

ESTTA Tracking number: **ESTTA344321**

Filing date: **04/27/2010**

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	SCORPION PERFORMANCE, INC.
Granted to Date of previous extension	04/28/2010
Address	3000 SW 4TH AVENUE FT. LAUDERDALE, FL 33315 UNITED STATES
Attorney information	JAMES F. GOSSETT HOWE & HUTTON, LTD. 20 NORTH WACKER DRIVE, SUITE 4200 CHICAGO, IL 60606 UNITED STATES jfg@howehutton.com Phone:312-263-3001, ext. 229

Applicant Information

Application No	77793895	Publication date	12/29/2009
Opposition Filing Date	04/27/2010	Opposition Period Ends	04/28/2010
Applicant	Daystar Products International, Inc. 841 South 71st Ave. Phoenix, AZ 85043 UNITED STATES		

Goods/Services Affected by Opposition

Class 012. First Use: 2009/07/00 First Use In Commerce: 2009/07/00
All goods and services in the class are opposed, namely: Vehicle parts, namely, shock absorbers

Grounds for Opposition

False suggestion of a connection	Trademark Act section 2(a)
Priority and likelihood of confusion	Trademark Act section 2(d)
Dilution	Trademark Act section 43(c)

Marks Cited by Opposer as Basis for Opposition

U.S. Registration No.	3397455	Application Date	04/06/2007
Registration Date	03/18/2008	Foreign Priority Date	NONE
Word Mark	SCORPION PERFORMANCE		

Design Mark	SCORPION PERFORMANCE
Description of Mark	NONE
Goods/Services	Class 007. First use: First Use: 1999/12/17 First Use In Commerce: 1999/12/17 HIGH PERFORMANCE AUTOMOTIVE RACING ENGINE PARTS, NAMELY, ROCKER ARMS

U.S. Registration No.	3384305	Application Date	04/05/2007
Registration Date	02/19/2008	Foreign Priority Date	NONE
Word Mark	SCORPION PERFORMANCE		
Design Mark			
Description of Mark	The mark consists of A SCORPION ABOVE THE WORDS "SCORPION PERFORMANCE".		
Goods/Services	Class 007. First use: First Use: 1999/12/17 First Use In Commerce: 1999/12/17 HIGH PERFORMANCE AUTOMOTIVE RACING ENGINE PARTS, NAMELY, ROCKER ARMS		

Attachments	77150396#TMSN.jpeg (1 page)(bytes) 77149510#TMSN.jpeg (1 page)(bytes) Scorpion.pdf (10 pages)(179825 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	/james f. gossett/
Name	JAMES F. GOSSETT

Date	04/27/2010
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In re Trademark Application

Serial No. 77-793,895

Filed: July 30, 2009

Published in the Official Gazette
of December 29, 2009 at Page
TM 507

Mark: DAYSTAR SCORPION PERFORMANCE SHOCKS, plus
Design

Applicant: Daystar Products International, Inc.

Class: Int. 12

SCORPION PERFORMANCE, INC.
OPPOSER

v.

Opposition No. _____

DAYSTAR PRODUCTS
INTERNATIONAL, INC.
APPLICANT

NOTICE OF OPPOSITION

Scorpion Performance, Inc., a corporation organized and existing under the laws of the State of Florida, believes that it will be damaged by registration of the mark shown in Serial No. 77-793,895 in International Class 12 and hereby opposes the same.

As grounds of opposition, it is alleged that:

1. The Applicant seeks to register the mark DAYSTAR SCORPION PERFORMANCE SHOCKS, plus design, as a trademark for “vehicle parts, namely, shock absorbers” in International Class 12.

2. The Applicant is seeking registration through a filing under Section 1(a) of the Lanham Act, having a filing date of July 30, 2009, an alleged date of first use of 07-00-2009, and an alleged date of first use in commerce of 07-00-2009, as is evidenced by the publication of said mark in the Official Gazette in the December 29, 2009 issue at Page TM 507.

