

ESTTA Tracking number: **ESTTA686038**

Filing date: **07/27/2015**

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	07/26/2015
Address	3850 Hamlin Road Auburn Hills, MI 48326 UNITED STATES
Attorney information	Thad Chaloehtiarana and Seth I. Appel Pattishall, McAuliffe, Newbury, Hilliard & Geraldson LLP 200 South Wacker Drive, Suite 2900 Chicago, IL 60606 UNITED STATES tc@pattishall.com, sia@pattishall.com, lkn@pattishall.com

**Applicant Information**

Application No	79146439	Publication date	01/27/2015
Opposition Filing Date	07/27/2015	Opposition Period Ends	07/26/2015
International Registration No.	1201637	International Registration Date	03/12/2014
Applicant	Borgward Trademark Holdings GmbH Industriestrasse 4, GERMANY		

**Goods/Services Affected by Opposition**

Class 012. First Use: 0 First Use In Commerce: 0 All goods and services in the class are opposed, namely: Motor vehicles by land, air, water or rail, namely, cars, boats, airplanes; fork lift trucks; lifting vehicles, namely, tip trucks; coaches; cycle cars; cars; automobiles; concrete mixing vehicles; engines for land vehicles; automobile tires
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**Grounds for Opposition**

Priority and likelihood of confusion	Trademark Act section 2(d)
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**Marks Cited by Opposer as Basis for Opposition**

U.S. Registration No.	1412240	Application Date	02/12/1986
Registration Date	10/07/1986	Foreign Priority Date	NONE

Word Mark	BORGWARNER
Design Mark	
Description of Mark	NONE
Goods/Services	Class 012. First use: First Use: 1928/07/01 First Use In Commerce: 1928/07/01 LAND VEHICLE PARTS, NAMELY [ AXLES, ] TIMING CHAINS, DRIVE CHAINS, CLUTCHES, BRAKE LININGS, CLUTCH LININGS, TRANSFER CASES, LOCKING HUBS, TORSIONAL VIBRATION DAMPERS, EMISSION CONTROLS NAMELY EGR VALVES, [ DIFFERENTIALS, ] TORQUE CONVERTERS, [ UNIVERSAL JOINTS, POWER TAKEOFFS, FAN DRIVES ] AND SYNCHRONIZERS

U.S. Registration No.	1414891	Application Date	02/12/1986
Registration Date	10/28/1986	Foreign Priority Date	NONE

Word Mark	BORGWARNER
Design Mark	
Description of Mark	THE MARK CONSISTS IN PART OF A STYLIZED "X" DESIGN.
Goods/Services	Class 012. First use: First Use: 1984/08/24 First Use In Commerce: 1984/08/24 LAND VEHICLE PARTS, NAMELY [ AXLES, ] TIMING CHAINS, DRIVE CHAINS, CLUTCHES, BRAKE LININGS, CLUTCH LININGS, TRANSFER CASES, LOCKING HUBS, TORSIONAL VIBRATION DAMPERS, EMISSION CONTROLS NAMELY EGR VALVES, [ DIFFERENTIALS, ] TORQUE CONVERTERS, [ UNIVERSAL JOINTS, POWER TAKEOFFS, FAN DRIVES ] AND SYNCHRONIZERS

Attachments	73582533#TMSN.png( bytes ) Notice of Opposition.BORGWARD.pdf(927681 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	/Seth I. Appel/
Name	Seth I. Appel
Date	07/27/2015

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

In the Matter of Application Serial No. 79/146,439: BORGWARD

BORGWARNER, INC.,	)	
Opposer,	)	
v.	)	Opposition No. _____
BORGWARD TRADEMARK HOLDINGS GMBH,	)	
Applicant.	)	

**NOTICE OF OPPOSITION**

Opposer BorgWarner, Inc. ("Opposer"), a Delaware corporation, believes that it will be damaged by registration of the mark shown in Application Serial No. 79/146,439 and hereby opposes the same.

The opposed mark is BORGWARD for the following goods in International Class 12: "Motor vehicles by land, air, water or rail, namely, cars, boats, airplanes; fork lift trucks; lifting vehicles, namely, tip trucks; coaches; cycle cars; cars; automobiles; concrete mixing vehicles; engines for land vehicles; automobile tires." The application, owned by Borgward Trademark Holdings GmbH ("Applicant"), was filed on March 12, 2014, and published for opposition on January 27, 2015. Opposer obtained extensions of time to oppose, and now timely files this notice of opposition.

As grounds for opposition, Opposer alleges:

1. Opposer manufactures, distributes, markets and sells a variety of products for motor vehicles.

2. For many years, Opposer has continuously used the BORGWARNER name and trademark in commerce throughout the United States in connection with its full line of products.

