

TTAB

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

**In re: Cancellation
No. 92040100**

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**Equistar Chemicals, LP)
(AQUATHENE)**

V.

**Reichhold, Inc.
(AQUATHANE)**
.....

TRADEMARK TRIAL AND
APPEAL BOARD
02 MAY - 3 PM 9:23

04-29-2002
U.S. Patent & TMO/TM Mail Rcpt Dt. #66

**REQUEST FOR DISMISSAL OF CANCELLATION ACTION
AGAINST AQUATHANE; WITHDRAWAL OF FINAL REJECTION
AND ISSUANCE OF NOTICE OF ALLOWANCE FOR AQUATHENE**

Commissioner for Trademarks
Attention: Box TTAB
2900 Crystal Drive
Arlington, VA 22202-3513

Dear Sir:

The above-identified cancellation action was brought by Equistar Chemicals LP ("Applicant") responsive to the final rejection of its Application Serial No. 75628350 for AQUATHENE in Int. Class 17as being confusingly similar to Reg. No. 1899494 for AQUATHANE in Int.Class 01 owned by Reichhold, Inc. ("Registrant").

Relevant to the issue of likelihood of confusion, Registrant has provided Applicant with a "Consent to Register" AQUATHENE application Ser. No. 75628350 over AQUATHANE Reg No. 1899494. Although the consent is merely pro forma, the parties have taken a number of steps to ensure against confusion. The parties have entered into an Operating Agreement whereby AQUATHENE and AQUATHANE will be able to co-exist. The agreement provides, among other things, that the parties will designate representatives who will periodically review and set procedures to ensure against public confusion. An additional important step taken by the parties to ensure against confusion was to agree not to use, license, register or attempt to use, license or register each others' mark for goods or services in any class.

SP

The cases go both ways on "Consents to Register" being determinative of likelihood of confusion. The effectiveness of a consent, whether pro forma or comprehensive, ultimately depends on the specific facts of the case. It is submitted that the facts in the present situation are so stacked in Applicant's favor that the Board can overturn the examiner's rejection and issue a notice of allowance as a matter of law.

Factual issues that favor registration of AQUATHENE include the following:

(1) Applicant did not adopt AQUATHENE as a Jonnie-Come-Lately trying to ride on the coattails of AQUATHANE, but rather Applicant was recalling to active duty an asset that it and its predecessor companies had been using periodically for over twenty-five years as shown by AQUATHENE Reg. No. 0843049 (copy attached) registered to National Distillers, a predecessor of Applicant, from 1968 to 1992 for Int. Class 01 goods.

(2) "AQUA" is a commonly used prefix for chemically related trademarks and service marks that have usages or applications associated or connected with water. There are numerous applications and registrations on the Principal Register in the chemical field owned by multiple parties relating to goods and services that have AQUA prefixes. In this environment anyone who uses a suffix with AQUA that is unique and non-descriptive of the goods or services is probably entitled to federal registration.

(3) "ENE" and "ANE" represent commonly used suffix nomenclature for chemicals. There is a big difference chemically between an "ene" product and a "ane" product, e.g., there is a world of difference between an alkene and an alkane. Therefore, rather than being viewed as being similar or related products, AQUATHENE and AQUATHANE would, to the contrary, be considered by the purchasing agents as belonging to different classes of products.

(4) Registrant's mark is classified in Int. Class 01. While Applicant's mark was filed in Int. Class 01, it was re-classified by the Examiner in Int. Class 17. The fact that the Examiner required Applicant to amend to Class 17 confirms that differences clearly exist between Applicant and Registrant's goods since otherwise they would not have been reclassified.

(5) And last but not least, the applications and uses of the products claimed by the parties in their statements of goods are different; neither product can be substituted for the other; the products are marketed to different industries.

DISMISSAL OF CANCELLATION

Applicant with the consent, knowledge and approval of Registrant requests that the subject cancellation against AQUATHANE be dismissed with prejudice.

WITHDRAWAL OF FINAL REJECTION
AND GRANT OF NOTICE OF ALLOWANCE

Applicant further requests that the Board, while it has jurisdiction over the matter, withdraw the final rejection and issue a Notice of Allowance for AQUATHENE. Termination of the cancellation and issuance of the subject application were dealt with collectively by the parties and desirably both should be similarly handled by the Board. However, if internal procedures prevent this, then Applicant respectfully requests then the matter be referred forthwith to the examining attorney.

