

TTAB

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

In the Matter of Application Serial No. 76-360987
Published in the Official Gazette on December 10, 2002

Scorpion Fasteners, Inc.
f/k/a Fasteners Specialties, Inc.

and

The Black & Decker Corporation,

Opposers,

v.

Comet Umetni Brusi In Nekovine, D.D.,

Applicant.


04-09-2003
U.S. Patent & TMO/TM Mail Rcpt. Dt. #40

Opposition No.:

Box TTAB FEE
Honorable Commissioner of Trademarks
2900 Crystal Drive
Arlington, VA 22202-3513

NOTICE OF OPPOSITION

Scorpion Fasteners, Inc., formerly Fasteners Specialties, Inc. ("Scorpion Fasteners"), a corporation organized and existing under the laws of the state of Connecticut, with an office located at 44 Commerce Way, South Windsor, CT 06074, and The Black & Decker Corporation ("Black & Decker"), a Maryland corporation, with a place of business at 701 E. Joppa Road, Towson, Maryland 21286, believe that they will be damaged by the registration of the mark SKORPIO shown in Application Serial No. 76360987 filed by Comet Umetni Brusi In Nekovine, D.D. ("Applicant") for use in connection with "parts of machines, namely, power-

operated grinding wheels," and "hand tools, namely, grinding discs," and having previously requested extensions of time up to and including April 9, 2003 to oppose said application, hereby oppose the same.

As grounds for the opposition, it is alleged that:

1. Scorpion Fasteners manufactures and sells a full line of screws, rivets, nails, staples, clips, anchors and other fasteners.

2. Since long prior to February 24, 2000, Applicant's claimed date of first use, Scorpion Fasteners has continuously used Scorpion, alone and as part of Scorpion Fasteners, as its name and principal corporate identification for and in connection with its business of manufacturing and selling fasteners. Scorpion Fasteners has long been and is identified and recognized by the trade and public by the name Scorpion, as well as by its full corporate name.

3. Since long prior to the date of first use claimed by the Applicant, Scorpion Fasteners has extensively advertised and promoted its name Scorpion in connection with its business and has achieved significant sales of fasteners sold in connection with the Scorpion name. By virtue of such advertising, promotion and sales, the Scorpion name has become and is a well-known name to the trade and the public.

4. Scorpion Fasteners has conspicuously used the SCORPION trademark upon and in connection with screws, rivets, nails, staples, clips, anchors and other fasteners long before the Applicant's claimed date of first use. Said goods have been extensively advertised and promoted under the SCORPION mark and said goods so marked and identified have been widely distributed and sold in interstate commerce throughout the United States.

5. Opposer, Black & Decker, is a global manufacturer and marketer of a wide-variety of products for home, commercial and industrial use, including power tools and accessories.

6. Scorpion Fasteners has licensed to Black & Decker the exclusive right to use the SCORPION mark for power and hand tool products, including screwdriver bits, in the United States.

7. Since long prior to Applicant's claimed date of first use, Black & Decker has continuously used the trademark SCORPION for power and hand tool products, including screwdriver bits.

8. Black & Decker has conspicuously used the SCORPION trademark for its power and hand tool products, including screwdriver bits, long before the Applicant's claimed date of first use. Said goods have been extensively advertised and promoted under the SCORPION mark, and said goods so marked and identified have been widely distributed and sold in interstate commerce throughout the United States.

9. By virtue of the long, continued and widespread sale of said goods identified by the trademark SCORPION and the advertising and promotion and quality of said goods, the trademark SCORPION is presently and, since long before the Applicant's claimed date of first use, have been relied upon by the trade and the public as identifying the products of Scorpion Fasteners and its exclusive licensee Black & Decker, and as distinguishing such products from the products of others. The trademark SCORPION has come to represent an extremely valuable goodwill belonging exclusively to Scorpion Fasteners.

10. Scorpion Fasteners' SCORPION trademark has long been registered in the United States Patent and Trademark Office as follows:

- SCORPION and Design, dated April 4, 1989, Reg. No. 1,532,652, for "metal fasteners, namely screws, rivets, nails, staples, and clips."
- SCORPION, dated October 30, 1990, Reg. No. 1,619,431, for "power driven tools for use with fasteners, and accessories, namely screwdriver bits, drill bits, bit holders and lag drivers" and "hand driven tools for use with fasteners, and accessories, namely, screwdriver bits, drill bits, and bit holders."
- SCORPION and Design, dated December 30, 1997, Reg. No. 2,125,537, for "power driven tools for use with fasteners, namely, screwdriver bits, nutdrivers, and screwdriver bit extensions" and "hand driven tools for use with fasteners, namely, screwdriver bits, nutdrivers, and screwdriver bit extensions."
- SCORPION and Design, dated December 30, 1997, Reg. No. 2,125,538, for "power driven tools for use with fasteners, namely, screwdriver bits, nutdrivers, and screwdriver bit extensions" and "hand driven tools for use with fasteners, namely, screwdriver bits, nutdrivers, and screwdriver bit extensions."

