

ESTTA Tracking number: **ESTTA218053**

Filing date: **06/16/2008**

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

Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

Opposer Information

Name	Maxtech Manufacturing Inc.
Granted to Date of previous extension	06/15/2008
Address	600 Weber Street North Waterloo, ON N2V 1K4 CANADA

Attorney information	Paul A. Keller/Jessica S. Sachs Harness, Dickey & Pierce, P.L.C. 5445 Corporate Drive, Suite 200 Troy, MI 48098 UNITED STATES jsachs@hdp.com Phone:248-641-1600
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Applicant Information

Application No	78926485	Publication date	12/18/2007
Opposition Filing Date	06/16/2008	Opposition Period Ends	06/15/2008
Applicant	Bessey Tools Ltd. P.O. Box 490 Cambridge, N1R 5V5 CANADA		

Goods/Services Affected by Opposition

Class 008. First Use: 2006/06/13 First Use In Commerce: 2006/06/13
All goods and services in the class are opposed, namely: Hand tools, namely, clamps

Grounds for Opposition

Priority and likelihood of confusion	Trademark Act section 2(d)
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Marks Cited by Opposer as Basis for Opposition

U.S. Registration No.	2480222	Application Date	07/30/1997
Registration Date	08/21/2001	Foreign Priority Date	NONE
Word Mark	MAXTECH		
Design Mark			
Description of Mark	NONE		

Goods/Services	Class 008. First use: First Use: 1996/11/30 First Use In Commerce: 1997/08/31 hand tools, namely, screwdrivers, hex keys and , tool cases therefor, sold as a unit with the hand tools		
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U.S. Registration No.	2615448	Application Date	04/05/2001
Registration Date	09/03/2002	Foreign Priority Date	NONE
Word Mark	MAXTECH		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 007. First use: First Use: 1997/11/17 First Use In Commerce: 1997/12/30 Power tool accessories namely step drills, hinge drills, hole enlarging bits, router bits, auger bits; drill bits, hex shank drill bits, flat bits, wood boring bits, screw guides, tabs, drywall depth setters, double ended holders for combination drill and driver, masonry drill bits, brad point drill bits, forstner bits, screwdriver bits, nutsetters, socket adapters, plug cutters, screw drivers, nut drivers, mandrels, deburring tool and wire brushes, hole saws, power bit extension, drill depth stops, countersinks and carrying cases for the same		

U.S. Registration No.	2715757	Application Date	04/09/2001
Registration Date	05/13/2003	Foreign Priority Date	NONE
Word Mark	MAXTECH		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 007. First use: First Use: 1997/11/17 First Use In Commerce: 1997/12/30 Power tool accessories namely step drills, hinge drills, hole enlarging bits, router bits, auger bits, drill bits, flat bits, wood boring bits, screw guides, taps, drywall depth setters, double ended holders for combination drill and driver, forstner bits, screwdriver bits, nutsetters, socket adapters, plug cutters, screw drivers, nut drivers, mandrels, deburring tools and wire brushes, hole saws, power bit extensions, drill depth stops, countersinks; carrying cases for any of the preceding, sold together as a unit		

Attachments	75333150#TMSN.gif (1 page)(bytes) 78057379#TMSN.gif (1 page)(bytes) Notice of Opposition.pdf (18 pages)(535779 bytes)
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Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by Overnight Courier on this date.

Signature	/jss/
Name	Jessica S. Sachs
Date	06/16/2008

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

In the Matter of Application Serial No. 78/926,485
Published in the *Official Gazette* of December 18, 2007

MAXTECH MANUFACTURING INC.]	
]	
Opposer,]	
]	
v.]	Opposition No. _____
]	
BESSEY TOOLS LTD.]	
]	
Applicant.]	

NOTICE OF OPPOSITION

Maxtech Manufacturing Inc., a Canadian corporation with its principal place of business at 600 Weber Street North, Waterloo, Ontario, Canada N2V 1K4 ("Opposer"), believes that it will be damaged by registration of the mark shown in the above-identified application in International Class 8 and hereby opposes the same.

