

THIS OPINION IS NOT A
PRECEDENT OF THE TTAB

Mailed:
November 6, 2013

UNITED STATES PATENT AND TRADEMARK OFFICE

—
Trademark Trial and Appeal Board

—
In re Visionstar, Inc.

—
Serial No. 85319715

—
Josh Gerben of the Gerben Law Firm PLLC for Visionstar, Inc.

Asmat Kahn, Trademark Examining Attorney, Law Office 114 (K. Margaret Le,
Managing Attorney).

—
Before Seeherman, Bergsman and Lykos, Administrative Trademark Judges.

Opinion by Bergsman, Administrative Trademark Judge:

Visionstar, Inc. (“applicant”) filed an intent-to-use application to register the mark **Maxgain**, in standard character form, for “natural supplements for male enhancement,” in Class 5.

The Trademark Examining Attorney refused to register applicant’s mark pursuant to Section 2(d) of the Trademark Act of 1946, 15 U.S.C. § 1052(d), on the ground that it so resembles the previously registered mark MAXIMUM GAIN, in standard character form, for the goods set forth below, that if used on applicant’s goods it is likely to cause confusion.

Supplements, namely, dietary food supplements, dietary supplements, food supplements, herbal supplements, meal replacement and dietary supplement drink mixes, mineral nutritional supplements, mineral supplements, nutritional supplements, nutritional supplemental drink mixes, vitamin and mineral supplements, vitamin supplements, meal replacement bars,” in Class 5.

Our determination of the issue of likelihood of confusion is based on an analysis of all of the probative facts in evidence that are relevant to the factors set forth in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973). *See also*, *In re Majestic Distilling Co., Inc.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods and/or services. *See Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976). *See also*, *In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531, 1533 (Fed. Cir. 1997).

A. The similarity or dissimilarity and nature of the goods as described in the application and registration, established likely-to-continue channels of trade and classes of consumers.

Applicant’s “natural supplements for male enhancement” are used for “increasing the size of a man’s penis or increasing the size of a man’s libido (i.e., the penis or libido ‘gain’ing ‘max’imum size).”¹ *See also* the Sooper Articles website (sooperarticles.com), “Why Dietary Supplements for Male Enhancement Have Become So Popular?” (June 10, 2010):²

¹ Applicant’s Brief, p. 9.

² February 10, 2012 Office action.

Male enhancement dietary supplements are the most debated topic of late. With an increasing number of men depending on the dietary supplements for enhancing the size of the penis and also increasing the girth of the organ in order to have a better sexual life, the concept of using external techniques and devices for penis enhancement has suddenly become news.

Other websites are not as direct with their claims regarding “male enhancement” and reference sexual health as opposed to penis size. *See* the Go Veda website (goveda.com), a retailer of Ayurvedic health supplements, that describes its male enhancement products as providing “a safe, effective solution that returns balance to the body and arousal to intimate relationships.”³ the Walgreens website (walgreens.com) that advertises that its Libido-Max Male Enhancement Dietary Supplement Liquid Soft-Gels “enhance drive & desire,” “increase blood flow,” and provide “longer performance & stamina”;⁴ and the Mystic Medicines website (mysticmedicines.com), an online retailer, that advertises that it sells “natural health products and herbal dietary supplements” for “cardiovascular health, sexual health and enhancement.”⁵

According to the above-noted article “Why Dietary Supplements for Male Enhancement Have Become So Popular?,” “dietary supplements have proved to be a very handy option and good choice” for penis enlargement:

Dietary supplements, particularly those that contain herbal ingredients, are believed to be extremely beneficial for health. In fact, diet plays a major role in maintaining the penile health. Eating a balanced diet with lots of

³ February 10, 2012 Office action.

⁴ *Id.*

⁵ *Id.*

vitamins and essential minerals along with whole, fresh, unprocessed and unrefined foods can be vital for your health and for male enhancement too. ... These foods must be made part of your daily diet along with proper doses of dietary supplements, such as vitamins and minerals to enhance the penis and to help it grow. Some foods also promote stronger erections. Males should also avoid junk and processed foods, foods containing sugar, fried stuffs, dairy products and caffeine to have a great sex life. The healthier the body, the healthier the penis, and, of course, with a healthy penis comes pleasure in the bedroom.

In considering the goods covered by the cited registration, we look to the registration itself, and not to extrinsic evidence about the registrant's actual goods, customers, or channels of trade. *In re Elbaum*, 211 USPQ 639, 640 (TTAB 1981).

