

ESTTA Tracking number: **ESTTA382451**

Filing date: **12/07/2010**

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	WolfPGraeser
Granted to Date of previous extension	01/01/2011
Address	Sonnenbergweg 14 Flein, 74223 GERMANY

Attorney information	Sarah E. Tallent, Esq. Reinhardt LLP 44 Wall Street 10th Fl New York, NY 10005 UNITED STATES stallent@reinhardt-law.com Phone:2127100970
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**Applicant Information**

Application No	76701998	Publication date	11/02/2010
Opposition Filing Date	12/07/2010	Opposition Period Ends	01/01/2011
Applicant	LAVATEC, INC 300 Great Hill Road Naugatuck, CT 06770 UNITED STATES		

**Goods/Services Affected by Opposition**

Class 007. First Use: 1987/02/15 First Use In Commerce: 1987/02/15 All goods and services in the class are opposed, namely: Dry-cleaning machines; washing machines for clothing; folders, namely, electric clothes folding machines for commercial dry cleaning and laundry purposes; electric clothing pressing machines for commercial dry cleaning and laundry purposes including shirt press, collar and cuff press, utility press, legger press, drapery press, pants topper, mushroom topper and puff iron
Class 011. First Use: 1987/02/15 First Use In Commerce: 1987/02/15 All goods and services in the class are opposed, namely: Clothes dryers

**Grounds for Opposition**

Deceptiveness	Trademark Act section 2(a)
False suggestion of a connection	Trademark Act section 2(a)
Priority and likelihood of confusion	Trademark Act section 2(d)
The mark is deceptively misdescriptive	Trademark Act section 2(e)(1)
Dilution	Trademark Act section 43(c)

Other	Applicant is not the owner of the mark.
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### Mark Cited by Opposer as Basis for Opposition

U.S. Application No.	85138139	Application Date	09/24/2010
Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	LAVATEC		
Design Mark			
Description of Mark	NONE		
Goods/Services	<p>Class 007. First use: Laundry machines, for commercial dry cleaning and laundry purposes, namely washing machines, double-drum washing machines, spin dryers, ironing machines, mangles, in particular multi-trough mangles and access platforms for mangles, fluff collectors for use in, on or with laundry machines, continuous batch washing machines, conveyor devices for laundry, folding apparatus, transfer devices for laundry and stacking devices for laundry, devices for sorting laundry</p> <p>Class 011. First use: Laundry machines for commercial dry cleaning and laundry purposes, namely, laundry boilers and electric laundry dryers</p> <p>Class 037. First use: Maintenance and repair of laundry machines</p>		

Attachments	85138139#TMSN.jpeg ( 1 page )( bytes ) Scan 160.PDF ( 8 pages )(367798 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 Overnight Courier on this date.

Signature	/Sarah E. Tallent/
Name	Sarah E. Tallent, Esq.
Date	12/07/2010



3. Since long prior to the filing date of the application-at-issue, the Mark (which Opposer and its predecessor in interest have circulated on a tremendous amount of products, packaging, advertising, brochures catalogs, etc. throughout the years) has been identified with Opposer, its predecessor in interest and the Products manufactured by Opposer and its predecessor in interest.

4. Opposer's Products are marketed and sold worldwide and, in the United States, on a nationwide basis, supported by substantial advertising and promotion. Since 1986, the Mark has been used to identify the Products. The nature and quality of such Products has always been controlled by Lavatec Germany and Opposer.

5. Opposer and its predecessor in interest made it possible for the Mark to acquire substantial customer recognition throughout the United States long prior to the filing date of the application-at-issue; the Mark also enjoys valuable goodwill and has become famous signifying Opposer as the source of products (designed and/or manufactured in Germany) and high-quality services. Lavatec Germany was the owner of the Mark before the Mark was sold to Opposer.

6. In addition to its prior common law rights in the Mark, Opposer is also the owner of an international trademark registration for the mark "LAVATEC" in standard characters which was registered with the European Community under Registration Number 008722688 on 08/10/2010, in International Classes 7, 11 and 37.

7. Opposer's registration for the Mark is valid, subsisting, in full force and effect, uncanceled and unrevoked, and serve as evidence of Opposer's exclusive right to use the Mark in commerce on or in connections with the goods and services identified in the registration.

8. Opposer filed an application to register the Mark with the United States Patent and Trademark Office and the application is currently pending under Serial Number: 85138139.

9. Opposer's and its predecessor in interest's use of the Mark has been continuous and it has not been abandoned. As a result of the long, extensive and widespread use, advertising, promotion and registration of the Mark on and in association with Opposer's goods and services, consumers have become accustomed to associating the Mark with a single source, that is, the Opposer and its predecessor in interest.

