

ESTTA Tracking number: **ESTTA1410249**Filing date: **01/23/2025**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding no.	91265658
Party	Defendant Spearhead Inc.
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Date	01/23/2025
Attachments	Applicant Spearhead Brief.pdf(311455 bytes)

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I. INTRODUCTORY BACKGROUND

This consolidated opposition/cancellation proceeding concerns 1) the lengthy nonuse and resulting abandonment in the United States of the registered mark, STERLING, by Opposer, TURAC DIS TICARET LIMITED SIRKETI (hereinafter Opposer), which resulted in a cancellation brought against Opposer's registration by Petitioner SPEARHEAD INC.; and 2) the published application for registration of the mark, STERLING, owned by Applicant/Petitioner, SPEARHEAD INC., (hereinafter "Applicant"), for which an opposition was brought by Opposer. For its case-in-chief, Opposer relies solely on the file histories for Applicant's application and Opposer's registration. These file histories are a matter of record by law. In defense of the Opposition and support for the Cancellation of the Opposer's registration, Applicant introduced the Declaration of Jeffrey Sterling with Exhibit A accompanying the Declaration identified as Applicant's Federal Firearms License, a necessary license for the manufacture, distribution, or sale of firearms, including ammunition, in United States commerce. The aforementioned is the entire evidence of record for this consolidated proceeding. Thus, Opposer has not used the mark, STERLING, in the United States at least for a period dating from the filing date of the application for registration up until 2020, a six-year period.

Opposer in its Trial Brief refers to evidence that is not of record in this proceeding. Opposer did not produce any evidence during its testimony period, nor did Opposer produce any evidence during its rebuttal period. Applicant objects to the introduction of evidence that is not a part of the record for this proceeding. In particular, Applicant objects to Opposer's documents and arguments presented in its trial brief and by footnotes numbered 1, 2, and 3, as this

information represents documentation not of record. The Board previously ruled that this evidence is not of record in the proceeding. See 36 TTABVUE 11 footnote 8, ... "motion to reopen is denied in its entirety".

In addition, the Opposer has never applied for a Federal Firearms License in the United States. At least no copy was ever produced despite requests made that the documents be produced. Without a Federal Firearms License, Opposer cannot do business in the United States in connection with the sale or offer for sale of firearms, heavy guns, or ammunition. This further supports Applicant's contention that Opposer never used the mark, STERLING, in the United States for a greater than three-year period following the issue date of the registration resulting in the abandonment of the registration.

II. STATEMENT OF THE RECORD

The STERLING registration issued to Opposer on July 21, 2015, for firearms, air guns, spring guns and their covers and slings; heavy weapons, namely, heavy guns, mortars, rockets; fireworks; sprays for personal defense purposes, Registration No. 4,774,729. The application for registration and subsequent registration was based on Section 66 (a) of the Trademark Act. 25 TSDR 73. No claim of use was ever made by Opposer from the time of the filing of the application on February 19, 2014, until Opposer's filing of a Section 71 Affidavit of Use, filed on December 27, 2021. The Affidavit deleted all goods but firearms from the registration. The USPTO rejected the Affidavit on grounds that the specimen submitted was unacceptable. 25 TSDR 104. On December 13, 2022, and then more than seven years after the issuance of the

registration, Opposer submitted a substitute specimen of a picture of a firearm. The USPTO then accepted the Affidavit of Use.

Applicant filed its application for STERLING on September 17, 2019, for ammunition, Application Serial No. 88619232, more than four years after the STERLING registration issued to Opposer, but well before any use date established by Opposer. Following a refusal to register on grounds of a likelihood of confusion with Opposer's STERLING registration, Applicant sought cancellation of the registration. Cancellation was instituted by the Board on March 27, 2020, Cancellation No. 92073765, on grounds of nonuse and abandonment. On November 4, 2020, the Cancellation proceeding was consolidated with the Opposition proceeding filed by Opposer. 4 TSDR 1. Applicant alleged that Opposer had not used the mark, STERLING, for any of the goods listed in the registration. Applicant further alleged that Opposer, to the extent it had used the mark in commerce with the United States, Opposer had ceased use of the mark for the goods listed in the registration for a period greater than three consecutive years. 1 TSDR 1-5 (Cancellation No 92073765).

