

ESTTA Tracking number: **ESTTA674593**

Filing date: **05/27/2015**

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	Security Equipment Corporation		
Entity	Corporation	Citizenship	Missouri
Address	747 Sun Park Drive Fenton, MO 63026 UNITED STATES		

Attorney information	Glenn K. Robbins II Spencer Fane Britt & Browne LLP 1 North Brentwood Boulevard Suite 1000 St. Louis, MO 63105 UNITED STATES sfbbaction@spencerfane.com Phone:314-863-7733		
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### Applicant Information

Application No	85907083	Publication date	04/28/2015
Opposition Filing Date	05/27/2015	Opposition Period Ends	05/28/2015
Applicant	Howell, Paul 4080 Burns Road Palm Beach Gardens, FL 33410 UNITED STATES		

### Goods/Services Affected by Opposition

Class 013. First Use: 2001/06/12 First Use In Commerce: 2001/06/26 All goods and services in the class are opposed, namely: Pepper spray and expressly excluding stun guns
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### Grounds for Opposition

Priority and likelihood of confusion	Trademark Act section 2(d)
The mark is merely descriptive	Trademark Act section 2(e)(1)
<i>Torres v. Cantine Torresella S.r.l.Fraud</i>	808 F.2d 46, 1 USPQ2d 1483 (Fed. Cir. 1986)

### Mark Cited by Opposer as Basis for Opposition

U.S. Application/ Registration No.	NONE	Application Date	NONE
Registration Date	NONE		
Word Mark	POLICE MAGNUM		
Goods/Services	Pepper spray		

Attachments	Notice of Opposition_85907083.pdf(221510 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	/glenn k. robbins ii/
Name	Glenn K. Robbins II
Date	05/27/2015

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

SECURITY EQUIPMENT CORPORATION	)	
	)	Opposition No.
Opposer,	)	
	)	Mark POLICE MAGNUM
	)	
vs.	)	
	)	
PAUL HOWELL	)	Serial No. 85/907,083
	)	
Applicant.	)	

**NOTICE OF OPPOSITION**

Security Equipment Corporation (“Opposer”), a Missouri corporation having a place of business at 747 Sun Park Drive, Fenton, Missouri 63026, believes that it would be damaged by the registration of the mark POLICE MAGNUM (“Applicant’s Mark”), shown in U.S. Trademark Application Serial No. 85/907,083 to Paul Howell (“Applicant”) and hereby opposes same.

Opposer alleges upon personal knowledge for its own acts and upon information and belief with respect to all other matters, as follows:

1. Application Serial No. 85/907,083 (hereinafter the "Opposed Application") seeks registration of the mark POLICE MAGNUM for goods described as “Pepper spray and expressly excluding stun guns” (Class 13).
2. The Opposed Application was filed on April 17, 2013 by Applicant alleging a use in commerce of the mark on June 26, 2001.

**COUNT I – LIKELIHOOD OF CONFUSION**

3. Opposer adopted and used the designation POLICE MAGNUM for pepper spray goods long prior to the April 17, 2013 filing date of the Opposed Application, and is still using to this date the designation POLICE MAGNUM for pepper spray goods.

4. By virtue of the prior and continuous advertising and sales of Opposer's goods under the designation POLICE MAGNUM, and the maintenance of high quality standards thereto, purchasers of such goods have come to recognize the designation POLICE MAGNUM as an indication of origin, as a consequence of which Opposer has established goodwill in the POLICE MAGNUM designation.

5. The pepper spray goods sold by Opposer, and the goods described in the Opposed Application are identical.

6. Therefore, purchasers, prospective purchasers and others are likely to be confused, mistaken or deceived into the belief, contrary to fact, that Applicant's described goods under the mark POLICE MAGNUM emanate from and/or are in some way sponsored, or approved by Opposer and/or that Applicant is somehow affiliated with Opposer, thereby damaging Opposer.

7. The grant of a certificate of registration to Applicant for the mark POLICE MAGNUM will seriously damage and injure Opposer because such registration would give Applicant a prima facie right to the use of the mark, despite the likelihood of confusion, mistake or deception as to the source of goods sold by Applicant as described in the paragraphs above.

