IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In re Application Serial No. 76/346,860
For a Miscellaneous Mark in International Class 9
Published in the Official Gazette on April 1, 2003

EXIDE TECHNOLOGIES	)	Box TTAB/FEE
	)	
Opposer,	)	
	)	
v.	)	Opposition No. _____
	)	
JOHNSON CONTROLS BATTERY GROUP, INC.	)	
	)	
Applicant.	)	

03-15-2004
U.S. Patent & TMOfc/TM Mail Rcpt Dt. #78

NOTICE OF OPPOSITION

Opposer, Exide Technologies, a corporation duly organized and existing under the laws of the State of Delaware, with its principal place of business at 13000 Deerfield Parkway, Suite 200, Alpharetta, Georgia 30004, believes it will be damaged by and hereby opposes registration of U.S. App. No. 76/346,860 for "the color blue as applied to the entire top (cover) portion of the goods" (hereinafter referred to as "The Blue Product Feature"). U.S. App. No. 76/346,860 was upon information and belief filed on December 10, 2001 and published in the Official Gazette of April 1, 2003 with goods identified as "batteries; including marine batteries." Opposer requests that registration of "The Blue Product Feature" in U.S. App. No. 76/346,860 be refused. As grounds therefor, Opposer alleges:

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1. Upon information and belief, Applicant, Johnson Controls Battery Group, Inc., is a corporation organized under the laws of Wisconsin, with an address of 5757 N. Green Bay Avenue, Milwaukee, Wisconsin 53201.

2. Opposer is now and has been for many years engaged in the manufacture and sale of batteries, including marine batteries. Opposer has expended considerable effort and expense in promoting its batteries and marine batteries. Opposer and Applicant are competitors.

3. Opposer expressly alleges and asserts Lanham Act §§ 1, 2, and 13, 15 U.S.C. §§ 1051, 1052, and 1063, as statutory grounds for sustaining this Notice of Opposition.

I.

"The Blue Product Feature" is Functional

4. The color blue has historically been, and is presently, commonly used in the battery trade and industry as a product feature on the top or cover portion of batteries. The historical, and present, uses of the color blue as a product feature on the entire (and/or substantial portions of the) top or cover portion of batteries are functional; they serve a specific non-trademark purpose, namely to designate and identify special characteristics of batteries such as a specific type, purpose, use, feature, quality, benefit, application, or grade, or as part of, or as a feature of, a color coding system that designates special characteristics of batteries.

5. Applicant has long been aware of the historically commonplace use in the battery trade and industry of the color blue as a product feature on the entire (and/or substantial portions of the) top or cover portion of batteries to designate special characteristics of batteries. Applicant is upon information and belief likewise aware of the presently commonplace use in the battery trade and industry of the color blue as a product feature on the entire (and/or substantial portions of the) top or cover portion of batteries to designate special characteristics of batteries.

6. The color blue is the color of water and the ocean. As one example, the color blue has been, and is presently, often used by numerous manufacturers and competitors in the battery trade and industry--even by Applicant--as a product feature on the entire (and/or substantial portions of the) top or cover portion of batteries to functionally designate, among other things, batteries with special characteristics, and specially designed and intended for special uses and applications, such as marine, water, or ocean related environments, such as water boat power.

7. Other manufacturers and competitors in the battery trade and industry use the color blue as a product feature on the entire (and/or substantial portions of the) top or cover portion of batteries to serve a specific non-trademark purpose, namely to designate and identify special characteristics of their batteries.

8. Opposer uses the color blue as a product feature on the entire (and/or substantial portions of the) top or cover portion of batteries to serve a specific non-trademark purpose, namely to designate and identify special characteristics of Opposer's batteries.

9. "The Blue Product Feature" is functional; it serves the purpose of designating--in a color coding system--batteries with special characteristics and specifically designed and intended for use in or with water, marine or ocean environments, such as powering "boats," "fishing boats," "performance boats," and helping in "rough waters."

