

ESTTA Tracking number: **ESTTA583975**

Filing date: **01/27/2014**

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 party opposes registration of the indicated application.

Opposer Information

Name	MSI Holdings, LLC
Granted to Date of previous extension	01/29/2014
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@gilmanpergament.com Phone:973 998-7722
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Applicant Information

Application No	85029832	Publication date	10/01/2013
Opposition Filing Date	01/27/2014	Opposition Period Ends	01/29/2014
International Registration No.	NONE	International Registration Date	NONE
Applicant	FPInnovations 570, Boulevard Saint-Jean Pointe-Claire, Quebec, CAX H9R3J9 CAX		

Goods/Services Affected by Opposition

Class 009. First Use: 0 First Use In Commerce: 0 All goods and services in the class are opposed, namely: Scientific instruments in the nature of electronic analyzers for identifying and analyzing contaminants in paper pulp and recycled paper; software for use in identifying and analyzing contaminants in paper pulp and recycled paper
Class 042. First Use: 0 First Use In Commerce: 0 All goods and services in the class are opposed, namely: Technology consulting services in the field of software development to identify and measure contaminants in paper pulp and recycled paper

Grounds for Opposition

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 of the opposed application at the time of the filing of the opposed application.

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 - FPautoSPECK.pdf(18945 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 Overnight Courier on this date.

Signature	/Michael R. Gilman/
Name	Michael R. Gilman
Date	01/27/2014

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

MSI HOLDINGS, LLC,	-----X	
	:	
Opposer,	:	Opposition No.
	:	
v.	:	
	:	Serial No. 85029832
FPINNOVATIONS,	:	
	:	
Applicant.	:	
	-----X	

NOTICE OF OPPOSITION

In the matter of Application Serial No. 85/029,832 (“the ‘832 application”) for registration in International Classes 009 and 042 of the mark FPautoSpeck, filed May 4, 2010, and published in the Official Gazette on October 1, 2013 in the name of FPInnovations (“applicant”), for “Scientific instruments in the nature of electronic analyzers for identifying and analyzing contaminants in paper pulp and recycled paper; and software for use in identifying and analyzing contaminants in paper pulp and recycled paper, class 9” and “Technology consulting services in the field of software development to identify and measure contaminants in paper pulp and recycled paper, class 42”.

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 FPautoSpeck of the ‘832 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, and contested herein by opposer, the earliest date of use applicant can claim for its mark FPautoSpeck of the ‘832 application, is the priority filing date of the ‘832 application’s Canadian parent application, namely, April 14, 2010.

3. Opposer’s rights in the mark SPEX are far superior by multiple decades to any rights which may be asserted by applicant in this proceeding.

4. Applicant’s use of the FPautoSpeck mark for its proposed goods and services of the ‘832 application 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 FPautoSpeck mark of applicant’s opposed ‘832 application for use on the goods and services of the ‘832 application with opposer’s SPEX mark for opposer’s highly similar 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 FPautoSpeck mark is intended to mimic and point uniquely to opposer’s identity or persona. In particular, the

FPautoSpeck mark is expressly calculated to suggest a false connection with opposer's already, long existing presence under the SPEX name by suggesting, at least, that the proposed FPautoSpeck goods and services of applicant are, in fact, 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. Since opposer previously used a mark essentially identical to dominant portion of applicant's proposed FPautoSpeck 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 FPautoSpeck mark in United States commerce on the goods or services identified in the '832 application as of, or even reasonably around, the date the '832 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 FPautoSpeck 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 highly similar goods.

11. On the basis of the foregoing, opposer is likely to be materially harmed and damaged by issuance to registration of applicant's FPautoSpeck mark of the opposed '832 application.

WHEREFORE, opposer prays that the instant opposition be sustained and the issuance of a registration based on Application Serial No. 85/029,832 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
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Phone (973) 998-7722

Dated: January 27, 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 27th day of January, 2014, by Federal Express on applicant and applicant’s attorney of record in application Serial No. 85/029,832, as follows:

FPIinnovations
570, Boulevard Saint-Jean
Pointe-Claire, Quebec H9R3J9
Canada

and

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Dated: January 27, 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 27th day of January, 2014.

Dated: January 27, 2014

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