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

Petition for Cancellation

Notice is hereby given that the following parties request to cancel indicated registration.

Petitioner 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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Registration Subject to Cancellation

Registration No	4448231	Registration date	12/10/2013
Registrant	MSC Microcomputers Systems Components Vertriebs GmbH Industriestr. 16 Stutensee, 76297 GERMANY		

Goods/Services Subject to Cancellation

<p>Class 009. First Use: 2011/09/01 First Use In Commerce: 2011/09/01 All goods and services in the class are cancelled, namely: Computer components and microcomputer components, namely, electronic components for computers; semiconductors; computer software development tools for microcontrollers; microcontrollers for peripheral components; microcontrollers, namely, touch technology microcontrollers, general purpose controllers, network and communication controllers, super low power controllers, high performance microcontrollers, microcontrollers for LCD-driving, for motor controlling, for low power application, for medical purposes; high reliability microprocessors, PC host microprocessors; PC integrated processors; PC multi-chip modules; VGA-controllers, graphic-controllers, image processors; computers, namely, board computers (SBC), personal computers (PCs), box PCs, desktop PCs, tablet computers, signage PCs, wall-mount PCs, lap-tops, computer notebooks, computer sub-notebooks, rack-mount computers, industrial PCs, embedded PCs, human machine interface units comprising a computer and a display, panel PCs, micro client computers, thin client computers, interactive client computers, kiosk PCs, gaming PCs, touch panel PCs, in-vehicle PCs, in-car PCs, infotainment PCs, telematics PCs, rugged computers, rugged computer notebooks, wearable PCs; rugged computers and parts and components thereof; computer memories; memory components, namely, DRAM, SRAM, Dual Port RAM, EEPROM, EPROM, Flash,</p>

FRAM, PROM, MRAM, multi-chip modules; programmable logic controllers, namely, ASICs, FPGA, GAL; prerecorded data carriers, storage media, storage cards, flash storage devices, hard disks, and flash-based hard disks allfeaturing computer software, namely, I/O driver software providing the interface between the dedicated operating systemand the computer hardware, and BIOS software; computer software development tools for programmable logic controllers; memory boards; diodes, namely, infrared diodes, laser diodes; optical transceiver, opt coupler; linear components, namely, AC/DC converters, DC/DC converters, analog digital converters and digital analog converters, amplifiers, comparator components, data conversion components, components for power management; power converters, electronic circuit boards; computer interface boards; integrated circuits (ic) for audio or video applications,driver-ICs; power components, namely, diodes, IGBTs, rectifiers, MOSFET, TRIACS, thyristors and transistors; wireless components, namely, W-LAN components, CATV components, GPS-components, GSM components, GPRS-components, crystal oscillators, crystal resonators, crystal filters,microwave products, real time clocks, watch crystals; electrical switches; flatpanel display solution components, namely, LCD monitors, open frame monitors, TFT components namely, thin film transistor liquid crystal displays, LCDs, namely, numeric LCD modules, graphic LCD monochrome components, touch screens; displayglasses; LCD controllers and -cards, LCD inverters and LCD backlights; LCD single board computer; touch panels; rugged liquid crystal displays (LCD); lightingcomponents, namely, LED components (light emitting diode components), LED secondary optics, drivers and controllers forLED components, namely, DC/DC constant current LED drivers, AC/DC LED power supplies, intelligent LED drivers for general illumination applications; software driver ICs for high brightness LED control, DC/DC converters for LED control; LEDcontrollers, namely, AC/DC LED controllers, DC/DC LED controllers, microcontrollers for LED lightning control, lightning controllers for fluoresecent ballast, printed circuit boards for LED and lightning components, connectors for LED applications; LED-modules for indoor and outdoor purposes; computer parts, namely, solid state drives, memory modules, flash cars, USB flash drivers, compact flash cards; network components, namely, optical transceivers; embedded communication components, namely, computer hardware fordata communication; electro mechanic components, namely, internal cooling fans for computers; relays, namely, relays for automatize applications, industrial applications, power applications, signal applications and solid state applications; batteries and battery components, namely, charges, super caps, primary batteries, lithium-ion batteries; connectors and connector components, namely, electro mechanic switches, jacks and modular jacks, switch boxes; electronic connectors for board to board and wire to wire applications, electronic connectors for automotive applications and medical applications, coaxial connectors, electronic connectors for IC-sockets, electronic connectors for interfaces; routers; embedded computers; embedded computer modules; embedded PC circuit boards; embedded computer circuit boards and baseboards; computer software development tools for embedded computers and embedded computer modules

Class 016. First Use: 2011/09/01 First Use In Commerce: 2011/09/01

All goods and services in the class are cancelled, namely: Printed matter, namely, textbooks, data-sheets, brochures, white papers, newsletters, technical manuals, user manuals, instruction guides, reference guides, reference manuals in the fields of embeddedcomputers, embedded computing, electronics, lightning and electronic components

Class 035. First Use: 2011/09/01 First Use In Commerce: 2011/09/01

All goods and services in the class are cancelled, namely: Computerized online retail store services, mail order and distributorship services in the fields of computer hardware, electronic devices, computer components,lightning components, LED components, LCD components, IT and network components, and electro mechanic components

