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

Proceeding	91215969
Party	Defendant ProSource Discounts, Inc.
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Submission	Answer
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Date	05/28/2014
Attachments	Answer 91215969.pdf(170054 bytes )

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

In the Matter of Trademark Application Serial No. 86/025401  
For the Mark: **PROSOURCE**  
In the name of ProSource Discounts, Inc.  
Published: January 21, 2014

MSC SERVICES CORP., ET AL.

Opposers,

v.

PROSOURCE DISCOUNTS, INC.

Applicant.

**Opposition No. 91215969**

**ANSWER TO NOTICE OF OPPOSITION**

PROSOURCE DISCOUNTS, INC. (hereinafter, “Applicant”), a California corporation with offices located at 8943 Oso Avenue, Unit C, Chatsworth, California 91311, is the owner of United States Trademark Application Serial No. 86/025401 (hereinafter, the “Application”) for the mark PROSOURCE (hereinafter, “Applicant’s Mark”), published for opposition on January 21, 2014. Applicant, by and through its attorneys, answers the allegations set forth by MSC SERVICES CORP. and SID TOOL CO., INC. (D/B/A MSC INDUSTRIAL SUPPLY CO.) (hereinafter, “Opposers”), as follows:

1. Applicant is without knowledge or information sufficient to form a belief as to the truth of the allegations set forth in Paragraph 1 of the Notice of Opposition and therefore denies any and all allegations therein.

2. Applicant is without knowledge or information sufficient to form a belief as to the truth of the allegations set forth in Paragraph 2 of the Notice of Opposition and therefore denies any and all allegations therein.

3. Applicant is without knowledge or information sufficient to form a belief as to the truth of the allegations set forth in Paragraph 3 of the Notice of Opposition and therefore denies any and all allegations therein.

4. Applicant is without knowledge or information sufficient to form a belief as to the truth of the allegations set forth in Paragraph 4 of the Notice of Opposition and therefore denies any and all allegations therein.

5. In response to Paragraph 5, Applicant states that the records of the United States Patent and Trademark Office speak for themselves. Applicant is without knowledge or information sufficient to form a belief or sufficient to truthfully admit or deny any remaining allegations of Paragraph 5 and, therefore, Applicant denies any and all remaining allegations therein.

6. In response to Paragraph 6, Applicant states that the records of the United States Patent and Trademark Office speak for themselves. Applicant is without knowledge or information sufficient to form a belief or sufficient to truthfully admit or deny any remaining allegations of Paragraph 6 and, therefore, Applicant denies any and all remaining allegations therein.

7. In response to Paragraph 7, Applicant states that the records of the United States Patent and Trademark Office speak for themselves.

8. In response to Paragraph 8, Applicant states that the records of the United States Patent and Trademark Office speak for themselves.

9. Admitted.

10. Denied.

11. Applicant is without knowledge or information sufficient to form a belief as to the truth of the allegations set forth in Paragraph 11 of the Notice of Opposition and therefore denies any and all allegations therein.

12. Applicant is without knowledge or information sufficient to form a belief as to the truth of the allegations set forth in Paragraph 12 of the Notice of Opposition and therefore denies any and all allegations therein.

13. Denied.

14. Denied.

#### **AFFIRMATIVE DEFENSES**

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

#### **FIRST AFFIRMATIVE DEFENSE**

15. Opposers' Notice of Opposition, and each cause of action thereof, fails to state a claim upon which relief can be granted.

**SECOND AFFIRMATIVE DEFENSE**

16. Applicant's mark PROSOURCE is readily distinguishable from Opposers' mark PRO SOURCE THE PROFESSIONAL CHOICE & Design<sup>1</sup> (as depicted in Registration Nos. 3773507, 4002807 and 4377808 and Application Serial No. 85/025688) in every perceivable way. The marks are visually distinguishable, aurally distinguishable, phonetically distinguishable, and distinguishable in terms of meaning and connotation. For these reasons, the marks will not be confused as to source and there is no likelihood of confusion, mistake, affiliation, connection or association of Applicant with Opposers or Opposers' goods.

**THIRD AFFIRMATIVE DEFENSE**

17. Opposers' claims fail because the examining attorney found no confusion between Applicant's mark PROSOURCE and Opposers' mark PRO SOURCE THE PROFESSIONAL CHOICE & Design during the examination phase of the opposed application.

**FOURTH AFFIRMATIVE DEFENSE**

18. Opponent Sid Tool Co., Inc. is barred from participating as a party to this action on the basis that the extension of time for filing the notice of opposition filed on February 20, 2014 was filed only in the name of MSC Services Corp. and not in the name of Sid Tool Co., Inc. Under TBMP § 203.02(b), Sid Tool Co., Inc.'s joint filing of the Notice of Opposition was not timely as the company had not requested an extension of time for filing a notice of opposition during the statutory publication period. Therefore, Sid Tool Co. should not be considered a party to this proceeding.



**FIFTH AFFIRMATIVE DEFENSE**

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

**SIXTH AFFIRMATIVE DEFENSE**

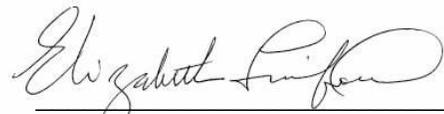
20. Applicant reserves the right to assert additional affirmative defenses, as they may become known through the process of discovery.

**RELIEF REQUESTED**

WHEREFORE, Applicant requests that the Notice of Opposition be dismissed with prejudice to Opposers and that Trademark Application Serial No. 86/025401 be permitted to proceed to registration.

Date: May 28, 2014

Respectfully Submitted,



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**CERTIFICATE OF ELECTRONIC TRANSMISSION**

I hereby certify that this correspondence is being electronically transmitted to the United States Patent and Trademark Office via ESSTA (*Electronic System for Trademark Trials and Appeals*) on the date identified below.

Dated: May 28, 2014

  
Elizabeth A. Linford

**PROOF OF SERVICE**

I hereby certify that a true and complete copy of the foregoing **ANSWER TO NOTICE OF OPPOSITION** has been served on counsel for Opposers, on this 28th day of May 2014 via First Class Mail, postage prepaid to:

Michael R. Graif, Esq.  
Curtis, Mallet-Prevost, Colt & Mosle LLP  
101 Park Avenue  
New York, NY 10178-0061

Dated: May 28, 2014

  
Edita Muradyan