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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	86801078
Applicant	Graphic Packaging International, LLC
Applied for Mark	AUTOMAXX
Correspondence Address	SARAH ANNE KEEFE WOMBLE CARLYLE SANDRIDGE & RICE LLP PO BOX 7037 ATLANTA, GA 30357-0037 UNITED STATES tmdocketing@wcsr.com 919-484-2327
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Filer's Name	Emily S. Whittaker
Filer's email	tmdocketing@wbd-us.com, emily.whittaker@wbd-us.com, laura.kees@wbd-us.com
Signature	/Emily S. Whittaker/
Date	12/17/2018

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

Applicant:	Graphic Packaging International,)	
	LLC)	
Serial No.:	86/801,078)	Examiner: Brandon N. Marsh
Filing Date:	October 27, 2015)	Law Office 127
Mark:	AUTOMAXX)	

APPLICANT'S APPEAL BRIEF

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INTRODUCTION

Pursuant to a timely filed notice of appeal, Graphic Packaging International, LLC (“Applicant” or “Graphic”) has appealed the Examining Attorney’s final refusal to register Applicant’s mark under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), because of a likelihood of confusion with the mark in U.S. Reg. No. 823,991. The issue on appeal is whether this registration bars registration of Applicant’s mark.

BACKGROUND

On October 27, 2015, Graphic filed the instant application to register the mark AUTOMAXX (“Applicant’s Mark”) on the Principal Register for use with “packaging machines for wraps” in International Class 7 (U.S. Ser. No. 86/801,078). The identification of goods has since been amended to “packaging machines, namely, for paperboard wraps used for cylindrical containers.” (April 18, 2016 Response to Office Action, TSDR p. 2). In his first office action dated December 10, 2015, the Examining Attorney refused registration of Applicant’s Mark because of a likelihood of confusion with the mark in U.S. Registration No. 823,991, namely, Gruppo Fabbri Vignola S.P.A.’s (“Registrant”) AUTOMAC mark for “packaging machines” in Class 7 (“Cited Mark”). (December 10, 2015 Office Action, TSDR p. 1). The Examiner indicated that both Applicant’s Mark and the Cited Mark contain the “AUTO” prefix combined with a suffix beginning with “MA” and concluded that the parties’ marks have a highly similar commercial impression. *Id.* The Examiner further concluded that the parties’ goods are related for likelihood of confusion purposes, as the identification set forth in the registration has no restrictions as to nature, type, channels of trade, or classes of purchaser. *Id.*

In its office action response dated April 18, 2016, Applicant argued that there is no likelihood of confusion due to the differences in the parties’ marks and the additional AUTOMA-

formative registrations on the register in Class 7. In support of its arguments, Applicant submitted as evidence a number of third-party registrations for marks containing the component AUTOMA. (April 18, 2016 Response to Office Action, Exhibit A).

In his second office action dated May 13, 2016, the Examining Attorney issued a final likelihood of confusion refusal pursuant to Section 2(d). (May 13, 2016 Office Action, TSDR p. 1). The Examiner rejected Applicant's arguments and submitted an additional argument that the marks are near phonetic equivalents where Applicant's Mark is pronounced in the same manner as the plural form of the Cited Mark. *Id.*

On November 14, 2016, Applicant simultaneously filed a notice of appeal with the Trademark Trial and Appeal Board ("Board") and its first request for reconsideration. In its request for reconsideration, Applicant presented additional arguments and evidence in support of its argument that there is no likelihood of confusion between the parties' marks. Specifically, Applicant submitted the Declaration of Barry D. Biddle stating no evidence of actual confusion exists. (November 14, 2016 Request for Reconsideration, Exhibit A). Additionally, Applicant submitted as evidence a now inactive registration for the mark AUTOMAX, and additional arguments regarding the differences between the marks and the goods, the trade channels and the sophistication of the purchasers, supported by the Declaration of Colin Ford. (November 14, 2016 Request for Reconsideration, TSDR p. 2, Exhibit H, Exhibit I).