3. Opposer's longstanding rights in its BORGWARNER trademark are reflected in part by the following U.S. registrations in Class 12:

<b>MARK</b>	<b>REG. NO. (DATE)</b>	<b>GOODS</b>
BORGWARNER	Reg. No. 1,412,240 (Oct. 7, 1986)	Land vehicle parts, namely timing chains, drive chains, clutches, brake linings, clutch linings, transfer cases, locking hubs, torsional vibration dampers, emission controls namely EGR valves, torque converters, and synchronizers.
BORGWARNER & Design	Reg. No. 1,414,891 (Oct. 28, 1986)	Land vehicle parts, namely timing chains, drive chains, clutches, brake linings, clutch linings, transfer cases, locking hubs, torsional vibration dampers, emission controls namely EGR valves, torque converters, and synchronizers.

Print-outs from the electronic records of the U.S. Patent and Trademark Office showing the current status and title of these registrations are attached as Exhibit A.

4. Opposer also has established strong common law rights in its BORGWARNER trademark by virtue of its sales, advertising, and promotion of products bearing this mark over many years.

5. Opposer's rights in its BORGWARNER trademark predate the filing of Application Serial No. 79/146,439.

6. The mark shown in Application Serial No. 79/146,439 so resembles Opposer's BORGWARNER trademark as to be likely, when used on or in connection with the goods identified in Application Serial No. 79/146,439, to cause confusion, to cause mistake, or to deceive.

7. Applicant's use and registration of the mark shown in Application Serial No. 79/146,439 is without Opposer's consent.

8. If Applicant is granted registration, Applicant will gain the *prima facie* right to use the mark shown in Application Serial No. 79/146,439 for the identified goods, thereby causing damage to Opposer. Accordingly, the Board should refuse registration under Section 2(d) of the Lanham Act, 15 U.S.C. § 1052(d).

WHEREFORE, Opposer prays that this opposition be sustained; that judgment be entered in favor of Opposer and against Applicant; and that Application Serial No. 79/146,439 be rejected.

Opposer submits the requisite filing fee of \$300.00. Please debit any deficiency from or credit any overpayment to Account No. 16-0650 and address all correspondence to Thad Chalocmtiarana and Seth I. Appel, Pattishall, McAuliffe, Newbury, Hilliard & Geraldson LLP, 200 South Wacker Drive, Suite 2900, Chicago, Illinois 60606.

Respectfully submitted,

PATTISHALL, McAULIFFE, NEWBURY,  
HILLIARD & GERALDSON LLP

Dated: July 27, 2015

By: /Seth I. Appel/

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Thad Chalocmtiarana  
Seth I. Appel  
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Chicago, Illinois 60606  
(312) 554-8000

*Attorneys for Opposer*

# **EXHIBIT A**

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**Mark:** BORGWARNER

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**US Serial Number:** 73582534

**Application Filing Date:** Feb. 12, 1986

**US Registration Number:** 1412240

**Registration Date:** Oct. 07, 1986

**Register:** Principal

**Mark Type:** Trademark

**Status:** The registration has been renewed.

**Status Date:** Dec. 21, 2006

**Publication Date:** Jul. 15, 1986

### Mark Information

### Related Properties Information

### Goods and Services

### Basis Information (Case Level)

### Current Owner(s) Information

**Owner Name:** BorgWarner Inc.

**Owner Address:** 3850 Hamlin Road  
Auburn Hills, MICHIGAN 48326

UNITED STATES

Legal Entity Type: CORPORATION

State or Country Where Organized: DELAWARE

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Mark: BORGWARNER



**BorgWarner**

US Serial Number: 73582533

Application Filing Date: Feb. 12, 1986

US Registration Number: 1414891

Registration Date: Oct. 28, 1986

Register: Principal

Mark Type: Trademark

Status: The registration has been renewed.

Status Date: Dec. 20, 2006

Publication Date: Aug. 05, 1986

**Mark Information**

**Related Properties Information**

**Goods and Services**

**Basis Information (Case Level)**

**Current Owner(s) Information**

Owner Name: BorgWarner Inc.

Owner Address: 3850 Hamlin Road  
Auburn Hills, MICHIGAN 48326  
UNITED STATES

Legal Entity Type: CORPORATION

State or Country Where Organized: DELAWARE

**Attorney/Correspondence Information**

**Prosecution History**

**Maintenance Filings or Post Registration Information**

**TM Staff and Location Information**

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**CERTIFICATE OF ELECTRONIC TRANSMISSION**

I, Seth I. Appel, certify that a true and correct copy of the foregoing **NOTICE OF OPPOSITION** is being electronically transmitted to the United States Patent and Trademark Office, Trademark Trial and Appeal Board, this 27<sup>th</sup> day of July, 2015.

/Seth I. Appel/

\_\_\_\_\_  
Seth I. Appel

**CERTIFICATE OF SERVICE**

I, Seth I. Appel, certify that a true and correct copy of the foregoing **NOTICE OF OPPOSITION** was served on Applicant, via first class mail, postage prepaid, addressed to Applicant's attorney or record as set forth below, this 27<sup>th</sup> day of July, 2015.

James M. Slattery, Esq.  
Birch, Stewart, Kolasch & Birch, LLP  
P.O. Box 747  
Falls Church, VA 22040-0747

/Seth I. Appel/

\_\_\_\_\_  
Seth I. Appel