

ESTTA Tracking number: **ESTTA1027576**

Filing date: **01/08/2020**

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

Proceeding	91253267
Party	Plaintiff MSCI Inc.
Correspondence Address	MARYANN E LICCIARDI COWAN LIEBOWITZ & LATMAN PC 114 WEST 47TH STREET NEW YORK, NY 10036 UNITED STATES mel@cll.com, fxm@cll.com, trademark@cll.com 212-790-9200
Submission	Motion to Amend Pleading/Amended Pleading
Filer's Name	Maryann E. Licciardi
Filer's email	mel@cll.com, fxm@cll.com, trademark@cll.com
Signature	/Maryann E. Licciardi/
Date	01/08/2020
Attachments	Letter to Commissioner - MSC RETAIL Amended NOO.pdf(57051 bytes) MSC RETAIL - Amended Consolidated Notice of Opposition 010820.pdf(37708 bytes) MSC RETAIL - Redline NOO.pdf(38118 bytes)



Cowan, Liebowitz & Latman, P.C.
114 West 47th Street
New York, NY 10036-1525
(212) 790-9200 Tel
(212) 575-0671 Fax
www.cll.com

Maryann E. Licciardi
212-790-9218
mel@cll.com

January 8, 2020

By Electronic Filing

Commissioner for Trademarks
Attn: TTAB
P.O. Box 1451
Alexandria, VA 22313-1451

Re: MSCI Inc.'s
Opposition against MSC Retail Inc.'s
Applications for **MSC RETAIL** and **MSC RETAIL & Design**
Ref. No. 25991.001

Dear Commissioner:

We enclose an Amended Consolidated Notice of Opposition against Application Serial Nos. 88303110 and 88302827, which were published in the Official Gazette on July 2, 2019. Pursuant to TBMP § 507.01, we enclose a clean version of the Amended Consolidated Notice of Opposition along with a red-lined copy showing the changes from the original Consolidated Notice of Opposition.

Respectfully submitted,

/Maryann E. Licciardi/
Maryann E. Licciardi

Enclosures

been granted extensions of time to oppose up to and including December 29, 2019, hereby opposes the same.

As grounds for opposition, it is alleged that:

1. Since long prior to February 15, 2019, Applicant's constructive first use date, Opposer and its predecessors, and their affiliated and related entities and/or licensees, have used various marks that comprise or contain the term MSCI, alone or with other word, letter and/or design elements (collectively, "Opposer's MSCI Marks") on or in connection with a wide variety of financial, business, research and technological goods and services, including, without limitation, providing financial information and analytics; financial indices; financial software; research reports; providing real estate appraisals, real estate information and real estate tools for investors, real estate owners, managers and brokers; software for use in performance analysis, database management and property investment management including in the real estate market; providing real estate indexes and real estate market insights and reports, and real estate blogs, and calculating and licensing performance results in a multitude of sectors including retail; providing occupancy information and statistics, rental information and other analytics; and instructional materials in the fields of real estate and finance (collectively, "Opposer's Goods and Services").

2. Opposer owns United States federal registrations for Opposer's MSCI Marks in International Classes 9, 16, 35, 36 and 42, namely Registration Nos. 1680303, 3875754, 5186952, 5737228 and 5852354, and Application Serial No. 88311576. Registration Nos. 1680303 and 3875754 are incontestable.

3. Since long prior to February 15, 2019, Applicant's constructive first use date, Opposer and its predecessors, and their affiliated and related entities and/or licensees, have

extensively promoted and advertised the sale and distribution of goods and services bearing or offered in connection with Opposer's MSCI Marks, including, but not limited to, Opposer's Goods and Services, and have sold or distributed such goods and rendered such services in commerce.

4. As a result of the sales and promotion of its goods and services bearing or offered in connection with Opposer's MSCI Marks, Opposer has built up highly valuable goodwill in Opposer's MSCI Marks and said goodwill has become closely and uniquely identified and associated with Opposer.

5. On February 15, 2019, Applicant filed the Applications to register Applicant's Marks for "Real estate brokerage specializing in retail leasing, sales, property management and advisory services related to commercial, restaurant, hospitality and higher learning institutions and student housing" in International Class 36, based on an intent to use.

6. Upon information and belief, Applicant did not use Applicant's Marks in United States commerce in connection with the services covered by the Applications prior to February 15, 2019, Applicant's constructive first use date.

7. The services covered by the Applications are closely related to the goods offered and services rendered in connection with Opposer's MSCI Marks.

8. The first three letters "MSC" in Applicant's Marks are identical to the first three letters "MSC" in Opposer's MSCI Marks.

9. The term "RETAIL" in Applicant's Marks is disclaimed as merely descriptive.

10. Applicant's Marks so resemble Opposer's MSCI Marks as to be likely, when used in connection with Applicant's services, to cause confusion, to cause mistake, and to deceive the

trade and public, who are likely to believe that Applicant's services have their origin with Opposer and/or that such services are approved, endorsed or sponsored by Opposer or associated in some way with Opposer.

11. Opposer's MSCI Marks are distinctive and famous and were so prior to February 15, 2019, Applicant's constructive first use date. Registration of Applicant's Marks will also injure Opposer by causing a likelihood of dilution by blurring of the distinctive quality of Opposer's MSCI Marks.