Trademark cases involving the issue of likelihood of confusion must be decided on the basis of the respective descriptions of goods. [Internal citations omitted]. **What is more significant than appellee's failure to limit the description of goods to a particular channel of trade or market is the absence of a limitation in appellant's registration which would exclude appellee's market.** [Internal citation omitted]. For purposes of this opposition proceeding, therefore, **we give full sweep to appellant's registration description of goods and view the goods and modes of distribution as the same.** (Emphasis added).

Paula Payne Products Company v. Johnson Publishing Company, Inc., 473 F.2d 901, 177 USPQ 76, 77 (CCPA 1973).

Because there are no restrictions or limitations in the registrant's description of goods, registrant's identified supplements must be deemed to be used for "male enhancement" and, therefore, applicant's "natural supplements for male enhancement" fall within the scope of the registrant's description of goods, namely, "supplements, namely, dietary food supplements, dietary supplements, food

supplements, herbal supplements.” Therefore, we must treat applicant’s goods as being legally identical to the registrant’s goods.

Because the goods described in the application fall within the scope of the goods in the cited registration, we must presume that the channels of trade and classes of purchasers are the same. *See American Lebanese Syrian Associated Charities Inc. v. Child Health Research Institute*, 101 USPQ2d 1022, 1028 (TTAB 2011); *In re Smith and Mehaffey*, 31 USPQ2d 1531, 1532 (TTAB 1994) (“Because the goods are legally identical, they must be presumed to travel in the same channels of trade, and be sold to the same class of purchasers.”). *See also In re Viterra Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012) (even though there was no evidence regarding channels of trade and classes of consumers, the Board was entitled to rely on this legal presumption in determining likelihood of confusion).

Even if we did not treat the goods as being legally identical, the Trademark Examining Attorney has submitted evidence, in the form of third-party registrations and websites, showing that dietary supplements in general and supplements for penile enhancement emanate from the same sources and are sold in the same channels of trade. Therefore, at a minimum, the goods are closely related.

We find that the *du Pont* factors of similarity of goods and channels of trade favor a finding of likelihood of confusion.

B. The similarity or dissimilarity of the marks in their entirety in terms of appearance, sound, connotation and commercial impression and the number and nature of similar marks in use on similar goods.

We turn next to the *du Pont* likelihood of confusion factor focusing on the similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression. *In re E. I. du Pont De Nemours & Co.*, 177 USPQ at 567. In comparing the marks, we are mindful that where, as here, the goods are legally identical, the degree of similarity necessary to find likelihood of confusion need not be as great as where there is a recognizable disparity between the goods. *See Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992); *Jansen Enterprises Inc. v. Rind*, 85 USPQ2d 1104, 1108 (TTAB 2007); *Schering-Plough HealthCare Products Inc. v. Ing-Jing Huang*, 84 USPQ2d 1323, 1325 (TTAB 2007).

Further, the test is not whether the marks can be distinguished when subjected to a side-by-side comparison, but rather whether the marks are sufficiently similar in terms of their overall commercial impression so that confusion as to the source of the goods offered under the respective marks is likely to result. *San Fernando Electric Mfg. Co. v. JFD Electronics Components Corp.*, 565 F.2d 683, 196 USPQ 1, 3 (CCPA 1977); *Spoons Restaurants Inc. v. Morrison Inc.*, 23 USPQ2d 1735, 1741 (TTAB 1991), *aff'd unpublished*, No. 92-1086 (Fed. Cir. June 5, 1992). The proper focus is on the recollection of the average customer, who retains a general rather than specific impression of the marks. *Winnebago Industries, Inc.*

v. Oliver & Winston, Inc., 207 USPQ 335, 344 (TTAB 1980); *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106, 108 (TTAB 1975).

Applicant's mark **Maxgain** is very similar to the registered mark MAXIMUM GAIN. Because both marks are in standard character form, the marks are not limited to any particular depiction. The rights associated with a mark in standard characters reside in the wording and not in any particular display. *In re Viterra Inc.*, 101 USPQ2d at 1909 ("to the extent that the Board simply held that a standard character mark is not limited to any particular font, size, style, or color, is entirely consistent with our case law, the relevant regulations and the TMEP."); *In re RSI Systems, LLC*, 88 USPQ2d 1445, 1448 (TTAB 2008); *In re Pollio Dairy Products Corp.*, 8 USPQ2d 2012, 2015 (TTAB 1988). Thus, although applicant's drawing of the mark indicates that it will display it as **Maxgain**, the cited standard character mark could be displayed in a similar manner as **Maximum gain**.