On December 9, 2016, the Examiner issued a subsequent office action maintaining the 2(d) refusal and submitting a Sections 1 and 45 refusal arguing the mark differed in the drawing and specimen. In reaching his conclusion that there is a likelihood of confusion, the Examiner rejected all of Applicant's arguments stating that actual confusion is not necessary, he was not bound by previous decisions of examining attorneys, evidence of actual use is not relevant and

the sophistication of consumers does not necessarily mean that they are sophisticated or knowledgeable in the field of trademarks. (December 9, 2016 Office Action, TSDR p. 1).

In its office action response dated June 8, 2017, Applicant continued to argue that there is no likelihood of confusion due to the difference in the marks and the sophistication of the consumers. It also submitted a substitute specimen.

On August 19, 2017, the Examiner issued a subsequent office action obviating the Sections 1 and 45 refusal, but maintaining the 2(d) refusal and submitting a Sections 1, 2, and 45 model designation refusal. The Examiner did not offer new arguments for the 2(d) refusal. (August 19, 2017 Office Action, TSDR p. 1).

In its office action response dated February 16, 2018, Applicant argued against the model designation and submitted new arguments against the 2(d) refusal. (February 16, 2018 Response to Office Action TSDR pgs. 2-3). Specifically, Applicant submitted a number of third-party registrations for marks containing the components MAXX/MAX and MAC covering identical or related goods. *Id.* at 4.

On March 12, 2018, the Examiner issued a second final action obviating the Sections 1, 2 and 45 refusal, but maintaining and making final the likelihood of confusion refusal pursuant to Section 2(d). The Examiner did not offer new arguments for the 2(d) refusal or address Applicant's additional arguments from its prior response.

On September 12, 2018, Applicant submitted its second request for reconsideration arguing against the similarities in the marks, specifically against the examining attorney's argument that the near phonetic equivalent of a plural form of a mark should be considered similar. (September 12, 2018 Request for Reconsideration, TSDR p. 2). Applicant also submitted additional third-party registrations for marks containing the components MAXX/MAX

and MAC covering identical or related goods, and additional arguments regarding the sophistication of the consumers. *Id.* at 3.

On October 12, 2018 the examining attorney denied Applicant's request for reconsideration. This appeal was resumed by the Board's order dated October 17, 2018.

ARGUMENT

Applicant submits that there is no likelihood of confusion between the parties' marks because the parties' marks and goods are sufficiently different from one another to avoid a likelihood of confusion, consumers of the relevant services are sophisticated and Registrant's Mark co-existed with a similar mark for thirty two years with no objection or confusion. Each of these arguments is discussed in detail below.

I. THE PARTIES' MARKS ARE SUFFICIENTLY DIFFERENT FROM ONE ANOTHER TO AVOID A LIKELIHOOD OF CONFUSION

A. THE PARTIES' MARKS DIFFER IN TERMS OF APPEARANCE, SOUND, CONNOTATION AND COMMERCIAL IMPRESSION

When viewed in their entireties, Registrant's AUTOMAC mark and Applicant's AUTOMAXX mark differ in terms of appearance, sound, connotation and commercial impression. Admittedly, the parties' marks share the element AUTOMA, but this fact alone does not compel a finding of a likelihood of confusion. *See, e.g., Nutri/System, Inc. v. Con-Stan Industries, Inc.*, 809 F.2d 601, 1 USPQ2d 1809, 1813-14 (9th Cir. 1987) (no likelihood of confusion between NUTRI/SYSTEM and NUTRI-TRIM); *Colgate-Palmolive Co. v. Carter-Wallace, Inc.*, 432 F.2d 1400, 167 USPQ 529, 530-31 (CCPA 1970) (no likelihood of confusion between PEAK for toothpaste and PEAK PERIOD for personal deodorant). (June 8, 2017 Response to Office Action, TSDR p. 3). Applicant's Mark has an emphasis on the end of the term by containing a double X. In contrast, the Cited Mark ends with a singular C. Not only do

the marks sound differently, but having a double X serves to distinguish the parties' marks in terms of appearance and sound.¹ (April 18, 2016 Response to Office Action, TSDR p. 2)