The grounds for the Opposition are as follows:

1. Opposer has been and is now using the MAXTECH trademark in connection with hand tools and power tool accessories, since at least as early as 1997.
2. Opposer is the owner of several trademark registrations, and the common law rights associated therewith, in the United States for marks comprised of the term MAXTECH, including the following:

Mark	Reg. No.	Reg. Date	Goods
	2,480,222	8/21/2001	Hand tools, namely, screwdrivers, hex keys and, tool cases therefor, sold as a unit with the hand tools

Notice of Opposition

Serial No. 78/926,485

Page 2 of 6

MAXTECH	2,615,448	9/3/2002	Power tool accessories namely step drills, hinge drills, hole enlarging bits, router bits, auger bits; drill bits, hex shank drill bits, flat bits, wood boring bits, screw guides, tabs, drywall depth setters, double ended holders for combination drill and driver, masonry drill bits, brad point drill bits, forstner bits, screwdriver bits, nutsetters, socket adapters, plug cutters, screw drivers, nut drivers, mandrels, deburring tool and wire brushes, hole saws, power bit extension, drill depth stops, countersinks and carrying cases for the same
	2,715,757	5/13/2003	Power tool accessories namely step drills, hinge drills, hole enlarging bits, router bits, auger bits, drill bits, flat bits, wood boring bits, screw guides, taps, drywall depth setters, double ended holders for combination drill and driver, forstner bits, screwdriver bits, nutsetters, socket adapters, plug cutters, screw drivers, nut drivers, mandrels, deburring tools and wire brushes, hole saws, power bit extensions, drill depth stops, countersinks; carrying cases for any of the preceding, sold together as a unit

Copies of the Certificates of Registration and TARR printouts for the foregoing marks are attached as Exhibit A.

3. Opposer's MAXTECH trademark symbolizes the extensive goodwill, reputation, and consumer recognition built up by Opposer as a result of the considerable time, money and effort spent in advertising and promoting the goods offered under the MAXTECH trademark, and establishing the MAXTECH trademark in the minds of consumers as an indicator of high-quality products. As a result, Opposer's MAXTECH trademark has become, through widespread and favorable public acceptance and recognition, an asset of substantial value as a symbol of Opposer, its quality products and its goodwill.

4. Applicant Bessey Tools Ltd. seeks to register the trademark MAXFLEX for "hand tools, namely, clamps" in International Class 8. Said trademark was published in the December 18, 2007 edition of the *Official Gazette*.

Notice of Opposition

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5. Applicant's application for the MAXFLEX trademark was filed on July 11, 2006 with an asserted date of first use of June 13, 2006. Opposer has been using its MAXTECH trademark, however, since a date earlier than the filing date or date of first use for the MAXFLEX trademark.

6. The MAXFLEX mark is visually and aurally similar to Opposer's MAXTECH trademark and the goods listed in Applicant's application are sufficiently related to the goods offered by Opposer as to be likely to cause confusion, or to cause mistake, or to deceive.

7. Opposer reasonably believes that purchasers, upon encountering Applicant's MAXFLEX mark on or in connection with Applicant's goods, are likely to believe that such goods emanate from, are authorized or sponsored by, are made in accordance with instructions or specifications of, or are in some other way affiliated with or connected to Opposer.

8. Applicant's MAXFLEX mark falsely suggests a connection or association between Opposer and Applicant. When Applicant's MAXFLEX mark is applied to goods traveling in the same channels of trade as those sold by Opposer under the MAXTECH trademark, Applicant's MAXFLEX mark so resembles Opposer's MAXTECH trademark as to be likely to cause confusion and lead to deception or mistake as to the origin of Applicant's goods offered under the MAXFLEX mark. Consequently, Opposer believes that Applicant's use and registration of the MAXFLEX mark will cause consumers to draw a false conclusion about the origin, nature, or quality of Applicant's goods under circumstances where such a conclusion will be material to the consumer's deliberations regarding the purchase of such goods.

