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Filing date: **04/01/2013**

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 party opposes registration of the indicated application.

**Opposer Information**

Name	MSI Holdings, LLC
Granted to Date of previous extension	04/10/2013
Address	203 Norcross Avenue Metuchen, NJ 08840 UNITED STATES

Attorney information	Michael R. Gilman Pergament Gilman & Cepeda LLP 1480 Route 9 North Suite 204 Woodbridge, NJ 07095 UNITED STATES mgilman@gilmanpergament.com Phone: 732 636-4500, ext. 111
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**Applicant Information**

Application No	85672502	Publication date	12/11/2012
Opposition Filing Date	04/01/2013	Opposition Period Ends	04/10/2013
Applicant	Acton Research Corporation 15 Discovery Way Acton, MA 01720 UNITED STATES		

**Goods/Services Affected by Opposition**

Class 009. All goods and services in the class are opposed, namely: Spectrometers, namely, imaging spectrometers and spectrometers used with microscopes
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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

**Mark 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

Attachments	Notice of Opposition.pdf ( 5 pages )(16234 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	04/01/2013

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
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MSI HOLDINGS, LLC,	:	
	:	
<b>Opposer,</b>	:	<b>Opposition No.</b>
	:	
v.	:	
	:	
ACTON RESEARCH CORPORATION,	:	<b>Serial No. 85/672,502</b>
	:	
<b>Applicant.</b>	:	
-----X	:	

**NOTICE OF OPPOSITION**

**In the matter of** Application Serial No. 85/672,502 (“the ‘502 application”) for registration in International Class 009 of the mark MICROSPEC, filed July 10, 2012, and published in the Official Gazette on December 11, 2012 in the name of Acton Research Corporation (“applicant”), for “Spectrometers, namely, imaging spectrometers and spectrometers used with microscopes”.

MSI Holdings, LLC (“opposer”), located and doing business at 203 Norcross Avenue, Metuchen, NJ 08840, believes it will be damaged by registration of the mark MICROSPEC of the ‘502 application by applicant and hereby timely opposes 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. Opposer is the owner of U.S. Trademark Registration No. 1,312,902, issued on January 8, 1985, for the mark SPEX for “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 class 009.

2. Upon information and belief, the earliest date of use applicant can claim for its mark MICROSPEC is the July 10, 2012 filing date of the ‘502 application; which was filed based upon intent to use under Section 1(b).

3. Opposer has rights in the mark SPEX for the spectrometers of the ‘502 application, as well as for other, broader measuring and scientific instruments and laboratory equipment, which rights are far superior by multiple decades to any rights which may be asserted by applicant in this proceeding.

4. Applicant’s use of the MICROSPEC mark for its proposed spectrometers is likely to be confused with opposer’s SPEX mark, which has been in use in US commerce since 1954 for the goods of opposer’s registration.

5. Applicant’s intention to use a mark that so closely resembles opposer’s 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 opposer’s goodwill.

6. Accordingly, there is a likelihood of confusion, mistake and/or deception between the MICROSPEC mark of applicant’s opposed ‘502 application for use on spectrometers, and opposer’s SPEX mark for opposer’s identical and highly overlapping goods, to the ordinary consumer within the meaning of Section 2(d) of the Lanham Act, 15 U.S.C. Section 1052(d).

7. Additionally, and upon information and belief, applicant’s use of the MICROSPEC mark is intended to mimic and point uniquely to opposer’s identity or persona. In particular, the MICROSPEC mark is expressly calculated to suggest a false connection with opposer’s already, long existing presence under the SPEX name by suggesting at least one of the

following; that the MICROSPEC goods of applicant are, either smaller versions of opposer's SPEX goods, or meant for analysis of smaller scientific/laboratory specimens than those analyzed using opposer's SPEX goods. Since, over the continuous period since 1954, the term SPEX is, and has come to be associated with, opposer and opposer's goods, applicant's mark is deceptive under Section 2(a) of the Lanham Act, 15, U.S.C. Section 1052(a).

8. 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 SPEC term of its mark will cause purchasers or consumers to assume that applicant's spectrometers, sold under applicant's mark, are connected with opposer's existing goods sold under its SPEX mark. Thus, and since opposer previously used a mark essentially identical to applicant's proposed MICROSPEC mark via opposer's extensive use in commerce since 1954 of the SPEX mark to designate opposer's identity or persona, applicant's mark suggests a false connection with opposer under Section 2(a) of the Lanham Act, 15, U.S.C. Section 1052(a).

9. Upon information and belief, applicant did not have a *bona fide* intent to use the MICROSPEC mark in United States commerce on the goods identified in the '502 application as of, or even reasonably around, the date the '502 application was filed.

10. Opposer 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 MICROSPEC mark, and applicant's exclusive right to use the mark, when, in fact, applicant is not entitled to such rights by virtue of opposer's prior rights in the SPEX mark as asserted herein, in association with identical and highly related goods.

11. On the basis of the foregoing, opposer is likely to be materially harmed and damaged by issuance to registration of applicant's MICROSPEC mark of the opposed '502

application.

**WHEREFORE**, opposer prays that the instant opposition be sustained and the issuance of a registration based on Application Serial No. 85/672,502 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  
1480 Route 9 North, Suite 204  
Woodbridge, NJ 07095  
Phone (732) 636-4500

Dated: April 1, 2013

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 1<sup>st</sup> day of April, 2013, by first class mail, postage prepaid, on applicant and applicant’s attorney of record in application Serial No. 85/672,502, as follows:

Eric S. Marzluf, Esq.  
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and

Acton Research Corporation  
15 Discovery Way  
Acton, Massachusetts 01720

Dated: April 1, 2013

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 1<sup>st</sup> day of April, 2013.

Dated: April 1, 2013

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