3. The Opposer is the owner of U.S. Trademark Registration No. 3,397,455 for the mark SCORPION PERFORMANCE on “high performance automotive racing engine parts, namely, rocker arms,” which was registered on the Principal Register on March 18, 2008. Said registration was based on an application filed in the U.S. Patent and Trademark Office April 6, 2007. Said registration is valid and subsisting and is prima facie evidence of the Opposer’s exclusive right to use said mark in commerce on the goods specified in that registration. A photocopy of said registration is attached hereto as Exhibit A.

4. The Opposer is the owner of U.S. Trademark Registration No. 3,384,305 for the mark SCORPION PERFORMANCE, plus design, on “high performance automotive racing engine parts, namely, rocker arms,” which was registered on the Principal Register on February 19, 2008. Said registration was based on an application filed in the U.S. Patent and Trademark Office April 5, 2007. Said registration is valid and subsisting and is prima facie evidence of the Opposer’s exclusive right to use said mark in commerce on the goods specified in that registration. A photocopy of said registration is attached hereto as Exhibit B.

5. The Opposer, since at least as early as December 17, 1999, and long prior to the Applicant’s first use of the mark for which it is seeking registration in U.S. Trademark

Application Serial No. 77-793,895, or the Applicant's filing date for U.S. Trademark Application Serial No. 77-793,895, has been using the mark SCORPION PERFORMANCE, registered as U.S. Trademark Registration No. 3,397,455, and the mark SCORPION PERFORMANCE, plus design, registered as U.S. Trademark Registration No. 3,384,305, in interstate commerce, on and in connection with the manufacture and sale of high performance automotive racing engine parts, namely, rocker arms. Said use has been valid and continuous since said date of first use and has not been abandoned. Said marks of the Opposer are symbolic of extensive good will and consumer recognition built up by the Opposer through substantial amounts of money, time and effort in advertising and promotion, and the relevant class of the public has come to associate the Opposer with such designations, and said marks have become famous as used by the Opposer in connection with the manufacture and sale of high performance automotive racing engine parts, namely, rocker arms.

6. The Applicant has not objected to or petitioned to cancel registration of the mark shown in U.S. Trademark Registration No. 3,397,455 or the mark shown in U.S. Trademark Registration No. 3,384,305.

7. In view of the similarity of the marks, and the nature of the goods, of the respective parties, it is alleged that the mark for which the Applicant is seeking registration so resembles the Opposer's marks previously used and registered in the United States, and not abandoned, as to be likely, when used on or in connection with the manufacturing and selling of vehicle parts, namely, shock absorbers, to cause confusion, or to cause mistake or to deceive, all to the injury or threatened injury of the Opposer.

8. If the Applicant is permitted to use and register its mark for its goods, as specified in the application herein opposed, persons familiar with the Opposer's marks would be likely to

believe the Applicant's goods are manufactured or sold by the Opposer, that the Applicant's products are endorsed by the Opposer, or that the Opposer and the Applicant are related entities, all to the injury or threatened injury of the Opposer. Furthermore, any defect, objection or fault found with the Applicant's products marketed under its mark would necessarily reflect upon and seriously injure the reputation which the Opposer has established for its products manufactured and sold under its marks.

9. If the Applicant is granted the registration herein opposed, it would thereby obtain at least a prima facie exclusive right to the use of its mark. Such registration would be a source of damage and injury to the Opposer.

10. The Applicant's mark sought to be registered dilutes the distinctive quality of the Opposer's famous marks as shown in U.S. Trademark Registration No. 3,397,455 and U.S. Trademark Registration No. 3,384,305, to the injury or threatened injury of the Opposer, in that such dilution could cause the Opposer to lose sales.

WHEREFORE, the Opposer prays that U.S. Trademark Application Serial No. 77-793,895 be rejected, and that the registration therein sought for the goods therein specified in International Class 12 be denied and refused.