9. If Applicant is permitted to register the MAXFLEX mark for the goods specified in the application herein opposed, damage and injury to Opposer would result by reason of the similarity between Applicant's MAXFLEX mark and Opposer's MAXTECH trademark. Persons familiar with Opposer's MAXTECH trademark may be likely to buy Applicant's goods rather than the goods sold by Opposer. Any such confusion inevitably would result in a loss of sales to Opposer. Furthermore, any defect, objection or fault found with Applicant's goods marketed

Notice of Opposition

Serial No. 78/926,485

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and sold under the MAXFLEX mark would necessarily reflect upon and seriously injure the reputation which Opposer has established under its MAXTECH trademark.

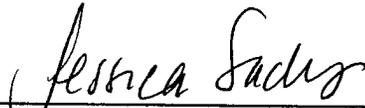
10. If Applicant is permitted to use and register the MAXFLEX mark in association with its goods, confusion in trade resulting in damage and injury to Opposer would result by reason of the similarity between Applicant's mark and Opposer's MAXTECH trademark.

WHEREFORE, Opposer, Maxtech Manufacturing Inc., prays that this opposition be sustained and that Applicant be denied registration of the mark MAXFLEX as identified in application Serial No. 78/926,485 in International Class 8.

The required fee is submitted herewith. The Commissioner is hereby authorized to charge any additional fees which may be required, or credit any overpayment to Deposit Account No. 08-0750.

Respectfully submitted,

Date: 6/16/08



Paul A. Keller
Jessica S. Sachs
Harness, Dickey & Pierce, P.L.C.
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Troy, Michigan 48098
Phone: (248) 641-1600
Fax: (248) 641-0270
Email: jsachs@hdp.com

**Attorneys for Opposer
MAXTECH MANUFACTURING INC.**

CERTIFICATE OF SERVICE

I hereby certify that on this 16th day of June, 2008, I mailed, via DHL overnight courier, postage prepaid, a true and correct copy of the foregoing NOTICE OF OPPOSITION to:

Applicant:

Bessey Tools Ltd.
1165 Franklin Blvd. Unit G
P.O. Box 490
Cambridge, Ontario N1R 5V5
Canada

-and-

Correspondent of Record:

Arne I. Fors
Gowling, Lafleur Henderson LLP
1 First Canadian Place
100 King Street West
Suite 1600
Toronto, Ontario M5X 1G5
Canada



Heather M. Rowe

Notice of Opposition
Serial No. 78/926,485
Page 6 of 6

**EXHIBIT A
TO
NOTICE OF OPPOSITION**

Int. Cl.: 8

Prior U.S. Cls.: 23, 28, and 44

United States Patent and Trademark Office

Reg. No. 2,480,222

Registered Aug. 21, 2001

**TRADEMARK
PRINCIPAL REGISTER**



MAXTECH MANUFACTURING INC. (CANADA
CORPORATION)
620 MCMURRAY ROAD
WATERLOO, ONTARIO, CANADA N2V 2E7

FIRST USE 11-30-1996; IN COMMERCE 8-31-1997.

SN 75-333,150, FILED 7-30-1997.

FOR: HAND TOOLS, NAMELY, SCREWDRI-
VERS, HEX KEYS AND , TOOL CASES THEREFOR,
SOLD AS A UNIT WITH THE HAND TOOLS, IN
CLASS 8 (U.S. CLS. 23, 28 AND 44).

VIVIAN MICZNIK FIRST, EXAMINING ATTOR-
NEY

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

This page was generated by the TARR system on 2008-06-16 13:24:48 ET

Serial Number: 75333150 Assignment Information Trademark Document Retrieval

Registration Number: 2480222

Mark



(words only): MAXTECH

Standard Character claim: No

Current Status: Section 8 and 15 affidavits have been accepted and acknowledged.