In 2019, and prior to the commencement of this proceeding, Applicant conducted extensive and exhaustive investigative research into whether Opposer had used the STERLING mark in commerce with the United States. Applicant also hired a professional advertising agency to augment Applicant's market research. Throughout the investigative research, which also included internet research, no evidence of a sale or offer for sale of STERLING products identified by the goods listed in Opposer's registration could be found. See Declaration of Jeffrey A. Sterling, 30 TSDR 3-4.

During this same period, Jeffrey Sterling, Applicant's President, conducted focus groups and more than 30 individual interviews which included gun instructors, firearm store owners, and gun enthusiasts. When questioned about STERLING ammunition or STERLING firearms, the individual responses were that they had never heard of STERLING firearms, heavy guns, or ammunition. 30 TSDR 4. No documentation evidence of any sale or offer for sale of STERLING firearms, heavy guns, or ammunition have ever been produced by Opposer in this proceeding from the time of the filing of the application for registration or for a period of more than five consecutive years following the issue date of the STERLING registration to Opposer.

In addition, Opposer has never applied for a Federal Firearms License (FFL) from the Bureau of Alcohol, Tobacco, Firearms and Explosives of the U.S. Department of Treasury. A Federal Firearms License (FFL) is a necessary requirement for the manufacture, distribution, or sale of firearms, including ammunition, in United States commerce. At least, no copy was produced in this proceeding despite the request made during the discovery process. 30 TSDR 5-6. Opposer only produced a form which is the necessary initial step in the process which allows for the legal sales of Opposer's goods. The form is dated May 26, 2020, nearly five (5) years after the registration date for Opposer's registration, and ten (10) days after the Board's Notice of Default issued in the Cancellation proceeding brought by Applicant and against Opposer's STERLING registration. 30 TSDR 6.

Opposer has neither an import license to ship products into the United States nor a registration with the Bureau of Alcohol, Tobacco, Firearms and Explosives to do business in the United States, at least prior to the publication date of Applicant's trademark application, nor has Opposer produced such documents during the course of discovery. In August, 2020, an investigation into whether Opposer was using the mark, STERLING, in the United States for any

goods, was made again. At the time, you could not purchase any STERLING firearms, heavy guns, or ammunition in the United States, and the earlier website of Opposer was no longer present. 30 TSDR 6.

III. ARGUMENT

A. Applicant Has Standing to Bring the Cancellation Proceeding.

Applicant's application to register STERLING for ammunition has been refused registration on grounds of a likelihood of confusion with Opposer's STERLING registration. The application remains suspended pending the outcome of this consolidated proceeding.

There can be no dispute that Applicant has standing to pursue its cancellation of the Opposer's trademark registration. See, *Mattel, Inc. v. Brainy Baby, Co.*, 101 USPQ2d 1140, 1142 (TTAB 2011) (office action refusing registration to plaintiff based on defendant's registration sufficient to establish standing); *Weatherford/Lamb, Inc. v. C & J Energy Services, Inc.*, 96 USPQ2d 1834, 1837 (TTAB 2010) (standing established where office action suspending plaintiff's pending application pending possible refusal based on alleged likelihood of confusion with defendant's registration made of record). In addition, Applicant is entitled to seek cancellation on grounds of abandonment because Applicant is licensed to manufacture and sell goods (ammunition) which are related to those goods (firearms) identified in the subject registration under an identical mark. See *Am. Vitamin Prods. Inc. v. DowBrands Inc.*, 22 USPQ2d 1313, 1314 (TTAB 1992).

**B. The STERLING Mark Has Not Been Used in Commerce with the United States by
Opposer Beginning With the Date of Issue of the Subject Registration and
Extending for a Period of Nearly Five Years at Least Until May 26, 2020**

The Trademark Act defines use of a trademark as “the bona fide use of such mark in the ordinary course of trade and not made merely to reserve a right in a mark.” *15 U.S.C. § 1127*.

The Board has made clear that the Trademark Act requires actual sales to establish use in commerce for marks covering goods, and that to argue otherwise is “in conflict with the clear and plain statutory definition of ‘use in commerce’.” *Clorox Co. v. Salazar, 108 USPQ 2d 1083, 1086 (TTAB 2013)*.