#### **COUNT II – THE MARK POLICE MAGNUM IS MERELY DESCRIPTIVE**

8. In the alternative, the term POLICE MAGNUM is merely descriptive with respect to the goods and therefore unregistrable under 15 U.S.C. §1052(e)(1).

9. The term POLICE MAGNUM was required to be disclaimed in the Opposed Application as being merely descriptive of a characteristic or intended user of Applicant's goods. The Examiner cited evidence showing that:

the pepper spray industry regularly uses the terms "POLICE" and "MAGNUM", and often even the phrase "POLICE MAGNUM", to refer to a particular size of pepper spray canister, namely, a large

canister that is appropriate for law enforcement use. ... This ... illustrates that the industry uses these terms descriptively to refer to the strength of the pepper spray and/or the size of the pepper spray canister.

Office Action dated July 22, 2013.

10. Opposer's own POLICE MAGNUM product was cited by the Examiner as evidence of the use by others of the term POLICE MAGNUM in support of the characterization that the term POLICE MAGNUM was descriptive.

11. Opposer believes it would be damaged if Applicant's mark was registered because it may affect Opposer's ability to use its own POLICE MAGNUM designation to refer to its pepper spray products.

### **COUNT III – FRAUD IN THE APPLICATION**

12. Applicant traversed the requirement that the term POLICE MAGNUM be disclaimed in the Opposed Application by arguing that its POLICE MAGNUM mark had become distinctive of its goods.

13. In support of his argument of distinctiveness, Applicant provided his sworn declaration stating that his mark POLICE MAGNUM had become distinctive through “substantially exclusive and continuous use in commerce for at least the five years, (in fact for twelve years), immediately before the date of this statement.”

14. As a result of Applicant's sworn declaration that his POLICE MAGNUM mark had become distinctive through the “substantially exclusive and continuous use”, the requirement that the term POLICE MAGNUM be disclaimed was withdrawn by the Examiner.

15. Upon information and belief, Applicant knew that others were making use of the term POLICE MAGNUM in connection with pepper spray during the period claimed in his sworn declaration as being substantially exclusive to his use of the POLICE MAGNUM mark.

16. Upon information and belief, Applicant was specifically aware that Opposer was using the term POLICE MAGNUM in connection with its pepper spray products and had been for many years.

17. Upon information and belief, Applicant knew that Opposer was an industry leader in the sales of pepper spray goods, and that Opposer used the term POLICE MAGNUM on a major line of its pepper spray goods.

18. Attached as Exhibit A is a copy of an e-mail exchange in April 2013 between Applicant and Robert Nance, vice-president of operations with Opposer (“the E-Mail Exchange”).

19. In Robert Nance’s April 25, 2013 e-mail, he advised Applicant of Opposer’s long use of the term POLICE MAGNUM in connection with pepper spray.

20. In Applicant’s April 26, 2013 reply, he stated he was willing to enter into a co-existence agreement with Opposer.

21. Upon information and belief, the E-Mail Exchange makes clear that Applicant knew and understood, at least as early of the Opposer’s April 25, 2013 e-mail, that Opposer had made substantial use of the term POLICE MAGNUM in connection with its pepper spray products, and that Applicant could not have been a substantially exclusive user of the POLICE MAGNUM mark during the stated period in his sworn declaration made on January 17, 2014 in support of acquired distinctiveness of the POLICE MAGNUM mark.

22. Upon information and belief, Applicant filed false statements in his sworn declaration during the prosecution of the Opposed Application that his use of the POLICE MAGNUM mark was substantially exclusive with the intent to mislead the Examiner on the

issue of whether Applicant's mark had acquired distinctiveness whereby the requirement that the term POLICE MAGNUM be disclaimed would be withdrawn.

WHEREFORE, Opposer believes that the present opposition should be sustained and the registration of Applicant's mark refused.