10. Granting registration of "The Blue Product Feature" to Applicant places Opposer and other manufacturers and competitors in the battery trade and industry, at a significant non-reputation-related disadvantage. Granting registration of "The Blue Product Feature" to Applicant would grant Applicant *prima facie* exclusive rights to use and own, to the exclusion of Opposer and other manufacturers and competitors, "The Blue Product Feature" and the color

blue on the entire top or cover portion of batteries as a means and feature to designate batteries with special characteristics. In addition, registration of "The Blue Product Feature" would potentially interfere with the use of the color blue on the entire (and/or substantial portions of the) top or cover portion of batteries by Opposer and other manufacturers and competitors due to the uncertainty that would be created regarding the scope of protection granted by such a registration.

11. If Applicant is granted registration of "The Blue Product Feature" and exclusive rights to the color blue on the entire top or cover portion of batteries, it would inhibit legitimate competition by allowing Applicant to control and monopolize a long established, useful and commonplace industry practice and product feature. In light of the historical and commonplace functional purpose of using the color blue as a product feature on the entire (and/or substantial portions of the) top or cover portion of batteries to designate special characteristics of batteries, the ability of Opposer and other manufacturers and competitors to continue such use is needed so Opposer and other manufacturers and competitors can continue to compete in the marketplace. There is a competitive need for the color blue on the entire (and/or substantial portions of the) top or cover portion of batteries to remain available in the battery trade and industry as a product feature to designate batteries with special characteristics.

12. Not content with seeking ownership of just one primary color (blue) long used as a product feature on the entire (and/or substantial portions of the) top or cover portion of batteries in the battery trade and industry, Applicant also filed application Nos. 76/346,868 and 76/346,855 for ownership of the other primary colors yellow and red, respectively, on the entire top or cover portion of batteries. Use by Applicant of the separate primary colors blue, yellow and red on battery tops or covers is part of a color coding system, or product feature, that serves

the specific non-trademark function of designating special characteristics of Applicant's batteries, such as, types, purposes, uses, qualities, features, benefits, applications, or grades. Applicant's color coding system of using blue, yellow and red as described above to designate special characteristics of batteries is functional. Applicant's use of specific individual colors in that coding system to designate special characteristics of batteries is functional. Appropriation from the public domain and a depletion of the ability to continue to use blue, yellow, and red on the entire (and/or substantial portions of the) top or cover portion of batteries for such functional purposes as described above places Opposer and other manufacturers and competitors at a significant non-reputation-related disadvantage, and inhibits legitimate competition. There is a competitive need for the three primary colors of blue, yellow and red on the entire (and/or substantial portions of the) top or cover portion of batteries to remain available to Opposer and other manufacturers and competitors in the battery trade and industry as a product feature to designate batteries with special characteristics.[1]

13. Granting Applicant registration of "The Blue Product Feature" would damage and cause injury to Opposer, place a cloud over Opposer's ongoing, concurrent, co-existing and simultaneous use of the color blue on the entire (and/or substantial portions of the) top or cover portion of batteries as a product feature for designating special characteristics, cause Opposer to possibly abandon, restrict or curtail its ongoing, concurrent, co-existing and simultaneous use, and to change its promotional and advertising tactics and materials, at severe expense, prejudice and detriment.

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[1] Opposer has concurrently opposed Applicant's application Nos. 76/346,868 and 76/346,855 for ownership of the primary colors yellow and red.

14. Granting Applicant registration of "The Blue Product Feature" would upon information and belief damage and cause injury to other manufacturers and competitors in the battery trade and industry, place a cloud over their ongoing, concurrent, co-existing and simultaneous uses of the color blue on the entire (and/or substantial portions of the) top or cover portion of batteries as a product feature for designating special characteristics, cause them to possibly abandon, restrict or curtail their ongoing, concurrent, co-existing and simultaneous uses, and to change their promotional and advertising tactics and materials, at severe expense, prejudice and detriment.

15. "The Blue Product Feature" is functional and not entitled to registration.

II.

"The Blue Product Feature" Has Not Acquired Distinctiveness

16. Applicant incorporates and alleges Paragraphs 1-15 as if fully set forth herein.

17. "The Blue Product Feature" is not inherently distinctive.

