

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

In the Matter of Application Serial No. 76/392,801  
Published in the Official Gazette on February 25, 2003

The Black & Decker Corporation,  
  
Opposer,  
  
v.  
  
Dewert Antriebs-und Systemtechnik  
GMBH & Co. KG,  
  
Applicant.

Opposition No.: \_\_\_\_\_



04-22-2003

U.S. Patent & TMO/TM Mail RcptDt. #11

US PATENT &  
TRADEMARK OFFICE

2003 APR 22 P 4: 23

TRADEMARK FEE PROCESS  
RECEIVED

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

**NOTICE OF OPPOSITION**

The Black & Decker Corporation, a Maryland corporation, with a place of business at 701 E. Joppa Road, Towson, Maryland 21286, believes that it is and will be damaged by the registration of the mark DEWERT shown in Application Serial No. 76392801 filed by Dewert Antriebs-und Systemtechnik GMBH & Co. KG ("Applicant"), and having previously requested an extension of time up to and including April 26, 2003 to oppose said application, hereby opposes the same.

As grounds for the opposition, it is alleged that:

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

2. For over 75 years and since long prior to April 8, 2002, Applicant's trademark application filing date, Opposer and its predecessors have continuously used DEWALT as a name and principal corporate identification for and in connection with its business of manufacturing, marketing and selling high performance power operated tools and machines, accessories therefor, and parts therefor and the service thereof. Opposer's DEWALT business includes and has included since long prior to the Applicant's trademark application filing date, the sale of electric power tools and the electric motors, electric driving mechanisms, electric and electronic controllers, electrical transformers, electromechanical control devices for electrical motors and electric driving mechanisms used for such power tools and the service of such tools. This business of opposer and its predecessors has long been and is identified and recognized by the trade and public by the name DEWALT.

3. Since long prior to Applicant's filing date, Opposer has extensively advertised and promoted its name DEWALT in connection with its business and has achieved significant sales of power operated tools and accessories, and the electric motors, electric driving mechanisms electric and electronic controllers, electrical transformers, electromechanical control devices for electrical motors, and electric driving mechanisms used for such power tools and the service of such tools. By virtue of such advertising, promotion and sales, the DEWALT name has become and is a famous and well-known name to the trade and the public.

4. Since at least as early as 1923, and long prior to Applicant's filing date, a predecessor of Opposer adopted and commenced to use the designation DEWALT as a

trademark for power operated tools and machines. Since that date, Opposer and its predecessors have continuously used the DEWALT mark for said goods and have expanded the goods and services for which the mark DEWALT is used to include a wide variety of other high performance power tools and accessories and the electric motors, electric driving mechanism, electric and electronic controllers, electrical transformers, electromechanical control devices for electrical motors and electric driving mechanisms used for such power tools and the service of such tools.

5. Black & Decker has conspicuously used the DEWALT trademark for such goods and services long before the Applicant's filing date. Said goods and services have been extensively advertised and promoted under the DEWALT mark, and said goods and services so marked and identified have been widely offered and sold in interstate commerce throughout the United States.

6. By virtue of the long, continued and widespread advertising, promotion and sale of said goods and services identified by the trademark DEWALT, as well as the high quality of said goods and services, the trademark DEWALT is presently and, since long before the Applicant's filing date, has been relied upon by the trade and the public as identifying the products and services of Opposer, and as distinguishing such products and services from the products and services of others. The trademark DEWALT has come to represent an extremely valuable goodwill belonging exclusively to Opposer.

7. Opposer's trademark DEWALT is a famous and distinctive trademark.

8. Opposer is the owner in the United States Patent and Trademark Office of the following registrations for the mark DEWALT:

MARK	REG. NO.	REG. DATE	GOODS
<b>DEWALT and Design</b>	2658744	12/10/2002	clothing, namely, gloves, hats, jackets, shirts, sweatshirts, t-shirts and caps (International Class 25); safety eye glasses (International Class 09); wristwatches and clocks (International Class 14); insulated cup holders; portable coolers; coffee cups; sports bottles; insulated travel mugs (International Class 21); bumper stickers; pens; pencils; hard hat stickers; pencil clips (International Class 16); balls for games, namely, golf balls and footballs (International Class 28); counter stools and nonmetal key rings and key tags (International Class 20); umbrellas; sports bags; brief cases (International Class 18)
<b>DEWALT</b>	2656133	12/03/02	safety eye glasses (International Class 09); wristwatches and clocks (International Class 14); bumper stickers; pens; pencils; hard hat stickers; pencil clips (International Class 16); insulated cup holders; portable coolers; coffee cups; sports bottles; insulated travel mugs (International Class 21); clothing, namely, gloves, hats, jackets, shirts, sweatshirts, t-shirts and caps (International Class 25); umbrellas; sports bags; brief cases (International Class 18); balls for games, namely, golf balls and footballs (International Class 28); counter stools and nonmetal key rings and key tags (International Class 20)
<b>DEWALT</b>	2605311	11/17/99	air compressors (International Class 07)
<b>DEWALT ROLLING THUNDER</b>	2171586	10/30/95	power tools, namely, drills, drill/drivers, screwdrivers, impact wrenches, saws, impact drivers, hammerdrills, routers, grinders, polishers, sanders, hammerdrill/drivers, screwdriver/drills (International Class 07)

