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

Proceeding	91222111
Party	Plaintiff Security Equipment Corporation
Correspondence Address	GLENN K ROBBINS II SPENCER FANE BRITT & BROWNE LLP 1 NORTH BRENTWOOD BOULEVARD, SUITE 1000 ST LOUIS, MO 63105 UNITED STATES sfbbaction@spencerfane.com
Submission	Motion to Amend Pleading/Amended Pleading
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Date	08/17/2015
Attachments	Amended Notice of Opposition - 91222111.pdf(302392 bytes)

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

SECURITY EQUIPMENT CORPORATION))	
)	Opposition No. 91222111
Opposer,)	
)	Mark POLICE MAGNUM
)	
vs.)	
)	
PAUL HOWELL)	Serial No. 85/907,083
)	
Applicant.)	

CONSENTED MOTION TO AMEND NOTICE OF OPPOSITION

Security Equipment Corporation (“Opposer”) respectfully states as follows for its Motion to Amend its Notice of Opposition:

1. The Notice of Opposition initially filed in this proceeding asserted Opposer’s long use of the designation POLICE MAGNUM on its pepper spray products.
2. In the interest of justice, Opposer wishes to clarify the basis for its opposition on the grounds of likelihood of confusion.
3. Specifically, Opposer’s use of the designation POLICE MAGNUM has acquired distinctiveness, whereby Opposer has gained valuable trademark rights in the term POLICE MAGNUM in connection with Opposer’s goods.
4. Accordingly, Opposer respectfully requests leave to amend its Notice of Opposition to affirmatively state Opposer’s trademark rights in the term POLICE MAGNUM. A proposed Amended Notice of Opposition is attached as Exhibit 1.
5. Applicant, through its counsel, has consented to this motion to Amend the Notice of Opposition.

WHEREFORE, Security Equipment Corporation respectfully requests that it be granted leave to file its Amended Notice of Opposition.

Respectfully submitted,

SPENCER FANE BRITT & BROWNE
LLP

By 

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Attorneys for Opposer
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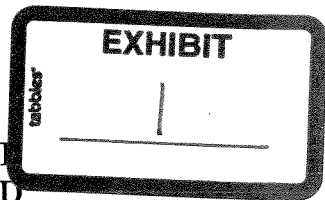
CERTIFICATE OF SERVICE

17th A copy of the foregoing was mailed, via first-class mail, postage prepaid, this day of August, 2015, to the following:

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

Attorney for Applicant





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

SECURITY EQUIPMENT CORPORATION))	Opposition No. 91222111
Opposer,))	Mark POLICE MAGNUM
vs.))	
PAUL HOWELL))	Serial No. 85/907,083
Applicant.))	

AMENDED 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 alleged date of first use on June 26, 2001 of Applicant's Mark.

4. Opposer has continuously used the designation POLICE MAGNUM ever since its first use, was using the designation POLICE MAGNUM before the April 5, 2013 filing date of the Opposed Application, and is still using to this date the designation POLICE MAGNUM for pepper spray goods.

5. 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 with Opposer, as a consequence of which Opposer has established goodwill in the POLICE MAGNUM designation.

6. Opposer's use of the designation POLICE MAGNUM on its goods has acquired distinctiveness as applied to its goods.

7. Because of the long and continuous use by Opposer of the designation POLICE MAGNUM on its goods, and the distinctiveness that the designation POLICE MAGNUM has acquired in connection with Opposer's use on its goods, Opposer has gained valuable trademark rights in the designation POLICE MAGNUM.

8. 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.

9. 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

10. 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).

11. 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.

12. 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.

13. 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

14. 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.

15. 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.”

16. 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.

17. 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.

18. 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.

19. 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.

20. 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”).

21. 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.

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

23. 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.

24. 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



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