“[A]lthough the marks at issue must be considered in their entireties, it is well-settled that one feature of a mark may be more significant than another, and it is not improper to give more weight to this dominant feature in determining the commercial impression created by the mark.” *In re Box Solutions Corp.*, 79 USPQ 1953, 1957 (TTAB 2006). (June 8, 2017 Response to Office Action, TSDR p. 3). Here, the ending of the Cited Mark is “MAC” and the ending of Applicant’s Mark is “MAXX”. Not only do the marks have visual differences, mentioned above, they also have a different commercial impression. The term “MAXX” is typically thought of as meaning “maximum”, whereas “MAC”, in this instance, appears to denote the term “machine” (April 18, 2016 Response to Office Action, TSDR p. 3-4). This is clear as the Cited Mark’s goods are “packaging machines”. *Id.* The term “MAXX” does not refer to “machines”. *Id.* Given the apparent emphasis on the second part of the mark and the different commercial impressions the Cited Mark and Applicant’s Mark represent, confusion is not likely.

B. THE CITED MARK COEXISTS WITH OTHER AUTOMA- FORMATIVE MARKS

Moreover, as illustrated by the chart below, there are a number of third-party registrations for marks containing the component “AUTOMA” for use in Class 7, which are currently coexisting with the Cited Mark.

Mark	Registration Number	Class 7 Goods	Owner
AUTOMAX INC.	1,517,015	Machine elements,	FLOWSERVE

¹ The parties are using their marks with different stylizations, backgrounds, and designs, thereby further minimizing any likelihood of confusion. For example, Registrant uses its mark in white lowercase letters inside of a red box. (Response to Office Action, February 16, 2018). In contrast, Applicant always emphasizes the MAXX portion of its mark by having MAXX in all capital letters in the design version of the mark or by having the “M” in MAXX capitalized when Applicant’s Mark is in word format. (*Id.*).

		namely pneumatic rack and pinion actuators, and pneumatic and hydraulic valve actuators and positioners for non-automotive applications	MANAGEMENT COMPANY DELAWARE BUSINESS TRUST 222 WEST LAS COLINAS BOULEVARD, SUITE 1500 IRVING, TEXAS, 75039
AUTOMA ²	1,246,865	Plastic molding machines	AUTOMA S.P.A. ITALY CORPORATION VIA CHIESACCIA N 38, FRAZIONE, CALCARA CREPELLANO (BOLOGNA), ITALY, 40056
AUTOMATAN	1,644,969	Machines for laminating paper and paperboard products, and machines for handling paper and paperboard products, namely, joggers, aerators and load turners	AUTOMATAN INCORPORATED WISCONSIN CORPORATION 2911 APACHE DRIVE PLOVER, WISCONSIN, 54467
AUTOMATE	2,214,088	Bottling and packaging machines	AUTO-KAPS, LLC NEW YORK LIMITED LIABILITY COMPANY 34 HINDA BOULEVARD RIVERHEAD, NEW YORK, 11901

(April 18, 2016 Response to Office Action, Exhibit A). These third-party registrations demonstrate that the Trademark Office has considered even the slightest variations in AUTOMA marks to be sufficient to avoid a likelihood of confusion.

² This mark cancelled on March 18, 2016 however was active during the issuance of the examining attorney's first office action.

Based on the Examining Attorney’s reasoning, these marks should not be able to coexist with the Cited Marks because the above marks “share the identical ‘AUTO’ prefix combined with a suffix beginning with ‘MA’. (December 10, 2016 Office Action, TSDR p. 1) Nevertheless, the coexistence of these registrations demonstrates further that Applicant’s Mark is not sufficiently similar to the Cited Mark to create confusion.

Moreover, a then-existing third-party registration on the Principal Register for the mark AUTOMAX for use with “cartoning machines” (U.S. Reg. No. 670,200) was not a bar to registration of Registrant’s AUTOMAC mark. These marks co-existed on the register for thirty two (32) years, apparently with no confusion. (November 14, 2016 Request for Reconsideration, TSDR p. 2). Even though this registration expired in 1999, it coexisted on the register with the Cited Mark from 1967 until 1999. *Id.* The Cited Mark and the AUTOMAX mark are even more similar in appearance than Applicant’s Mark. Applicant’s Mark has the distinct double X ending, where the AUTOMAX mark has a one X ending. This is over thirty years of evidence that there is no likelihood of confusion between a mark nearly identical to Applicant’s Mark and the Cited Mark for the same goods, which cannot be ignored.