10. The Applicant seeks to register "LAVATEC" in standard characters as a trademark in International Classes 7 and 11.

11. The Applicant's application was published for opposition on November 2, 2010.

12. Applicant is a wholly owned subsidiary of Lavatec GmbH (f/k/a Lavatec AG), a German limited liability company registered with the Commercial Registry of Stuttgart under number HRB 3349 on October 15, 1986 ("Lavatec Germany"). Since its incorporation in 1987, one hundred percent of the authorized, issued and outstanding shares of the Applicant have been owned by Lavatec Germany. Consequently, since its incorporation, Applicant has been a wholly owned subsidiary of Lavatec Germany and is under the direct control of Lavatec Germany.

13. Lavatec Germany is the predecessor in interest of Opposer, the latter having acquired Lavatec Germany's assets, including all of its intellectual property rights worldwide.

14. Applicant was formed by Lavatec Germany for the mere purpose of serving as Lavatec Germany's U.S. sales office for Products designed and/or manufactured by Lavatec Germany. Applicant was at all times under the control of Lavatec Germany, therefore, even assuming for a moment that Applicant was the first to use the Mark (which Opposer strongly denies), such use would be attributable to Opposer pursuant to the provisions of U.S.C. §1055.

15. Applicant was never granted a written license to use the Mark, nor was the Mark ever assigned to Applicant. At best, Applicant had an oral, implied, revocable license to use the Mark in connection with the sale of the Products manufactured by its parent company Lavatec Germany. As a matter of fact, Applicant never attempted to register the Mark until March 2010, and did so without the knowledge or consent of Lavatec Germany.

16. Upon information and belief, the Applicant does not manufacture any of the products for which it seeks registration in International Classes 7 and 11 other than "folders, namely, electric clothes folding machines for commercial dry cleaning and laundry purposes". Upon information and belief, Applicant did not commence manufacturing such folding machines until approximately 1991. Upon information and belief, Applicant attempted to manufacture washer extractors, which were designed by Lavatec Germany, on or about 1997, however, the project was unsuccessful and was terminated. The vast majority of the products for which Applicant seeks registration in International Classes 7 and 11 (i.e., "dry-cleaning machines; washing machines for clothing; electric clothing pressing machines for commercial dry cleaning and laundry purposes including shirt press, collar and cuff press, utility press, legger press, drapery press, pants topper, mushroom topper and puff iron") are not manufactured by Applicant and, as of the date of the application, many are not even sold by Applicant.

17. It was Lavatec Germany that first introduced and commenced marketing the Products under the Mark in the United States in 1986 and has continuously sold Products in the United States under the Mark ever since.

18. In furtherance of its interstate commerce, Lavatec Germany then incorporated the Applicant, its wholly owned subsidiary, for the purposes of acting as a sales office for Lavatec Germany's Products in the United States.

19. On May 7, 2009, Lavatec Germany commenced bankruptcy proceedings in Germany.

20. In the course of Lavatec Germany's bankruptcy proceedings, Opposer purchased the assets of Lavatec Germany, including without limitation, its land, plant, manufacturing equipment and all of its worldwide intellectual property.

21. Opposer then filed to register the Mark with the European Trademark Office.

22. Opposer has continued the business of Lavatec Germany and continues to manufacture the Products in Germany and sell them under the Mark worldwide.

23. Opposer is selling the Products in the United States through a new sales office and is no longer supplying the Products to Applicant.

24. Applicant filed for protection under Chapter XI of the United States Bankruptcy Code in July 2009. Following such filing, Applicant filed to register the Mark without the knowledge or consent of Lavatec Germany or its bankruptcy trustee.

25. As a result of the efforts of Lavatec Germany and its successor the Opposer, the Mark has become associated with the Products manufactured by Lavatec Germany and its successor the Opposers.

26. At the time Lavatec Germany began using the Mark in interstate commerce in connection with the business of manufacturing and selling commercial laundry equipment, no other entity was utilizing the Mark. Indeed, it was Lavatec Germany that first introduced the products (for which Applicant is now attempting to seek registration in the U.S.) by supplying such products to its own U.S. sales office (i.e., the Applicant). Opposer necessarily sold machines in the U.S. prior to the Applicant, or else Applicant would have had no Products to market and sell.

27. The Applicant is not the owner of the Mark. The Mark has been consistently used to identify the Products manufactured by Opposer and its predecessor in interest. As a matter of fact, the vast majority of the photographs in the specimen attached to Applicant's original application, show Products manufactured by the Opposer, photographed in locations which are either the Opposer's facility in Germany or the facilities of Lavatec Germany's clients. Therefore, most of the

photographs in the specimen filed by Applicant are not products manufactured by the Applicant.

