

ESTTA Tracking number: **ESTTA614341**

Filing date: **07/08/2014**

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	SPEX SamplePrep, LLC
Granted to Date of previous extension	07/13/2014
Address	15 Liberty St. Metuchen, NJ 08840 UNITED STATES

Name	MSI Holdings, LLC
Granted to Date of previous extension	07/13/2014
Address	203 Norcross Avene Metuchen, NJ 08840 UNITED STATES

Name	SPEX CertiPrep, Inc.
Granted to Date of previous extension	07/13/2014
Address	203 Norcross Ave. Metuchen, NJ 08840 UNITED STATES

Attorney information	MICHAEL R GILMAN PERGAMENT GILMAN & CEPEDA LLP 163 MADISON AVE, STE 110 MORRISTOWN, NJ 07960 UNITED STATES mgilman@pgclawgroup.com Phone:973 998-7722
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Applicant Information

Application No	79129065	Publication date	01/14/2014
Opposition Filing Date	07/08/2014	Opposition Period Ends	07/13/2014
International Registration No.	1157599	International Registration Date	01/15/2013
Applicants	Roger Thomas Mascull 11 Mason Place NEW ZEALAND		

	Elizabeth Jocelyn Mascull 11 Mason Place NEW ZEALAND
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Goods/Services Affected by Opposition

Class 010. First Use: 0 First Use In Commerce: 0 All goods and services in the class are opposed, namely: Medical apparatus, namely, medical products in the nature of therapeutic seats,pads, cushions, adductor supports, forearm supports, knee supports, backrests, trunk supports, head supports, pelvic supports, limb stabilizers and tray tablesfor wheelchairs and component parts therefor; medical postural care products, namely, posture correction devices in thenature of belts and harnesses for postural support
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Grounds for Opposition

Deceptiveness	Trademark Act section 2(a)
False suggestion of a connection	Trademark Act section 2(a)
Priority and likelihood of confusion	Trademark Act section 2(d)
Other	lack of bona fide intent to use the mark on the goods as of the filing date of the opposed application

Marks Cited by Opposer as Basis for Opposition

U.S. Registration No.	1312902	Application Date	01/20/1984
Registration Date	01/08/1985	Foreign Priority Date	NONE
Word Mark	SPEX		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 001. First use: First Use: 1954/01/01 First Use In Commerce: 1954/01/01 Inorganic Chemicals and Chemical Standards for General Industrial and Laboratory Use Class 009. First use: First Use: 1954/01/01 First Use In Commerce: 1954/01/01 Measuring and Scientific Instruments-Namely, Spectrometers and Parts Therefor, Spectrographs, Spectrophotometers, Phosphorimeters, Colorimeters, Monochromators, Spectrofluorometers and Parts Therefor, Controllers and Parts Therefor, and Microprocessor Data-Processors for Spectrometric Instrumentation; Laboratory Equipment-Namely, Presses and Grinders for Preparing Materials for Spectrometric Analysis		

U.S. Registration No.	4419863	Application Date	12/03/2012
Registration Date	10/15/2013	Foreign Priority Date	NONE
Word Mark	SPEXQUE		

Design Mark	
Description of Mark	NONE
Goods/Services	Class 001. First use: First Use: 2013/03/18 First Use In Commerce: 2013/03/18 Chemical test kits for examining pesticide residues in food for laboratory or re-search use

Attachments	85792624#TMSN.jpeg(bytes) Notice of Opposition - Medifab's US SPEX App.pdf(18595 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. Gilman/
Name	MICHAEL R GILMAN
Date	07/08/2014

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

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MSI HOLDINGS, LLC,	:	
SPEX SAMPLEPREP, LLC and	:	
SPEX CERTIPREP, INC.,	:	
	:	Opposition No.
Opposers,	:	
	:	
v.	:	Serial No. 79-129,065
	:	
ROGER THOMAS MASCULL and	:	
ELIZABETH JOCELYN MASCULL,	:	Opposed Mark: SPEX
Together D/B/A MEDIFAB MEDICAL	:	
FABRICATION	:	
	:	
Applicants.	:	
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NOTICE OF OPPOSITION

