

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
TRADEMARK EXAMINING OPERATION

Atty. Ref: 720374.3054269

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In re Application of :
Mitsui Chemicals, Inc. :

Serial No.: 85/417,367 :

Filed: September 8, 2011 :

Mark: **MILEX** :
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: Law Office: 113

: Exam. Atty: Amy C. Kean

Commissioner for Trademarks
P.O. Box 1451
Alexandria, VA 22313-1451

"EXPRESS MAIL" Label No.:

I hereby certify that this paper or fee is being deposited with the United Postal Service "Express Mail Post Office to Addressee" service under 37 C.F.R. § 2.198 on the date indicated below and is addressed to the Commissioner for Trademarks, P.O. Box 1451, Alexandria, VA 22313-1451.

Signature

Printed Name

Date June , 2012

DECLARATION

I hereby declare that:

1) I am fully familiar with the use of applicant's trademark "MILEX" in the United States of America.

2) Applicant hereby amends the identification of goods in its above-identified application to read as follows:

Unprocessed synthetic resins; unprocessed plastics in all forms; unprocessed plastics for industrial use; phenolic resins; chemical additives for general industrial use in the manufacture of a wide variety of goods, other than resin softener and maleimide; hardeners with an epoxy resin base, namely, hardening agents for industrial use in the manufacture of flexible foams, rigid foams, elastomers and plastics; chemical photoresists; adhesives for industrial purposes; chemical binding agent for industrial use in the manufacture of textile, fabrics, furs, molding compounds and paint, other than maleimide; binder resins, for general industrial use in the manufacture of a wide variety of goods; chemical binding agents for use in the manufacture of brake pads.

- 3) Applicant has never used the prefix "I" or any other prefix with its trademark "MILEX", and has no intention of doing so.
- 4) Applicant has never used the trademark "MILEX" to identify the goods "N-phenyl maleimide for use in the manufacture of chemical compounds used as resin softening agents and resin modifying agents", and has no intention of doing so.
- 5) Applicant has used the trademark "MILEX" in the U.S.A. since at least as early as 2002, on a continuous basis until the present time, and has never learned of any instances of confusion with the cited trademark "IMILEX". Furthermore, the owner of the cited trademark "IMILEX" has never objected to applicant's use of "MILEX".
- 6) Applicant has made substantial sales of "MILEX" products in the U.S.A.,
e.g.:

Annual sales for 2011	at least \$3,476,000
Annual sales for 2010	at least \$3,006,000
Annual sales for 2009	at least \$2,530,000
Annual sales for 2008	at least \$2,830,000
Annual sales for 2007	at least \$3,298,000
Annual sales for 2006	at least \$3,828,000
Annual sales for 2005	at least \$3,447,000

Annual sales for 2004	at least \$2,449,000
Annual sales for 2003	at least \$1,914,000
Annual sales for 2002	at least \$1,480,000

7) Applicant's leading U.S. customers for "MILEX" products include Akebono Brake Corporation, Nisshibo Automotive Manufacturing, Inc., Federal Mogul Corporation, and SAFA LLC (the manufacturing company of Advics North America). The customers for such goods are all sophisticated industrial buyers who buy the goods only after making detailed analyses of the properties, specifications and uses of the goods in order to ensure that they will satisfy their needs and requirements.

8) Applicant has also made presentations for its "MILEX" products to the Society of Automotive Engineers' "Brake Colloquium & Exhibition" for approximately the last ten years. As a result of applicant's overall sales and promotional efforts, the "MILEX" trademark has achieved a distinct identity in the marketplace for industrial chemicals, particularly among the manufacturers of brake pads and also in the electronics industry where resins for hostile environments are required.

9) Applicant has expended the following sums in advertising its "MILEX" products in the U.S.A.:

Annual advertising for 2011	at least \$6,100
Annual advertising for 2010	at least \$5,300
Annual advertising for 2009	at least \$6,000
Annual advertising for 2008	at least \$6,000
Annual advertising for 2007	at least \$6,000
Annual advertising for 2006	at least \$6,000

Annual advertising for 2005	at least \$6,000
Annual advertising for 2004	at least \$6,000
Annual advertising for 2003	at least \$6,000
Annual advertising for 2002	at least \$6,000

Annexed to this "Declaration" are samples of applicant's promotional materials for "MILEX" products, e.g., pages from its website "mitsuichemicals.com", and samples of product labeling, all describing the properties and characteristics of its goods. While the aforementioned dollar amounts expended on advertising are not substantial, applicant's goods are not the type which need to be advertised in expensive mass-market media such as on television or on billboards. Advertising and promoting of the goods on applicant's website costs very little but is directed precisely to the applicant's target customers and markets.

10) Applicant's "MILEX" products have specifically different compositions, functions and uses than the "IMILEX" products sold by the owner of the cited registration. The annexed chart, entitled "Difference between MILEX and IMILEX", sets forth their differences in chemical structures, properties and uses, and supports applicant's position that the respective goods will be bought with a high degree of care for use under distinctly-different conditions.

I further declare that all statements made herein of my own knowledge are true, and all statements made on information and belief are believed to be true; and that said statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of this document or any registration resulting from this application.

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Mark: MILEX
Ser. No.: 85/417,367
Class: 1

Respectfully submitted,

MITSUI CHEMICALS, INC.

Dated: June 28, 2012

By



Print Name: Hiroshi Ito

Title: General Manager, Intellectual Property
Division