18. Applicant alleged during prosecution of its application that its use of "The Blue Product Feature" was "substantially exclusive" for a period of more than five years, and submitted alleged evidence of acquired distinctiveness, pursuant to a claim under 15 U.S.C. 1052(f).

19. Applicant's use of "The Blue Product Feature" was in fact not "substantially exclusive" for a period of more than five years.

20. Although research and investigation are ongoing and continuing, Opposer believes it originally used the color blue as a product feature on the entire (and/or substantial portions of the) top or cover portion of batteries several decades ago. Opposer can state with certainty based on its recent records that it has used and placed the color blue as a product feature

on the entire (and/or substantial portions of the) top or cover portion of batteries without interruption since at least as early as 2000.

21. Opposer's own use of the color blue on the entire (and/or substantial portions of the) top or cover portion of batteries coincides, is concurrent, co-existing, or overlaps with Applicant's alleged period of "substantially exclusive" use of "The Blue Product Feature." Opposer's own records show that Opposer's use, advertising, promotion, and marketing of the color blue as a product feature on the entire (and/or substantial portions of the) top or cover portion of batteries and related sales was significant during Applicant's alleged period of "substantially exclusive" use of "The Blue Product Feature."

22. Upon information and belief, numerous third party manufacturers and competitors of batteries, other than Opposer, have also used or currently use the color blue as a product feature on the entire (and/or substantial portions of the) top or cover portion of batteries, to serve a specific functional purpose, namely, to designate the special characteristics, types, purposes, uses, features, qualities, benefits, applications and/or grades of the manufacturer's battery.

23. Upon information and belief, the use by numerous third party manufacturers and competitors of the color blue as a product feature on the entire (and/or substantial portions of the) top or cover portion of batteries coincides, is concurrent, co-existing or overlaps with Applicant's alleged period of "substantially exclusive" use of "The Blue Product Feature." Upon information and belief, the records of such third party manufacturers and competitors show that their use, advertising, promotion and marketing of the color blue as a product feature on the entire (and/or substantial portions of the) top or cover portion of batteries and related sales was significant during Applicant's alleged period of "substantially exclusive" use of "The Blue Product Feature."

24. Upon information and belief, during Applicant's alleged period of "substantially exclusive" use of "The Blue Product Feature," numerous manufacturers and competitors in the battery trade and industry used the color blue as a product feature on the entire (and/or substantial portions of the) top or cover portion of batteries, such that the public became accustomed to co-existing, concurrent, and simultaneous uses of the color blue as a product feature on the entire (and/or substantial portions of the) top or cover portion of batteries, and Applicant cannot, therefore, claim any exclusive rights in "The Blue Product Feature." "The Blue Product Feature" was not used exclusively by Applicant for any five year period.

25. Purchasers of batteries or marine batteries do not perceive "The Blue Product Feature" as a trademark, and do not associate "The Blue Product Feature" or the color blue on the entire top or cover portion of batteries with Applicant alone. "The Blue Product Feature" does not distinguish Applicant's batteries from those manufactured or sold by others. "The Blue Product Feature" does not indicate the source of Applicant's batteries. "The Blue Product Feature" serves purposes other than source identification. In the mind of the public, the primary significance of "The Blue Product Feature" is to identify the special characteristics of the batteries or marine batteries.

26. "The Blue Product Feature" has not acquired distinctiveness and is not entitled to registration.

III.

Fraud On The PTO

27. Applicant incorporates and alleges Paragraphs 1-26 as if fully set forth herein.

28. At least as early as June 14, 2001 (before this application was filed), Applicant was aware of Opposer's use of the color blue on the entire (and/or substantial portions of the) top

or cover portion of batteries. This prior awareness is relevant and material. This awareness was stated in a June 14, 2001 letter sent on Applicant's letterhead from the President of Applicant's "Automotive Systems Group, Battery" division to the President of Opposer's "Transportation Business Group."

29. Upon information and belief, at least as early as December 10, 2001, Applicant was also aware of numerous other manufacturers' and competitors' concurrent, co-existing and simultaneous use of the color blue on the entire (and/or substantial portions of the) top or cover portion of batteries. This prior awareness is relevant and material.