Mark	Reg/App No.	Registration Date	Goods
AUTOMAX	670,200	November 25, 1958	23: cartoning machines
AUTOMAC	823,991	February 14, 1967	23: packaging machines
AUTOMAXX	86/801,078		07: packaging machines, namely for paperboard wraps

(Id.)

When an applicant files for a trademark application, it is required under 15 U.S.C. § 1051 to sign a declaration stating that “to the best of the verifier’s knowledge and belief, no other person has the right to use such mark in commerce either in the identical form thereof or in such near resemblance thereto as to be likely, when used on or in connection with the goods of such

other person, to cause confusion, or to cause mistake, or to deceive.” This law was in effect in 1966 when the Registrant filed its application. Therefore, the Registrant admitted that the mark AUTOMAX for use with a packaging machine, registered in 1958, was not likely to cause confusion with the Cited Mark. (*Id.*).

C. NUMEROUS MARKS USING THE TERMS MAX/MAXX AND MAC CURRENTLY CO-EXIST ON THE REGISTER WITH NO LIKELIHOOD OF CONFUSION

The Examiner notes the marks are “near phonetic equivalents” but never states the marks are phonetically identical. (May 13, 2016 Office Action, TSDR p. 1) The Examiner then cites to case law arguing “the singular or plural form of a registered mark is essentially identical in sound, appearance, meaning and commercial impression. . .” *Id.* The Examining Attorney has focused on the fact that the plural form of the Cited Mark creates a similar sound to Applicant’s Mark. *Id.* The Examining Attorney has cited multiple cases for this notion; however, none of these cases support the Examining Attorney’s argument that the near phonetic equivalent of a plural form is considered similar in sight, sound and meaning. (September 12, 2018 Request for Reconsideration, TSDR p. 2). In fact, Applicant has not been able to find any cases supporting the Examining Attorney’s argument. *Id.* While cases do exist stating the plural form of a mark can be considered confusingly similar to the singular version of the same mark, Applicant’s Mark is not the plural version of the Cited Mark. At most, Applicant’s Mark could be considered phonetically similar to a plural version of the Cited Mark. *Id.* Basing an argument off of a convoluted interpretation of the Cited Mark, i.e. pluralizing the Cited Mark and then comparing it to the sound of Applicant’s Mark, takes some mental gymnastics. Accordingly, Applicant again asserts that confusion is unlikely.

Evidencing that near phonetic equivalents of plural forms of singular marks do not create likelihood of confusion, the component MAX(X) and MAC has consistently been found by the Trademark Office not to constitute sufficient similarity to support a refusal to register. (September 12, 2018 Request for Reconsideration, TSDR p. 3). Applicant points to the following registrations and approved applications containing the term MAX/MAXX for goods and services that are identical or overlapping to registrations and approved applications for the term MAC. This indicates that the likelihood of confusion between a mark containing MAX/MAXX and a mark containing MAC, is low. (February 16, 2018 Response to Office Action, TSDR p. 4). We have bolded the identical or overlapping goods and services for convenience.

Trademark	Full Goods/Services	Status/ Owner
MAXX (Stylized) RN: 4211565 SN: 85469668	Class 3: detergents for household use	Registered: September 18, 2012 U.S. Soaps Manufacturing Company
MAC RN: 1070071 SN: 73107743	Class 3: general purpose cleaner for sinks, toilet bowls, tile walls and floors, stainless steel, and the like	Registered: July 26, 1977 Minuteman International, Inc.
MAXX RN: 2908610 SN: 78319305	Class 6: stainless steel bars	Registered: December 7, 2004 Thyssenkrupp Materials Na, Inc.
MAC and Design RN: 4854307 SN: 86523387	Class 6: carbon steel structural , ornamental, and mechanical tubing and pipes	Registered: November 17, 2015 Maruichi American Corporation

