

ESTTA Tracking number: **ESTTA593727**

Filing date: **03/20/2014**

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

Name	MSC Services Corp.		
Entity	Corporation	Citizenship	New York
Address	75 Maxess Road Melville, NY 11747 UNITED STATES		

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		

Attorney information	Michael R. Graif Curtis, Mallet-Prevost, Colt & Mosle LLP 101 Park Avenue New York, NY 10178 UNITED STATES mgraif@curtis.com Phone:212-696-6000		
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Applicant Information

Application No	85859210	Publication date	02/18/2014
Opposition Filing Date	03/20/2014	Opposition Period Ends	03/20/2014
Applicant	Volvo Construction Equipment North America, LLC 312 Volvo Way Shippensburg, PA 17257 GERMANY		

Goods/Services Affected by Opposition

<p>Class 007. First Use: 2013/02/01 First Use In Commerce: 2013/02/01 All goods and services in the class are opposed, namely: Earth working equipment, namely, soil and asphalt compactor vehicles, and replacement and structural parts and fittings therefor; earth moving machines, namely, motor graders, loaders, excavators, concrete and asphalt paving machines, street rollers, vibration rollers and plates; backhoe loaders; wheel loaders; ground surface finishing and compacting machine; road rollers; bulldozers; concrete and asphalt finishing machines, cranes; fork lifts; loading and unloading machines; mechanical discharging hoppers; machine tools for breaking up road surface; roadway construction and paving machines, namely, pavers, wideners and grading and sloping machines; mill machinery, namely, rolling mills, ladles, ladle pouring units, ladle feeders, furnace and ladle lining machines, lance hoists, dust recovery machines; mill machinery accessories, namely, ladles, grapples, buckets, scoops, tongs, concrete buckets and hooks for material handling machines; parts for the foregoing mill machinery; rolling mills and parts thereof; tunnel agitators for concrete construction work</p>
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Grounds for Opposition

Priority and likelihood of confusion	Trademark Act section 2(d)
Other	Priority and likelihood of confusion under common law; MSC Services and SID Tool have acquired common law rights to the marks in question that are superior to any rights of the applicant

Marks Cited by Opposer as Basis for Opposition

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		

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

Mark	
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, 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

U.S. Application No.	77968650	Application Date	03/25/2010
Registration Date	NONE	Foreign Priority Date	NONE

Word Mark	WORKSMART
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Design Mark	<h1>WORKSMART</h1>
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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; rubber tubes 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

Word Mark	WORKSMART
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Design Mark	<h1>WORKSMART</h1>
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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 and lifting apparatuses, namely hand
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	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
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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		

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

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

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) Volvo Smart Works Opposition.pdf(90753 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	03/20/2014

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

In re Application Serial No. : 85859210
Mark : SMART WORKS
International Class : 007
Applicant : Volvo Construction Equipment North America, LLC
Filed : February 25, 2013
Published : February 18, 2014

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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. _____
: :
VOLVO CONSTRUCTION EQUIPMENT :
NORTH AMERICA, LLC, :
: :
: :
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. 85859210 (the “Opposed Application”) for the mark SMART WORKS. The Opposed Application was filed by the Volvo Construction Equipment North America, LLC (the “Applicant”) on February 25, 2013 and published for opposition on February 18, 2014 in International Class 007 and United States Classes 013, 019, 021, 023, 031, 034 and 035 for:

Earth working equipment, namely, soil and asphalt compactor vehicles, and replacement and structural parts and fittings therefor; earth moving machines, namely, motor graders, loaders,

excavators, concrete and asphalt paving machines, street rollers, vibration rollers and plates; backhoe loaders; wheel loaders; ground surface finishing and compacting machine; road rollers; bulldozers; concrete and asphalt finishing machines, cranes; fork lifts; loading and unloading machines; mechanical discharging hoppers; machine tools for breaking up road surface; roadway construction and paving machines, namely, pavers, wideners and grading and sloping machines; mill machinery, namely, rolling mills, ladles, ladle pouring units, ladle feeders, furnace and ladle lining machines, lance hoists, dust recovery machines; mill machinery accessories, namely, ladles, grapples, buckets, scoops, tongs, concrete buckets and hooks for material handling machines; parts for the foregoing mill machinery; rolling mills and parts thereof; tunnel agitators for concrete construction work.

The Opposed Application claims a date of first use of February 1, 2013. Opposers hereby oppose the Opposed Application.

As grounds for opposition, Opposers assert that:

1. Opposers market, distribute and sell a variety of tools, industrial products, milling equipment, machinery and machine equipment, and maintenance, repair and operations products (“MRO products”) throughout the United States. In particular, Opposers market, distribute and sell a variety of products under the mark WORKSMART, including fleet maintenance equipment, machinery equipment, fasteners and adhesives, tools, plumbing equipment, hoses, tubes, fittings, tool cabinets, workstations, pumps, measuring equipment, electrical equipment, safety supplies, and MRO products.

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

3. 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.

4. Opposer MSC Services Inc. is the owner of U.S. Trademark Application Serial No. 77968707 (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.

5. Opposer MSC Services Inc. is the owner of U.S. Trademark Application Serial No. 77968529 (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.

6. Opposer MSC Services Inc. is the owner of U.S. Trademark Application Serial No. 77968650 (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.

7. Opposer MSC Services Inc. is the owner of U.S. Trademark Application Serial No. 77968461 (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.

8. Opposer MSC Services Inc. is the owner of U.S. Trademark Application Serial No. 77968369 (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.

9. Opposer MSC Services Inc. is the owner of U.S. Trademark Application Serial No. 85448652 (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.

10. Upon information and belief, Applicant is a corporation organized under the laws of the State of Delaware and is located and doing business at 312 Volvo Way Shippensburg, Pennsylvania 17257.

11. The Applicant's SMART WORKS mark is substantially identical or confusingly similar to the Opposers' WORKSMART marks. The Applicant's reversal of the order of the words "work" and "smart" in Opposers' WORKSMART marks and does not distinguish Applicant's SMART WORKS mark from the Opposers' WORKSMART marks. Nor does the pluralization of the word "work" in Applicant's SMART WORKS mark distinguish that mark from Opposers' WORKSMART marks.

12. Opposers use their WORKSMART marks 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 Opposed Application.

13. In view of Opposers' use of the WORKSMART mark before the Applicant's claimed first use of its SMART WORKS mark, Opposers have rights in the names and marks WORKSMART and SMART WORKS that are superior and have priority to those of the Applicant.

14. If the Opposed Application is not withdrawn or amended so as to avoid a likelihood of confusion with Opposers' WORKSMART marks, 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.

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

WHEREFORE, Opposers pray that this opposition be sustained and that Application Serial No. 85859210 for the SMART WORKS 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
March 20, 2014

By: /s/ Michael R. Graif
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