

RESPONSE TO OFFICE ACTION

This is in response to Office Action No. 1, with a mailing date of October 31, 2017. The Examining Attorney has refused registration of The Dow Chemical Company's (hereinafter "Dow") trademark application for SUSTAIN based on a potential for likelihood of confusion with the mark SUSTAINICS, U.S. Registration No. 5107201. Trademark Act Section 2(d), 15 U.S.C. §1052(d); see TMEP §§1207.01 *et seq.* In light of the fact that SUSTAINICS was allowed during the pendency of Dow's prior existing application for SUSTAIN, the difference in the marks, and the differences in the goods the refusal is respectfully traversed and reconsideration is requested in view of the following comments.

1. Prior Coexistence of SUSTAIN and SUSTAINICS

As a preliminary matter, Dow would like to respectfully bring to the Examining Attorney's attention the fact that the Trademark Office has previously allows Dow's intent-to-use application in Class 1.

Dow was the owner of Trademark Application Serial No. 86222974 for SUSTAIN, which was filed on March 17, 2014, and allowed on August 12, 2014. This prior application went abandoned because use had not commenced despite business efforts prior to September 18, 2017. See attached Exhibit A. A new trademark application for SUSTAIN was submitted on August 11, 2017.

The SUSTAINICS application was filed on May 5, 2016, and registered on December 27, 2016. The two trademarks coexisted on the register in Class 1 for one year before the instant SUSTAIN application was refiled. This prior coexistence is strong evidence that there is no likelihood of confusion between the two trademarks.

2. Likelihood of Confusion

The Examining Attorney has refused the applied for mark, SUSTAIN, because of the potential for likelihood of confusion with the following mark:

- Registration No. 5107201 for the mark SUSTAINICS, owned by Puraglobe GmbH for, as relevant, "*unprocessed artificial resins*", "*unprocessed plastics*", and "*bases in the nature of chemical preparations, namely, polymer base compositions used in the manufacture of commercial, industrial and domestic goods*" in Class 1.

However, Dow respectfully submits that the marks are dissimilar and that the goods are sufficiently distinct such that there is no likelihood of confusion.

A. The Marks are Dissimilar

When compared as a whole, the trademarks themselves are dissimilar in sight and sound. While the marks do share the "SUSTAIN" formative, the addition of "ICS" at the end of SUSTAINICS gives a completely different sight and sound to the word. Furthermore, the marks are dissimilar in meaning. SUSTAIN is an English word; however, the English meaning has no correlation to the use of SUSTAIN as an "unprocessed synthetic resin." SUSTAINICS appears to be a coined word

with no defined meaning. The owner of SUSTAINICS, Puraglobe GmbH, claims to be a key player in the sustainable oil business. Therefore, it can be assumed that the use of the SUSTAINICS trademark is meant to capitalize on the sustainability of Puraglobe's product offerings. Considering the trademarks in their entirety presents a very different commercial impression even with the common "SUSTAIN" prefix.

B. The Goods are Different

Dow's SUSTAIN application was filed in International Class 1 for "*unprocessed synthetic resins for further manufacturing of seals and insulation in appliances.*" Dow's product is a synthetic resin raw material which is to be used in appliance gasket manufacturing. Dow would provide the unprocessed synthetic resin raw material to licensed compounders to manufacture the final SUSTAIN product for use in appliances, such as refrigerators.

The SUSTAINICS registration is registered in International Classes 1, 4, 35, 37, 40, 42, and 45 for, as relevant, "*unprocessed artificial resins*", "*unprocessed plastics*", and "*bases in the nature of chemical preparations, namely, polymer base compositions used in the manufacture of commercial, industrial and domestic goods*" in Class 1. Puraglobe GmbH provides base oils and solvent technologies ready for use in lubricants, fuels, polymers, coatings, and other products. See attached Exhibit B.

While the goods descriptions are both classified in International Class 1 and do contain the term "resin", the differences between our particular goods of interests and the goods associated with SUSTAIN are such that they are extremely unlikely to cause any confusion on the part of the relevant public. Thus, this reference should not create an obstacle to registration.

3. Conclusion

In view of the foregoing, Dow believes that this application is now in condition for allowance and publication, and notice to that effect is earnestly and respectfully requested. Should the Examiner have further questions regarding this application, please contact the undersigned at the telephone number listed below.

Respectfully submitted,

The Dow Chemical Company

By:  _____

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Dated: April 31, 2018