Trademark	Full Goods/Services	Status/ Owner
MAC RN: 1974452 SN: 74322001	Class 7: electric power tools , namely, drills, wrenches, hydraulic power tools, namely, sprayers, air brushes, rivet guns and riveters; pneumatic and air power tools and accessories, namely, air ratchets, air wrenches, air drills, grinders; cut-off tools, namely, cut-off wheels for exhaust work and engine rebuilding, cut-off wheel mandrels, buffers, scrapers, screwdrivers, punch and flange tools, rivet guns and riveters, air saws, air saw and file tool, air sanders, air polishers not for use on floors, air hammers, bits, shanks, grinders, burrs, stones, blades, files, sander belts and pads, sanding shoes, chucks, safety retainers, abrasive and grinding wheels, disc holders, air fittings and couplers, tire chucks, chuck keys, drills, drill sharpeners, drill gauges, hole saws and cutters; and parts and fittings for all the aforesaid goods *goods shortened for relevancy	Registered: May 21, 1996 Stanley Logistics, LLC
MAX and Design RN: 4304096 SN: 85569109	Class 7: electric hand screwdrivers; electric hand drills; electric hand cutting tools; machines, namely, saws; electric scissors	Registered: March 19, 2013 Max Co., LTD.
MAX and Design RN: 4924853 SN: 79170336	Class 7: powered fastener driving tools for use in driving fasteners into wood , metal, masonry or concrete substrates, namely, drills, screwdrivers, nailing machines, tackers, nailing guns and rivet guns	Registered: March 29, 2016 Max Co., LTD.
MAC RN: 1974452 SN: 74322001	Class 8: non-power operating hand tools for automotive mechanics, namely, sockets and wrenches, drivers, ratchets and attachments therefor, wrenches, hex keys, screwdrivers, nut drivers, screw starters, punches, chisels, hammers, mallets, pry bars, pliers, files; file accessories, namely, file cleaners and handles; hacksaws, snips, bolt cutters, pocket knives, saws, scissors; sharpening tools, namely, sharpeners and sharpening stones; picks, scribes, scrapers, tweezers, hexagon threading and rethreading dies, die stocks, extractors, flaring tools, tube cutters, oil filter wrenches, soldering guns; battery tools, namely, battery pliers, terminal pullers, crimping tool for repairing and replacing battery cable terminal ends, battery cable cutters, battery terminal and post cleaner, battery terminal reshaper, battery post and terminal tool used to make contact between post and terminal, battery terminal box wrenches, hex-nut pliers, clamp spreader and cleaner, battery tool service kit comprised of battery pliers, terminal pullers, side post cleaner, clamp spreader, and battery carrier;	Registered: May 21, 1996 Stanley Logistics, LLC

Trademark	Full Goods/Services	Status/ Owner
	<p>cooling system and radiator tools, namely, anti-freeze and coolant testers, cooling system pressure testers, adapters, radiator temperature gauge, cooling system flush tool, radiator petcock socket, radiator cap off tool, specialty pliers, heater core tube straightener, hose cutters and slitters; piston tools, namely, ring groove cleaners, ring compressors, ring compressors, gasket cutter set, piston ring installer, piston hammer, engine and engine component holding fixture; valve tools, namely, valve spring compressors, valve spring compressor adapter tools, specialty screwdrivers, valve tappets remover, valve guide drivers, specialty wrenches, exhaust tools, namely, exhaust and tailpipe reshaping and stretching tools, stretcher for removing and installing exhaust mounting hangers, muffler/tailpipe cutoff tool, muffler chisel, and tail and exhaust pipe remover, specialty wrenches, punch and bolts; and parts for all of the aforesaid goods</p> <p>*goods shortened for relevancy</p>	
<p>MAX RN: 4532471 SN: 86022803</p>	<p>Class 8: hand tools, namely, a multipurpose hand tool with multiple attachments comprised of an ax, shovel, pick, rake, hoe, and storage bag, sold as a unit; hand-operated impact wrenches</p>	<p>Registered May 20, 2014 Forrest Tool Company, Inc.</p>
<p>MAC RN: 4040131 SN: 77855339</p>	<p>Class 12: fitted covers for boats and marine vehicles; bimini tops; cup holders for use in marine vehicles; boat paddles and oars; oarlocks; non-metal boat cleats</p>	<p>Registered: October 18, 2011 The Coast Distribution System, Inc.</p>
<p>MAC RN: 4100613 SN: 77981354</p>	<p>Class 12: boat seats</p>	<p>Registered: February 21, 2012 The Coast Distribution System, Inc.</p>
<p>MAX and Design RN: 3159089 SN: 79015271</p>	<p>Class 12: boats, inflatable boats</p>	<p>Registered: October 17, 2006 Z Marine International S.R.L.</p>
<p>MAC and Design RN: 4184695 SN: 78626371</p>	<p>Class 18: carry all bags, cosmetic bags sold empty, shoulder bags, tote bags, clutch bags and travel bags</p>	<p>Registered August 7, 2012 Estee Lauder Cosmetics LTD.</p>

