

ESTTA Tracking number: **ESTTA576342**

Filing date: **12/13/2013**

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	Johnson Controls Hybrid and Recycling GmbH
Granted to Date of previous extension	02/02/2014
Address	Am Leineufer 51 Hannover, 30419 GERMANY

Attorney information	Peter J. Lynfield Abelman Frayne Schwab 666 Third Avenue New York, NY 10017 UNITED STATES pjlynfield@lawabel.com, nwbranthover@lawabel.com Phone:212-949-9022
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Applicant Information

Application No	79122927	Publication date	08/06/2013
Opposition Filing Date	12/13/2013	Opposition Period Ends	02/02/2014
International Registration No.	1142204	International Registration Date	10/26/2012
Applicant	VARTA Microbattery GmbH Daimlerstr. 1 DEX DEX		

Goods/Services Affected by Opposition

Class 009. First Use: 0 First Use In Commerce: 0 All goods and services in the class are opposed, namely: Batteries, namely, primary and rechargeable lithium ion cells, lithium polymer cells, primary and rechargeable lithium batteries, lithium accumulators, lithium round cells of bobbin construction, zinc-air batteries, rechargeable lithium ion polymer cells, primary lithium polymer cells, oxygen cells, micro fuel cells and gas hydrogen cells, the aforesaid cells, batteries and accumulators with the exception of cells, batteries and accumulators in a standard IEC size with a cell height over 25 mm or with a cell height over 11 mm, but not more than 25 mm, provided that the height-diameter ratio is greater than 1; battery energy storage systems, comprised of arrays of batteries
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Grounds for Opposition

Other	Breach of contract.
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Related Proceedings	TTAB Opposition Nos. 91197255; 91208212; and 91208732. TTAB Cancellation No. 92053247.
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Attachments	Notice of Opposition - SIGNED - December 12, 2013.pdf(170484 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	/Peter J. Lynfield/
Name	Peter J. Lynfield
Date	12/13/2013

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

In the Matter of Serial No. 79/122,927
Filed October 26, 2012

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Johnson Controls Technology Company	:	
	:	
and	:	
	:	
Johnson Controls Hybrid and Recycling GmbH	:	
	:	
Opposers,	:	Opposition No.
	:	
v.	:	
	:	
VARTA Microbattery GmbH	:	
	:	
Applicant.	:	
	:	
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NOTICE OF OPPOSITION

Johnson Controls Technology Company, (“JCTC”), a corporation organized and existing under the laws of the state of Michigan, with an office at 915 East 32nd Street, Holland, MI 49423, and JCTC’s related corporation, Johnson Controls Hybrid and Recycling GmbH (“Johnson Hybrid”), a corporation organized under the laws of the Federal Republic of Germany with an office at Am Leineufer 51, 30419 Hannover, Germany (hereinafter JCTC and Johnson Hybrid collectively “Opposers” and “JCI”) believe that they will be damaged by the registration of U.S. Trademark Application Serial No. 79/122,927 (“Trademark Application”) for the Varta Triangle Design Mark and hereby oppose registration.

1. Upon information and belief, Applicant VARTA Microbattery GmbH (hereinafter “Varta Micro” and “Applicant”) is a corporation organized under the laws of the

Federal Republic of Germany with an office at Am Leineufer 51 30419 Hannover,
Federal Republic of Germany.

2. Applicant's Trademark Application for the Varta Triangle Design Mark (hereinafter "VARTA Mark") was filed on October 26, 2012 under the Madrid Protocol pursuant to Section 66(a) of The Lanham Act and based on International Registration No. 1142204.
3. The Trademark Application was published in the Official Gazette on August 6, 2013 for goods described as follows:

International Class 9:

"Batteries, namely, primary and rechargeable lithium ion cells, lithium polymer cells, primary and rechargeable lithium batteries, lithium accumulators, lithium round cells of bobbin construction, zinc-air batteries, rechargeable lithium ion polymer cells, primary lithium polymer cells, oxygen cells, micro fuel cells and gas hydrogen cells, the aforesaid cells, batteries and accumulators with the exception of cells, batteries and accumulators in a standard IEC size with a cell height over 25 mm or with a cell height over 11 mm, but not more than 25 mm, provided that the height-diameter ratio is greater than 1; battery energy storage systems, comprised of arrays of batteries".

4. Prior to Applicant filing the Trademark Application, Applicant Varta Micro entered into an agreement entitled "Trademark and Domain Name Protection and Delimitation Agreement" ("TPDA") with Varta Aktiengesellschaft (hereinafter as "Varta AG"), the owner of the VARTA Mark globally including the United States and with Opposers and their affiliates, as well as other companies concerning inter alia the ownership and use of the VARTA Mark worldwide including the United States. In particular, the TPDA, split among several companies, including the Opposers, the ownership and registration of the VARTA Mark for goods and services related inter alia to specific types of batteries for the entire world including the United States.
5. The TPDA limits Applicant's ownership, use and registration of the VARTA Mark to goods and services for "microbatteries" and prohibits the Applicant from using and

registering the VARTA Mark for goods and services for batteries in general or other specific types of batteries that are not “microbatteries” as defined by the TPDA.

6. The Applicant’s description of goods in International Class 9 as stated above exceeds the grant set forth in the TPDA, and therefore, constitutes a breach of the TPDA.
7. Opposers are also parties to the TPDA and have been assigned the rights to the VARTA Mark for inter alia automotive batteries and automotive parts and related goods and services as well as industrial batteries.
8. Applicant’s Trademark Application for the VARTA Mark for batteries that exceed the grant in the TPDA will cause damage to Opposers.
9. Since Applicant does not have the right to register the VARTA Mark for such batteries, the Applicant is not the rightful owner of the mark as required by 37 C.F.R. §2.33(e)(3) and 37 C.F.R. §2.33(e)(4); therefore, Applicant’s Mark should be denied registration.

WHEREFORE, the Opposers respectfully request that Trademark Application Serial No. 79/122,927 for the VARTA MARK be denied registration and that this opposition be sustained.

Date: December 12, 2013

Respectfully Submitted,



Peter J. Lynfield, Esq.

Ned Branthover, Esq.

Caridad Scordato, Esq.

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Attorneys for Opposers

Johnson Controls Technology Company

***Johnson Controls Hybrid and Recycling
GmbH***

CERTIFICATE OF SERVICE

I hereby certify that this 3rd day of December, 2013, I electronically filed the foregoing with the United States Patent and Trademark Office before the Trademark Trial and Appeal Board by using the ESTTA system and a copy of the foregoing was sent via first class mail in an addressed postage paid envelope to the following:

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Ned W. Branthover