Applicant, in its Petition to Cancel the STERLING registration, filed on March 18, 2020, asserts that Opposer “does not currently use and has not used the STERLING mark in interstate commerce or in any commerce within the United States on any goods listed in the STERLING registration. And to the extent Registrant has ever used the STERLING mark on any goods listed in the STERLING registration... within the United States, Registrant has ceased to use the STERLING mark for all of the goods listed in the STERLING registration for a period greater than three consecutive years. 1 TSDR 4-5 (Cancellation No. 92073765). Applicant/Petitioner, in asserting an allegation of nonuse or abandonment, has the difficult task of proving a negative, particularly due to the failure of the Opposer to demonstrate the use of its mark during the relevant time period, and the complete lack of evidence of use of the STERLING mark by Opposer from the issue date of its registration until the filing date of the Petition to Cancel the STERLING registration, a period of nearly five years. As such, Applicant is permitted to draw inferences of nonuse from the facts known and evidence presented. *See Cerveceria Centroamericana, S.A. v. Cerveceria India, Inc., 892 F.2d 1021, 1024, 13 USPQ 2d at 1310 (Fed. Cir. 1989)* (“Especially

when a party must prove a negative, as in proving abandonment through nonuse, without resort to proper inferences the burdened party could be faced with an insurmountable task.”); *Elkins v. U.S.*, 364 U.S. 206, 218, 80 S. Ct. 1437, 1444, 4 L. Ed. 2d 1669 (1960) (“Since as a practical matter it is never easy to prove a negative, it is hardly likely that conclusive factual data could ever be assembled.”).

Opposer has not produced a single document evidencing the use of the STERLING mark for firearms, heavy guns, ammunition, or any of the listed goods in the STERLING registration. Opposer, a foreign entity, filed its application for registration based on an International Registration achieved abroad. The STERLING trademark registered without a claim of use in the United States for any goods. Investigative research, including internet research could not find a single person or retailer that offered for sale or sold STERLING products identified by the goods listed in the Opposer’s registration. 30 TSDR 3-4. During the period leading up to the filing of Applicant’s application for STERLING for ammunition, Applicant conducted focus groups, interviewed gun instructors, firearm store owners, and gun enthusiasts, collectively representing hundreds of years of gun retail expertise, yet no one interviewed had ever heard of STERLING firearms, heavy guns, or ammunition. 30 TSDR 4.

Neither has Opposer ever applied for a Federal Firearms License (FFL), a necessary requirement for the manufacture, distribution, or sale of firearms, including ammunition, in United States commerce. Applicant requested that Opposer produce a copy of their license, but no copy was ever produced. 30 TSDR 5-6. A Form 5330 dated May 26, 2020, nearly five years after the registration date for Opposer’s STERLING registration, is the only document produced by Opposer in connection with the lawful sale of firearms in the United States. Form 5330 is a necessary initial step in the process which allows for the legal sales of firearms, heavy guns, and

ammunition in the United States. 30 TSDR 6. Opposer did not produce an import license to ship products into the United States nor a registration with the Bureau of Alcohol, Tobacco, Firearms, and Explosives to do business in the United States, at least prior to the publication date of the Applicant's trademark application, nor has Opposer produced any such documents in the course of discovery. 30 TSDR 6. In August, 2020, following the filing of the opposition to the Applicant's STERLING application, Applicant checked again whether Opposer was using the mark, STERLING, in the United States for any goods. Nowhere could you purchase STERLING product anywhere in the United States, and the website for the Opposer was no longer present. 30 TSDR 6.

To physically deliver foreign small arms ammunition into the United States, the foreign company/importer must file both an ATF Form 6, Application and Permit for Importation of Firearms, Ammunition, and Implements of War and an International Import Certificate. Opposer did not provide a signed and dated ATF Form 6 that would show Turac imported ammunition into the United States between the July 21, 2015 registration date for its registration, and May 26, 2020. The lack of these forms demonstrate that Opposer could not have possibly sold legally the STERLING brand of firearms or ammunition in the United States during the protested abandonment period.

Declaration of Jeffrey A. Sterling, 30 TSDR 7.

