

Oral Hearing:
June 22, 1999

Paper No. 14
GDH/gdh

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DEC. 22, 99

U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Modern Muzzleloading, Inc.
v.
Thompson Intellectual Properties, Ltd.

Opposition No. 108,230 to application Serial No. 74/734,228
filed on September 25, 1995

Donald H. Zarley, Timothy J. Zarley and Dennis L. Thomte of
Zarley, McKee, Thomte, Voorhees & Sease, P.L.C., for Modern
Muzzleloading, Inc.

Elizabeth D. Chicknavorian and Gerry A. Blodgett of Blodgett &
Blodgett, P.C. for Thompson Intellectual Properties, Ltd.

Before Hanak, Hohein and Bucher, Administrative Trademark Judges.

Opinion by Hohein, Administrative Trademark Judge:

An application has been filed by Thompson Intellectual
Properties, Ltd. to register the mark "T/C IS #1 IN
MUZZLELOADING!" for "firearms and firearm accessories, namely,
non-optical and non-telescopic gun sights; shotgun wads; ball
patches; balls; bullets and moulds therefor; loading implements,
namely, powder measures, starters, ramrods and cappers; cleaning
and maintenance products for firearms, namely, rods, brushes,
cleaning patches, pull-throughs, closer-cups, shell extractors,
and decappers; firearm cleaning and maintenance kits comprised of

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rods, brushes, ball patches, wrenches, solvents, cleaners, lubricants, and cleaning patches, sold as a unit; ball dischargers and sabots; and carrying devices for firearms, namely, holsters, pouches and sling straps".¹

Registration has been opposed by **Modern Muzzleloading, Inc.** on the ground that opposer "has for over two years manufactured, advertised and sold firearms and firearm accessories under its well-known brand and trademark '#1 IN MUZZLELOADING'"; that, in particular, opposer "has prominently used its trademark '#1 IN MUZZLELOADING' in connection with the manufacturing, sale, and advertising of muzzleloading firearms prior to the filing of the application herein opposed and has not abandoned said usage"; that such mark "has been in continuous use [by opposer] since prior to the filing date of Applicant's mark"; that opposer is the owner of an application, Ser. No. 75/038,812, for federal registration thereof which it filed on December 29, 1995; that, in the prosecution thereof, "Applicant's mark is currently being cited against Opposer's mark" as a bar to registration; and that applicant's mark, when used in connection with applicant's products, so resembles opposer's mark for its goods as to be likely to cause confusion, mistake or deception.

Applicant, in its answer, has denied the salient allegations of the opposition and has alleged as affirmative defenses that, inter alia, "Opposer's mark is merely descriptive, and therefore creates no rights for Opposer."

¹ Ser. No. 74/734,228, filed on September 25, 1995, which alleges a bona fide intention to use the mark in commerce. The phrase "#1 IN MUZZLELOADING" is disclaimed.

The record consists of the pleadings; the file of the opposed application; and, as opposer's case-in-chief, the testimony, with exhibits, of Bruce Evan Watley, who is marketing manager for opposer. Applicant, however, did not take testimony or otherwise introduce any evidence in its behalf. Only opposer filed a brief and attended the oral hearing held at the Board.

The only real issue to be determined herein is which party has priority of use of its mark. Clearly, applicant's mark "T/C IS #1 IN MUZZLELOADING!," if used in connection with "firearms and firearm accessories," is so substantially similar in sound, appearance, connotation and overall commercial impression to opposer's mark "#1 IN MUZZLELOADING" for firearms and firearm accessories that the contemporaneous use thereof in connection with legally identical goods would be likely to cause confusion as to source or sponsorship.

According to the record, opposer "makes and sells ... muzzleloading rifles and accessories." (Watley dep. at 11.) Opposer, which is also known to consumers by the trade name "Knight Rifles," has utilized the expression "#1 IN MUZZLELOADING" to convey to those in the marketplace that it "is on the cutting edge and that we are leading the muzzleloading industry". (Id. at 12.) Specifically, around June 22, 1994, opposer and its advertising agency, the LaSalle Group, commenced development of advertising materials utilizing such a theme. By August 19, 1994, opposer had developed clip art for advertising its goods which featured a new logo incorporating the slogan "#1

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IN MUZZLELOADING". Concept ads incorporating such expression were subsequently developed by September 24, 1994 and advertising copy including such phrase was finalized for use in opposer's 1995 catalog by October 12, 1994.

