

ESTTA Tracking number: **ESTTA140679**

Filing date: **05/15/2007**

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                                  | BorgWarner Inc.                                             |
| Granted to Date of previous extension | 05/16/2007                                                  |
| Address                               | 3850 Hamlin Road<br>Auburn Hills, MI 48326<br>UNITED STATES |

|                            |                                                                                                                      |
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| Correspondence information | BorgWarner Inc.<br>3850 Hamlin Road<br>Auburn Hills, MI 48326<br>UNITED STATES<br>essp@essp-law.com Phone:4192431294 |
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**Applicant Information**

|                        |                                                                                      |                        |            |
|------------------------|--------------------------------------------------------------------------------------|------------------------|------------|
| Application No         | 78724473                                                                             | Publication date       | 01/16/2007 |
| Opposition Filing Date | 05/15/2007                                                                           | Opposition Period Ends | 05/16/2007 |
| Applicant              | Morse Automotive Corporation<br>4130 S. Morgan<br>Chicago, IL 60609<br>UNITED STATES |                        |            |

**Goods/Services Affected by Opposition**

|                                                                                                                                  |
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| Class 012.<br>All goods and services in the class are opposed, namely: Disc Brakes, disc brake pads and Brake Shoes for vehicles |
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**Grounds for Opposition**

|                                      |                             |
|--------------------------------------|-----------------------------|
| Priority and likelihood of confusion | Trademark Act section 2(d)  |
| Dilution                             | Trademark Act section 43(c) |

**Marks Cited by Opposer as Basis for Opposition**

|                       |            |                       |            |
|-----------------------|------------|-----------------------|------------|
| U.S. Registration No. | 417640     | Application Date      | 05/07/1945 |
| Registration Date     | 11/06/1945 | Foreign Priority Date | NONE       |
| Word Mark             | MORSE      |                       |            |
| Design Mark           |            |                       |            |

|                     |                                                                                                                                                                                                                              |
|---------------------|------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------|
| Description of Mark | NONE                                                                                                                                                                                                                         |
| Goods/Services      | Class U013 (International Class 006). First use: First Use: 1893/10/24 First Use In Commerce: 1893/10/24<br>METAL CHAINS FOR SPROCKETS AND THE LIKE AND PARTS THEREOF INCLUDING SIDE LINKS, ANTI-BACKBEND LINKS, AND PINTLES |

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| U.S. Registration No. | 2330029                                                                                                                                                                                                                  | Application Date      | 03/15/1995 |
| Registration Date     | 03/14/2000                                                                                                                                                                                                               | Foreign Priority Date | NONE       |
| Word Mark             | MORSE-GEMINI                                                                                                                                                                                                             |                       |            |
| Design Mark           |                                                                                                                                                                                                                          |                       |            |
| Description of Mark   | NONE                                                                                                                                                                                                                     |                       |            |
| Goods/Services        | Class 012. First use: First Use: 1998/03/20 First Use In Commerce: 1998/03/20<br>power transmitting devices for land vehicles, namely, chains, sprockets, and continuously variable transmission (CVT) belts and sheaves |                       |            |

|                       |                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                         |                       |            |
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| U.S. Registration No. | 2443778                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                 | Application Date      | 02/26/1999 |
| Registration Date     | 04/17/2001                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                              | Foreign Priority Date | NONE       |
| Word Mark             | MORSE                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                   |                       |            |
| Design Mark           |                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                         |                       |            |
| Description of Mark   | NONE                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                    |                       |            |
| Goods/Services        | Class 006. First use: First Use: 1983/00/00 First Use In Commerce: 1983/00/00<br>METAL CHAINS FOR NON-AUTOMOTIVE USE<br>Class 007. First use: First Use: 1983/00/00 First Use In Commerce: 1983/00/00<br>MACHINE PARTS, NAMELY, GEAR UNITS AND GEAR SETS, OIL SEALS, BEARINGS, SHAFTS, HOUSINGS AND KEY STOCK FOR GEAR UNITS; CLUTCHES AND SEALS, BEARINGS, [ CAGES ] *GAGES *, CAMS AND SPRAGS FOR CLUTCHES; CONVEYING COMPONENTS, NAMELY, CONVEYOR MODULES, MODULAR BELTS, CONVEYING CHAINS AND REPLACEMENT PINS AND MODULES; AND FLEXIBLE COUPLINGS FOR INDUSTRIAL MACHINES AND SEALS, BOLT SETS, WASHERS, BISCUITS, BUSHINGS AND COVERS FOR SUCH FLEXIBLE COUPLINGS |                       |            |