Respectfully submitted,

SPENCER FANE BRITT & BROWNE LLP

By 

Glenn K. Robbins II  
One North Brentwood Blvd., Suite 1000  
St. Louis, Missouri 63105  
Telephone: (314) 863-7733  
Facsimile: (314) 862-4656

Attorneys for Opposer  
Security Equipment Corporation

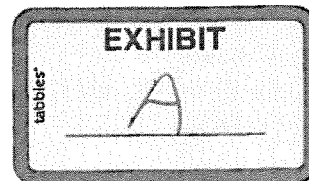
#### CERTIFICATE OF SERVICE

A copy of the foregoing was mailed, via first-class mail, postage prepaid, this 27<sup>TH</sup> day of May, 2015, to the following:

Carl J. Spagnuolo  
McHale & Slavin, P.A.  
2588 PGA Blvd.  
Palm Beach Gardens, Florida 33410-2910

Attorney for Applicant





**From:** paul@advanctec.com  
**Sent:** Friday, April 26, 2013 5:58 PM  
**To:** Robert Nance  
**Subject:** RE: Police Magnum

Bobby,

I spoke with my trademark attorney as well on this MAGNUM issue. To further assure you that we mean no ill intent toward you, I am willing to enter into a co-existence agreement with you that states that we can both go our separate ways and we will not interfere with each other. If you would like that extra assurance, I will have a brief agreement drafted.

I may not be on your guys favorite list but in keeping with the pattern I have always demonstrated, I try to get along with you guys and prefer to work with cooperation being in the same industry. I think this thing my lawyer mentioned should accomplish that if I am being honest with you and have no hidden agenda and the same with regards to you. When we spoke on the phone I did come away with the feeling you had been honest with me and had no hidden agenda either so I feel confident this will work for me and accomplish my needs and solve the worry you have at the same time. Let me know, Thanks, paul

----- Original Message -----

Subject: Police Magnum  
From: "Bob Nance" <[rnance@sabrered.com](mailto:rnance@sabrered.com)>  
Date: Thu, April 25, 2013 4:59 pm  
To: <[paul@advanctec.com](mailto:paul@advanctec.com)>  
Cc: <[dnance@sabrered.com](mailto:dnance@sabrered.com)>

Hello Paul,

The "Police Magnum" trademark application does not request a trademark on your Police Magnum design. Rather it is a general application for use of the words "Police Magnum". As I have indicated, we have used that terminology since our business was founded in the 1970's. We have printed catalogs and price lists that use the term "Police Magnum" from the early 1990's which is well before your stated first use. Since we still use the term "Police Magnum" for our products, we must deny the trademark application.

Additionally, we are concerned with the advertisement of your Police Magnum product as a 17% OC spray. I know you mentioned that the packaging does not say 17%, but as the link below shows, it is being advertised as 17% OC. This is false and misleading information. You have stated that you want to clean up the industry and state factual information, however, this does not seem to be the reality. Therefore, we must move to prevent you from obtaining a trademark on the "Police Magnum" name.

[http://www.amazon.com/Police-Magnum-Pepper-0-5-Ounce-Keyring/dp/B002B3WOW6/ref=sr\\_1\\_3?ie=UTF8&qid=1366904323&sr=8-3&keywords=pepper+spray](http://www.amazon.com/Police-Magnum-Pepper-0-5-Ounce-Keyring/dp/B002B3WOW6/ref=sr_1_3?ie=UTF8&qid=1366904323&sr=8-3&keywords=pepper+spray)

5/27/2015



## **Police Magnum O C 17% Pepper Spray with UV Dye and Twist Top, 0.5-Ounce Keyring**

- Pack of Two 0.5-Ounce Keyring Style OC
- 17-Percent OC Oleoresin Capsicum Solution, Non-Toxic, Non-Flammable
- Safety Top to Reduce Accidental Discharge
- UltraViolet UV Identifying Dye for Subject Identification
- Made in the USA

Thanks.

### **Robert Nance**

V.P. of Operations

### **SECURITY EQUIPMENT CORPORATION**

747 Sun Park Drive

Fenton, MO 63026 U.S.A.

1-636-343-0200 • 1-800-325-9568

Fax: 1-636-343-1318

[Rnance@sabrered.com](mailto:Rnance@sabrered.com)

[www.sabrered.com](http://www.sabrered.com)

ISO 9001:2008 Certified

