

ESTTA Tracking number: **ESTTA586466**

Filing date: **02/10/2014**

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 parties oppose registration of the indicated application.

Opposers Information

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| Name | MSC Services Corp. |
| Granted to Date of previous extension | 02/08/2014 |
| Address | 75 Maxess Road Melville, NY 11747 UNITED STATES |

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| Name | Sid Tool Co., Inc. (d/b/a MSC Industrial Supply Co.) | | |
| Entity | Corporation | Citizenship | New York |
| Address | 75 Maxess Road Melville, NY 11747 UNITED STATES | | |

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| Attorney information | Michael R. Graif Curtis, Mallet-Prevost, Colt & Mosle LLP 101 Park Avenue New York, NY 10178 UNITED STATES trademark@curtis.com |
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Applicant Information

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|------------------------|--|------------------------|------------|
| Application No | 86046036 | Publication date | 12/10/2013 |
| Opposition Filing Date | 02/10/2014 | Opposition Period Ends | 02/08/2014 |
| Applicant | DAP Brands Company 2628 Pearl Road Medina, OH 44256 GERMANY | | |

Goods/Services Affected by Opposition

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| Class 017. First Use: 0 First Use In Commerce: 0 All goods and services in the class are opposed, namely: Adhesive sealants and caulking compounds; Aerosol foam sealants for use in connection with residential and commercial construction projects |
| Class 035. First Use: 0 First Use In Commerce: 0 All goods and services in the class are opposed, namely: Providing consumer product news, information, and technical data in the field of caulks, sealants, adhesives, aerosol foam sealants, and surface repair products; Customer service, namely, providing an advisory service and assistance to consumers regarding the selection of products and items to be purchased in the field of caulks, sealants, adhesives, aerosol foam sealants, and surface repair products; Providing information and advice for consumers regarding the selection of products and items to be purchased in the field of |

caulks, sealants, adhesives, aerosol foam sealants, and surface repair products; Retail stores and on-line retail store services featuring caulks, sealants, adhesives, aerosol foam sealants, and surface repair products

Grounds for Opposition

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| Priority and likelihood of confusion | Trademark Act section 2(d) |
| Other | Common law infringement |

Marks Cited by Opposer as Basis for Opposition

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|----------------------|---|-----------------------|------------|
| U.S. Application No. | 77968707 | Application Date | 03/25/2010 |
| Registration Date | NONE | Foreign Priority Date | NONE |
| Word Mark | WORKSMART | | |
| Design Mark |  | | |
| Description of Mark | NONE | | |
| Goods/Services | Class 022. First use: First Use: 0 First Use In Commerce: 0 Ropes and cords for lifting and securing loads, namely, non-metal belts, webbings, lifting bands, ropes, nets, non-metal lifting slings, raising bands as well as parts thereof sold as a unit with the goods; bands made of canvas for lifting and securing loads | | |

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| U.S. Application No. | 77968529 | Application Date | 03/25/2010 |
| Registration Date | NONE | Foreign Priority Date | NONE |
| Word Mark | WORKSMART | | |
| Design Mark |  | | |
| Description of Mark | NONE | | |

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| Goods/Services | Class 011. First use: First Use: 0 First Use In Commerce: 0 Lighting fixtures, lighting tracks, heating installations, electric space heaters, ventilating exhaust fan, ventilatingfans for commercial and industrial use, ventilating louvers and water conditioning units and pipes sold as a unit with the water closets and water conditioningunits; reinforcements for water-pipes, namely, shower control valves, tub control valves, plumbing fittings, namely, bibs, cocks, traps, couplers, drains, valves and spouts |
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| U.S. Application No. | 77968650 | Application Date | 03/25/2010 |
| Registration Date | NONE | Foreign Priority Date | NONE |

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| Word Mark | WORKSMART |
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| Design Mark |  |
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| Description of Mark | NONE |
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| Goods/Services | Class 017. First use: First Use: 0 First Use In Commerce: 0 Air hoses; plastic hoses for plumbing; watering hoses; non-metallic hoses and pipes; plastic tubes for plumbing; rubbertubes and pipes; pipe fittings comprised primarily of plastic |
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|----------------------|----------|-----------------------|------------|
| U.S. Application No. | 77968461 | Application Date | 03/25/2010 |
| Registration Date | NONE | Foreign Priority Date | NONE |