Trademark	Full Goods/Services	Status/ Owner
MAC RN: 3237448 SN: 78945323	Class 18: carry-all bags; clutch bags; cosmetic bags sold empty; roll bags; travelling bags ; waist bags	Registered: May 1, 2007 Estee Lauder Cosmetics LTD.
MAX and Design RN: 5169065 SN: 79193929	Class 18: leather and imitations of leather; animal skins, hides; trunks and travelling bags ; handbags, rucksacks, purses ; umbrellas, parasols and walking sticks; whips, harness and saddlery; clothing for animals	Registered March 28, 2017 Maximilian Jewellery LTD.
MAC RN: 439367 SN: 71506678	Class 23: mechanics' hand tools -namely, screwdrivers, cold chisels, punches, wrenches of various sizes and designs, hammers, awls, pliers, and files	Registered: June 22, 1948 Stanley Logistics, L.L.C.
MAX (Stylized) RN: 922756 SN: 72316015	Class 23: hand and power operated staplers ; wire stitchers; tackers; nailing machines ; machines for removing staples, stitches, nails, tacks, rivets, screws and the like; clinching tools; clip applying tools; hog-ringers; tools for twisting and/or tying wire; hand tool for applying tape; electric scissors; and machines for packaging articles in nets	Registered: October 26, 1971 Max Company Limited
MAC RN: 3880273 SN: 77327068	Class 25: clothing , namely, trousers, shorts	Registered: November 23, 2010 Mac Mode GmbH & Co KgaA, Mac Mode Verwaltungs-GmbH & Co. Beteiligungs Kg, Germany, General Partner
MAX RN: 4949034 SN: 86451821	Class 25: hats; hooded sweatshirts; jackets; shirts ; sports caps and hats; sweat shirts ; woolly hats; all of the foregoing goods related to live musical performances by an entertainer	Registered May 3, 2016 Jawline Inc.
MAXX (Stylized) RN: 4844059 SN: 86397256	Class 35: retail department store services	Registered November 3, 2015 Nbc Fourth Realty Corp.
MAC SN: 87311762	Class 35: retail store services , online store services, and wholesale distributorship services featuring printers, wide format printers, packaging equipment, packing supplies, janitorial and sanitation products	Published January 23, 2018 Mac Papers, Inc.

Trademark	Full Goods/Services	Status/ Owner
MAC and Design RN: 3092847 SN: 78626418	Class 35: on-line retail store services in the field of cosmetics, personal care products, toiletries, fragrances, skin care products; and retail store services in the field of cosmetics, personal care products, toiletries, fragrances, skin care products	Registered: May 16, 2006 Estee Lauder Cosmetics LTD.
MAC RN: 4540164 SN: 85940931	Class 36: insurance services, namely, underwriting financial guaranty insurance for municipal obligations	Registered May 27, 2014 Assured Guaranty LTD.
MAX and Design SN: 86314759	Class 36: provision of a financial exchange for trading mortgages and mortgage-backed assets and securities; financial services, namely, an exchange and clearinghouse for the purchase and sale of mortgage loans and mortgage-related assets and securities; mortgage banking services, namely, arranging for loans, loan pricing, counterparty financial risk management, loan underwriting , namely, loan review, loan settlement, loan servicing, loan surveillance; compiling and analyzing mortgage loan data for financial purposes	Allowed - Intent to Use 5th Extension of Time Granted December 11, 2018 Maxex, LLC
MAX RN: 2866938 SN: 78306256	Class 36: underwriting of property and casualty insurance	Registered: July 27, 2004 Mutualaid Exchange
MAC and Design RN: 620128 SN: 71660261	Class 39: railroad freight transportation as a common carrier in inter-state commerce	Registered: January 24, 1956 Central Michigan Railway Company, Db Detroit and Mackinac Railway Company
MAX and Design RN: 5194858 SN: 87146391	Class 39: bus transport , bus chartering, transportation management services, namely, planning and coordinating transportation of people for others ; transportation of passengers and/or good by bus; transportation reservation services	Registered: May 2, 2017 Truenorth Transit Group LLC
MAC and Design RN: 5169377 SN: 86871810	Class 41: film production	Registered: March 28, 2017 Enigma Mac Productions, Inc.

