

RESPONSE TO OFFICE ACTION IN APPLICATION NO. 88352431

The Examining Attorney has refused registration of Applicant's Mark THERMOSEAL for "heat and pressure activated self-locking adhesive coatings for use on threaded metal fasteners and other discrete metal objects, namely, industrial adhesives for use on metal fasteners and metal fastener components providing self-locking and vibration resistant properties to fasteners used in high temperature environments" in Class 1 on the ground that Applicant's Mark is likely to be confused with Cited Mark THERMOSEAL for "high temperature resistant fluid coatings for industrial use for protecting surfaces against erosion, corrosion, abrasion and spalling caused by flames, hot gasses and molten metals" in Class 2. Applicant respectfully submits that because of differences in the goods offered under Applicant's Mark and the Cited Mark, the differences between the markets in which such goods are sold, and the coexistence of several other registered marks using the name THERMOSEAL or variations thereof for other coating and heat resistant products showing that the market can clearly distinguish between even relatively narrow differences in the products, there is no likelihood of confusion with Applicant's Mark.

The differences in Applicant's and the Cited Mark's products are sufficient to prevent confusion. Although they are both "coatings," they perform very different functions, involve distinct technologies, and are sold to entirely different sophisticated markets. The purpose of Applicant's product is to keep fasteners, like screws, in place despite vibration and shock. This is accomplished through a chemical reaction that results in a self-sealing and self-locking cure between the fastener and what it is fastened to. On the other hand, the Cited Mark's product is a specialized insulation product whose purpose is flame-resistance and anti-corrosion. Vibration

resistance for keeping a fastener in place is a very different purpose than resistance to corrosion from extreme heat caused by flames, hot gasses and molten metals.


Simply because goods are related to the same broad field or have the same broad general characteristics does not mean that they overlap sufficiently to cause confusion. See *Electronic Design & Sales v. Electronic Data Systems*, 954 F.2d 713, 21 U.S.P.Q. 2d 1388 (Fed. Cir. 1992). Accordingly, the mere fact that both Applicant's and Cited Mark's goods are coatings is not sufficient to create confusion. Applicant's product is distinct from the Cited Mark's product because it is used exclusively on fasteners, not other items, for the purpose of keeping those fasteners from loosening due to pressure, shock, and vibration.

Conversely, the Cited Mark's product is a "thick paint" or "heavy paste" that can be brushed onto a variety of surfaces. See the pages attached to this Response from the website of the Cited Mark at <https://mid-mountain.com/wp-content/uploads/datasheets/Thermoseal%20Coatings.pdf>. The primary purpose of the Cited Mark's product generally is for "refractory lining repair" in products such as ovens or furnaces. See the pages attached to this Response from the website of the Cited Mark at <https://mid-mountain.com/high-temperature-resistant-materials/>.

Due in part to the significant differences between them, the products at issue in this case will be marketed and sold in distinct channels of trade. The dissimilarity of the relevant channels of trade must be considered. See *E.I. DuPont DeNemours & Co.*, 476 F.2d 1357, 1361 (C.C.P.A. 1973) (noting that "it is the duty of the examiner . . . to find, upon consideration of all the evidence, whether or not confusion appears likely"). Notably, the market for "coatings" is not generally a single channel of trade. In this case, the products marketed in conjunction with Applicant's Mark and the Cited Mark will be marketed in differing channels of trade due to their

very different purposes. The products marketed under Applicant's Mark will be marketed and sold primarily to sophisticated professional or commercial buyers of fasteners for use in the assembly of industrial machinery. Like Applicant's Mark, the products marketed under the Cited Mark are also marketed toward sophisticated customers for corrosion protection. The purpose of the products of the Cited Mark are too important for it to be an impulse or lightly taken purchase. The protection of very expensive equipment is at stake.

Additionally, Applicant's Mark will not create a likelihood of confusion with the Cited Mark because the weakness of the mark means that even narrow differences between the products will be enough to differentiate them. This is illustrated by the fact that Applicant's Mark and the Cited mark coexist with several other products bearing the mark THERMOSEAL or THERMO-SEAL for products of a similar nature. Thus, the mark is diluted and the markets have become used to differentiating between different products that bear this same mark. The market has clearly come to recognize that there are several coating and heat resistant products on the market from a variety of sources and can distinguish between them. The Trademark Office has also previously recognized that the mark THERMOSEAL can coexist for various products sold in the industrial setting. The USPTO has allowed the following registrations to coexist:

1. THERMO-SEAL, Reg. No. 3451156, in Class 2 for "coatings in the nature of a heat-reflective, waterproofing thermoplastic coating for use on roofs, walls, and exterior wood trim."
2.  THERMOSEAL, Reg. No. 3850356, in Class 11 for "metal frame doors incorporating glass inserts for refrigerated cabinets."
3. THERMOSEAL, Reg. No. 2078145, in Class 17 for "fibrous or rubber non-metal gasket material sold in sheet form for use in industrial . . . applications."

4. THERMOSEAL, Reg. No. 0778145, in Class 7 for “oil, gas, water, and sulphur well tools and equipment.”
5. THERMO-SEAL, Reg. No. 2047759, in Class 19 for “crack and join sealant, hot applied for Portland cement concrete and asphaltic cement concrete pavements.”
6. THERMO-SEAL, Reg. No. 1120522, in Class 17 for “rolls of tape for heat sealing identification tags” and Reg. No. 0773673, in Class 16 for “rolls of tape coated with thermoplastic material from which identification tags are formed” and Reg. No. 1117128, in Class 7 for “machines for heat sealing identification tags to garments and the like.”

TSDR printouts for all of the above marks are attached to this Response.

Attached to this Response are webpages from these registrants which show that the products do truly coexist in the marketplace. The coexistence of these marks—which are each a suggestive play on words indicating the product has something to do with temperature and sealing—indicate that the various customers can differentiate between these products in their various contexts. For example, customers currently differentiate between THERMO-SEAL as a coating for roofs, Reg. No. 3451156, and THERMO-SEAL as a sealant for pavement, Reg. No. 2047759 and the THERMOSEAL Cited Mark for flame-resistance and anti-corrosion coatings, despite the fact that the marks are virtually identical and all are also coating applications. These products are closer in character to the Cited Mark than Applicant’s products are. Accordingly, just like with these products, the relevant customers are able to differentiate and discriminate between the different goods offered under the Cited Mark and Applicant’s Mark. Accordingly, confusion is unlikely.

In summary, the THERMOSEAL mark is weak and customers easily differentiate between the various products that bear it. As a result, the differences in the goods and sophistication of the purchasers concerning Applicant's Mark and the Cited Mark prevent a likelihood of confusion between them as much as the lack of confusion with the numerous other THERMOSEAL/THERMO-SEAL products on the market. Applicant's Mark can coexist with this Cited Mark without confusion as easily, if not easier, than the Cited Mark already coexists in the market with all of these other THERMOSEAL products. For these reasons, there is no likelihood of confusion between Applicant's Mark and the Cited Mark.

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