

ESTTA Tracking number: **ESTTA607030**

Filing date: **05/29/2014**

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 kparsons@curtis.com Phone:212-696-6000		
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Applicant Information

Application No	86115272	Publication date	04/29/2014
Opposition Filing Date	05/29/2014	Opposition Period Ends	05/29/2014
Applicant	Dominus Innovations, LLC 2202 N. West Shore Blvd. Tampa, FL 33607 UNITED STATES		

Goods/Services Affected by Opposition

Class 002. First Use: 2012/07/00 First Use In Commerce: 2012/07/00 All goods and services in the class are opposed, namely: Industrial, marine protective, and specialty coatings in the nature of industrial sealants for waterproofing and surface protection
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Grounds for Opposition

Priority and likelihood of confusion	Trademark Act section 2(d)
Other	Opposers have common law rights in the MSC mark that have priority and are superior to those of the Applicant

Marks Cited by Opposer as Basis for Opposition

U.S. Registration No.	3020989	Application Date	12/15/2004
Registration Date	11/29/2005	Foreign Priority Date	NONE
Word Mark	MSC		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 035. First use: First Use: 1983/08/12 First Use In Commerce: 1983/08/12 Retail store services, catalog mail order services and online retail store services featuring industrial tools, hand tools, power tools, measuring devices, machine tools, machinery and machine accessories, abrasives, machinery labels and maintenance, repair and operations supplies, known as MRO		

U.S. Registration No.	1549612	Application Date	09/29/1988
Registration Date	07/25/1989	Foreign Priority Date	NONE
Word Mark	MSC		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 042. First use: First Use: 1986/01/02 First Use In Commerce: 1986/01/02 RETAIL STORE AND CATALOG MAIL ORDER SERVICES FOR INDUSTRIAL TOOLS, MEASURING DEVICES, MACHINE TOOLS, MACHINERY AND MACHINE ACCESSORIES, ABRASIVES, AND MACHINERY LABELS		

U.S. Registration No.	3054131	Application Date	12/15/2004
Registration Date	01/31/2006	Foreign Priority Date	NONE
Word Mark	MSC INDUSTRIAL SUPPLY CO.		

Design Mark			
Description of Mark	NONE		
Goods/Services	Class 035. First use: First Use: 1985/05/31 First Use In Commerce: 1985/05/31 Retail store services, catalog mail order services and online retail store services featuring industrial tools, hand tools, power tools, measuring devices, machine tools, machinery and machine accessories, abrasives, machinery labels and MRO, namely, maintenance, repair and operations supplies		

U.S. Registration No.	3847258	Application Date	09/16/2009
Registration Date	09/14/2010	Foreign Priority Date	NONE
Word Mark	MSC INDUSTRIAL SUPPLY CO. METALWORKING		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 035. First use: First Use: 2009/02/00 First Use In Commerce: 2009/02/00 Retail store services, catalog mail order services and online retail store services featuring industrial tools, hand tools, power tools, measuring devices, machine tools, machinery and machine accessories, abrasives, machinery labels and maintenance, repair and operations supplies, known as MRO		

U.S. Application/ Registration No.	NONE	Application Date	NONE
Registration Date	NONE		
Word Mark	MSC (common law)		
Goods/Services	sealants, marine sealants, coatings, marine lubricants, marine adhesives, adhesives, paints, caulking, pipe sealants, waterproofing supplies, surface preparation tools, surface preparation supplies, marine supplies, tools, industrial products, and maintenance, repair and operations supplies		

Attachments	78532769#TMSN.jpeg(bytes) 73754834#TMSN.gif(bytes) 78532773#TMSN.jpeg(bytes) 77827781#TMSN.jpeg(bytes) MSC Dominus Opposition.pdf(17441 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	/Michael R. Graif/
Name	Michael R. Graif
Date	05/29/2014

1. Opposers own a trade name MSC (“Trade Name”) and a family of famous common law and federal MSC trademarks and service marks for a large group of products including sealants, marine sealants, coatings, marine lubricants, marine adhesives, adhesives, paints, caulking, pipe sealants, waterproofing supplies, surface preparation tools, surface preparation supplies, marine supplies, tools, industrial products, and maintenance, repair and operations supplies (the “MSC Marks”).

2. Opposers have continuously made commercial use of the Trade Name and family of MSC Marks throughout the United States since at least 1983.

3. By virtue of Opposers’ continuous use of the Trade Name and family of MSC Marks in interstate commerce, Opposers have acquired common law rights in them prior to the alleged first use claimed by the Applicant in the Application. Opposers have expended significant amounts of time, money and effort in promoting and advertising the Trade Name and family of MSC Marks as well as the products and services distributed, marketed and sold thereunder. Opposers’ Trade Name and family of MSC Marks are famous and consumers have come to recognize them as identifiers of Opposers’ products and services and as a single source of origin.