Class 042. First Use: 2011/09/01 First Use In Commerce: 2011/09/01

All goods and services in the class are cancelled, namely: Design and development of embedded computers, computer hardware, and networks; technology consulting services in the fields of embedded computers and embedded computing, and electronics; technical support services, namely, troubleshooting problems in the fields of embedded computers and embedded computing; providing information in the fields of developing embedded computers and embedded computingover computer networks and global communication networks

Grounds for Cancellation

Abandonment	Trademark Act section 14
Priority and likelihood of confusion	Trademark Act section 2(d)

Other	Petitioners have common law rights in the MSC mark that are superior and have priority to Respondent's use
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Marks Cited by Petitioner as Basis for Cancellation

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
Goods/Services	tools, industrial products, AC/DC converters, DC/DC converters, batteries and battery components, lighting components, clocks, electrical switches, LED components, CATV components, lighting controllers for fluorescent ballasts, electro mechanic components, relays, switch boxes, electro mechanic switches, coaxial connectors, electronic connectors and maintenance, repair and operations supplies

Attachments	78532769#TMSN.jpeg(bytes) 73754834#TMSN.gif(bytes) 78532773#TMSN.jpeg(bytes) 77827781#TMSN.jpeg(bytes) MSC Microcomputers.pdf(22488 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	05/07/2014

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

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MSC SERVICES, CORP., SID TOOL CO., INC. (D/B/A MSC INDUSTRIAL SUPPLY CO.)	:	
	:	
Petitioners,	:	
	:	
against	:	Cancellation No. _____
	:	
MSC MICROCOMPUTERS SYSTEMS COMPONENTS VERTRIEBS GMBH,	:	
	:	
Respondent.	:	
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PETITION FOR CANCELLATION

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 “Petitioners”), and believe that they are damaged by United States Trademark Registration No. 4,448,231 (the “Registration No. 4,448,231”) and hereby petitions to cancel the same under the provisions of 15 U.S.C. § 1064. As grounds for cancellation, Petitioners assert that:

Petitioners and Their Family of MSC Marks

1. Petitioners 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 tools, industrial products, AC/DC converters, DC/DC converters, batteries and battery components, lighting components, clocks, electrical switches, LED components, CATV components, lighting controllers for fluorescent ballasts, electro mechanic components, relays,

switch boxes, electro mechanic switches, coaxial connectors, electronic connectors and maintenance, repair and operations supplies (the “MSC Marks”).

2. Petitioners 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 Petitioners’ continuous use of the Trade Name and family of MSC Marks in interstate commerce, Petitioners have acquired common law rights in them prior to the alleged first use claimed by the Registration No. 4,448,231. Petitioners 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. Petitioners’ Trade Name and family of MSC Marks are famous and consumers have come to recognize them as identifiers of Petitioners’ products and services and as a single source of origin.

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

5. Petitioners’ 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. Petitioners' 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. Petitioners' 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. Petitioners' 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, Petitioner MSC Services filed an application to register its MSC INDUSTRIAL SUPPLY COMPANY mark. Petitioners' 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. Petitioners' federal registration for this mark was cancelled on July 29, 1992; however, Petitioners' common law rights in this mark are valid and subsisting.

Respondent and Registration No. 4,448,231

11. Upon information and belief, MSC Microcomputers Systems Components Vertriebs GmbH is a corporation organized under the laws of Germany, located and doing business at Industriestraße16, 76297 Stutensee, Germany ("Respondent").

12. Upon information and belief, Respondent is the owner of record of Registration No. 4,448,231, dated December 10, 2013, for the mark MSC for:

"Computer components and microcomputer components, namely, electronic components for computers; semiconductors; computer software development tools for microcontrollers; microcontrollers for peripheral components; microcontrollers, namely, touch technology microcontrollers, general purpose controllers, network and communication controllers, super low power controllers, high performance microcontrollers, microcontrollers for LCD-driving, for motor controlling, for low power application, for medical purposes; high reliability microprocessors, PC host microprocessors; PC integrated processors; PC multi-chip modules; VGA-controllers, graphic-controllers, image processors; computers, namely, board computers (SBC), personal computers (PCs), box PCs, desktop PCs, tablet computers, signage PCs, wall-mount PCs, lap-tops, computer notebooks, computer sub-