Opposer first used the slogan "#1 IN MUZZLELOADING" during the week of November 20, 1994, when its 1995 catalog was displayed and distributed to between 300 and 400 people who, along with representatives from opposer and applicant, attended the National Association of Sporting Goods Wholesalers ("NASGW") trade show. In particular, opposer's witness, Mr. Watley, remembers that a representative of applicant, Jim Smith, was handed a copy of opposer's 1995 catalog, which prominently featured the slogan "#1 IN MUZZLELOADING" on the front cover thereof, while attending the NASGW show. By late in 1994, opposer had run an ad featuring such slogan in the January 1995 editions of the dealer publications Straight Shooting and Fishing Tackle News. The ad played upon the theme of "#1 IN MUZZLELOADING" by referring to Knight Rifles as "YOUR #1 MONEY GUN" and "your #1 choice in muzzleloading profits." (Opposer's Ex. 12.) Another ad featuring the slogan "#1 IN MUZZLELOADING" appeared in the Shot Show Directory, a trade show guide which was published in January 1995. Such ad, according to Mr. Watley, "was also blown up ... to a large transparency which was displayed prominently at our shot show booth" and was seen by "thousands" of attendees, including representatives of applicant. (Watley dep. at 28.)

Opposer, since January 1995, has in addition continuously used the phrase "#1 IN MUZZLELOADING" on the cover of the owner's manual for its muzzleloading rifles. According to Mr. Watley, such manual is "packaged with every rifle that we ship". (Id. at 34.) The owner's manual is "packaged inside the shipping container so that when the individual opens the rifle box, they see the rifle, they see the owner's manual with the mark on it, [a] video, and an accessory kit." (Id. at 35.) Opposer has printed "[h]undreds of thousands" of such manuals, of which approximately 90,000 copies were distributed in 1995, with between 45,000 to 50,000 of those being distributed during the period from January 1, 1995 to August 1, 1995.

Opposer has also continuously used its "#1 IN MUZZLELOADING" slogan on shipping containers for its products and, since the "early part of 1995," has continuously used such slogan in connection with its "Value Pack," which "refers to a clamshell [packaging], where a consumer can purchase a muzzleloading rifle and all the accessories he needs except for powder and caps." (Id. at 37-38.) Between 40 to 50 percent of the rifles made by opposer are sold using its value pack transparent packaging. In addition, opposer die stamps its "KNIGHT" logo, which prominently features the slogan "#1 IN MUZZLELOADING," on the barrel of each of its rifles and has done so continuously since late February of 1995.

Although confidential, sales of opposer's rifles under its "#1 IN MUZZLELOADING" mark were indicated by Mr. Watley to be in the neighborhood of \$20 million in 1995, around \$19 million in

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1996 and approximately \$21 million in 1997. Opposer's advertising and promotional expenditures with respect to such mark, while also confidential, were stated to be--at a minimum--in excess of roughly \$250,000 annually for the years from 1995 through 1997.

The record contains relatively little information concerning applicant and its business activities. According to Mr. Watley, opposer's earliest knowledge of applicant's use of its asserted mark occurred in "August of 1995, where they had an ad that was displayed in Shooting Times and that bore the mark T/C is #1 in Muzzleloading." (Id. at 45.) Counsel for opposer wrote a letter to applicant on August 23, 1995 stating that such use constituted common law trademark infringement of opposer's "#1 IN MUZZLELOADING" mark and requesting that applicant immediately cease and desist therefrom. Applicant's response, in a letter from its attorneys to opposer's counsel dated September 20, 1995, was an assertion that applicant is the "premier company in the muzzleloading field" and that opposer "discontinue the arrogant and deceitful use ... of the slogan '#1 IN MUZZLELOADING'." (Opposer's Ex. 22.) Five days latter, on September 25, 1995, applicant filed its involved intent-to-use application.

Furthermore, according to Mr. Watley, applicant has not only knowingly appropriated from opposer the phrase "#1 IN MUZZLELOADING," but has also utilized opposer's value pack packaging as a prototype for the packaging of applicant's goods by substituting its rifle, accessories and header card bearing

the expression "T/C IS #1 IN MUZZLELOADING" for those utilized by opposer. Applicant displayed such prototype at the NASGW trade show held in November 1995. Opposer, however, regards itself as being perceived by the purchasing public as "the leader when it comes to muzzleloading technology". (Watley dep. at 66.) Consumers, according to Mr. Watley, "identify Knight Rifles with [the mark] #1 in Muzzleloading" due to opposer's technological innovations and "a very loyal customer base that looks to us." (Id. at 65-66.) Mr. Watley, in fact, testified that "[o]ver 50 percent of our consumer purchases are done ... based on referrals, [that is,] somebody recommending that they buy a Knight Rifle." (Id. at 66.)

Consequently, in a letter to applicant's attorneys dated December 6, 1995, opposer's counsel noted that applicant's September 20, 1995 letter contained no denial that applicant was the subsequent user of the expression "#1 IN MUZZLELOADING" nor did it deny that such expression had been adopted by applicant with knowledge of opposer's prior use thereof. The letter by counsel for opposer also pointed out that applicant had copied opposer's value pack packaging and otherwise had emulated opposer's "trade style." (Opposer's Ex. 24.)

Thereafter, on December 29, 1995, opposer filed an application to register the mark "#1 IN MUZZLELOADING" for muzzleloading firearms, claiming dates of first use of February 20, 1995. Such application, in addition to meeting with a refusal on the ground of mere descriptiveness, has been held up,

however, in light of the potential bar to registration presented by applicant's earlier filed application.