4. Opposer MSC Services Inc. owns several federal trademark registrations for its family of MSC Marks, and Opposer Sid Tool Co., Inc. is a licensee of each of these registrations.

5. Opposers’ MSC mark was registered with the United States Patent and Trademark Office (“USPTO”) under the U.S. Trademark Registration No. 3,020,989 on November 29, 2005 for “retail store services, catalog mail order services and online retail store services featuring industrial tools, hand tools, power tools, measuring devices, machine tools, machinery and machine accessories, abrasives, machinery labels and maintenance, repair and operations

supplies, known as MRO” in International Class 35 and recites a date of first use in commerce at least as early as August 12, 1983.

6. Opposers’ MSC (stylized) mark was registered with the USPTO under the U.S. Trademark Registration No. 1,549,612 on May 2, 1989 for “retail store services and catalog mail order services for industrial tools, measuring devices, machine tools, machinery and machine accessories, abrasives, and machinery labels” in International Class 42 and recites a date of first use in commerce of January 2, 1989.

7. Opposers’ MSC INDUSTRIAL SUPPLY CO. mark was registered with the USPTO under the U.S. Trademark Registration No. 3,054,131 on January 31, 2006 for “retail store services, catalog mail order services and online retail store services featuring industrial tools, hand tools, power tools, measuring devices, machine tools, machinery and machine accessories, abrasives, machinery labels and MRO, namely, maintenance, repair and operations supplies” in International Class 35 and recites a date of first use in commerce at least as early as May 31, 1985.

8. Opposers’ MSC INDUSTRIAL SUPPLY CO. METALWORKING mark was registered with the USPTO under the U.S. Trademark Registration No. 3,847,258 on September 14, 2010 for “retail store services, catalog mail order services and online retail store services featuring industrial tools, hand tools, power tools, measuring devices, machine tools, machinery and machine accessories, abrasives, machinery labels and maintenance, repair and operations supplies, known as MRO” in International Class 35 and recites a date of first use in commerce at least as early as February 2009.

9. Registration Nos. 1,549,612, 3,020,989, 3,054,131 and 3,847,258 (the “MSC Registrations”) are registered on the Principal Register of the USPTO and are valid and

subsisting. Moreover, Registration Nos. 1,549,612, 3,020,989 and 3,054,131 (the “Incontestable Registrations”) have been continuously registered for five years and are incontestable under Section 15 of the Lanham Act (15 U.S.C. § 1065). The Incontestable Registrations are presumptively valid and the marks registered thereunder are presumptively strong.

10. On May 17, 1985, Opposer MSC Services filed an application to register its MSC INDUSTRIAL SUPPLY COMPANY mark. Opposers’ MSC INDUSTRIAL SUPPLY COMPANY mark was registered with the USPTO on December 10, 1985 under U.S. Registration No. 1,375,246 for “retail store and catalog mail order services for industrial tools, measuring devices, machine tools, machinery and machine accessories, abrasives, and machinery labels” in International Class 42 and recites a date of first commercial use of May 1, 1985. Opposers’ federal registration for this mark was cancelled on July 29, 1992; however, Opposers’ common law rights in this mark are valid and subsisting.

11. Upon information and belief, Applicant Dominus Innovations, LLC is a limited liability company organized under the laws of Delaware and is located and doing business at 2202 N. West Shore Blvd. Tampa, FL 33607.

12. Opposers’ commercial use of the Trade Name and family of MSC Marks predates Applicant’s claimed date of first use of the identical MSC mark.

13. The Application claims that Applicant uses the MSC mark in connection with marketing, distributing and selling products and services that are substantially similar and/or related to the goods and services covered by Opposers’ Trade Name and family of MSC Marks.

14. In view of Opposers’ use of the Trade Name and family of MSC Marks that had acquired distinctiveness before the Applicant’s claimed first use of the MSC mark, Opposers’

rights in the names and marks MSC are superior and have priority to Applicant's rights in the MSC mark.

15. On information and belief, Applicant and Opposers use some of the same channels of trade.

16. By reason of all of the foregoing, 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 Application would seriously damage Opposers.

WHEREFORE, Opposers request that this Opposition be sustained, that Application Serial No. 86115272 for the MSC mark be refused registration and that Opposers be granted all such further relief as the Trademark Trial and Appeal Board may deem necessary and just.

Respectfully submitted,

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

Dated: New York, New York
May 29, 2014

By: /s/ Michael R. Graif
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CERTIFICATE OF SERVICE

I hereby certify that, on the 29th day of May, 2014, I caused a true and correct copy of the Notice of Opposition to be served, pursuant to 37 C.F.R. § 2.101, via First Class Mail upon:

Noland J. Cheung, Esq.
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Attorney for Applicant

/s/ Michael R. Graif

Michael R. Graif