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| Word Mark | WORKSMART |
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| Design Mark |  |
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| Description of Mark | NONE |
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| Goods/Services | Class 008. First use: First Use: 0 First Use In Commerce: 0 Manually operated lifting equipment andlifting apparatuses, namely hand operated lifting jacks; hand tools, namely, wire cutters, steel strap cutters, |
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| | diagonal cutters, bolt cutters, flush cutters, cable cutters, hammers, hacksaws and hacksaw blades, hex keys, hex key sets, insulated pliers, insulated screwdrivers, insulated wrenches, insulated hex keys, insulated socket wrenches, utility knives and replacement blades, snap blade knives and replacement blades, pocket knives; multi-function hand tools comprised of screwdrivers, knives, can openers, pliers, scissors, files, rulers, wire crimpers, lanyards and awls; hand tools, namely, nutdrivers, pliers, punches, chisels, ratchet wrenches, ratchet wrenches sets, screwdrivers, scissors, shears, socket wrenches, socket sets and socket wrenches; tool sets comprised of hand tools, namely, wrenches, socket wrenches, saws, pliers, hammers, knives, wire cutters, screwdrivers, chisels, punches; hand tools, namely, torque wrenches, torque screwdrivers, wrenches and wrench sets, wire strippers, wire crimpers |
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|----------------------|--|-----------------------|------------|
| U.S. Application No. | 77968369 | Application Date | 03/25/2010 |
| Registration Date | NONE | Foreign Priority Date | NONE |
| Word Mark | WORKSMART | | |
| Design Mark |  | | |
| Description of Mark | NONE | | |
| Goods/Services | Class 006. First use: First Use: 0 First Use In Commerce: 0 Metal building materials, namely, soffits, fascia, wall framing, metal sheets, crossbeams, retaining tubes, reinforcing material of metal for building purposes, metal cladding, metal roofing, metal flooring, metal floor tiles and metal partitions; metal hardware, namely, springs, nuts, washers, pulleys, pulls, nails, screws, locks, hinges of metal, metal hooks, metal fastening collars, metal cables and wires not for electrical purposes, metal cable rollers and reels, metal cable holders, metal rivets and pins, metal threaded rods, non-electric metal terminals, namely, wire clamps, quick-release fasteners; pipes and tubes of metal; industrial metal hoses and metal hose fittings; metal hoses for plumbing use; general purpose storage containers made of metal | | |

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| U.S. Application No. | 85448652 | Application Date | 10/17/2011 |
| Registration Date | NONE | Foreign Priority Date | NONE |
| Word Mark | WORKSMART | | |

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|---------------------|---|
| Design Mark | WORKSMART |
| Description of Mark | NONE |
| Goods/Services | Class 018. First use: First Use: 0 First Use In Commerce: 0 Tool bags sold empty |

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| Attachments | 77968707#TMSN.jpeg(bytes) 77968529#TMSN.jpeg(bytes) 77968650#TMSN.jpeg(bytes) 77968461#TMSN.jpeg(bytes) 77968369#TMSN.jpeg(bytes) 85448652#TMSN.jpeg(bytes) WORK SMARTER DAP Opposition.pdf(22717 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 First Class Mail on this date.

| | |
|-----------|----------------------|
| Signature | /s/ Michael R. Graif |
| Name | Michael R. Graif |
| Date | 02/10/2014 |

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

In re Application Serial Nos. : 86/046036
Marks : WORK SMARTER
International Classes : 017 and 035
Applicant : DAP Brands Company
Filed : August 23, 2013
Published : December 10, 2013

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MSC SERVICES CORP.; SID TOOL CO., INC. :
(D/B/A MSC INDUSTRIAL SUPPLY CO.) :
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: :
Opposers, :
: :
against : Opposition No. _____
: :
DAP BRANDS COMPANY, :
: :
: :
Applicant. :
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NOTICE OF OPPOSITION

MSC Services Corp. and Sid Tool Co., Inc. (d/b/a MSC Industrial Supply Co.), are corporations organized under the laws of the State of New York, located and doing business at 75 Maxess Road, Melville, New York 11747 (the “Opposers”), and believe that they would be damaged by the registration of United States Trademark Application Serial No. 86/046,036 (the “DAP Application”) for the mark WORK SMARTER. The DAP Application was filed by the DAP Brands Company (the “Applicant”) on August 23, 2013 and published for opposition on December 10, 2013 in:

- (a) International Class 017 and United States Classes 001, 005, 012, 013, 035 and 050 for “Adhesive sealants and caulking compounds; Aerosol foam sealants for use in connection with residential and commercial construction projects”; and

(b) International Class 035 and United States Classes 100, 101 and 102 for “Providing consumer product news, information, and technical data in the field of caulks, sealants, adhesives, aerosol foam sealants, and surface repair products; Customer service, namely, providing an advisory service and assistance to consumers regarding the selection of products and items to be purchased in the field of caulks, sealants, adhesives, aerosol foam sealants, and surface repair products; Providing information and advice for consumers regarding the selection of products and items to be purchased in the field of caulks, sealants, adhesives, aerosol foam sealants, and surface repair products; Retail stores and on-line retail store services featuring caulks, sealants, adhesives, aerosol foam sealants, and surface repair products”.

