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

Proceeding	91216619
Party	Defendant Dominus Innovations, LLC
Correspondence Address	NOLAND J. CHEUNG COHEN & GRIGSBY, P.C. 625 LIBERTY AVE FL 7 PITTSBURGH, PA 15222-3152  iptrademark@cohenlaw.com
Submission	Answer
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Date	09/08/2014
Attachments	Answer-to-Notice-of-Opposition.pdf(52725 bytes )



- the Notice of Opposition are legal conclusions for which no responsive pleading is required.
2. Applicant is without information sufficient to form a belief as to the factual contentions of Paragraph 2 of the Notice of Opposition and therefore denies the same and leaves Opposers to their proofs. The other contentions of Paragraph 2 of the Notice of Opposition are legal conclusions for which no responsive pleading is required.
  3. Applicant is without information sufficient to form a belief as to the factual contentions of Paragraph 3 of the Notice of Opposition and therefore denies the same and leaves Opposers to their proofs. The other contentions of Paragraph 3 of the Notice of Opposition are legal conclusions for which no responsive pleading is required.
  4. Applicant is without information sufficient to form a belief as to the factual contentions of Paragraph 4 of the Notice of Opposition and therefore denies the same and leaves Opposers to their proofs. The other contentions of Paragraph 4 of the Notice of Opposition are legal conclusions for which no responsive pleading is required.
  5. Applicant admits that Registration No. 3,020,989 purports to have been issued on November 29, 2005 for the mark MCS 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 of

August 12, 1983. Applicant is without information sufficient to form a belief as to the other averments of Paragraph 5 of the Notice and therefore denies the same and leaves Opposers to their proofs.

6. Applicant admits that Registration No. 1,549,612 purports to have been issued on May 2, 1989 for the stylized mark MCS 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 use in commerce of January 2, 1989. Applicant is without information sufficient to form a belief as to the other averments of Paragraph 6 of the Notice and therefore denies the same and leaves Opposers to their proofs.
7. Applicant admits that Registration No. 3,054,131 purports to have been issued on January 31, 2006 for the mark MCS INDUSTRIAL SUPPLY CO. 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 of May 31, 1985. Applicant is without information sufficient to form a belief as to the other averments of Paragraph 7 of the Notice and therefore denies the same and leaves Opposers to their proofs.
8. Applicant admits that Registration No. 3,847,258 purports to have been issued on September 14, 2010 for the mark MCS INDUSTRIAL SUPPLY CO. METAL WORKINNG 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 of February 2009. Applicant is without information sufficient to form a belief as to the other averments of Paragraph 8 of the Notice and therefore denies the same and leaves Opposers to their proofs.
9. Applicant is without information sufficient to form a belief as to the factual contentions of Paragraph 9 of the Notice of Opposition and therefore denies the same and leaves Opposers to their proofs. The other contentions of Paragraph 9 of the Notice of Opposition are legal conclusions for which no responsive pleading is required.
10. Applicant admits that Registration No. 1,375,246 purports to have been issued on December 10, 1985 based on an application that was filed on May 17, 1985 for the mark MCS INDUSTRIAL SUPPLY COMPANY 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 use in commerce of May 1, 1985. Applicant further admits that Registration No. 1,375,246 was cancelled on July 29, 1992. Applicant is without information sufficient to form a belief as to the other factual averments of Paragraph 10 of the Notice and therefore denies the same and leaves Opposers to their proofs. The other contentions of Paragraph 10 of the Notice of Opposition are legal conclusions for which no responsive pleading is required.
11. Admitted.

12. Applicant is without information sufficient to form a belief as to the factual contentions of Paragraph 12 of the Notice of Opposition and therefore denies the same and leaves Opposers to their proofs. The other contentions of Paragraph 12 of the Notice of Opposition are legal conclusions for which no responsive pleading is required.
13. The Application is a document that speaks for itself. Applicant denies that the goods and services identified in the Application are substantially similar and/or related to the goods and services that are identified in Registration Nos. 1,549,612; 3,020,989; 3,054,131; or 3,847,258. Applicant is without information sufficient to form a belief as to the other factual contentions of Paragraph 13 of the Notice of Opposition and therefore denies the same and leaves Opposers to their proofs. The other contentions of Paragraph 13 of the Notice of Opposition are legal conclusions for which no responsive pleading is required.
14. Applicant is without information sufficient to form a belief as to the factual contentions of Paragraph 14 of the Notice of Opposition and therefore denies the same and leaves Opposers to their proofs. The other contentions of Paragraph 14 of the Notice of Opposition are legal conclusions for which no responsive pleading is required.
15. Denied.
16. Paragraph 16 of the Notice avers conclusions of law for which no responsive pleading is required. To the extent that any responsive pleading is deemed necessary, Applicant is without information sufficient to form a belief as to the factual

contentions of Paragraph 16 of the Notice and therefore denies the same and leaves Opposers to their proofs.

17. Paragraph 17 of the Notice avers conclusions of law for which no responsive pleading is required. To the extent that any responsive pleading is deemed necessary, Applicant is without information sufficient to form a belief as to the averments of Paragraph 17 of the Notice and therefore denies the same and leaves Opposers to their proofs.

### **AFFIRMATIVE DEFENSES**

In further answer to the Notice of Opposition, Applicant asserts as separate and affirmative defenses that:

1. The Notice of Opposition and each paragraph thereof, taken individually or collectively, fails to support a basis for the relief sought.
2. The Notice of Opposition fails to state a cause of action upon which relief may be granted in law or equity.
3. Opposer lacks standing to oppose the Application in that Opposer is not likely to be damaged or injured by Applicant's use and registration of MSC.
4. Opposer's unclean hands will prevent it from being held to be the prior user of the mark MSC, as Opposer has not sufficiently used that mark in United States commerce in connection with Opposer's goods to establish exclusive rights therein.
5. There is no likelihood of confusion, mistake or deception as to MSC as used due to differences in: (a) the meaning and appearance of Applicant's mark and Opposer's purported mark when considered in their entirety; (b) the respective goods and services offered under

each mark; (c) the potential purchasers of goods under each mark; and (d) the channels of trade for the parties' respective goods in which each mark is used; which negate any likelihood of confusion.

6. Opposers' unclean hands will prevent it from being held to be the prior user of the mark MCS, as Opposers have not engaged in the bona fide use of the MSC mark in the ordinary course of business so as to be able to assert recognizable prior rights to the MSC mark in connection with Opposers' goods.

7. Applicant reserves the right to plead any appropriate counterclaims and additional affirmative defenses and to supplement those claims and defenses asserted herein upon discovery of further information and investigation into the Opposers' claims.

WHEREFORE, Applicant respectfully requests the Notice of Opposition be denied and dismissed with prejudice, and Application Serial No. 86/115,272 be promptly referred for registration.

Respectfully submitted,

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Attorney for Applicant

Dated: September 8, 2014

## CERTIFICATE OF SERVICE

The undersigned hereby certifies that a true and correct copy of the foregoing  
APPLICANT'S ANSWER TO NOTICE OF OPPOSITION related to Opposition No. 91216619  
was mailed on September 8, 2014, first-class postage prepaid, to counsel for Opposer:

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