Trademark	Full Goods/Services	Status/ Owner
MAX RN: 4272417 SN: 85694671	Class 41: entertainment services in the nature of providing entertainment programming and content, namely, motion pictures and television programs, and related video clips, graphics and information in the fields of comedy, drama, action, variety, adventure and animation, via television, cable and satellite systems, the internet, electronic communications networks, computer networks and wireless communications networks; entertainment services in the nature of video and audio programming, television and motion picture programming ; premium and pay television programming services	Registered January 8, 2013 Home Box Office, Inc.
MAX & Design RN: 4,211,061 SN: 85/334,894	Class 2: Aerosol spray paints	Registered: September 18, 2012 Swimc LLC
MAC'S RN: 1,011,993 SN: 73/029,941	Class 2: compositions in the nature of coatings, additives and aerosol sprays for the prevention and inhibition of rust and corrosion on metallic surfaces and paints and enamels for automotive tires	Registered: June 3, 1975 National Automotive Parts Association
MAX RN: 3,077,651 SN: 78/430,438	Class 3: Skin care lotion enriched with vitamins C, E and B5, and with grapeseed oil and aloe vera	Registered: April 4, 2006 Shumate, David D.

Trademark	Full Goods/Services	Status/ Owner
MAC (Stylized) RN: 1,642,532 SN: 73/734,276	Class 3: cosmetics, namely, eye shadow, eye make-up remover, eye liner, foundation make-up, face powder, lipstick, lip gloss, lip shiner, mascara, nail polish, eyebrow pencil, rouge, face shimmers, [hair tints,] body lotions, moisture lotion , moisture tonics, skin cleaner, [hair shampoo, hair conditioner, non-medicated hair conditioner, non-medicated hair preparations,] dusting powder, facial moisturizers.	Registered: April 30, 1991 Estee Lauder Cosmetics Ltd.
MAX & Design RN: 5,169,065 SN: 79/193,929	Class 14: Precious metals and their alloys; jewellery , costume jewellery, precious stones, clocks and watches	Registered: March 28, 2017 Maximilian Jewellery Ltd.
MAC'S (Stylized) RN: 4,389,670 SN: 85/794,336	Class 14: Jewelry	Registered: August 20, 2013 TJM USA LLC

(February 16, 2018 Response to Office Action, Exhibit B; September 12, 2018 Request for Reconsideration, Exhibit E).

D. APPLICANT'S MARK AND THE CITED MARK CURRENTLY CO-EXIST INTERNATIONALLY WITH NO LIKELIHOOD OF CONFUSION

Applicant's Mark and the Cited Mark currently co-exist on two international registers without a likelihood of confusion. (September 12, 2018 Request for Reconsideration, TSDR p. 5). Applicant has filed several applications internationally for the mark AUTOMAXX and two of those applications were filed covering countries where Registrant owns registrations for AUTOMAC. Applicant's AUTOMAXX mark currently co-exists with Registrant's AUTOMAC mark in the European Union, which covers twenty-eight (28) different countries. *Id.*

Additionally, Applicant owns a pending application in China for AUTOMAXX. While this application received an office action, the office action did not cite Registrant’s Chinese registration for AUTOMAC as a bar to registration. *Id.* The cited mark has now cancelled and Applicant’s application in China will register in due course. Therefore, Applicants AUTOMAXX mark will peacefully co-exist on two international registers covering twenty-nine countries with Registrant’s AUTOMAC mark. (*Id.* at Exhibit H). Applicant submits that confusion is clearly unlikely.

Country	Mark	Goods	Status
EU	AUTOMAXX Reg. No. 1301329	7: Packaging machines for wraps	Registered: April 18, 2016
China	AUTOMAXX App. No. 1301329	7: Packaging machines for wraps	Pending Applicant received a refusal based on a now cancelled registration. Applicant’s mark in China will proceed to registration in due course. Notably, Registrant’s mark in China was not cited against Applicant’s mark in China.

