

ESTTA Tracking number: **ESTTA653520**

Filing date: **02/02/2015**

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	Kennametal Inc.
Granted to Date of previous extension	02/01/2015
Address	1600 Technology Way Latrobe, PA 15650 UNITED STATES

Name	Kennametal Produktions GMBH & CO. KG		
Entity	Corporation	Citizenship	Germany
Address	Wehlauer Strasse 73 Furth/Bay, 90766 GERMANY		

Attorney information	Alan Towner Pietragallo Gordon Alfano Bosick & Raspanti, LLP 38th Floor, One Oxford Centre Pittsburgh, PA 15219 UNITED STATES agt@pietragallo.com, dmh@pietragallo.com, ipgroup@pietragallo.com
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Applicant Information

Application No	85931282	Publication date	08/05/2014
Opposition Filing Date	02/02/2015	Opposition Period Ends	02/01/2015
Applicant	Portable Storage of MN, Inc. 587 First Street S.W. New Brighton, MN 55112 UNITED STATES		


Goods/Services Affected by Opposition

Class 006. First Use: 2008/01/25 First Use In Commerce: 2008/01/25 All goods and services in the class are opposed, namely: Portable steel containers for the storage and transportation of goods, for residential and commercial use
Class 039. First Use: 2008/01/25 First Use In Commerce: 2008/01/25 All goods and services in the class are opposed, namely: Storage services, namely, rental, storage, delivery and pick up of mobile storage containers containing personal property

Grounds for Opposition

Priority and likelihood of confusion	Trademark Act section 2(d)
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Mark Cited by Opposer as Basis for Opposition

U.S. Registration No.	2687880	Application Date	09/11/2000
Registration Date	02/18/2003	Foreign Priority Date	NONE
Word Mark	BLUE BOX		
Design Mark			
Description of Mark	NONE		
Goods/Services	<p>Class 006. First use: First Use: 0 First Use In Commerce: 0 HARD MATERIALS, NAMELY, CUTTING METAL, HARD METAL ROLLER, DIE PLATES; COMMON AND HARD METALS, NAMELY, WOLFRAM, COBALT, IRON, NICKLE AND THEIR ALLOYS; GOODS OF COMMON METAL, NAMELY, TRANSPORT CONTAINERS, CASES AND BOXES AND REPLACEMENT PARTS THEREFOR</p> <p>Class 007. First use: First Use: 0 First Use In Commerce: 0 MACHINE TOOLS, NAMELY, METAL CUTTING TOOLS, INDUSTRIAL CUTTING TOOLS; CUTTING AND INDEX ABLE INSERTS FOR USE WITH MACHINE TOOLS, CERAMIC MATERIALS AS SEMI-FINISHED PRODUCTS IN THE NATURE OF CUTTING AND INDEX ABLE INSERTS FOR USE WITH MACHINE TOOLS; TOOL HOLDERS AND REPLACEMENT PARTS THEREFOR</p> <p>Class 020. First use: First Use: 0 First Use In Commerce: 0 NON-METAL CONTAINERS, CASES AND BOXES FOR THE TRANSPORTATION AND STORAGE OF GOODS</p> <p>Class 039. First use: First Use: 0 First Use In Commerce: 0 TRANSPORT BY FERRY, BOAT, RAIL, AIR, CAR, PACKAGING AND DELIVERING ARTICLES FORTRANSPORTATION; STORAGE OF MACHINE TOOLS, FETCHING AND DELIVERING OF TOOLS BY FERRY, BOAT, RAIL, AIR AND CAR</p> <p>Class 040. First use: First Use: 0 First Use In Commerce: 0 RE-PROCESSING OF TOOLS</p> <p>Class 042. First use: First Use: 0 First Use In Commerce: 0 TECHNICAL CONSULTATION SERVICES IN THE FIELD OF USE, RE-PROCESSING AND RE-USE OF TOOLS</p>		

Attachments	76126165#TMSN.png(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	/Alan G. Towner/
Name	Alan Towner
Date	02/02/2015

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

In re Application of:

Applicant : **Portable Storage of MN, Inc.**
Application Number : **85/931282**
Mark : **THE BIG BLUE BOX**
Application Date : **May 14, 2013**
Publication Date : **August 5, 2014**

Kennametal Inc. and)
Kennametal Produktions GMBH & CO. KG,)
)
Opposers,)
)
v.)
)
Portable Storage of MN, Inc.,)
)
Applicant.)