In the matter of Application Serial No. 79/129,065 (“the ‘065 application”) for registration in International Class 10 of the mark SPEX, having an effective filing date in the United States Patent and Trademark Office (“USPTO”) of January 15, 2013, and published in the Official Gazette on January 14, 2014, in the names of Roger Thomas Mascull and Elizabeth Jocelyn Mascull (collectively “applicant”), believed to be doing business as Medifab Medical Fabrication, for “Medical apparatus, namely, medical products in the nature of therapeutic seats, pads, cushions, adductor supports, forearm supports, knee supports, backrests, trunk supports, head supports, pelvic supports, limb stabilizers and tray tables for wheelchairs and component parts therefor; medical postural care products, namely, posture correction devices in the nature of belts and harnesses for postural support”.

MSI Holdings, LLC, a limited liability company of Delaware, located and doing business at 203 Norcross Avenue, Metuchen, NJ 08840 (“MSIH”), is the owner of the SPEX mark in the

United States and around the world, and with its licensees, SPEX SamplePrep, LLC, a limited liability company of Delaware, located and doing business at 15 Liberty Street, Metuchen, NJ 08840 (“SamplePrep”) and SPEX CertiPrep, Inc., a Delaware corporation, located and doing business at 203 Norcross Avenue, Metuchen, NJ 08840 (“CertiPrep”), believe they will be damaged by registration of the mark SPEX of the ‘065 application by applicants and hereby timely oppose registration of said mark pursuant to Section 13 of the Trademark Act of July 5, 1946, 15 U.S.C. Sec. 1063, on the following grounds:

1. MSIH is the owner of U.S. Trademark Registration No. 1,312,902, issued on January 8, 1985, for the mark SPEX for “Inorganic Chemicals and Chemical Standards for General Industrial and Laboratory Use” in International Class 1 and “Measuring and Scientific Instruments-Namely, Spectrometers and Parts Therefor, Spectrographs, Spectrophotometers, Phosphorimeters, Colorimeters, Monochromators, Spectrofluorometers and Parts Therefor, Controllers and Parts Therefor, and Microprocessor Data-Processors for Spectrometric Instrumentation; Laboratory Equipment-Namely, Presses and Grinders for Preparing Materials for Spectrometric Analysis” in International Class 9.

2. MSIH is the owner of U.S. Trademark Registration No. 4,419,863, issued on October 15, 2013, for the mark SPEXQUE for “Chemical test kits for examining pesticide residues in food for laboratory or research use” in International Class 1.

3. SamplePrep and CertiPrep are the licensees of MSIH, at least in the United States, under the SPEX and SPEXQUE marks.

4. Upon information and belief, the earliest date of use or constructive use applicant can claim for its mark SPEX in the United States is the filing date of the ‘065 application; namely, January 15, 2013.

5. Opposers' SPEX mark and applicant's SPEX mark are identical.
6. Opposers' SPEXQUE mark and applicant's SPEX mark are so highly related and similar in look, sound, connotation and commercial impression as to be essentially identical.
7. Applicant's medical apparatus are similar in scope to the chemical and chemical standards and the measuring and scientific instruments and laboratory equipment and chemical test kits of opposers' SPEX and SPEXQUE registrations.
8. Opposers' rights in the SPEX mark are far superior by multiple decades to any rights which may be asserted by applicant in this proceeding.
9. Opposers' rights in the SPEXQUE mark are superior to any rights which may be asserted by applicant in this proceeding.
10. The marks being identical and substantially similar, and the goods being highly related, consumers of applicant's goods would be likely to be confused, mistaken and/or deceived as to the source or origin of applicant's goods and/or as to there being an affiliation or connection between applicant and its goods, and opposers' and their goods, within the meaning of Section 2(d) of the Lanham Act, 15 U.S.C. Section 1052(d).
11. Applicant's intention to use a mark that so closely resembles opposers' SPEX mark, which has both constructive and actual use dates well prior to any date applicant may rely upon in this proceeding, evidences an intention by applicant to trade on opposers' goodwill.
12. Opposers' use and registration of the SPEXQUE mark shows opposers' continuing intention to expand both the SPEX mark and the goods sold under the SPEX mark.
13. Additionally, and upon information and belief, applicant's use of the SPEX mark is intended to mimic and point uniquely to opposers' identity or persona. In particular, applicant's SPEX mark is expressly calculated to suggest a false connection with opposers'