Date of Status: 2007-09-11

Filing Date: 1997-07-30

Transformed into a National Application: No

Registration Date: 2001-08-21

Register: Principal

Law Office Assigned: LAW OFFICE 104

If you are the applicant or applicant's attorney and have questions about this file, please contact the Trademark Assistance Center at TrademarkAssistanceCenter@uspto.gov

Current Location: 830 -Post Registration

Date In Location: 2007-09-11

LAST APPLICANT(S)/OWNER(S) OF RECORD

1. Maxtech Manufacturing Inc.

Address:

Maxtech Manufacturing Inc.
620 McMurray Road

Waterloo, Ontario N2V 2E7

Canada

Legal Entity Type: Corporation

State or Country of Incorporation: Canada

GOODS AND/OR SERVICES

International Class: 008

Class Status: Active

hand tools, namely, screwdrivers, hex keys and, tool cases therefor, sold as a unit with the hand tools

Basis: 1(a)

First Use Date: 1996-11-30

First Use in Commerce Date: 1997-08-31

ADDITIONAL INFORMATION

Design Search Code(s):

26.13.01 - Quadrilaterals as carriers or as single or multiple line borders

MADRID PROTOCOL INFORMATION

(NOT AVAILABLE)

PROSECUTION HISTORY

NOTE: To view any document referenced below, click on the link to "Trademark Document Retrieval" shown near the top of this page.

2007-09-11 - Section 8 (6-year) accepted & Section 15 acknowledged

2007-09-06 - Assigned To Paralegal

2007-08-21 - Section 8 (6-year) and Section 15 Filed

2007-08-21 - TEAS Section 8 & 15 Received

2007-02-12 - Case File In TICRS

2002-05-27 - TEAS Change Of Correspondence Received

2001-08-21 - Registered - Principal Register

2001-04-26 - Allowed for Registration - Principal Register (SOU accepted)

2001-02-09 - Assigned To Examiner

2001-02-03 - Statement of use processing complete

2000-11-30 - Amendment to Use filed
2000-05-30 - Notice of allowance - mailed
2000-04-08 - Opposition terminated for Proceeding
2000-04-08 - Opposition dismissed for Proceeding
1999-03-11 - Opposition instituted for Proceeding
1998-12-21 - Opposition papers filed
1998-12-01 - Published for opposition
1998-10-30 - Notice of publication
1998-07-22 - ITU claim added
1998-08-25 - Approved for Pub - Principal Register (Initial exam)
1998-07-22 - Communication received from applicant
1998-04-30 - Non-final action mailed
1998-04-16 - Assigned To Examiner

ATTORNEY/CORRESPONDENT INFORMATION

Attorney of Record

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Correspondent

PAUL A. KELLER

Harness, Dickey & Pierce, P.L.C.

Suite 200

5445 Corporate Drive

Troy MI 48098

Phone Number: (248)641-1600

Fax Number: (248)641-0270

Domestic Representative

Robert H. Ware

Int. Cl.: 7

Prior U.S. Cls.: 13, 19, 21, 23, 31, 34 and 35

Reg. No. 2,615,448

United States Patent and Trademark Office

Registered Sep. 3, 2002

**TRADEMARK
PRINCIPAL REGISTER**

MAXTECH

**MAXTECH MANUFACTURING INC. (CANADA
CORPORATION)
620 MCMURRAY ROAD
WATERLOO, ONTARIO N2V 2E7**

**FOR: POWER TOOL ACCESSORIES NAMELY
STEP DRILLS, HINGE DRILLS, HOLE ENLARGING
BITS, ROUTER BITS, AUGER BITS; DRILL BITS,
HEX SHANK DRILL BITS, FLAT BITS, WOOD
BORING BITS, SCREW GUIDES, TABS, DRYWALL
DEPTH SETTERS, DOUBLE ENDED HOLDERS
FOR COMBINATION DRILL AND DRIVER, MA-
SONRY DRILL BITS, BRAD POINT DRILL BITS,
FORSTNER BITS, SCREWDRIVER BITS, NUTSET-**

**TTERS, SOCKET ADAPTERS, PLUG CUTTERS,
SCREW DRIVERS, NUT DRIVERS, MANDRELS,
DEBURRING TOOL AND WIRE BRUSHES, HOLE
SAWS, POWER BIT EXTENSION, DRILL DEPTH
STOPS, COUNTERSINKS AND CARRYING CASES
FOR THE SAME, IN CLASS 7 (U.S. CLS. 13, 19, 21, 23,
31, 34 AND 35).**

FIRST USE 11-17-1997; IN COMMERCE 12-30-1997.

