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

Proceeding	91214851
Party	Defendant DAP Brands Company
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In re Application Serial No. 86/046,036	)	
MSC Services Corp.; Sid Tool Co., Inc.	)	
(d/b/a MSC Industrial Supply Co.)	)	
	)	
Opposers,	)	
	)	
v.	)	Opposition No. 91214851
	)	
DAP Brands Company	)	
	)	
Applicant.	)	
	)	

APPLICANT'S ANSWER TO THE NOTICE OF OPPOSITION

In response to the Notice of Opposition filed by MSC Services Corp. and Sid Tool Co., Inc. d/b/a MSC Industrial Supply Co. (collectively, "Opposers") on February 10, 2014, and instituted by the Trademark Trial and Appeal Board ("Board") on February 10, 2014, DAP Brands Company (hereinafter "Applicant") hereby timely answers the Notice of Opposition as follows:

In response to the first un-numbered paragraph of the Notice of Opposition, Applicant denies that Opposers will be damaged by registration of Applicant's mark, WORK SMARTER, as shown in Serial No. 86/046,036. Applicant admits that the application was filed on August 23, 2013, and published for opposition on December 10, 2013. Applicant admits that the goods and services recited in Application Serial No. 86/046,036 are "Adhesive sealants and caulking compounds; Aerosol foam sealants for use in connection with residential and commercial

construction projects," in International Class 17, and "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," in International Class 35. Applicant otherwise denies the remaining allegations contained in first unnumbered paragraph of the Notice of Opposition.

Applicant responds to the numbered allegations in the Notice of Opposition as follows:

1. Applicant is without knowledge or information sufficient to form a belief as to the truth of the matters asserted by Opposers in Paragraph 1 of the Notice of Opposition, and therefore, denies the same leaving Opposers to establish proof thereof.

2. Applicant is without knowledge or information sufficient to form a belief as to the truth of the matters asserted by Opposers in Paragraph 2 of the Notice of Opposition, and therefore, denies the same leaving Opposers to establish proof thereof.

3. Applicant is without knowledge or information sufficient to form a belief as to the truth of the matters asserted by Opposers in Paragraph 3 of the Notice of Opposition, and therefore, denies the same leaving Opposers to establish proof thereof.

4. Applicant is without knowledge or information sufficient to form a belief as to the truth of the matters asserted by Opposers in Paragraph 4 of the Notice of Opposition, and therefore, denies the same leaving Opposers to establish proof thereof.

5. Applicant is without knowledge or information sufficient to form a belief as to the truth of the matters asserted by Opposers in Paragraph 5 of the Notice of Opposition, and therefore, denies the same leaving Opposers to establish proof thereof. Applicant specifically denies that Opposers' claimed WORKSMART mark is "famous" as defined in the federal Trademark Act, 15 U.S.C. §1125(c), and leaves Opposers to establish proof thereof.

6. Applicant admits that the online trademark records of the U.S. Patent and Trademark Office database show that MSC Services Corp. filed an application on March 25, 2010 for the WORKSMART mark, designated as Serial No. 77/968707, 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 22, but is without knowledge or information sufficient to form a belief as to the truth of the remaining statements in Paragraph 6, and, therefore, denies the same leaving Opposers to establish proof thereof.

7. Applicant admits that the online trademark records of the U.S. Patent and Trademark Office database show that MSC Services Corp. filed an application on March 25, 2010 for the WORKSMART mark, designated as Serial No. 77/968529, 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 11, but is without knowledge or information sufficient to form a belief as to the truth of the remaining statements in Paragraph 7, and, therefore, denies the same leaving Opposers to establish proof thereof.

8. Applicant admits that the online trademark records of the U.S. Patent and Trademark Office database show that MSC Services Corp. filed an application on March 25, 2010 for the WORKSMART mark, designated as Serial No. 77/968650, 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 17, but is without knowledge or information sufficient to form a belief as to the truth of the remaining statements in Paragraph 8, and, therefore, denies the same leaving Opposers to establish proof thereof.

9. Applicant admits that the online trademark records of the U.S. Patent and Trademark Office database show that MSC Services Corp. filed an application on March 25, 2010 for the WORKSMART mark, designated as Serial No. 77/968461, 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 8, but is without knowledge or information sufficient to form a belief as to the truth of the remaining statements in Paragraph 9, and, therefore, denies the same leaving Opposers to establish proof thereof.

10. Applicant admits that the online trademark records of the U.S. Patent and Trademark Office database show that MSC Services Corp. filed an application on March 25, 2010 for the WORKSMART mark, designated as Serial No. 77/968369, 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 6, but is without knowledge or information sufficient to form a belief as to the truth of the remaining statements in Paragraph 10, and, therefore, denies the same leaving Opposers to establish proof thereof.

11. Applicant admits that the online trademark records of the U.S. Patent and Trademark Office database show that MSC Services Corp. filed an application on October 17,

2011 for the WORKSMART mark, designated as Serial No. 85/448652, for "Tool bags sold empty" in International Class 18, but is without knowledge or information sufficient to form a belief as to the truth of the remaining statements in Paragraph 11, and, therefore, denies the same leaving Opposers to establish proof thereof.

12. Applicant admits the allegations contained in Paragraph 12 of the Notice of Opposition.

13. Applicant denies the allegations contained in Paragraph 13 of the Notice of Opposition.

14. Applicant is without knowledge or information sufficient to form a belief as to the truth of the statements asserted in Paragraph 14 of the Notice of Opposition, and, therefore, denies the same, leaving Opposers to establish proof thereof.