Country	Mark	Goods	Status
EU	AUTOMAC Reg. No. 1350161	7: Automatic and manual machines for packaging and wrapping in general	Registered: August 29, 2006
China	AUTOMAC Reg. No. 15812833	7: Packing machine	Registered: November 28, 2016

(*Id.*).

II. CONSUMERS OF THE PARTIES' GOODS ARE SOPHISTICATED

The sophistication of the buyer is an important factor, which lessens the likelihood of confusion, because of the amount of care exercised for each purchase. (June 8, 2017 Response to Office Action TSDR p. 5) *See* TMEP § 1207.01(d)(vii); *Astra Pharmaceutical Products, Inc. v. Beckman Instruments, Inc.*, 718 F.2d 1201, 1206, 220 USPQ 786, 791 (1st Cir. 1983). *Id.* This is especially apparent for expensive goods. *Id. See Checkpoint Sys. v. Check Point Software Techs, Inc.*, 269 F.3d 270, 284, 60 USPQ2d 1609 (3d Cir. 2001) (affirming decision finding no likelihood of confusion and declaring that “the price level of the goods or services is an important factor in determining the amount of care the reasonably prudent buyer will use”). Courts have held that “there is always less likelihood of confusion where goods are expensive and purchased after careful consideration.” *Electronic Design & Sales, Inc. v. Electronic Data Systems Corp.*, 954 F.2d 713, 718, 21 USPQ2d 1388 (Fed. Cir. 1992) (no likelihood of confusion when opposer’s computer services were very expensive and purchased by experienced corporate officials). *Id.* Under conditions involving complex or expensive goods or services, consumers tend to be more careful and knowledgeable about the available options and particularly careful in making their final purchase. *Id.* Moreover, such consumers are unlikely to confuse products based on their trademarks. *See, e.g., In re Software Design, Inc.*, 220 USPQ 662 (TTAB 1983). *Id.*

Applicant’s goods are of a highly specialized nature and are for sale through contractual agreement only to major brewers and beverage packagers. (November 14, 2016 Request for Reconsideration TSDR p. 6) Accordingly, Applicant submits that, in addition to Applicant’s goods being sufficiently different from those for which the Cited Marks are used to avoid a

likelihood of confusion, the relevant purchasers of Applicant's goods are likely to take great care in the purchase of Applicant's products and therefore will unquestionably know, and distinguish, the source of Applicant's goods. Applicant's machine packages bottles in wraps and cartons, whereas the Cited Mark's machine packages fresh products in trays, for example the type of packaging that comes around chicken products in a grocery store. *Id.* The type of consumer purchasing or leasing Applicant's machines would not be purchasing or have use for Registrant's machines. Lastly, the products greatly differ in appearance and cost, which would further differentiate them to potential customers. While the Registrant's machines are around 1.5m x 3m in size, Applicant's machines are around 2.25 m x 13.3 m in size. *Id.* Additionally, Applicant's machines cost more than 1 (one) million dollars. A consumer who is purchasing a large machine for more than 1 (one) million dollars is certainly buying with great care and would understand that there is no association between Applicant and Registrant. *Id.* Therefore, due to the degree of care that these consumers would exercise in purchasing Applicant's goods and Registrant's goods, confusion is not likely.

CONCLUSION

Registrant's AUTOMAC mark should not be considered a bar to Applicant's registration of its AUTOMAXX mark. There is no likelihood of confusion between the two marks due to the differences in the parties' marks and goods and the sophistication of consumers. Accordingly, Applicant respectfully requests the Board to reverse the Examiner's refusal to register Applicant's AUTOMAXX mark.

This 17th day of December, 2018.

Respectfully submitted,

/Laura A. Kees/

Laura A. Kees

WOMBLE BOND DICKINSON (US) LLP

271 17th Street NW

Suite 2400

Atlanta, GA 30363

Tel: (404) 879-2427

Fax: (919) 755-6093

Email: laura.kees@wbd-us.com

Attorney for Graphic Packaging International, LLC

CERTIFICATE OF MAILING

I do hereby certify that on December 17, 2018, I filed via electronic means (ESTTA) APPLICANT'S APPEAL BRIEF with the:

U.S. Patent and Trademark Office
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, Virginia 22313-1451

/Emily S. Whittaker/
Emily S. Whittaker