SER. NO. 78-056,950, FILED 4-5-2001.

JULIE WATSON, EXAMINING ATTORNEY

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

This page was generated by the TARR system on 2008-06-16 13:24:06 ET

Serial Number: 78056950 Assignment Information Trademark Document Retrieval

Registration Number: 2615448

Mark (words only): MAXTECH

Standard Character claim: No

Current Status: Registered.

Date of Status: 2002-09-03

Filing Date: 2001-04-05

Transformed into a National Application: No

Registration Date: 2002-09-03

Register: Principal

Law Office Assigned: LAW OFFICE 104

If you are the applicant or applicant's attorney and have questions about this file, please contact the Trademark Assistance Center at TrademarkAssistanceCenter@uspto.gov

Current Location: 40S -Scanning On Demand

Date In Location: 2007-10-26

LAST APPLICANT(S)/OWNER(S) OF RECORD

1. Maxtech Manufacturing Inc.

Address:

Maxtech Manufacturing Inc.
620 McMurray Road
Waterloo, ON N2V 2E7
Canada

Legal Entity Type: Corporation

State or Country of Incorporation: Canada

Phone Number: 519 885 5336

Fax Number: 519 885 5327

GOODS AND/OR SERVICES

International Class: 007**Class Status:** Active

Power tool accessories namely step drills, hinge drills, hole enlarging bits, router bits, auger bits; drill bits, hex shank drill bits, flat bits, wood boring bits, screw guides, tabs, drywall depth setters, double ended holders for combination drill and driver, masonry drill bits, brad point drill bits, forstner bits, screwdriver bits, nutsetters, socket adapters, plug cutters, screw drivers, nut drivers, mandrels, deburring tool and wire brushes, hole saws, power bit extension, drill depth stops, countersinks and carrying cases for the same

Basis: 1(a)**First Use Date:** 1997-11-17**First Use in Commerce Date:** 1997-12-30**ADDITIONAL INFORMATION**

(NOT AVAILABLE)

MADRID PROTOCOL INFORMATION

(NOT AVAILABLE)

PROSECUTION HISTORY

NOTE: To view any document referenced below, click on the link to "Trademark Document Retrieval" shown near the top of this page.

2007-10-26 - Case File In TICRS

2006-08-11 - Review Of Correspondence Complete

2002-09-23 - PAPER RECEIVED

2002-09-16 - TEAS Change Of Correspondence Received

2002-09-03 - Registered - Principal Register

2002-06-11 - Published for opposition

2002-05-27 - TEAS Change Of Correspondence Received

2002-05-22 - Notice of publication

2002-03-12 - Approved for Pub - Principal Register (Initial exam)