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| U.S. Registration No. | 2445586                                                                                                                                                                                                                                                             | Application Date      | 02/26/1999 |
| Registration Date     | 04/24/2001                                                                                                                                                                                                                                                          | Foreign Priority Date | NONE       |
| Word Mark             | MORSE                                                                                                                                                                                                                                                               |                       |            |
| Design Mark           |                                                                                                                                                                                                                                                                     |                       |            |
| Description of Mark   | NONE                                                                                                                                                                                                                                                                |                       |            |
| Goods/Services        | Class 006. First use: First Use: 1893/10/24 First Use In Commerce: 1893/10/24<br>METAL CHAINS FOR NON-AUTOMOTIVE USE<br>Class 007. First use: First Use: 1930/00/00 First Use In Commerce: 1930/00/00<br>MACHINE PARTS, NAMELY GEAR UNITS AND GEAR SETS, OIL SEALS, |                       |            |

|  |                                                                                                                                                                                                                                                                                                                                                                                                    |
|--|----------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------|
|  | BEARINGS, SHAFTS, HOUSINGS AND KEY STOCK FOR GEAR UNITS; CLUTCHES AND SEALS, BEARINGS, GAGES, CAMS AND SPRAGS FOR CLUTCHES; CONVEYING COMPONENTS, NAMELY, CONVEYOR MODULES, MODULAR [ BETS ] * BELTS *; CONVEYING CHAINS AND REPLACEMENT PINS AND MODULES; AND FLEXIBLE COUPLINGS FOR INDUSTRIAL MACHINES AND SEALS, BOLT SETS, WASHERS, BISCUITS, BUSHINGS AND COVERS FOR SUCH FLEXIBLE COUPLINGS |
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| Related Proceedings | 91176849 91177173 91173134 |
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| Attachments | 74647115#TMSN.gif ( 1 page )( bytes )<br>75650379#TMSN.gif ( 1 page )( bytes )<br>Notice of Opposition - Morse Elite.pdf ( 6 pages )(195172 bytes ) |
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|           |                     |
|-----------|---------------------|
| Signature | /Charles R. Schaub/ |
| Name      | BorgWarner Inc.     |
| Date      | 05/15/2007          |

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

In re Application Ser. No. 78/724,473 for the mark MORSE ELITE, filed on September 30, 2005, and published on January 16, 2007

|                              |   |                |
|------------------------------|---|----------------|
| BORGWARNER INC.,             | ) |                |
|                              | ) |                |
| Opposer,                     | ) | Opposition No. |
| v.                           | ) |                |
|                              | ) |                |
| MORSE AUTOMOTIVE CORPORATION | ) |                |
|                              | ) |                |
| Applicant.                   | ) |                |

**NOTICE OF OPPOSITION**

Opposer BorgWarner Inc., (“Opposer”), a corporation duly organized and existing under the laws of Delaware, having its principal place of business at 3850 Hamlin Road, Auburn Hills, Michigan, believes that it will be damaged by the registration of the mark shown in Application No. 78/724,473, and hereby opposes the same under the provisions of Section 13 of the Trademark Act of 1946, 15 U.S.C. §1063.

As grounds for opposition, Opposer alleges the following:

1. Opposer is the owner of all right, title and interest in and to the marks MORSE and MORSE-GEMINI, which are used in connection with automotive parts including variable cam timing systems, engine timing systems, and drivetrain components, namely transmissions and transfer cases.
2. Opposer has used its mark MORSE in the U.S. since October 24, 1893 in connection with power transmitting devices for automobiles.

3. Opposer's rights in MORSE and MORSE-GEMINI have been recognized by the United States Patent and Trademark Office, which issued as US. Registration Nos. 417,640, 2,443,778 and 2,445,586 for the mark MORSE and U.S. Registration No. 2,330,029 for the mark MORSE-GEMINI.

4. Opposer's registrations for the mark MORSE and MORSE-GEMINI, are valid and subsisting, constituting prima facie evidence of Opposer's ownership of its marks and its exclusive right to its marks in commerce. Opposer will file a Notice of Reliance accompanied by copies of the registrations showing current status of and current title to the registrations during its testimony period.

5. Since October 24, 1893, long prior to the filing date of Applicant's application, Opposer's MORSE mark has been extensively used, advertised, and promoted in connection with automotive parts throughout the U.S. and the world.

6. Since long prior to the filing date of Applicant's application, Opposer BorgWarner through its other divisions has sold parts for brakes, namely, brake bands, anti-lock brake relays, brake fluid level sensors, parking brake switches, front ABS wheel sensors, rear ABS wheel sensors, ABS control modules, brake pressure relays, ABS speed sensors and skid control relays.

7. Since long prior to the filing date of Applicant's application, Opposer's MORSE TEC division has been considered as the world leader in automotive chain as well as a leading supplier of oil pump systems.

