

## **RESPONSE TO OFFICE ACTION**

This is in response to Office Action No. 1, with a mailing date of March 18, 2018. The trademark Examining Attorney has refused registration of The Dow Chemical Company's (hereinafter "Dow") trademark application for ENHANCER, U.S. Serial No. 87704883, on the grounds that the proposed mark is merely descriptive. Trademark Act Section 2(e)(1), 15 U.S.C. §1052(e)(1); see TMEP §§1209.01(b), 1209.03 *et seq.* In light of the fact that a prior application for ENHANCER was previously allowed, and Dow's use of the proposed mark is not descriptive but arbitrary in nature, the refusal is respectfully traversed and reconsideration is requested in view of the following comments.

### **1. Prior Allowance of Intent-to-Use Application**

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

Dow was the owner of Trademark Application Serial No. 86285340 for ENHANCER, which was filed on May 19, 2014, and allowed on December 2, 2014. This Application was abandoned due to the inability to provide a Statement of Use on January 8, 2018. See attached Exhibit A.

A new trademark application for ENHANCER with an identical specification of goods was submitted under Serial No. 87704883 on December 1, 2017.

### **2. Dow's Use of ENHANCER**

Dow has filed its application with the goods description "chemicals used in industry, namely polyurethane polymer compositions for use in the manufacture of backings for carpet, synthetic turf and carpet padding" in Class 1; however, the Dow's use of the name ENHANCER does not merely describe a characteristic, purpose, or function of the goods.

While one feature of Dow's ENHANCER polyurethane materials is certainly increased strength in carpet backing and synthetic turf, there are a number of other features, such as: high traffic durability, increased carpet performance, comfort and noise reduction, easy and effective cleaning, shock absorption for safer athletic performance, stable playing field, and reduced energy consumption. Dow's ENHANCER Sport Systems are used for cushioning artificial turf and improving its appearance. See attached Exhibits B, C, D, E, and F for further examples of Dow's use of the ENHANCER mark.

Dow maintains its use of the word ENHANCER is not descriptive, but arbitrary in nature. Arbitrary marks comprise words that are in common linguistic use but, when used to identify particular goods or services, do not suggest or describe a significant ingredient, quality, or characteristic of the goods or services. Examples of arbitrary trademarks include APPLE (computers), SHELL (petrol products and services), and CAMEL (tobacco). *Nautilus Grp., Inc. v. Icon Health & Fitness, Inc.*, 372 F.3d 1330, 1340, 71 USPQ2d 1173, 1180 (Fed. Cir. 2004) defines an arbitrary mark as "a known word used in an unexpected or uncommon way." While

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ENHANCER is a common dictionary word, the word ENHANCER is in no way related to the applied-for goods of “polyurethane polymer compositions for use in the manufacture of backings for carpet, synthetic turf and carpet padding.” ENHANCER is defined in the Merriam-Webster dictionary as “one that enhances” and in the Oxford dictionary as “a person or thing that enhances something.” In contrast, the ENHANCER brand name is used to identify polyurethane polymer composite material used in carpet backing and synthetic turf applications. The use of a dictionary word in connection with unrelated products makes it an arbitrary trademark. A consumer would not automatically assume that the word “ENHANCER” as defined in the Merriam-Webster and Oxford dictionaries has any relation to carpet backing or synthetic turf materials. Therefore, the use of ENHANCER in connection with carpet backing and synthetic turf makes it inherently distinctive.

### 3. Conclusion

Accordingly, the mark ENHANCER is not associated with any characteristic, quality or function of the product. It is a nominative word used as an arbitrary trademark and, therefore, is an inherently distinctive trademark.

In view of the foregoing, Applicant 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: September 18, 2018