Respectfully submitted,

HOWE & HUTTON, LTD.

By: James F. Gossett
James F. Gossett

20 North Wacker Drive, Suite 4200
Chicago, IL 60606
Telephone: (312) 263-3001
Facsimile: (312) 372-6685

EXHIBIT A

to

Notice of Opposition

In re U.S. Trademark Application Serial No. 77-793,895

Mark: DAYSTAR SCORPION PERFORMANCE SHOCKS, plus design

Applicant: Daystar Products International, Inc.

Int. Cl.: 7

Prior U.S. Cls.: 13, 19, 21, 23, 31, 34 and 35

United States Patent and Trademark Office

Reg. No. 3,397,455

Registered Mar. 18, 2008

TRADEMARK
PRINCIPAL REGISTER

SCORPION PERFORMANCE

SCORPION PERFORMANCE, INC. (FLORIDA
CORPORATION)
3000 SW 4TH AVENUE
FORT LAUDERDALE, FL 33315

FOR: HIGH PERFORMANCE AUTOMOTIVE RA-
CING ENGINE PARTS, NAMELY, ROCKER ARMS,
IN CLASS 7 (U.S. CLS. 13, 19, 21, 23, 31, 34 AND 35).

FIRST USE 12-17-1999; IN COMMERCE 12-17-1999.

THE MARK CONSISTS OF STANDARD CHAR-
ACTERS WITHOUT CLAIM TO ANY PARTICULAR
FONT, STYLE, SIZE, OR COLOR.

NO CLAIM IS MADE TO THE EXCLUSIVE
RIGHT TO USE PERFORMANCE, APART FROM
THE MARK AS SHOWN.

SER. NO. 77-150,396, FILED 4-6-2007.

DANIEL CAPSHAW, EXAMINING ATTORNEY

EXHIBIT B

to

Notice of Opposition

In re U.S. Trademark Application Serial No. 77-793,895

Mark: DAYSTAR SCORPION PERFORMANCE SHOCKS, plus design

Applicant: Daystar Products International, Inc.

Int. Cl.: 7

Prior U.S. Cls.: 13, 19, 21, 23, 31, 34 and 35

United States Patent and Trademark Office

Reg. No. 3,384,305

Registered Feb. 19, 2008

**TRADEMARK
PRINCIPAL REGISTER**



SCORPION PERFORMANCE, INC. (FLORIDA CORPORATION)

3000 SW 4TH AVENUE

FORT LAUDERDALE, FL 33315

FOR: HIGH PERFORMANCE AUTOMOTIVE RACING ENGINE PARTS, NAMELY, ROCKER ARMS, IN CLASS 7 (U.S. CLS. 13, 19, 21, 23, 31, 34 AND 35).

FIRST USE 12-17-1999; IN COMMERCE 12-17-1999.

NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE PERFORMANCE, APART FROM THE MARK AS SHOWN.

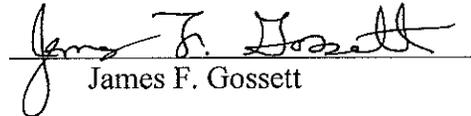
THE MARK CONSISTS OF A SCORPION ABOVE THE WORDS "SCORPION PERFORMANCE".

SER. NO. 77-149,510, FILED 4-5-2007.

DANIEL CAPSHAW, EXAMINING ATTORNEY

CERTIFICATE OF SERVICE

I hereby certify that a true copy of the foregoing NOTICE OF OPPOSITION has been served upon the Applicant's attorney of record, David A. Lowe, Esq., Black, Lowe & Graham, 701 5th Avenue, Suite 4800, Seattle, WA 98104-7009, via first class mail, postage prepaid, by depositing same in the U.S. mail on APRIL 27, 2010 before the hour of 5:00 p.m.


James F. Gossett