Opposers hereby oppose the Applications.

As grounds for opposition, Opposers assert that:

1. Opposers market, distribute and sell a variety of tools, industrial products, and maintenance, repair and operations supplies throughout the United States. In particular, Opposers market, distribute and sell a variety of products under the mark WORKSMART, including fasteners and adhesives, tools, plumbing equipment, hoses, tubes, fittings, tool cabinets, workstations, pumps, measuring equipment, electrical equipment, safety supplies, and MRO products.
2. Opposers also maintain a website at the URL www.mscdirect.com which serves as an online resource for customers. Opposers market and sell products on their website under their WORKSMART mark. Opposers provide customer service assistance to their customers over their website as well as via email and telephone. Opposers also make a variety of digital

publications available on their website. Many of these digital publications include information on products marketed and sold under Opposers' WORKSMART mark.

3. Opposers also maintain brick-and-mortar retail stores. Opposers' retail stores offer goods and services under the WORKSMART mark. Opposers also provide customer service assistance in their retail stores.

4. Opposers have continuously made commercial use of WORKSMART as a trademark throughout the United States since at least February 2010.

5. By virtue of their continuous use of the WORKSMART mark and trade name in commerce, Opposers have acquired common law rights in the WORKSMART mark and trade name. Opposers have expended significant amounts of time, money and effort in promoting and advertising the WORKSMART mark and trade name as well as the products and services distributed, marketed and sold thereunder. Opposers' WORKSMART mark and trade name are famous and consumers have come to recognize the WORKSMART mark and trade name as identifiers of Opposers' products and services and as a single source of origin.

6. Opposer MSC Services Inc. is the owner of U.S. Trademark Application Serial No. 77/968707 (the "707 Application") for the mark WORKSMART for "Ropes and cords for lifting and securing loads, namely, non-metal belts, webbings, lifting bands, ropes, nets, non-metal lifting slings, raising bands as well as parts thereof sold as a unit with the goods; bands made of canvas for lifting and securing loads" in International Class 022 and United States Classes 02, 03, 07, 19, 22, 42 and 50. Opposer MSC Services filed the 707 Application on March 25, 2010 and the United States Patent and Trademark Office (the "USPTO") published it for opposition on January 11, 2011. Opposer Sid Tool Co., Inc. is a licensee of the 707 Application.

7. Opposer MSC Services Inc. is the owner of U.S. Trademark Application Serial No. 77/968529 (the “529 Application”) for the mark WORKSMART for “Lighting fixtures, lighting tracks, heating installations, electric space heaters, ventilating exhaust fan, ventilating fans for commercial and industrial use, ventilating louvers and water conditioning units and pipes sold as a unit with the water closets and water conditioning units; reinforcements for water-pipes, namely, shower control valves, tub control valves, plumbing fittings, namely, bibs, cocks, traps, couplers, drains, valves and spouts” in International Class 011 and United States Classes 13, 21, 22, 31 and 34. Opposer MSC Services filed the 529 Application on March 25, 2010 and the USPTO published it for opposition on January 11, 2011. Opposer Sid Tool Co., Inc. is a licensee of the 529 Application.

8. Opposer MSC Services Inc. is the owner of U.S. Trademark Application Serial No. 77/968650 (the “650 Application”) for the mark WORKSMART for “Air hoses; plastic hoses for plumbing; watering hoses; non-metallic hoses and pipes; plastic tubes for plumbing; rubber tubes and pipes; pipe fittings comprised primarily of plastic” in International Class 017 and United States Classes 01, 05, 12, 13, 35 and 50. Opposer MSC Services filed the 650 Application on March 25, 2010 and the USPTO published it for opposition on January 4, 2011. Opposer Sid Tool Co., Inc. is a licensee of the 650 Application.