Turning to the issue of which party has priority of use of its respective mark, we find that applicant, since it did not take testimony or otherwise present any evidence in its behalf, is limited to the September 25, 1995 filing date of its involved application as the earliest date upon which it can rely for priority purposes. See, e.g., Lone Star Manufacturing. Co., Inc. v. Bill Beasley, Inc., 498 F.2d 906, 182 USPQ 368, 369 (CCPA 1974) and Columbia Steel Tank Co. v. Union Tank & Supply Co., 277 F.2d 192, 125 USPQ 406, 407 (CCPA 1960); and Zirco Corp. v. American Telephone & Telegraph Co., 21 USPQ2d 1542, 1544 (TTAB 1991). Moreover, even if applicant could rely upon its earlier advertising bearing the phrase "T/C IS #1 IN MUZZLELOADING," which opposer reportedly first observed in August of 1995 in an ad by applicant in Shooting Times, as constituting sufficient use analogous to trademark use, opposer is still the prior user of the mark "#1 IN MUZZLELOADING". This is so irrespective of whether such mark is regarded as suggestive or whether it is a merely descriptive term which has acquired distinctiveness.

In particular, the record shows that by January of 1995, opposer was prominently displaying the mark "#1 IN MUZZLELOADING" on the front cover of the owner's manual packaged with its rifles and by February of 1995 was die stamping such mark on the barrels of its rifles. Moreover, by the early part of 1995, opposer was also using the slogan "#1 IN MUZZLELOADING" on shipping containers for its products and on its value pack

packaging for its rifles and accessories. In addition, even if the slogan "#1 IN MUZZLELOADING," as alleged by applicant in its affirmative defense, were otherwise to be regarded as merely descriptive of opposer's firearms and related goods, in that (as contended by an Examining Attorney in the first office action issued in connection with opposer's application) the mark is laudatory since it merely touts opposer's goods as being the best or finest muzzleloading firearms, the record establishes that opposer rather than applicant has priority of acquired distinctiveness.² Specifically, in view of opposer's continuous use, in what plainly is a niche market, of the slogan "#1 IN MUZZLELOADING" as a mark for its goods since at least as early as January of 1995; its sales of hundreds of thousands of rifles (and their associated owner's manuals) in the amount of approximately \$60 million over a three year period; and its advertising expenditures during such period of around \$250,000 annually, it is clear that the slogan has acquired distinctiveness as indicative of opposer as the source of its muzzleloading rifles and their accessories. Thus, in either instance, we agree with opposer that it has established priority

² As pointed out by the Board in *Perma Ceram Enterprises Inc. v. Preco Industries Ltd.*, 23 USPQ2d 1134, 1138 (TTAB 1992):

[T]he controlling law ... is that where the mark relied upon by a plaintiff in support of its priority of use and likelihood of confusion claim is ... descriptive ..., then the plaintiff must establish priority of acquired distinctiveness. As noted above, the priority contest ... is not solely one of who used the mark first chronologically--rather, the test is which party first achieved secondary meaning in its mark [or the merely descriptive portion thereof]. See: J. T. McCarthy, *Trademarks and Unfair Competition*, Section 16:12 (2d ed. 1984).

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in that it is the first user of its mark and such mark has acquired distinctiveness.

We also concur with opposer that, upon consideration of the pertinent factors set forth in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973), for determining whether a likelihood of confusion exists, confusion as to the source or sponsorship of the parties' products is likely. Here, not only are the respective goods of the parties legally identical, and thus such products would be sold in the same channels of trade to the same classes of customers, but when considered in their entirety, applicant's mark "T/C IS #1 IN MUZZLELOADING!" is so substantially similar, as noted earlier, in sound, appearance, connotation and overall commercial impression to opposer's mark "#1 IN MUZZLELOADING" as to be likely to cause confusion.

Our conclusion in this regard is bolstered by the fact that the record reveals that applicant has slavishly copied opposer's marketing practices, including using opposer's own value pack packaging with only a change in the header card and contents to reflect applicant's mark and goods, thereby evidencing its intent to create a likelihood of confusion. See, e.g., *Mobil Oil Corp. v. Pegasus Petroleum Corp.*, 818 F.2d 254, 2 USPQ2d 1677, 1680 (2d Cir. 1987) ["Intentional copying gives rise to a presumption of a likelihood of confusion"]; *Perfect Fit Industries, Inc. v. Acme Quilting Co., Inc.*, 618 F.2d 950, 205 USPQ 297, 301 (2d Cir. 1980), *cert. denied*, 459 U.S. 832 (1982) ["If there was intentional copying the second comer will be

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presumed to have intended to create a confusing similarity"]; and Jolly Good Industries Inc. v. Elegra Inc., 9 USPQ2d 1534, 1538 (S.D.N.Y. 1988) ["In any event, it is by now axiomatic that intentional copying gives rise to a presumption of a likelihood of confusion"].

Decision: The opposition is sustained and registration to applicant is refused.

E. W. Hanak

G. D. Hohein

D. E. Bucher
Administrative Trademark Judges,
Trademark Trial and Appeal Board