notebooks, rack-mount computers, industrial PCs, embedded PCs, human machine interface units comprising a computer and a display, panel PCs, micro client computers, thin client computers, interactive client computers, kiosk PCs, gaming PCs, touch panel PCs, in-vehicle PCs, in-car PCs, infotainment PCs, telematics PCs, rugged computers, rugged computer notebooks, wearable PCs; rugged computers and parts and components thereof; computer memories; memory components, namely, DRAM, SRAM, Dual Port RAM, EEPROM, EPROM, Flash, FRAM, PROM, MRAM, multi-chip modules; programmable logic controllers, namely, ASICs, FPGA, GAL; prerecorded data carriers, storage media, storage cards, flash storage devices, hard disks, and flash-based hard disks all featuring computer software, namely, I/O driver software providing the interface between the dedicated operating system and the computer hardware, and BIOS software; computer software development tools for programmable logic controllers; memory boards; diodes, namely, infrared diodes, laser diodes; optical transceiver, opt coupler. linear components, namely, AC/DC converters, DC/DC converters, analog digital converters and digital analog converters, amplifiers, comparator components, data conversion components, components for power management; power converters, electronic circuit boards; computer interface boards; integrated circuits (ic) for audio or video applications, driver-ICs; power components, namely, diodes, IGBTs, rectifiers, MOSFET, TRIACS, thyristors and transistors; wireless components, namely, W-LAN components, CATV components, GPS-components, GSM components, GPRS-components, crystal oscillators, crystal resonators, crystal filters, microwave products, real time clocks, watch crystals; electrical switches; flat panel display solution components, namely, LCD monitors, open frame monitors, TFT components namely, thin film transistor liquid crystal displays, LCDs, namely, numeric LCD modules, graphic LCD monochrome components, touch screens; display glasses; LCD controllers and -cards, LCD inverters and LCD backlights; LCD single board computer; touch panels; rugged liquid crystal displays (LCD); lightning components, namely, LED components (light emitting diode components), LED secondary optics, drivers and controllers for LED components, namely, DC/DC constant current LED drivers, AC/DC LED power supplies, intelligent LED drivers for general illumination applications; software driver ICs for high brightness LED control, DC/DC converters for LED control; LED controllers, namely, AC/DC LED controllers, DC/DC LED controllers, microcontrollers for LED lightning control, lightning controllers for fluorescent ballast, printed circuit boards for LED and lightning components, connectors for LED applications; LED-modules for indoor and outdoor purposes;

computer parts, namely, solid state drives, memory modules, flash cards, USB flash drivers, compact flash cards; network components, namely, optical transceivers; embedded communication components, namely, computer hardware for data communication. electro mechanic components, namely, internal cooling fans for computers; relays, namely, relays for automatize applications, industrial applications, power applications, signal applications and solid state applications; batteries and battery components, namely, charges, super caps, primary batteries, lithium-ion batteries; connectors and connector components, namely, electro mechanic switches, jacks and modular jacks, switch boxes; electronic connectors for board to board and wire to wire applications, electronic connectors for automotive applications and medical applications, coaxial connectors, electronic connectors for IC-sockets, electronic connectors for interfaces; routers; embedded computers; embedded computer modules; embedded PC circuit boards; embedded computer circuit boards and baseboards; computer software development tools for embedded computers and embedded computer modules” in International Class 009 and United States Classes 021, 023, 026, 036 and 038;

“Printed matter, namely, textbooks, datasheets, brochures, white papers, newsletters, technical manuals, user manuals, instruction guides, reference guides, reference manuals in the fields of embedded computers, embedded computing, electronics, lightning and electronic components” in International Class 016 and United States Classes 002, 005, 022, 023, 029, 037, 038 and 050;

“Computerized online retail store services, mail order and distributorship services in the fields of computer hardware, electronic devices, computer components, lightning components, LED components, LCD components, IT and network components, and electro mechanic components” in International Class 035 and United States Classes 100, 101 and 102; and

“Design and development of embedded computers, computer hardware, and networks; technology consulting services in the fields of embedded computers and embedded computing, and electronics; technical support services, namely, troubleshooting problems in the fields of embedded computers and embedded computing; providing information in the fields of developing embedded computers and embedded computing over computer networks and global communication networks” in International Class 042 and United States Classes 100 and 101.

Registration No. 4,448,231 claims a date of first use in commerce of the MSC mark of September 1, 2011 with respect to all goods and services.

Registration No. 4,448,231 Should Be Cancelled As Likely to Cause Confusion with Petitioners' Trade Name and Family of MSC Marks

13. Petitioners' commercial use of the Trade Name and family of MSC Marks predates Respondent's claimed date of first use of the identical MSC mark.

14. Registration No. 4,448,231 claims that Respondent 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 Petitioners' Trade Name and family of MSC Marks.

15. In view of Petitioners' use of the Trade Name and family of MSC Marks that had acquired distinctiveness before the Respondent's claimed first use of the MSC mark, Petitioners' rights in the names and marks MSC are superior and have priority to Respondent's rights in the MSC mark.

16. On information and belief, Respondent and Petitioners use some of the same channels of trade.

17. 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 Respondent's goods and/or Petitioners' affiliation, sponsorship or connection with Respondent

18. As a result of Respondent's Registration No. 4,448,231, Petitioners have been and will continue to be damaged unless Registration No. 4,448,231 is cancelled.

WHEREFORE, Petitioner requests cancellation of United States Trademark Registration No. 4,448,231 under § 2(d) of the Lanham Act because the registration is likely to cause consumer confusion, and requests that Petitioners 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 7, 2014

By: /s/ Michael R. Graif
Michael R. Graif
Curtis, Mallet-Prevost,
Colt & Mosle LLP
101 Park Avenue
New York, New York 10178-0061
Telephone: (212) 696-6000
Facsimile: (917) 368-8842
Email: mgraif@curtis.com