Opposition No. _____

NOTICE OF OPPOSITION

1. Opposers Kennametal Inc., a Pennsylvania Corporation having a principal place of business at 1600 Technology Way, Latrobe, Pennsylvania, 15650, and Kennametal Produktions GMBH & CO. KG, a German Corporation having a principal place of business at Wehlauer Strasse 73, Furth/Bay 90766, Germany (collectively "Opposer" and/or "Kennametal") believe that they will be damaged by Application No. 85/931,282 for the mark THE BIG BLUE BOX and hereby opposes said Application and Registration.

2. To the best of Opposer's knowledge, the name and address of the Applicant of the THE BIG BLUE BOX Application is Portable Storage of MN, Inc., ("Applicant"), a Minnesota Corporation with a principal place of business at 587 First Street S.W., New Brighton, Minnesota 55112.

3. On May 14, 2013, Applicant filed a use application, Serial No. 85/931,282, to register the standard character mark THE BIG BLUE BOX (“Applicant’s BLUE BOX Mark”). Applicant’s BLUE BOX Mark is applied for in International Class 6 for: “PORTABLE STEEL CONTAINERS FOR THE STORAGE AND TRANSPORTATION OF GOODS, FOR RESIDENTIAL AND COMMERCIAL USE”; and in International Class 39 for: “STORAGE SERVICES, NAMELY, RENTAL, STORAGE, DELIVERY AND PICK UP OF MOBILE STORAGE CONTAINERS CONTAINING PERSONAL PROPERTY”.

4. Applicant alleges a date of first use of the mark of January 25, 2008 for both applied-for classes, and a date of first use of the mark in commerce of January 25, 2008 for both applied-for classes.

OPPOSER’S PRIORITY

5. Opposer Kennametal Produktions GMBH & CO. KG is the owner of U.S. trademark registration no. 2,687,880 for the mark “BLUE BOX” in international classes 6, 7, 20, 39, 40, and 42, which has a filing date of September 11, 2000, and a registration date February 18, 2003 (hereinafter referred to as "Opposer’s BLUE BOX Mark"). Kennametal Inc. is the parent company of Kennametal Produktions GMBH & CO. KG

6. Opposer’s BLUE BOX Mark, Registration No. 2,687,880, is registered in the following international classes: International Class 6 for: “HARD MATERIALS, NAMELY, CUTTING METAL, HARD METAL ROLLER, DIE PLATES; COMMON AND HARD METALS, NAMELY, WOLFRAM, COBALT, IRON, NICKLE AND THEIR ALLOYS; GOODS OF COMMON METAL, NAMELY, TRANSPORT CONTAINERS, CASES AND BOXES AND REPLACEMENT PARTS THEREFOR”; International Class 7 for: “MACHINE TOOLS, NAMELY, METAL CUTTING TOOLS, INDUSTRIAL CUTTING TOOLS;

CUTTING AND INDEX ABLE INSERTS FOR USE WITH MACHINE TOOLS, CERAMIC MATERIALS AS SEMI-FINISHED PRODUCTS IN THE NATURE OF CUTTING AND INDEX ABLE INSERTS FOR USE WITH MACHINE TOOLS; TOOL HOLDERS AND REPLACEMENT PARTS THEREFOR”; International Class 20 for: “NON-METAL CONTAINERS, CASES AND BOXES FOR THE TRANSPORTATION AND STORAGE OF GOODS”; International Class 39 for: “TRANSPORT BY FERRY, BOAT, RAIL, AIR, CAR, PACKAGING AND DELIVERING ARTICLES FOR TRANSPORTATION; STORAGE OF MACHINE TOOLS, FETCHING AND DELIVERING OF TOOLS BY FERRY, BOAT, RAIL, AIR AND CAR”; International Class 40 for: “RE-PROCESSING OF TOOLS”; and International Class 42 for: “TECHNICAL CONSULTATION SERVICES IN THE FIELD OF USE, REPROCESSING AND RE-USE OF TOOLS”

7. Opposer’s BLUE BOX Mark has become incontestable as a matter of law under 15 U.S.C. §1065.

8. Since at least as early as March 10, 2000, Opposer has been, and is now, using its BLUE BOX Mark in commerce, and is using its BLUE BOX Mark in connection with storage containers and cases for the transport of goods.