ADDITIONAL FEES:

Please charge any additional filing or late fees that are acquired and have not been submitted previously to Applicant's Trademark Office account as indicated below. Use of this account has been approved by Vickie Thomas, Paralegal for Equistar Chemicals, LP.

Equistar Chemicals, LP
Account No. 122493

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SPECIAL CONSIDERATION

If Applicant has failed to observe any formalities relative to this cancellation, indulgence by the Board is respectfully requested. The attorney for Applicant handling this matter had had major surgery in December, 2001 which resulted in a three week stay in the hospital followed by another week in the hospital in February of this year and yet another operation in April, which effects he is still recovering from. In view of Applicant's attorney's recent medical condition, Registrant had graciously permitted Applicant to take whatever extensions were a reasonably necessary to put on hold any responses due from Applicant pending termination of the cancellation action. Of course, rescheduling the various docket dates becomes a moot issue with dismissal of the cancellation.

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Copies of this document with attachments including the "Consent to Register" and a database printout of Reg. No. 0843049 are submitted in triplicate.

Respectfully submitted,

Robert E. Lee, Jr.
Robert E. Lee, Jr.
Member of the Texas Bar
972-606-5224 V.M.
214-403-8833 Mobile

4 - 24 - 02

Date

CERTIFICATE OF MAILING

I, the undersigned, certify under 37CFR1.10 that this correspondence is being deposited by me with the U.S. Postal Service on the date indicated below in an envelop, first class postage prepaid, addressed to Box TTAB, Commissioner For Trademarks, 2900 Crystal Drive, Arlington, VA 22202-3513.

R E Lee Jr

R.E. Lee, Jr.

4-24-02

date of mailing/signature

CERTIFICATE OF SERVICE

I, the undersigned, CERTIFY that a COMPETE COPY of the "REQUEST FOR DISMISSAL OF CANCELLATION ACTION AGAINST AQUATHANE; WITHDRAWAL OF FINAL REJECTION; ISSUANCE OF NOTICE OF ALLOWANCE FOR AQUATHENE" WAS DEPOSITED BY ME WITH THE U.S. POSTAL SERVICE, on the date indicated below, in an envelop, first class postage prepaid, addressed to Joan Grace, Legal Assistant, Reichhold, Inc., 2400 Ellis Road, Durham, North Carolina 277035543.

R E Lee Jr

R.E. Lee, Jr.

4-24-02

date of mailing/ signature

Herbert J. Zeh, Jr.
Senior Vice President
Phone: 919-990-7864
Fax: 919-990-7707
e-mail: herb.zeh@reichhold.com

March 18, 2002

Mark: AQUATHENE
Serial No.: 75628350
Filed: 01-26-1999
Applicant: Equistar Chemicals, L.P.

CONSENT TO REGISTER

To Whom It May Concern:

Dear Sirs:

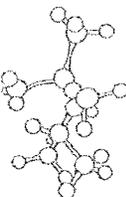
Be advised that Reichhold, Inc. is the owner of U.S. trademark Registration No. 189949 for AQUATHANE which issued on June 13, 1995. It is our understanding that the above-identified application for AQUATHENE has been rejected as being confusingly similar to AQUATHANE.

As the owner of the AQUATHANE registration and mark, we respectfully controvert this rejection and side with the Applicant's attorney that it is unlikely that any public confusion will result if AQUATHENE and AQUATHANE are allowed to co-exist on the Principal Register.

Therefore, this letter may be taken as our approval and consent for AQUATHENE to register to Equistar Chemicals, L.P.

Sincerely,


Herbert J. Zeh, Jr.
Senior Vice President



Thank you for your request. Here are the latest results from the TARR web server.

This page was generated by the TARR system on 03/07/2002 01:12:32 ET

Serial Number: 72260353

Registration Number: 843049

Mark

AQUATHENE

(words only): AQUATHENE

Current Status: This registration was not renewed and is considered to be expired.

Date of Status: 1992-11-03 (C A p s e d)

Filing Date: 1966-12-08 (r e l l e d)

Registration Date: 1968-01-30 (s e r i a l)

Law Office Assigned: Unknown

CURRENT APPLICANT(S)/OWNER(S)

1. NATIONAL DISTILLERS AND CHEMICAL CORPORATION

Address:

NATIONAL DISTILLERS AND CHEMICAL CORPORATION
99 PARK AVE.
NEW YORK, NY 10016
United States

Country of Citizenship: United States

Incorporated in State: Virginia

Legal Entity Type: Corporation

GOODS AND/OR SERVICES

PLASTIC RESIN

U.S. Class: 001 (International Class 001)

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