The presence or absence of a space between the two words is an inconsequential difference that even if noticed or remembered by consumers would not serve to distinguish these marks. *See, e.g., Seaguard Corp. v. Seaward International, Inc.*, 223 USPQ 48, 51 (TTAB 1984) (SEA GUARD and SEAGUARD are "essentially identical"); *In re Best Western Family Steak House, Inc.*, 222 USPQ 827 (TTAB 1984) ("there can be little doubt that the marks [BEEFMASTER for restaurant services and BEEF MASTER for frankfurters and bologna] are practically identical and indeed applicant has not *argued* otherwise.") (Emphasis in the original).

On the other hand, applicant makes the following argument:

When examined in their entireties, the Applicant's mark MAXGAIN is comprised of one word, whereas the MAXIMUM GAIN mark is comprised of two words. As such, the MAXGAIN mark is visually shorter than the MAXIMUM GAIN mark and thus differs in appearance.

Phonetically, MAXGAIN has two syllables, whereas MAXIMUM GAIN contains four syllables. Accordingly, MAXIMUM GAIN takes longer to pronounce. As a result of the foregoing, the overall spoken sounds of the marks MAXGAIN and MAXIMUM GAIN differ.⁶

However, consumers are not going to dissect the competing trademarks into discrete points of similarity and dissimilarity; rather they will focus on the overall commercial impression created by the marks. *See Fuji Jyukogyo Kabushiki Kaisha v. Toyota Jidosha Kabushiki Kaisha*, 228 USPQ 672, 674 (TTAB 1985) (“that the number of letters in the two marks is almost the same is immaterial. Purchasers do not count letters when reacting to trademarks in the marketplace.”); *American B.D. Company v. N.P. Beverages, Inc.*, 213 USPQ 387, 388 (TTAB 1981) (“However, in determining whether there is a likelihood of confusion, we must consider the marks in their entireties. Purchasers are not expected to, and do not, count the number of letters which marks have in common.”).

The prefix “max” means “maximum.”⁷ The word “gain” is defined, *inter alia*, as “to acquire as an increase or addition: *to gain weight; to gain speed.*” (Emphasis

⁶ Applicant's Brief, p. 8.

⁷ *Infoplease.com* dictionary derived from the **RANDOM HOUSE UNABRIDGED DICTIONARY** (1997) (August 30, 2011 Office action). *See also* the Acronym Finder website (acronymfinder.com) attached to the August 30, 2011 Office action.

in the original).⁸ Thus, **Maxgain** and MAXIMUM GAIN have the same meaning and engender the same commercial impression (*i.e.*, the greatest result or acquisition). Applicant contends that **Maxgain** for “natural supplements for male enhancement” “has a meaning and commercial impression related to increasing the size of a man’s penis or increasing the size of a man’s libido (*i.e.*, the penis or libido ‘gain’ing ‘max’imum size),”⁹ and, thus, **Maxgain** engenders a commercial impression “related to increasing male sexuality or virility” while MAXIMUM GAIN “in connection with vitamins and dietary supplements would be a meaning and commercial impression related to muscle gain.”¹⁰ As discussed above, because applicant’s “natural supplements for male enhancement” are legally identical to registrant’s “dietary food supplements, dietary supplements, food supplements, herbal supplements,” the marks would have the same commercial impression (*i.e.*, increasing or maximizing the benefit from the supplements).

Because the marks have similar meanings and engender similar commercial impressions, consumers are likely to understand **Maxgain** and MAXIMUM GAIN as variations of the same mark and will view **Maxgain** as merely a shortened form of MAXIMUM GAIN.

[C]ompanies are frequently called by shortened names, such as Penney’s for J.C. Penney’s, Sears for Sears and

⁸ **THE RANDOM HOUSE DICTIONARY OF THE ENGLISH LANGUAGE (UNABRIDGED)**, p. 781 (2nd ed. 1987). The Board may take judicial notice of dictionary definitions. *Univ. of Notre Dame du Lac v. J.C. Gourmet Food Imp. Co.*, 213 USPQ 594 (TTAB 1982), *aff’d*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983).

⁹ Applicant’s Brief, p. 9.

¹⁰ Applicant’s Brief, p. 9.

Roebuck (even before it officially changed its name to Sears alone), Ward's for Montgomery Ward's, and Bloomies for Bloomingdales.

