 F. Supp. 1231, 194 USPQ 128 (D. Kan. 1977) (“famous and strong mark” is entitled to “broad protection”); *Waples-Platter Cos. v. General Foods Corp.*, 439 F. Supp. 551, 196 USPQ 50 (N.D. Tex. 1977) (“The relative strength of a trademark is but a legal shorthand for the breadth of protection to be afforded the mark.”); *SquirtCo v. Seven-Up Co.*, 628 F.2d 1086, 207 USPQ 897 (8th Cir. 1980) (“a strong and distinctive trademark is entitled to greater protection than a weak or commonplace one”); *Ameritech, Inc. v. American Information Technologies Corp.*, 811 F.2d 960, 1 USPQ2d 1861 (6th Cir. 1987) (the stronger a trademark, the greater the protection afforded); *GoTo.com, Inc. v. Walt Disney Co.*, 202 F.3d 1199, 53 USPQ.2d 1652 (9th Cir. 2000) (the stronger the mark “the greater protection the mark is accorded by trademark laws.”).

For all of the above reasons, the combination of the terms BIO and MAX is indeed very weak and entitled to only a narrow scope of protection. Use of such a weak term by the Registrants places the mark in a crowd of similar marks. In such a crowd, customers will not



likely be confused between any two of the crowd and may have learned to carefully pick out one from the other. Even a slight difference in marks in a crowded field can be sufficient to differentiate it from other similar marks. Applicant's mark does not contain a hyphen, an important part of the cited registration. Although not normally a compelling differentiator, in this crowded field, it is sufficient to differentiate these two marks.

As Professor McCarthy notes, a mark that is hemmed in on all sides by similar marks on similar goods or services cannot be very "distinctive." It is merely one of a crowd of similar marks. In such a crowd, customers will not likely be confused between any two of the crowd and may have learned to carefully pick out one from the other.

2 McCarthy on Trademarks and Unfair Competition § 11:85 (5th ed.)

When numerous sellers in a product or service line use similar marks, there may be little if any individual distinctiveness and consumers may have difficulty telling one seller from another. "[I]f consumers don't have a clear sense of what plaintiff's mark represents, they are unlikely to purchase defendant's product or service thinking it is plaintiff's."<sup>3</sup>

In a "crowded" field of look-alike marks, each member of the crowd is relatively "weak" in its ability to prevent use by others in the crowd. *See Standard Brands Incorporated v. RJR Foods, Inc.*, 192 U.S.P.Q. 383, 385, 1976 WL 21135 (T.T.A.B. 1976) (no proof that the public had been educated by exposure to many uses of ROYAL marks to distinguish between different ROYAL marks "on the basis of minute distinctions"); *Miss World (UK) Ltd. v. Mrs. America Pageants, Inc.*, 856 F.2d 1445, 1449, 8 U.S.P.Q.2d 1237, 1241 (9th Cir. 1988) (quoting treatise with approval); *Source Services Corp. v. Chicagoland JobSource, Inc.*, 643 F. Supp. 1523, 1531, 1 U.S.P.Q.2d 1048 (N.D. Ill. 1986) ("Where numerous producers or providers use similar marks for similar products or services, consumers may not be at all sure whose mark they are dealing with. ... [P]aradoxically, that sort of real confusion militates against finding a 'likelihood of confusion' in the Lanham Act infringement sense."). *In re Broadway Chicken Inc.*, 38 U.S.P.Q.2d 1559, 1996 WL 253841 (T.T.A.B. 1996) ("Evidence 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 other elements of the marks as a means of distinguishing the source of goods or services in the field.”).

## **II. CONCLUSION**

In light of all of the above arguments and evidence, Applicant strongly asserts that mark its mark, BIOMAX for cosmetics and personal care products, is not likely to cause confusion with the registered mark BIO-MAX, for “vitamin, mineral, and nutritional dietary supplements in tablet form exclusively for human consumption.”

By this response, Applicant has addressed the issues raised by the Examining Attorney and respectfully requests that the application be approved for publication at an early date.

If the Examining Attorney has any questions or comments, Applicant respectfully requests that the Examining Attorney contact the undersigned Attorney of record.