15. Applicant is without knowledge or information sufficient to form a belief as to the truth of the statements asserted in Paragraph 15 of the Notice of Opposition, and, therefore, denies the same, leaving Opposers to establish proof thereof.

16. Applicant denies the allegations contained in Paragraph 16 of the Notice of Opposition.

17. Applicant denies the allegations contained in Paragraph 17 of the Notice of Opposition.

AFFIRMATIVE DEFENSES

In further answer to the Notice of Opposition, Applicant asserts that:

FIRST AFFIRMATIVE DEFENSE

18. Opposers' claims are barred from recovery due to the fact that no likelihood of confusion, mistake or deception exists between Applicant's WORK SMARTER mark and Opposers' WORKSMART mark.

SECOND AFFIRMATIVE DEFENSE

19. Opposers' claims are barred from recovery due to the fact that Applicant's mark is not confusingly similar in appearance, sound or meaning to Opposers' WORKSMART mark.

THIRD AFFIRMATIVE DEFENSE

20. Applicant's use of the mark WORK SMARTER on the particular goods and services described in its Application Serial No. 86/046,036 will not mistakenly be thought by the public to derive from the same source as Opposers' goods, nor will such use be thought by the public to be a use by Opposers or with Opposers' authorization or approval.

FOURTH AFFIRMATIVE DEFENSE

21. Applicant's mark, when used in connection with Applicant's particular goods and services, is not likely to cause confusion, or to cause mistake, or to deceive as to the affiliation, connection or association of Applicant with Opposers or Opposers' goods, or as to the origin, sponsorship or approval of Applicant's goods by Opposers.

FIFTH AFFIRMATIVE DEFENSE

22. Applicant's goods and services are readily distinguishable from the goods of Opposers; Applicant's goods are sold and promoted in different trade channels to a distinctly different set of end consumers than Opposers'; and, as such, Applicant's goods are not likely to be assumed to derive from the same source as Opposers' goods.

SIXTH AFFIRMATIVE DEFENSE

23. Opposers will sustain no damage, injury, or prejudice as a result of the issuance of a registration to Applicant for the particular goods and services described in Application Serial No. 86/046,036, since the goods and services described therein have no relation to and will not be confused with the goods on which Opposers purport to use its WORKSMART mark.

SEVENTH AFFIRMATIVE DEFENSE

24. Opposers have failed to establish any prior rights in any goods or services similar to those covered by Applicant's Application Serial No. 86/046,036 for "Adhesive sealants and caulking compounds; Aerosol foam sealants for use in connection with residential and commercial construction projects," in International Class 17, and "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," in International Class 35. Opposers merely assert that it owns prior rights for its use of its WORKSMART marks for goods that are unrelated to the goods and services on which Applicant intends to use the mark WORK SMARTER. Indeed, Opposers' rights to its WORKSMART marks are narrowly limited to the particular goods described in its applications, and extend no further.

EIGHTH AFFIRMATIVE DEFENSE

25. Opposers' claims are barred from recovery due to the fact that there is no evidence or allegation of any actual confusion, deception or mistake among consumers as to the source of each party's respective goods and services.

NINTH AFFIRMATIVE DEFENSE

26. Opposers' claims are barred from recovery due to the fact that Opposers' marks are not distinctive to Opposers.

TENTH AFFIRMATIVE DEFENSE

27. Opposers' claims are barred from recovery due to the fact that Applicant's use of Applicant's WORK SMARTER mark has not diluted, blurred, or tarnished Opposers' WORKSMART mark, reputation or good will, and Opposers have not shown any injury to Opposers' business reputation or the quality of goods or services relating thereto.

ELEVENTH AFFIRMATIVE DEFENSE

28. Applicant is informed and believes, and on this basis asserts that there is no likelihood of confusion because the United States Patent and Trademark Office did not cite Opposers' WORKSMART mark as a bar or refusal to registration of Applicant's mark after considering the reality of the marks existing simultaneously in the marketplace.

TWELFTH AFFIRMATIVE DEFENSE

29. Opposers' claims are barred from recovery due to the fact that Applicant adopted and created its mark in good faith and without any intent to confuse or deceive the public.

THIRTEENTH AFFIRMATIVE DEFENSE

30. Opposers' claims are barred from recovery due to the fact that Applicant's use of Applicant's WORK SMARTER mark has not interfered with or damaged Opposers in any manner.

FOURTEENTH AFFIRMATIVE DEFENSE

31. Opposers' claims may be barred due to one or more of the following defenses: laches, estoppel, and/or acquiescence.

FIFTEENTH AFFIRMATIVE DEFENSE

32. Applicant reserves the right to assert additional affirmative defenses as they may become known through the process of discovery.

RELIEF REQUESTED

WHEREFORE, Applicant requests that this Opposition be dismissed with prejudice to Opposers, and that Applicant's Application Serial No. 86/046,036 be reinstated and be permitted to proceed to registration.

Dated: March 24, 2014

Respectfully submitted,

By _____

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CERTIFICATE OF SERVICE

I hereby certify that a true and correct copy of the foregoing Applicant's Answer to the Notice of Opposition has been served upon the following by e-mail and regular U.S. mail this 24th day of March, 2014:

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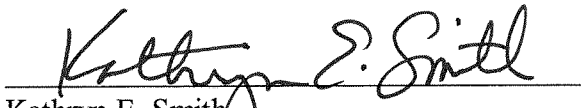

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