28. The "LAVATEC" mark sought to be registered by the Applicant is identical, therefore confusingly similar, to the "LAVATEC" mark owned by Opposer.

29. If the Applicant is permitted to use and/or register the "LAVATEC" mark in connection with the products and services described in the application herein opposed, the Opposer will be damaged because the public is likely to be confused as to the source of the products offered by the Opposer and the products offered by the Applicant.

30. If the Applicant is permitted to use and/or register the "LAVATEC" mark in connection with the products and services described in the application herein opposed, the Opposer will be damaged because the public is likely to be misled into believing that the products and services offered by the Applicant are endorsed by, sponsored by, or somehow otherwise connected with the Opposer. As a matter of fact, Opposer has already received numerous inquiries from industry operators requesting clarification as to the source of the Products in the United States.

31. If the Applicant is permitted to use and/or register the "LAVATEC" mark in connection with the products and services described in the application herein opposed, the Opposer will be damaged because the Applicant would thereby receive at least a prima facie exclusive right to the use of the "LAVATEC" mark even though this mark is confusingly similar to a mark that the Opposer, through its predecessor in interest, was using in interstate commerce long prior to the date of the Applicant's application.

32. Registration of the Applicant's alleged mark, which is the subject to the application-in-opposition, is barred by the provisions of Section 2(d) of the Trademark Act of 1946 because said mark consists of or comprises a mark which so resembles Opposer's Mark, which have been in use and are also the subject of a prior registration to register marks, as to be likely, when used in connection with the alleged goods of the Applicant to cause confusion, deception or mistake.

33. Opposer has priority over Applicant because Opposer's use of the Mark precedes the Applicant's filing date for its application at issue and/or any alleged date of first use in commerce of Applicant's purported mark.

34. Applicant's alleged mark, which is the subject of the application-in-opposition, and Opposer's mark are similar. Indeed, Applicant's claimed mark incorporates Opposer's mark in its entirety.

35. Opposer's Products are related to the products that Applicant markets and sells or intends to market and sell.

36. Accordingly, Applicant's claimed mark LAVATEC shown in the application-in-opposition so resembles Opposer's foregoing and previously used and/or registered mark as to be likely to cause confusion, cause misstate or to deceive with consequent injury to the Opposer. The likelihood of confusion, mistake or deception that would also arise from concurrent use and registration of the applied mark with Opposer's use and registration of its Mark is that: (a) persons are likely to believe that Applicant's goods have their source in Opposer or that Applicant is the manufacturer, or (b) Applicant and its goods are a version of Opposer's marks or are in some way legitimately connected or affiliated with, sponsored, approved, endorsed or licensed by Opposer, when, in fact they are not.

37. In view of the foregoing, registration of Applicant's alleged mark is barred by the provisions of Section 2(d) of the Trademark Act of 1946 because the said mark consist or comprises a mark which, when used in connection with the alleged goods of the Applicant, is likely to cause confusion, mistake or deception.

38. Opposer's inherently distinctive Mark became famous prior to the filing date of Applicant's application-in-opposition. Registration and use of Applicant's claimed mark would likely dilute Opposer's famous and inherently distinctive Mark in violation of 15. U.S.C. §1125(c). Accordingly, the applied-for mark LAVATEC is not entitled to registration under 15. U.S.C. §1052(f) and Section 13 of the Lanham Act, 15 U.S.C. §1063.

39. Opposer will be damaged by the issuance of the registration sought by Applicant within the meaning of 15 U.S.C. §1063 because such registration would support and assist Applicant in the confusing, misleading, deceptive and/or dilutive use of the LAVATEC mark and would give the color of exclusive statutory rights to Applicant in violation and derogation of the prior and superior rights of the Opposer.

40. Applicant is not the owner of the mark, therefore, is not entitled to register the mark.

41. By way of multiple communications dated September 2010, Opposer made demand on the Applicant that, among other things, it immediately cease all use of the "LAVATEC" mark and all marks that are similar thereto.

**PRAYER FOR RELIEF**

Based on the foregoing, the Opposer respectfully requests that Application Number 76701998 be rejected and that registration of the mark therein sought to be registered be denied and refused, and that the Board grant all further relief to Opposer that is necessary and just in these circumstances.

Respectfully submitted,

REINHARDT LLP

Dated December 7, 2010

By:

  
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Wolf-Peter Graeser

**CERTIFICATE OF SERVICE**

I hereby certify that a copy of the foregoing Notice of Opposition was served on Applicant at the correspondence address of record by express courier, in an envelope with sufficient postage addressed to:

LAVATEC, INC.  
300 Great Hill Road  
Naugatuck, CT 06770

On December 7, 2010.

By: ST  
Sarah E. Tallent, Esq.