C. The STERLING Mark Could Not Have Been Lawfully Used in Commerce with the United States by Opposer From the Period Beginning With the Date of Issue of the Subject Registration and Extending for a Period of Nearly Five Years at Least Until May 26, 2020

As set forth in the Declaration of Jeffrey A. Sterling, any use of the STERLING mark for the goods listed in the STERLING registration before May 26, 2020, could not have been lawful use. This is because, according to the Bureau of Alcohol, Tobacco, Firearms and Explosives (ATF) (<https://www.atf.gov/firearms/import-firearms-ammunition-and-defense-articles>) an ammunition

importer shall file an ATF Form 6, Application and Permit for Importation of Firearms, Ammunition and Implements of War to legally bring small arms ammunition product into the United States. From the exporting side, the Department of Commerce requires an International Import Certificate Form BIS-645P/ATF-4522/DPS-53 <https://www.bis.doc.gov/index.php/documents/licensing-forms/1-bis-645p-international-import-certificate> which notifies the importing country the intent to bring a controlled commodity i.e. firearms and/or ammunition into the United States. An importer must submit the ATF Form 6 and the BIS-645P/ATF-4522/DPS-53 with the appropriate U.S. agencies in order to legally bring small arms into the United States. See Declaration of Jeffrey A. Sterling 30 TSDR 7-8. Accordingly, even if Opposer had presented evidence of use of the STERLING mark for firearms, heavy guns, or ammunition, prior to the filing date of Applicant's application for registration of the mark, STERLING, for ammunition, and which Opposer has not introduced any evidence of use, said use would be unlawful in violation of regulatory statutes. See *Weight Watchers International, Inc. v. I. Rokeach & Sons, Inc.*, 211 USPQ 700 (TTAB 1981).

D. Opposer Never Used the STERLING Mark For At Least Three Consecutive Years After the Registration Issued Resulting in a Prima Facie Abandonment.

As set forth herein, Applicant has established that Opposer did not use the STERLING mark on firearms, heavy guns, or ammunition for at least the nearly five-year period following the issue date of the STERLING registration. Nonuse for three consecutive years is prima facie abandonment. 15 U.S.C. § 1127. Applicant has established a prima facie case of abandonment as set forth herein. Once this happens, the presumption shifts the burden to Opposer to produce evidence that it either used the STERLING mark during the statutory period or intended to resume or commence use. *Rivard v. Linville*, 133 F. 3d 1446, 45 USPQ 2d 1374 (Fed. Cir.

1998). Opposer has presented no evidence to rebut the presumption of abandonment. As a result, Opposer's registration is subject to cancellation on grounds of nonuse and abandonment.

E. Applicant May Rely on the Filing Date of Its Trademark Application to Establish Priority of Use of Its STERLING Mark for Ammunition against Opposer's Mark.

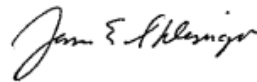
Section 7 of the Trademark Act, *15 U.S.C. § 1057(c)*, provides that the filing date of an application for registration on the Principal Register be afforded the constructive use date of first use of the mark in commerce, contingent upon the registration of the mark. Applicant filed its application on the Principal Register for the mark, STERLING, for ammunition, on September 17, 2019. The mark was approved and published for opposition. Opposer cannot rely on any evidence to show prior use of the STERLING registration prior to the filing date of Applicant's mark. Moreover, Opposer's registration is subject to cancellation based on nonuse and abandonment. Applicant, during its testimony period produced a copy of its Federal Firearms License (FFL) dated November 2, 2020, a necessary license to manufacture firearms and other destructive devices, a license the Opposer has never sought to obtain. In view of the prior use of the Applicant's mark, and the anticipated cancellation of Opposer's STERLING registration, the Opposer has no standing to pursue the opposition to the registration of Applicant's mark, Application Serial No. 88619232, for the mark, STERLING, for ammunition.

IV. CONCLUSION

For all of the above reasons, it is requested that the Cancellation of Opposer's registration be granted and that the Opposition to the registration of the Applicant's mark be dismissed with prejudice.

Respectfully submitted,

SPEARHEAD INC.



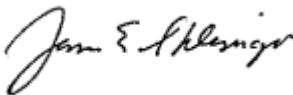
Date: January 23, 2025

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CERTIFICATE OF SERVICE

It is hereby certified that this Applicant's Motion for Judgement has been served upon Opposer by emailing a copy thereof to Counsel for Opposer, Alexander Lazouski, Lazouski IP LLC, to al@lzlawoffice.com this 23rd day of January, 2025.

By: 
James E. Shlesinger