

ESTTA Tracking number: **ESTTA216421**

Filing date: **06/09/2008**

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	ContiTech North America, Inc.
Granted to Date of previous extension	06/07/2008
Address	136 Summit Ave, Suite 201 Montvale, NJ 07645 UNITED STATES

Attorney information	Zachary D. Cohen McGuireWoods LLP 901 East Cary Street Richmond, VA 23219 UNITED STATES zcohen@mcguirewoods.com Phone:804-775-1194
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**Applicant Information**

Application No	77143412	Publication date	04/08/2008
Opposition Filing Date	06/09/2008	Opposition Period Ends	06/07/2008
Applicant	BFS Diversified Products, LLC 310 East 96th Street Indianapolis, IN 46240 UNITED STATES		

**Goods/Services Affected by Opposition**

Class 007. First Use: 1989/10/31 First Use In Commerce: 1989/10/31 All goods and services in the class are opposed, namely: pneumatic actuators for use as a motion control device in manufacturing, material handling, assembly, forestry, paper, hydraulics and pneumatics, and related industries; vibration absorbing suspensions and vibration isolators for machinery and parts therefor; pneumatic suspension springs and shock absorber units for machinery and equipment and structural and replacement parts therefor
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**Grounds for Opposition**

Deceptiveness	Trademark Act section 2(a)
The mark is merely descriptive	Trademark Act section 2(e)(1)
The mark is deceptively misdescriptive	Trademark Act section 2(e)(1)

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

U.S. Application/Registration No.	NONE	Application Date	NONE
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Registration Date	NONE
Word Mark	World's Number 1 Air Spring
Goods/Services	air springs, pneumatic suspension springs, shock absorber units

Related Proceedings	1. Civil Action in US District Court for the Southern District of Indiana, 1:08-cv-0416-LJM-TAB 2. Notice of Opposition to be filed by Opposer against Ser. No. 77/143307
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Attachments	77143412.pdf ( 5 pages )(103450 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	/Zachary D. Cohen/
Name	Zachary D. Cohen
Date	06/09/2008



## BACKGROUND

3. Opposer and its affiliates are part of a leading global automotive and industrial equipment company, offering innovative product design and technology. Opposer sells air springs and air spring systems as well as other automotive and industrial parts, including pneumatic brakes, hydraulic brakes, steering shock absorbers, hoses, hose lines, power transmission systems, and parts for vibration control, among others. Opposer sells to both corporate and retail accounts.

4. Opposer is the worldwide leader in manufacturing and sales of air springs and air spring systems and has used the phrase “world’s number 1 air spring” to truthfully describe its air springs and air spring systems.

5. Opposer and its affiliates and Applicant and its affiliates are competitors.

6. Opposer’s customers and the general public are likely to be misled, mistaken or deceived by Applicant’s Mark as to Applicant’s status in the air spring marketplace to the damage of Opposer.

## SECTION 2(E)

7. Applicant’s Mark is descriptive under Section 2(e) of the Lanham Act. In fact, Applicant’s Mark is trade puffery and so highly laudatory and descriptive as to be incapable of acquiring distinctiveness as a trademark. As such, Applicant has failed to show and cannot show that its putative mark has become distinctive under Section 2(f) of the Lanham Act.

8. The phrase “world’s number 1 air spring” is not now, and never has been exclusively identified with Applicant’s goods, and the mark sought to be registered does not distinguish Applicant’s goods from the goods of the Opposer.

## SECTION 2(A)

9. Applicant's Mark, when applied to Applicant's goods, is deceptive under Section 2(a) of the Lanham Act and/or deceptively misdescriptive under Section 2(e). The mark inaccurately connotes that Applicant is the world's leading producer of air springs, when in fact Opposer and its affiliates enjoy that status.

10. As such, Applicant's Mark misrepresents a material fact as to the character and/or quality of the goods. Prospective purchasers are likely to believe the misdescription actually describes Applicant's goods and the misdescription is likely to affect the decision to purchase Applicant's versus Opposer's goods.

11. Applicant's Mark is, in fact, intentionally calculated to mislead consumers by falsely bestowing upon Applicant's goods an appearance of marketplace preeminence and/or superior quality.

## DAMAGE TO OPPOSER

12. Opposer would be damaged by registration of Applicant's Mark in that, although Applicant's Mark is descriptive, Applicant could use it to limit Opposer's right to truthfully proclaim its preeminence in the field of air springs in connection with goods produced and sold by Opposer. Indeed, Applicant and its alleged related company, Firestone Industrial Products Company, LLC, have already sued Opposer for trademark infringement and unfair competition arising from Opposer's alleged use of the phrases "world's number 1 air spring" and "world's no. 1 air spring" basing the claim in part upon Applicant's Mark.

13. Opposer would be damaged by registration of Applicant's Mark in that the mark is deceptive or deceptively misdescriptive when applied to Applicant's goods and is, therefore, likely to cause consumers to purchase Applicant's goods under the misimpression that such

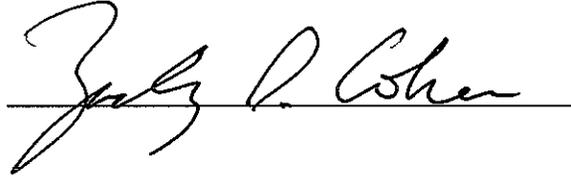
goods are of superior character and/or quality to Opposer's goods, thereby diverting and confusing Opposer's potential and existing customers

WHEREFORE, Opposer prays that Application Serial No. 77/143412 be rejected, that no registration be issued thereon to Applicant, and that this Opposition be sustained.

Respectfully submitted,

CONTITECH NORTH AMERICA, INC.

By Counsel

A handwritten signature in black ink, appearing to read "Zachary D. Cohen", is written over a horizontal line.

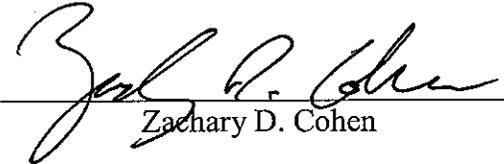
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Counsel for CONTITECH NORTH AMERICA, INC.  
Dated: June 9, 2008  
Electronically Filed via ESTTA: June 9, 2008

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## CERTIFICATE OF SERVICE

I certify that on June 9, 2008, a copy of this Notice of Opposition was mailed, first class, postage prepaid to Michael R. Huber, Bridgestone Americas Holding, Inc., 1200 Firestone Parkway, Akron, Ohio 44317, counsel for Applicant.

  
Zachary D. Cohen