9. Opposer's use of its BLUE BOX Mark has been valid and continuous since its date of first use.

10. Opposer's use of its BLUE BOX Mark and Opposer's filing of the application for its BLUE BOX Mark pre-date both Applicant's first use of, and application for registration of, Applicant’s BLUE BOX Mark, and establishes the priority of Opposer's BLUE BOX Mark.

11. Opposer's BLUE BOX Mark is symbolic of extensive goodwill established by Opposer, has acquired a high degree of recognition through continued use and expenditures of time, effort and money in advertising and promotion, and serves as a unique identifier of the goods offered by Opposer. In particular, Opposer uses its BLUE BOX Mark in conjunction with providing containers primarily for use as packing and shipping containers for tools and/or other industrial equipment.

12. Applicant's BLUE BOX Mark is similar to Opposer's BLUE BOX Mark in that all the marks incorporate the "BLUE BOX" element as the dominant element of the Mark.

13. The goods listed in Applicant's Application include "PORTABLE STEEL CONTAINERS" which are substantially identical to at least some of the goods listed in Opposer's Registration including "GOODS OF COMMON METAL, NAMELY, TRANSPORT CONTAINERS, CASES AND BOXES".

14. The services listed by Applicant's Applicant including "STORAGE SERVICES...STORAGE, DELIVERY AND PICK-UP" are substantially identical to at least a portion of the services listed by Opposer including "TRANSPORT...PACKAGING AND DELIVERING...STORAGE...FETCHING AND DELIVERING".

15. Upon information and belief, Applicant's goods and services with which it uses the BLUE BOX Mark, and the products and services with which Opposer uses its BLUE BOX Marks are offered for sale and are sold, at least in part, through the same channels of trade and offered and sold to the same class of purchasers.

COUNT I
LIKELIHOOD OF CONFUSION

16. Opposer hereby incorporates by reference and re-alleges each and every allegation set forth in Paragraphs 1 through 15.

17. Opposer's date of first use of Opposer's BLUE BOX Mark in commerce is prior to the date of filing of Applicant's BLUE BOX Application and the date of Applicant's claimed date of first use of its BLUE BOX Mark in commerce.

18. Opposer's BLUE BOX Registration is valid and subsisting and is *prima facie* evidence of Opposer's exclusive right to use its BLUE BOX Mark in commerce on the goods and services specified in Opposer's BLUE BOX Registration.

19. In view of the similarity of the respective marks, the substantially identical channels of trade and goods offered for sale by the respective parties, Applicant's BLUE BOX Mark so resembles Opposer's BLUE BOX Mark, previously used in the United States, and not abandoned, as to be likely to cause confusion, or to cause mistake, or to deceive as to source by suggesting that Applicant's goods are associated with or approved, endorsed, affiliated, authorized or sponsored by Opposer.

WHEREFORE, Applicant's BLUE BOX Mark, Application No. 85/931,282, is damaging to Kennametal and, accordingly, Kennametal requests that the instant Notice of Opposition be granted and that registration of Applicant's BLUE BOX Mark be refused.

Please charge Deposit Account No. 500859 in the amount of \$300 for the filing fee required by 2.6(a)(17) for this Notice of Opposition. Please charge any underpayment or credit any overpayment to Deposit Account No. 500859.

Respectfully submitted,

/s/Douglas M. Hall

ALAN G. TOWNER, ESQ.

USPTO Reg. No. 32,949

DOUGLAS M. HALL, ESQ.

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Attorneys for Opposers

Dated: February 2, 2015

CERTIFICATE OF SERVICE

The undersigned hereby certifies that on the 2nd day of February, 2015, I served a true and correct copy of the foregoing NOTICE OF OPPOSITION via First Class Mail, postage prepaid, upon the attorney of record for Applicant addressed as follows:

Kristine M. Boylan, Esq.
Briggs and Morgan, P.A.
2200 IDS Center
80 South Eighth Street
Minneapolis, MN 55402

/s/Douglas M. Hall
Douglas M. Hall, Esq.