WHEREFORE, Opposer believes that it will be damaged by registration of Applicant's Marks and requests that the consolidated opposition be sustained and said registrations be denied.

Please recognize as attorneys for Opposer in this proceeding Maryann E. Licciardi (member of the bar of and admitted before the highest court of the State of New York) and the firm Cowan, Liebowitz & Latman, P.C., 114 West 47th Street, New York, New York 10036.

Dated: New York, New York
January 8, 2020

Respectfully submitted,

COWAN LIEBOWITZ & LATMAN
Attorneys for Opposer

By: /Maryann E. Licciardi/
Maryann Licciardi (Bar No. 4181954, admitted 2004)
114 West 47th Street
New York, New York 10036
212-790-9200

been granted extensions of time to oppose up to and including December 29, 2019, hereby opposes the same.

As grounds for opposition, it is alleged that:

1. Since long prior to February 15, 2019, Applicant's constructive first use date, Opposer and its predecessors, and their affiliated and related entities and/or licensees, have used various marks that comprise or contain the term MSCI, alone or with other word, letter and/or design elements (collectively, "Opposer's MSCI Marks") on or in connection with a wide variety of financial, business, research and technological goods and services, including, without limitation, providing financial information and analytics; financial indices; financial software; research reports; providing real estate appraisals, real estate information and real estate tools for investors, real estate owners, managers and brokers; software for use in performance analysis, database management and property investment management including in the real estate market; providing real estate indexes and real estate market insights and reports, and real estate blogs, and calculating and licensing performance results in a multitude of sectors including retail; providing occupancy information and statistics, rental information and other analytics; and instructional materials in the fields of real estate and finance (collectively, "Opposer's Goods and Services").

2. Opposer owns United States federal registrations for Opposer's MSCI Marks in International Classes 9, 16, 35, 36 and 42, namely Registration Nos. 1680303, 3875754, 5186952, 5737228 and 5852354, and Application Serial No. 88311576. Registration Nos. 1680303 and 3875754 are incontestable.

3. Since long prior to February 15, 2019, Applicant's constructive first use date, Opposer and its predecessors, and their affiliated and related entities and/or licensees, have

extensively promoted and advertised the sale and distribution of goods and services bearing or offered in connection with Opposer's MSCI Marks, including, but not limited to, Opposer's Goods and Services, and have sold or distributed such goods and rendered such services in commerce.

4. As a result of the sales and promotion of its goods and services bearing or offered in connection with Opposer's MSCI Marks, Opposer has built up highly valuable goodwill in Opposer's MSCI Marks and said goodwill has become closely and uniquely identified and associated with Opposer.

5. On February 15, 2019, Applicant filed the Applications to register Applicant's Marks for "Real estate brokerage specializing in retail leasing, sales, property management and advisory services related to commercial, restaurant, hospitality and higher learning institutions and student housing" in International Class 36, based on an intent to use.

6. Upon information and belief, Applicant did not use Applicant's Marks in United States commerce in connection with the services covered by the Applications prior to February 15, 2019, Applicant's constructive first use date.

7. The services covered by the Applications are closely related to the goods offered and services rendered in connection with Opposer's MSCI Marks.

8. The first three letters "MSC" in Applicant's Marks are identical to the first three letters "MSC" in Opposer's MSCI Marks.

9. The term "RETAIL" in Applicant's Marks is disclaimed as merely descriptive.

10. Applicant's Marks so resemble Opposer's MSCI Marks as to be likely, when used in connection with Applicant's services, to cause confusion, to cause mistake, and to deceive the

trade and public, who are likely to believe that Applicant's services have their origin with Opposer and/or that such services are approved, endorsed or sponsored by Opposer or associated in some way with Opposer.

11. Opposer's MSCI Marks are distinctive and famous and were so prior to February 15, 2019, Applicant's constructive first use date. Registration of Applicant's Marks will also injure Opposer by causing a likelihood of dilution by blurring of the distinctive quality of Opposer's MSCI Marks.

WHEREFORE, Opposer believes that it will be damaged by registration of Applicant's Marks and requests that the consolidated opposition be sustained and said registrations be denied.

Please recognize as attorneys for Opposer in this proceeding Maryann E. Licciardi (member of the bar of and admitted before the highest court of the State of New York) and the firm Cowan, Liebowitz & Latman, P.C., 114 West 47th Street, New York, New York 10036.

Dated: New York, New York

~~December 26, 2019~~ January 8, 2020

Respectfully submitted,

COWAN LIEBOWITZ & LATMAN
Attorneys for Opposer

By: /Maryann E. Licciardi/
Maryann Licciardi (Bar No. 4181954, admitted 2004)

114 West 47th Street
New York, New York 10036
212-790-9200

CERTIFICATE OF SERVICE

I HEREBY CERTIFY that, on January 8, 2020, I caused a true and complete copy of the foregoing Amended Consolidated Notice of Opposition to be sent by email to Applicant's attorney Joshua A. Steinberg, Esq., Kaplin Stewart Meloff Reiter & Stein, at JSteinberg@kaplaw.com, with a copy to the email address of record in this proceeding jrome@mscretail.com

Dated: New York, New York
January 8, 2020

/Maryann E. Licciardi/
Maryann E. Licciardi