MARK	REG. NO.	REG. DATE	GOODS
<b>DEWALT and Design</b>	1734404	11/24/92	power operated tools and machines, namely, drills, drill presses and hammer drills; impact wrenches; planers; routers; sanders; and saws, namely, chop saws, circular saws, miter saws, reciprocating saws and table saws; bits, namely, drill bits, router bits, and screwdriver bits; drill chucks; drill chuck keys; hole cutter; hole saw mandrels; saw blades; and wheels, namely, abrasive wheels, grinding wheels, and wire wheels; and parts therefor (International Class 07); battery packs and battery chargers (International Class 09)
<b>DEWALT (stylized)</b>	1734403	11/24/92	power operated tools and machines, namely, drills, drill presses, and hammer drills; impact wrenches; planers; routers; sanders; shapers; and saws, namely, chop saws, circular saws, miter saws, panel saws, radial arm saws, reciprocating saws, and table saws; bits; namely, drill bits, router bits, and screwdriver bits; drill chucks; drill chuck keys; hole cutter; hole saw mandrels; saw blades; and wheels, namely, abrasive wheels, grinding wheels, and wire wheels; and parts therefor (International Class 07); battery packs and battery chargers (International Class 09)
<b>DEWALT and Design</b>	1950781	1/23/96	toy vehicles (International Class 28)
<b>DEWALT and Design</b>	1328005	4/2/85	power operated machines, namely, table saws, miter saws, saw blades and parts therefor (International Class 07)
<b>DEWALT (stylized)</b>	0621152	2/14/56	power saws and woodworking machines, and parts thereof and attachments therefor (International Class 07)

Said registrations are valid and subsisting, unrevoked and uncancelled, and Opposer is still the owner of the registrations and the marks shown therein and of all the business and goodwill connected therewith. Opposer exclusive right to use the DEWALT mark is incontestable.

9. Applicant filed on April 8, 2002 an intent-to-use application in the United States Patent and Trademark Office to register the designation DEWERT as a trademark for "electric motors and electric driving mechanisms comprising electric motors and mechanical gears namely control rods for controlling all types of devices" and "electric and electronic controllers, electrical transformers, electromechanical control devices for electrical motors and electric driving mechanisms," under Application No. 76392801.

10. The parties' DEWALT and DEWERT marks are closely similar in sound, appearance and commercial impression.

11. Opposer uses its DEWALT mark for the same kinds of goods as described in Applicant's application, namely; electric motors and electric driving mechanisms electric and electronic controllers, electrical transformers, electromechanical control devices for electrical motors and electric driving mechanisms. The parties' goods described in their respective applications and registrations both include power operated machines.

12. Applicant's mark DEWERT so nearly resembles Opposer's DEWALT mark, previously used and registered in the United States, and not abandoned, as to be likely, when applied to the goods of the Applicant, to cause confusion, to cause mistake, or to deceive with consequent injury to Opposer, the trade and the public, in violation of Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d).

13. The use or intended use by applicant of the DEWERT mark is likely to dilute the distinctive quality of Opposer's famous, registered DEWALT mark in violation of Sections 13(a) and 43(c) of the Trademark Act, 15 U.S.C. §§ 1063(a) and 1125(c).

14. Opposer will be damaged by the registration sought by Applicant because such registration will support and assist Applicant in the confusing, misleading, deceptive and diluting 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 Opposer.

WHEREFORE, Opposer believes that it will be damaged by the registration of Applicant's mark and prays that Application Serial No. 76392801 be denied pursuant to Sections 2(d), 13(a) and 43(c) of the Trademark Act of 1946, 15 U.S.C. §§ 1052(d), 1063(a), and 1125(c).

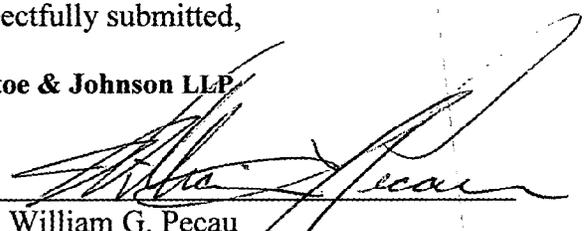
Please recognize as attorneys for The Black & Decker Corporation in this proceeding, William G. Pecau (a member of the bars of the states of New York and California, and the District of Columbia) and Marc A. Paul (a member of the bars of the state of Pennsylvania and the District of Columbia) whose address is Steptoe & Johnson LLP, 1330 Connecticut Avenue, NW, 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

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Washington, DC 20006

(202) 429-6244

*Attorneys for The Black & Decker Corporation*

Dated: April 22, 2003

**STEPTOE & JOHNSON LLP**

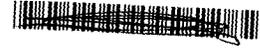
ATTORNEYS AT LAW

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TTAB



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April 22, 2003

**BY HAND DELIVERY**

Trademark Trial and Appeal Board  
United States Patent and Trademark Office  
2900 Crystal Drive  
Room 9B-40  
Arlington, VA 22202-3513

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U.S. PATENT &  
TRADEMARK OFFICE

**Re: Notice of Opposition against the mark DEWERT  
Serial No. 76/392,801  
Our Ref.: 14470.0022**

Dear Sir:

On behalf of The Black & Decker Corporation, please find for filing at the Trademark Trial and Appeal Board ("TTAB") an original and one copy of the Notice of Opposition against the trademark DEWERT, Serial No. 76/392,801, in International Classes 7 and 9. The opposition period is currently scheduled to end on April 26, 2003.

In addition, enclosed is 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.

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

Sincerely,

William G. Pecau  
Marc A. Paul

WGP/MAP/dmh

Enclosures

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