9. Opposer MSC Services Inc. is the owner of U.S. Trademark Application Serial No. 77/968461 (the “461 Application”) for the mark WORKSMART for “Manually operated lifting equipment and lifting apparatuses, namely hand operated lifting jacks; hand tools, namely, wire cutters, steel strap cutters, diagonal cutters, bolt cutters, flush cutters, cable cutters, hammers, hacksaws and hacksaw blades, hex keys, hex key sets, insulated pliers, insulated screwdrivers, insulated wrenches, insulated hex keys, insulated socket wrenches, utility knives

and replacement blades, snap blade knives and replacement blades, pocket knives; multi-function hand tools comprised of screwdrivers, knives, can openers, pliers, scissors, files, rulers, wire crimpers, lanyards and awls; hand tools, namely, nutdrivers, pliers, punches, chisels, ratchet wrenches, ratchet wrenches sets, screwdrivers, scissors, shears, socket wrenches, socket sets and socket wrenches; tool sets comprised of hand tools, namely, wrenches, socket wrenches, saws, pliers, hammers, knives, wire cutters, screwdrivers, chisels, punches; hand tools, namely, torque wrenches, torque screwdrivers, wrenches and wrench sets, wire strippers, wire crimpers” in International Class 008 and United States Classes 023, 028 and 44. Opposer MSC Services filed the 461 Application on March 25, 2010. Opposer Sid Tool Co., Inc. is a licensee of the 461 Application.

10. Opposer MSC Services Inc. is the owner of U.S. Trademark Application Serial No. 77/968369 (the “369 Application”) for the mark WORKSMART for “Metal building materials, namely, soffits, fascia, wall framing, metal sheets, crossbeams, retaining tubes, reinforcing material of metal for building purposes, metal cladding, metal roofing, metal flooring, metal floor tiles and metal partitions; metal hardware, namely, springs, nuts, washers, pulleys, pulls, nails, screws, locks, hinges of metal, metal hooks, metal fastening collars, metal cables and wires not for electrical purposes, metal cable rollers and reels, metal cable holders, metal rivets and pins, metal threaded rods, non-electric metal terminals, namely, wire clamps, quick-release fasteners; pipes and tubes of metal; industrial metal hoses and metal hose fittings; metal hoses for plumbing use; general purpose storage containers made of metal” in International Class 006 and United States Classes 02, 12, 13, 14, 23, 25 and 50. Opposer MSC Services filed the 369 Application on March 25, 2010 and the USPTO published it for opposition on September 10, 2013. Opposer Sid Tool Co., Inc. is a licensee of the 369 Application.

11. Opposer MSC Services Inc. is the owner of U.S. Trademark Application Serial No. 85/448652 (the “652 Application” and, together with the 707, 529, 650, 461 and 369 Applications, the “MSC WORKSMART Applications”) for the mark WORKSMART for “Tools bags sold empty” in International Class 018 and United States Classes 02, 03, 22 and 41. Opposer MSC Services filed the 652 Application on October 17, 2011 and the USPTO published it for opposition on October 16, 2012. Opposer Sid Tool Co., Inc. is a licensee of the 652 Application.

12. Upon information and belief, Applicant is a corporation organized under the laws of the State of Delaware and is located and doing business at 2628 Pearl Road, Medina, Ohio 44256.

13. The Applicant’s WORK SMARTER mark is substantially identical or confusingly similar to the Opposers’ WORKSMART marks. The Applicant’s addition of the letters “E” and “R” at the end of the WORK SMARTER mark does not distinguish that mark from the Opposers’ WORKSMART marks.

14. Opposers use the WORKSMART mark in connection with marketing, distributing and selling products and services that are substantially similar and/or related to the goods and services listed in the DAP Application.

15. In view of Opposers’ use of the WORKSMART mark before the effective filing of date of the DAP Application, Opposers have rights in the names and marks WORKSMART, and WORK SMARTER that are superior and have priority to those of the Applicant.

16. If the opposed DAP Application is not withdrawn or amended so as to avoid a likelihood of confusion with Opposers’ WORKSMART mark, Opposers will suffer damage to their goodwill and reputation, and the public is likely to be confused or deceived with respect to

the source, origin, connection, affiliation, sponsorship or approval of Applicant's goods and/or Opposers' affiliation, sponsorship or connection with Applicant.

17. By reason of all of the foregoing, issuance of a registration to Applicant with respect to the DAP Application would seriously damage Opposers.

WHEREFORE, Opposers pray that this opposition be sustained and that Application Serial No. 86/046036 for the WORK SMARTER mark be refused registration.

Respectfully submitted,

MSC Services Corp., Sid Tool Co., Inc.
(d/b/a MSC Industrial Supply Co.)

Dated: New York, New York
February 10, 2014

By: /s/ Michael R. Graif
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