8. Since long prior to the filing date of Applicant's application, Opposer has operated plants and offices relating to its MORSE TEC division throughout the U.S. and the world in Ithaca, New York, Cortland, New York, Auburn Hills, Michigan, Sallisaw,

Oklahoma, Simcoe, Ontario, Mexico, Italy, three in Japan, two in China, Taiwan, India, and Korea.

9. Opposer's MORSE mark has been widely used and extensively advertised in the United States and, therefore, the mark has become well known and famous as a distinctive symbol of Opposer's goodwill.

10. Opposer's MORSE marks became well known and famous before Applicant filed its alleged mark.

11. Notwithstanding Opposer's prior rights in the marks MORSE and MORSE-GEMINI, Applicant filed an application with the United States Patent and Trademark Office to register the mark MORSE ELITE (Ser. No. 78/724,473) for "disc brakes, disc brake pads and brake shoes for vehicles".

12. Notwithstanding Opposer's prior rights in MORSE and MORSE-GEMINI, Applicant also filed applications with the United States Patent and Trademark Office to register the marks:

MORSE, Serial No. 78/724,372, already opposed

MORSE FRICTIONMASTER, Serial No. 78/724,493, already opposed

MORSE CERAMIC, Serial No. 78/724,436, opposition filed concurrently

herewith

MORSE EXTREME, Serial No. 78/724,485, opposition filed concurrently

herewith

MORSE ULTRALIFE, Serial No. 78/724,497, already opposed

13. Upon information and belief, Applicant knew or had reason to know of Opposer's prior rights in its MORSE and MORSE-GEMINI marks when Applicant filed its application.

14. The mark which Applicant seeks to register is identical to or so closely resembles Opposer's marks MORSE and MORSE-GEMINI that the use and registration thereof is likely to cause confusion, mistake and deception as to the source or origin of Applicant's goods in violation of Section 2 (d) of the Trademark Act, and will injure and damage Opposer and the goodwill and reputation symbolized by Opposer's mark.

15. The goods of Applicant are identical to or so closely related to the goods of Opposer that the public is likely to be confused, to be deceived, and to assume erroneously that Applicant's goods are those of Opposer, or that Applicant is in some way connected with, sponsored by, or affiliated with Opposer, all to Opposer's irreparable damage.

16. Applicant is not affiliated or connected with or endorsed or sponsored by Opposer, nor has Opposer approved any of the goods offered or sold or intended to be sold by Applicant under its alleged mark.

17. Likelihood of confusion in this case is enhanced by the fame of Applicant's mark MORSE and by the fact that consumers will associate Applicant's alleged mark with goods sold, approved or endorsed by Opposer.

18. When Applicant's alleged mark is used on goods of the type described in its application, said mark will cause purchasers to mistakenly assume that Opposer is endorsing, attempting to promote, or encouraging the sale of Applicant's goods by permitting Applicant's alleged mark to be used on such goods.

19. Applicant's alleged mark has caused dilution of the distinctive quality of Opposer's mark MORSE.

20. Likelihood of confusion, dilution and deception is enhanced by the fact that the parties' goods are sold through the same trade channels to the same classes of prospective purchasers.

21. Applicant's use or registration of the alleged mark MORSE ELITE for the goods listed in its application will tarnish the goodwill symbolized by Opposer's marks MORSE and MORSE-GEMINI.

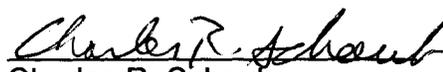
22. Applicant's use or registration of the alleged mark MORSE for the goods listed in its application will cause dilution by blurring, thus diluting or weakening the unique and distinctive significance of Opposer's MORSE marks to identify and distinguish one source.

23. Likelihood of damage to Opposer's goodwill is enhanced by the fact that prospective customers who may not be satisfied in the quality of Applicant's goods will attribute such lack of quality to Opposer, and this will injure Opposer's reputation and goodwill.

24. By reason of the foregoing, Opposer will be damaged by the registration of Applicant's alleged mark and registration should be refused.

Wherefore, Opposer prays that this opposition be sustained and that registration be denied.

BORGWARNER INC.



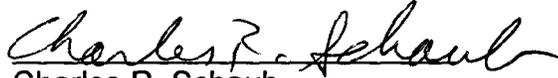
Charles R. Schaub  
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P.O. Box 916  
Toledo, Ohio 43697-0916  
Telephone: (419) 243-1294  
Attorney for Opposer

Date: May 15, 2007

CERTIFICATE OF SERVICE

I hereby certify that a true and correct copy of the foregoing NOTICE OF OPPOSITION was served on Applicant, this 15<sup>th</sup> day of May, 2007, via first class mail, postage prepaid, to James Michael Faier, Faier & Faier P.C., 566 W. Adams Street, Suite 600, Chicago, Illinois 60661.

  
Charles R. Schaub