already, long existing presence under the SPEX name. Since, over the continuous period since 1954, the term SPEX is, and has come to be associated with, opposers and opposers' goods, applicant's mark is deceptive under Section 2(a) of the Lanham Act, 15, U.S.C. Section 1052(a).

14. Moreover, applicant is deceiving the consuming public in a way that would materially affect their decision to purchase applicant's goods; *i.e.*, applicant's emphasis on the term SPEX in its mark will cause purchasers or consumers to assume that applicant's medical apparatus, sold under applicant's SPEX mark, are connected with opposers' existing goods sold under their identical SPEX mark. Thus, and since opposer previously used the identical SPEX mark for sixty (60) years (since 1954) to designate opposers' identity or persona, applicant's mark suggests a false connection with opposers under Section 2(a) of the Lanham Act, 15, U.S.C. Section 1052(a).

15. Upon information and belief, applicant did not have a *bona fide* intent to use the SPEX mark in United States commerce on the goods identified in the '065 application as of, or even reasonably around, the date the '065 application was filed.

16. Opposers will therefore be damaged by the registration sought by applicant, insofar as the registration would constitute *prima facie* evidence of the validity of the registration, applicant's ownership of the SPEX mark, and applicant's exclusive right to use the mark, when, in fact, applicant is not entitled to such rights by virtue of opposers' prior rights in the SPEX and SPEXQUE marks as asserted herein, in association with highly related goods.

17. On the basis of the foregoing, opposers are likely to be materially harmed and damaged by issuance to registration of applicant's SPEX mark of the opposed '065 application.

WHEREFORE, opposers pray that the instant opposition be sustained and the issuance of a registration based on Application Serial No. 79-129,065 to applicant be denied.

The Commissioner is authorized to charge any deficiencies in payment, or credit any overpayment, to Deposit Account No. 50-4711.

Respectfully submitted,

PERGAMENT GILMAN & CEPEDA LLP
Attorneys for Opposers
163 Madison Avenue, Suite 110
Morristown, NJ 07960
Phone (973) 998-7722

Dated: July 8, 2014

By: s/Michael R. Gilman/
Michael R. Gilman

CERTIFICATE OF SERVICE

I, Michael R. Gilman, do hereby certify that a true and correct copy of the foregoing document, entitled “**NOTICE OF OPPOSITION**,” was served on this 8th day of July, 2014, by first class mail, postage prepaid, on applicant, applicant’s US counsel, and applicant’s foreign attorneys of record in application Serial No. 79/129,065, as follows:

A J Pietras & Co
PO Box 30173
Lower Hutt 5040
New Zealand

and

Elizabeth Jocelyn Mascull
Roger Thomas Mascull
11 Mason Place
Ashburton
New Zealand

and

Dana P. Jozefczyk, Esq.
Merchant & Gould
1801 California St., Ste 3300
Denver, CO 80202

Dated: July 8, 2014

By: s/Michael R. Gilman/
 Michael R. Gilman

Certificate Of Filing On ESTTA System

I hereby certify that this document is being filed using the United States Patent and Trademark Office website ESTTA service, on this 8th day of July, 2014.

Dated: July 8, 2014

By: s/Michael R. Gilman/
 Michael R. Gilman