30. In its application for "The Blue Product Feature," filed December 10, 2001, Applicant declared it was the sole and exclusive owner of "The Blue Product Feature," and that no other person, firm, corporation or association had the right to use "The Blue Product Feature."

31. Upon information and belief, Applicant and its agents and representatives committed fraud on the U.S. Patent and Trademark Office ("PTO") when the Applicant declared in the application it was the sole and exclusive owner of "The Blue Product Feature," and that no other person, firm, corporation or association had the right to use "The Blue Product Feature."

32. In a PTO Office Action related to the application dated April 9, 2002, the Examining Attorney stated: "The applicant must also indicate whether competitors produce the goods in the identified colors and in colors other than the identified color. The applicant must provide color photographs and color advertisements showing competitive goods."

33. In a response to this PTO Office Action, on October 9, 2002, Applicant stated "the Applicant has made *substantially exclusive* and continuous use of its Trade Dress in commerce for more than six years" (emphasis added). Response to Office Action, at ¶2 d. Applicant submitted as evidence of "substantially exclusive" use the Declaration of Paul

VanHoof, General Manager of Optima Batteries, Inc., a wholly-owned subsidiary of Applicant. In this Declaration, Applicant, through Mr. VanHoof, represented to the PTO that Applicant's blue covers for batteries had been "substantially exclusive." VanHoof Declaration, at ¶5. Applicant, through Mr. VanHoof, represented it was not aware that blue covers for batteries had been used by any other entity. VanHoof Declaration, at ¶6. Applicant, through Mr. VanHoof, represented that "The Blue Product Feature" on batteries and marine batteries served no functional purpose. VanHoof Declaration, at ¶9. Lastly, Applicant, through Mr. VanHoof, attached as Exhibit C-3 to the VanHoof Declaration copies of competitor publications to support the representations that no other competitors (including Opposer) incorporated the blue color for battery covers and that the Applicant's use of the blue color for battery covers was substantially exclusive. VanHoof Declaration, at ¶10.

34. A depiction of Opposer's use of the color blue on the entire (and/or substantial portions of the) portion of the top or cover of Opposer's **ORBITAL®** brand battery was prominently displayed on pages at Opposer's Internet web site www.exide.com when Applicant, its agents or representatives, visited www.exide.com, including visiting pages therein about Opposer's **ORBITAL®** brand batteries. Copies of pages from www.exide.com about Opposer's **ORBITAL®** brand batteries--missing the proximate pages showing use of the color blue on the entire (and/or substantial portions of the) top or cover portion of **ORBITAL®** brand batteries--were submitted to PTO as part of Exhibit C-3 to the VanHoof Declaration as evidence in support of Applicant's allegation of "substantially exclusive" use of "The Blue Product Feature."

35. Upon information and belief, in reviewing Opposer's website www.exide.com to locate images of Opposer's and competitor's batteries that did not have blue tops or covers to use in Applicant's Exhibit C-3 to the VanHoof Declaration, Applicant, its agents or representatives,

necessarily became aware of the prominently and proximately displayed images of Opposer's **ORBITAL®** brand battery using a blue top or cover.

36. Upon information and belief, when Applicant filed its Response to Office Action, and the VanHoof Declaration with the PTO, Applicant, it's agents or representatives, were aware of the concurrent, co-existing and simultaneous uses of the color blue on the entire (and/or substantial portions of the) top or cover portion of batteries by Opposer or other manufacturers or competitors during Applicant's period of alleged "substantially exclusive" use of "The Blue Product Feature." This prior awareness is relevant and material. As respects Opposer's concurrent use of the color blue on the entire (and/or substantial portions of the) top or cover portion of batteries, this prior awareness by Applicant existed for nearly a year and a half at the time Applicant filed its Response to Office Action, and the VanHoof Declaration.