2002-02-13 - Communication received from applicant

2002-01-30 - Communication received from applicant

2001-07-30 - Non-final action mailed

2001-07-19 - Assigned To Examiner

ATTORNEY/CORRESPONDENT INFORMATION

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Correspondent

Paul A. Keller

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P.O. Box 828

Bloomfield Hills MI 48303

Phone Number: (248) 641-1600

Fax Number: (248) 641-0270

Domestic Representative

Ware, Fressola, Van Der Sluys & Adolphso

n

Phone Number: 203-261-1234

Fax Number: 203-261-5676

Int. Cl.: 7

Prior U.S. Cls.: 13, 19, 21, 23, 31, 34 and 35

United States Patent and Trademark Office

Reg. No. 2,715,757

Registered May 13, 2003

**TRADEMARK
PRINCIPAL REGISTER**



**MAXTECH MANUFACTURING INC. (CANADA
CORPORATION)
620 MCMURRAY ROAD
WATERLOO, ONTARIO, CANADA N2V 2E7**

**FOR: POWER TOOL ACCESSORIES NAMELY
STEP DRILLS, HINGE DRILLS, HOLE ENLARGING
BITS, ROUTER BITS, AUGER BITS, DRILL BITS,
FLAT BITS, WOOD BORING BITS, SCREW GUIDES,
TAPS, DRYWALL DEPTH SETTERS, DOUBLE
ENDED HOLDERS FOR COMBINATION DRILL
AND DRIVER, FORSTNER BITS, SCREWDRIVER
BITS, NUTSETTERS, SOCKET ADAPTERS, PLUG
CUTTERS, SCREW DRIVERS, NUT DRIVERS,**

**MANDRELS, DEBURRING TOOLS AND WIRE
BRUSHES, HOLE SAWS, POWER BIT EXTENSIONS,
DRILL DEPTH STOPS, COUNTERSINKS; CARRY-
ING CASES FOR ANY OF THE PRECEDING, SOLD
TOGETHER AS A UNIT, IN CLASS 7 (U.S. CLS. 13, 19,
21, 23, 31, 34 AND 35).**

FIRST USE 11-17-1997; IN COMMERCE 12-30-1997.

SER. NO. 78-057,379, FILED 4-9-2001.

NANCY CLARKE, EXAMINING ATTORNEY

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

This page was generated by the TARR system on 2008-06-16 13:23:30 ET

Serial Number: 78057379 Assignment Information Trademark Document Retrieval

Registration Number: 2715757

Mark



(words only): MAXTECH

Standard Character claim: No

Current Status: Registered.

Date of Status: 2003-05-13

Filing Date: 2001-04-09

Transformed into a National Application: No

Registration Date: 2003-05-13

Register: Principal

Law Office Assigned: LAW OFFICE 102

If you are the applicant or applicant's attorney and have questions about this file, please contact the Trademark Assistance Center at TrademarkAssistanceCenter@uspto.gov

Current Location: 40S -Scanning On Demand

Date In Location: 2008-03-31

LAST APPLICANT(S)/OWNER(S) OF RECORD

1. Maxtech Manufacturing Inc.

Address:

Maxtech Manufacturing Inc.
620 McMurray Road

Waterloo, Ontario N2V 2E7

Canada

Legal Entity Type: Corporation

State or Country of Incorporation: Canada

Phone Number: 519 885 5336

Fax Number: 519 885 5327

GOODS AND/OR SERVICES

International Class: 007

Class Status: Active

Power tool accessories namely step drills, hinge drills, hole enlarging bits, router bits, auger bits, drill bits, flat bits, wood boring bits, screw guides, taps, drywall depth setters, double ended holders for combination drill and driver, forstner bits, screwdriver bits, nutsetters, socket adapters, plug cutters, screw drivers, nut drivers, mandrels, deburring tools and wire brushes, hole saws, power bit extensions, drill depth stops, countersinks; carrying cases for any of the preceding, sold together as a unit

Basis: 1(a)

First Use Date: 1997-11-17

First Use in Commerce Date: 1997-12-30

ADDITIONAL INFORMATION

Design Search Code(s):

26.11.21 - Rectangles that are completely or partially shaded

26.13.21 - Quadrilaterals that are completely or partially shaded

MADRID PROTOCOL INFORMATION

(NOT AVAILABLE)

PROSECUTION HISTORY

NOTE: To view any document referenced below, click on the link to "Trademark Document Retrieval" shown near the top of this page.

2008-03-31 - Case File In TICRS

2003-05-13 - Registered - Principal Register

2003-02-18 - Published for opposition

2003-01-29 - Notice of publication

2002-09-17 - Approved for Pub - Principal Register (Initial exam)

2002-05-27 - TEAS Change Of Correspondence Received

2002-03-29 - Final refusal mailed

2002-03-14 - Assigned To Examiner

2002-03-12 - Assigned To Examiner

2002-02-18 - Communication received from applicant

2001-08-21 - Non-final action mailed

2001-08-16 - Assigned To Examiner

ATTORNEY/CORRESPONDENT INFORMATION

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