Marshall Field & Co. v. Mrs. Fields Cookies, 25 USPQ2d 1321, 1333 (TTAB 1992).

Applicant argues that there are so many third-party marks incorporating "Max" and "Gain" that consumers will be able to distinguish between applicant's mark and the registered mark because the registered mark is weak and it is entitled to only a narrow scope of protection. To support this argument, applicant makes the following assertion:

Moreover, there are 512 registered or pending federal marks in International Class 005 containing the word "MAX." There are 292 registered or pending federal marks in International Class 005 containing the word "MAX" for supplements. There are 112 registered or pending federal marks in International Class 005 containing the word "GAIN" and 68 registered or pending federal marks in International Class 005 containing the word "GAIN" for supplements."¹¹

Applicant's mere assertion in its brief is not sufficient to make the registrations of record. However, applicant has made of record the seven third-party registrations set forth below, the first three of which have been cancelled, and therefore have no probative value:

1. Registration No. 2660501 for the mark MAXIMAN;¹²
2. Registration No. 3168768 for the mark GAINER MAXX;¹³

¹¹ Applicant's Brief, p. 14. Pending applications are evidence only that the applications were filed on a certain date; they are not evidence of use of the marks. *Nike Inc. v. WNBA Enterprises LLC*, 85 USPQ2d 1187, 1193 n.8 (TTAB 2007); *Interpayment Services Ltd. v. Docters & Thiede*, 66 USPQ2d 1463, 1468 n.6 (TTAB 2003); *In re Juleigh Jeans Sportswear, Inc.*, 24 USPQ2d 1694, 1699 (TTAB 1992).

¹² Cancelled July 12, 2013.

Serial No. 85319715

3. Registration No. 3100789 for the mark MAXIMUM MAN;¹⁴
4. Registration No. 3234054 for the mark MAXIMUM CREA-GAIN;
5. Registration No. 3248626 for the mark MAXILEAN;
6. Registration No. 2236722 for the mark MAXIMUM HUMAN PERFORMANCE; and
7. Registration No. 3479289 for the mark ISO MASS XTREME GAINER.

These registrations are not evidence that the marks are in use, or that the public is familiar with them. *See Smith Bros. Mfg. Co. v. Stone Mfg. Co.*, 476 F.2d 1004, 177 USPQ 462, 463 (CCPA 1973) (the purchasing public is not aware of registrations reposing in the U.S. Patent and Trademark Office); *Productos Lacteos Tocumbo S.A. de C.V. v. Paeteria La Michoacana Inc.*, 98 USPQ2d 1921, 1934 (TTAB 2011). However, they corroborate the common sense conclusion that the registrant's mark "Maximum Gain" is suggestive because, as discussed above, it connotes the greatest result or acquisition. However, even though MAXIMUM GAIN is suggestive and, therefore, an inherently weak mark, that would not be fatal to finding likelihood of confusion because even weak marks are entitled to protection against confusion. *King Candy Co. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108, 109 (CCPA 1974).

Finally, applicant argues that "[h]ere, there is [sic] a voluminous number of registered marks containing the words MAX or MAXIMUM and GAIN in the

¹³ Cancelled July 14, 2013.

¹⁴ Cancelled January 11, 2013.

international class at issue, class 005.”¹⁵ However, none of the third-party registrations is as close to the registered mark as applicant’s mark. In this regard, we note that the issue before us is the similarity or dissimilarity of the marks **Maxgain** and MAXIMUM GAIN, both presented in standard character form, not how many “Max” formative marks or “Gain” formative marks have been registered. The relevant fact is how many marks containing both “Max” and “Gain” are in use on related goods. Applicant has not provided any such evidence. Moreover, even if we were to view the third-party registrations as showing such use (and as indicated above, such registrations are not probative of use), there is only one other mark having both elements: Registration No. 3234054 for the mark MAXIMUM CREA-GAIN. That one mark does not persuade us that consumers will view **Maxgain** and MAXIMUM GAIN as indicating identical goods having separate sources.

In view of the foregoing, we find that applicant’s mark **Maxgain** is similar to the registered mark MAXIMUM GAIN.

C. Balancing the factors.

In view of the facts that the marks are similar, the goods are legally identical, and that the goods move in the same channels of trade and are sold to the same classes of consumers, we find that applicant’s mark **Maxgain** for “natural supplements for male enhancement” is likely to cause confusion with the registered mark MAXIMUM GAIN for supplements.

Decision: The refusal to register is affirmed.

¹⁵ Applicant’s Brief, pp. 11-15.