37. Upon information and belief, the PTO was never made aware by Applicant, its agents or representatives, of the concurrent, co-existing and simultaneous uses of the color blue on the entire (and/or substantial portions of the) top or cover portion of batteries by Opposer or other manufacturers or competitors during Applicant's period of alleged "substantially exclusive" use of "The Blue Product Feature." This omission is relevant and material.

38. Upon information and belief, Applicant, its agents or representatives, committed fraud on the PTO when such evidence, knowledge, awareness, and information of relevant and material concurrent, co-existing, and simultaneous uses of the color blue on the entire (and/or substantial portions of the) top or cover portion of batteries by Opposer and other manufacturers or competitors during Applicant's period of alleged "substantially exclusive" use of "The Blue Product Feature" was omitted and withheld from the Response to Office Action, and from the VanHoof Declaration.

39. Upon information and belief, Applicant, its agents or representatives, withheld and did not disclose to the PTO evidence, knowledge, awareness or information of relevant and material concurrent, co-existing, and simultaneous uses of the color blue on the entire (and/or substantial portions of the) top or cover portion of batteries by Opposer and other manufacturers or competitors, because of a belief that disclosure of the same to the PTO might have interfered with Applicant's ability to demonstrate five or more years of "substantially exclusive" use of "The Blue Product Feature."

40. Upon information and belief, Applicant, its agents or representatives, committed fraud on the PTO when both the Response to Office Action and the VanHoof Declaration represented to the PTO that Applicant's use of "The Blue Product Feature" was "substantially exclusive."

41. In May, 2003, Applicant's counsel corresponded with Opposer's counsel about Opposer's concurrent, co-existing and simultaneous use of the color blue on the entire (and/or substantial portions of the) top or cover portion of batteries. This second stated awareness of Opposer's co-existing and simultaneous use of the color blue on the entire (and/or substantial portions of the) top or cover portion of batteries is relevant and material. Applicant is at all times under a duty to correct materially false statements to the PTO when their falsity becomes known.

42. Upon information and belief, Applicant, its agents or representatives, perpetuated fraud on the PTO by failing to bring to the attention of the PTO Applicant's awareness of Opposer's and other manufacturers and competitors concurrent, co-existing and simultaneous use of the color blue on the entire (and/or substantial portions of the) top or cover portion of batteries during the Applicant's alleged period of exclusive use of the "The Blue Product Feature," and by failing to supplement, update, and correct in the Response to Office Action, and

in the VanHoof Declaration Applicant's omissions about and false representations of "substantially exclusive" use of "The Blue Product Feature."

43. Upon information and belief, the original application declaration, Applicant's Response to Office Action, and the VanHoof Declaration, contain statements or omissions of material fact made by Applicant, its authorized agents or representatives, with the knowledge, information, awareness and belief that such statements or omissions were false, deceptive or misleading. Upon information and belief, such false, deceptive or misleading statements or omissions were made knowingly, with the intent to induce and deceive authorized agents of the PTO to allow the application for "The Blue Product Feature."

44. Upon information and belief, reasonably relying on the truth and materiality of the false statements or omissions made in the original application declaration, Response to Office Action, and the VanHoof Declaration, the PTO did, in fact, allow "The Blue Product Feature."

45. Upon information and belief, had the foregoing false, deceptive or misleading statements, misrepresentations or omissions of material fact not been made, the PTO would have refused to allow "The Blue Product Feature."

46. Upon information and belief, had the PTO been aware of the concurrent, co-existing and simultaneous uses of the color blue on the entire (and/or substantial portions of the) top or cover portion of batteries or marine batteries by Opposer or other manufacturers and competitors during Applicant's period of alleged "substantially exclusive" use, the PTO would have refused to allow "The Blue Product Feature."

47. Upon information and belief, Applicant did not properly qualify "The Blue Product Feature" for federal registration, and the related papers and declarations filed by Applicant under 37 C.F.R. §2.20, and under §1001 of Title 18 of the United States Code, are

erroneous, false, inaccurate, ineffectual, invalid, and void.

WHEREFORE, Opposer requests that its Opposition be sustained, and that registration of "The Blue Product Feature" be denied.