Said registrations are valid and subsisting, unrevoked and uncancelled, and Scorpion Fasteners is still the owner of the registrations and the marks shown therein and of all the business and goodwill connected therewith.

11. By the application herein opposed, Applicant seeks to register the designation SKORPIO for "parts of machines, namely, power-operated grinding wheels," and "hand tools, namely, grinding discs."

12. Applicant's designation SKORPIO so nearly resembles the SCORPION name and trademark that it is likely, when applied to the goods of Applicant, to cause confusion, mistake or deception as to the source, origin or sponsorship of Applicant's goods, with consequent injury to Scorpion Fasteners and its licensee Black & Decker and to the trade and public, in violation of Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d).

13. Scorpion Fasteners and Black & Decker will be damaged by the registration sought by Applicant because such registration will support and assist Applicant in the confusing and misleading use of the mark sought to be registered, and will give color of exclusive statutory rights in Applicant in violation and derogation of the prior and superior rights of Scorpion Fasteners and its exclusive licensee Black & Decker.

WHEREFORE, Scorpion Fasteners and Black & Decker believe that it will be damaged by the registration of Applicant's mark and prays that Application Serial No. 76/360,987 be denied.

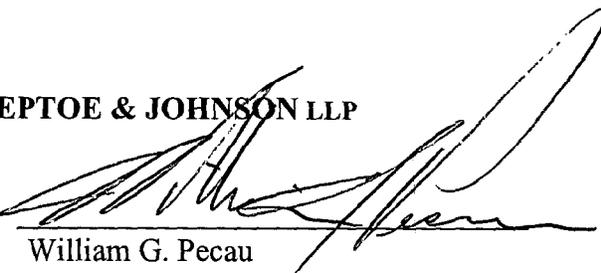
Please recognize as attorneys for Scorpion Fasteners and Black & Decker in this proceeding, William G. Pecau (a member of the bars of the states of New York and California and the District of Columbia) and Marc A. Paul (a member of the bars of the state of Pennsylvania and the District of Columbia) whose address is Steptoe & Johnson LLP, 1330 Connecticut Avenue, N.W., Washington, DC 20036. Please address all communications to William G. Pecau, Esq. at the above address.

Enclosed please find a check for \$600.00 (\$300.00 per class) to cover the required fee for this Notice of Opposition. If any additional fees are due in connection with this filing, please debit our Deposit Account No. 19-4293 and provide us with a receipt.

This Notice of Opposition is submitted in duplicate pursuant to 37 C.F.R. § 2.104(a).

Respectfully submitted,

STEPTOE & JOHNSON LLP

By: 

William G. Pecau

Marc A. Paul

Steptoe & Johnson LLP

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(202) 429-6244

*Attorneys for Opposers Scorpion Fasteners,
Inc. and The Black & Decker Corporation*

Dated: April 9, 2003

STEPTOE & JOHNSON LLP

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04-09-2003

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April 9, 2003

BY HAND DELIVERY

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Arlington, VA 22202-3513

**RE: Scorpion Fasteners, Inc. f/k/a Fasteners Specialties, Inc. and The Black & Decker Corporation, Opposers, v. Comet Umetni Brusi In Nekovine, D.D., Applicant.
Serial No. 76/360,987
Our Ref.: 14470.0003**

Dear Sir:

On behalf of The Black & Decker Corporation, opposer in the above-referenced matter, please find for filing the Notice of Opposition. This Notice of Opposition is submitted in duplicate pursuant to 37 C.F.R. § 2.104(a).

A check in the amount of \$600.00 is enclosed to cover the required fee:
2 x \$300.00 = \$600.00 (Notice of Opposition for 2 classes)

If any additional fees are due in connection with this filing, please debit our Deposit Account No. 19-4293 and provide us with a receipt.

Also enclosed is one additional copy of the Notice of Opposition to be date-stamped and returned via messenger. If you have any questions, please do not hesitate to contact me.

Sincerely,



William G. Pecau
Marc A. Paul

WGP/MAP/dmh

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TRADEMARK OFFICE

