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Filing date: **06/30/2014**

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 Yor
Address	75 Maxess Road Melville, NY 11747 UNITED STATES		

Attorney informa- tion	Michael R. Graif Curtis, Mallet Prevost, Colt & Mosle LLP 101 Park Avenue New York, NY 10178 UNITED STATES mgraif@curtis.com, kmeehan@curtis.com, kparsons@curtis.com Phone:212-696-6000		
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Registration Subject to Cancellation

Registration No	4520469	Registration date	04/29/2014
Registrant	Ninghai Chuangxin Tourists Products Co., Ltd. No. 1, Huancheng South Road Zhejiang, CHINA		

Goods/Services Subject to Cancellation

Class 022. First Use: 2010/01/26 First Use In Commerce: 2010/01/26 All goods and services in the class are cancelled, namely: Awnings; Camouflage nets; Hammocks; Packaging bags of textile material; Sacks or bags for the transportation or storage of materials in bulk; Sails; Tarpaulins; Tents; Unfitted covers for boats and marine vehicles; Unfitted vehicle covers

Grounds for Cancellation

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

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 supplies, bags, packaging and shipping materials, storage supplies, tarps, fleet maintenance supplies, shelters, and maintenance, repair and operations (MRO) supplies		

Attachments	78532769#TMSN.jpeg(bytes) 73754834#TMSN.gif(bytes) 78532773#TMSN.jpeg(bytes) 77827781#TMSN.jpeg(bytes) Petition to Cancel Ninghai.pdf(20927 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	/s/ Michael R. Graif
Name	Michael R. Graif
Date	06/30/2014

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

MSC SERVICES CORP.; SID TOOL CO., INC. (D/B/A MSC INDUSTRIAL SUPPLY CO.)	:	X	
	:	:	
Petitioners,	:	:	
	:	:	
against	:	:	Cancellation No. _____
	:	:	
NINGHAI CHUANGXIN TOURISTS PRODUCTS CO., LTD.,	:	:	
	:	:	
Respondent.	:	:	
	:	X	

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. 4520469 (the “Challenged Registration”) owned by Ninghai Chuangxin Tourists Products Co., Ltd. (the “Respondent”) and hereby petitions to cancel the same under the provisions of 15 U.S.C. § 1064(1). As grounds for cancellation, Petitioner asserts 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, bags, packaging and shipping materials, storage supplies, tarps, fleet maintenance supplies, shelters, and maintenance, repair and operations supplies (the “MSC Marks”).

2. Petitioners have continuously made commercial use of MSC as a trademark 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 Registration No. 1,623,002. 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 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, Opposer MSC Services filed an Challenged Registration 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.

11. In fact, Petitioners have acquired common law rights in all of their MSC marks by virtue of their continuous use of their MSC marks in commerce. Petitioners have expended significant amounts of time, money and effort in promoting and advertising their MSC marks as well as the products and services distributed, marketed and sold thereunder. Petitioners' MSC marks are famous and consumers have come to recognize the MSC marks as identifiers of Petitioners' products and services and as a single source of origin.

Respondent and the Challenged Registration

12. Upon information and belief, Respondent Ninghai Chuangxin Tourists Products is a corporation organized under the laws of China and is located and doing business at No. 1, Huancheng South Road Shenquan Town, Ninghai County Zhejiang, China.

13. Upon information and belief, Respondent is the owner of the Challenged Registration (Registration No. 4,520,469), dated April 29, 2014, for the mark MSC for “Awnings; Camouflage nets; Hammocks; Packaging bags of textile material; Sacks or bags for the transportation or storage of materials in bulk; Sails; Tarpaulins; Tents; Unfitted covers for boats and marine vehicles; Unfitted vehicle covers” in International Class 022 and United States

Classes 001, 002, 007, 022, 042 and 050. The Challenged Registration claims a date of first use of January 23, 2010.

The Challenged Registration Should Be Cancelled As Likely to Cause Confusion with Petitioners' Trade Name and Family of MSC Marks

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

15. Respondent's MSC mark is identical or confusingly similar to the Petitioners' MSC marks.

16. The Challenged Registration claims that Respondent uses the MSC mark in connection with marketing, distributing and selling products and services that are identical and/or related to the goods and services covered by Petitioners' Trade Name and family of MSC Marks.

17. In view of Petitioners' use of the Trade Name and family of MSC Marks that had acquired distinctiveness before the Respondent's 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.

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

19. 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

20. As a result of the Challenged Registration, Petitioners have been and will continue to be damaged unless the Challenged Registration is cancelled.

WHEREFORE, Petitioners pray that this opposition be sustained and that United States Trademark Registration No. 4520469 for the MSC mark be refused registration.

Respectfully submitted,

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

Dated: New York, New York
June 30, 2014

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

I hereby certify that, on the 30th day of June, 2014, I caused a true and correct copy of the Notice of Petition for Cancellation to be served, pursuant to 37 C.F.R. § 2. 111, via Email and First Class Mail upon:

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Attorney for Respondent

/s/ Michael R. Graif
Michael R. Graif