Exide Technologies hereby appoints Roger P. Furey, Esq., Peter J. Riebling, Esq., Courtney Bailey, Esq., Sylvia Denise Davis, Esq., Dawn C. Hayes, Esq., and Rebecca McDougall, Esq. all of KATTEN MUCHIN ZAVIS ROSENMAN, 1025 Thomas Jefferson Street, N.W., Suite 700, East Lobby, Washington, DC 20007, a law firm comprising members of the Bar of the District of Columbia, as its attorneys with full powers of substitution and revocation, to file this Notice of Opposition, to receive all related communications, to transact all business in the U.S. Patent and Trademark Office and/or Trademark Trial and Appeal Board in connection therewith, and to represent it in all proceedings and appeals that may arise in the U.S. Patent and Trademark Office or the courts concerning this proceeding. Please address all communications related to this Opposition to:

Roger P. Furey, Esq.
Katten Muchin Zavis Rosenman
1025 Thomas Jefferson Street, N.W.
Suite 700, East Lobby
Washington, DC 20007
(202) 625-3500
roger.furey@kmzr.com

The filing fees in the amount of $300.00 for the filing of this Opposition, and any additional fees, should be charged to the Deposit Account of Katten Muchin Zavis Rosenman, Account No. 50-1877.

A duplicate copy of this Notice of Opposition is enclosed herewith.

EXIDE TECHNOLOGIES

Dated: March 15, 2004

By: Peter J. Riebling

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PATENT & TRADEMARK OFFICE

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2900 Crystal Drive
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VIA HAND DELIVERY

03-15-2004
U.S. Patent & TMOfc/TM Mail Rcpt Dt. #78

MAIL STOP BOX TTAB – NO FEE

RE: Opposer: Exide Technologies
Applicant: Johnson Controls Battery Group, Inc,
Application No.: 76/346,860 for "color blue as applied to entire top (cover) portion of the goods [batteries; including marine batteries]"
Publication Date: April 1, 2003
Our Reference: 320513.00010

Dear Sir:

Submitted herewith are the following:

1. Notice of Opposition in triplicate (original and two copies) (45 Pages total);

2. Certificate of Hand Delivery with Certificate of Service (1 Page); and

3. A receipt to be date stamped with the filing date (1 Pink sheet).

The Commissioner is hereby authorized to charge the $300.00 Notice of Opposition fee for filing this Opposition and any additional fees associated with this filing to the Deposit Account of Katten Muchin Zavis Rosenman, Account No. 50-1877.

Please direct all inquiries and correspondence in this matter to Roger P. Furey, Esq., at the address on this letterhead or by telephone at (202) 625-3630.

Respectfully submitted,

Valerie A. Purdy
Trademark Paralegal

Date: March 15, 2004

Enclosures

cc: Barbara Hatcher, Esq.
Peter J. Riebling, Esq.

CERTIFICATE OF HAND-DELIVERY

I hereby certify that the foregoing **Notice of Opposition of Application No. 76/346,860 for "color blue as applied to entire top (cover) portion of the goods [batteries; including marine batteries]"**, filed on behalf of Opposer, Exide Technologies, was hand-delivered to the following address, this 15th day of March, 2004:

Commissioner for Trademarks
U.S. Patent and Trademark Office
2900 Crystal Drive
Arlington, Virginia 22202-3514
MAIL STOP BOX TTAB - NO FEE

Valerie A. Purdy
Trademark Paralegal
KATTEN MUCHIN ZAVIS ROSENMAN

CERTIFICATE OF SERVICE

I hereby certify that a copy of the foregoing **Notice of Opposition of Application No. 76/346,860 for "color blue as applied to entire top (cover) portion of the goods [batteries; including marine batteries]"**, filed on behalf of Opposer, Exide Technologies, was served on:

Mark J. Diliberti, Esq.
FOLEY & LARDNER
Firstar Center
777 East Wisconsin Avenue
Milwaukee, WI 53202-5367

Applicant's counsel, via first-class mail, postage prepaid, this 15th day of March, 2004.

Valerie A. Purdy
Trademark Paralegal
KATTEN MUCHIN ZAVIS ROSENMAN