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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re King Par Corporation

Serial No. 77488735

Marshall G. MacFarlane of Young Basile for King Par Corporation.

Tasneem Hussain, Trademark Examining Attorney, Law Office 105 (Thomas G. Howell, Managing Attorney).

Before Quinn, Taylor and Bergsman, Administrative Trademark Judges.

Opinion by Quinn, Administrative Trademark Judge:

King Par Corporation filed an application to register the mark ESCAPE (in standard characters) for "golf clubs" (in International Class 28).¹

The trademark examining attorney refused registration under Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d), on the ground that applicant's mark, when used in connection with applicant's goods, so resembles the

¹ Application Serial No. 77488735, filed June 2, 2008, alleging first use anywhere and first use in commerce on April 1, 1996.

previously registered mark THE GREAT ESCAPE (in standard characters) for "golf clubs" (in International Class 28)² as to be likely to cause confusion.

When the refusal was made final, applicant appealed. Applicant and the examining attorney filed briefs.

Applicant asserts, by way of background, that it is the prior user and owner of now-cancelled Registration No. 2033776 of the mark ESCAPE for "golf clubs," that is, the same mark and goods that are the subjects of the present application. Due to a docketing error, applicant's counsel failed to file a renewal of the registration, and the Office accordingly cancelled the registration. While applicant's prior registration was still subsisting, it was cited as a Section 2(d) bar in the underlying application of the now-cited registration. Registrant appealed, arguing against the likelihood of confusion refusal by asserting that the marks were not confusingly similar; but, during the pendency of the appeal, applicant's registration was cancelled. By the time applicant filed the present application, registrant's application matured into Registration No. 3520997, and this registration now forms

² Registration No. 3520997, issued October 21, 2008, setting forth first use anywhere and first use in commerce on June 7, 2004.

the basis of the refusal to register applicant's mark. In addition to this "equity" argument, applicant contends that the marks convey different commercial impressions. In this connection applicant argues that the purchasing public will immediately associate "THE GREAT ESCAPE" with the 1963 "award-winning" motion picture starring Steve McQueen.³ Applicant further asserts that its golf clubs are sand wedges while registrant's are "trouble woods." Applicant also claims that the purchase of golf clubs requires careful study, and indicates that there is no evidence of any actual confusion between the marks.

The examining attorney maintains that the marks engender similar commercial impressions when used in connection with legally identical goods. The examining attorney is not persuaded by applicant's claim of priority, indicating that the claim is a collateral attack on the

³ Attached to applicant's brief are a NEXIS search report and excerpts of several articles referring to "The Great Escape" in the context of the motion picture and/or historic event involving the escape of American prisoners from a German POW camp during World War II. The examining attorney objected to this evidence on the basis of its untimely submission. The objection is sustained. Trademark Rule 2.142(d) provides that the record in the application should be complete prior to the filing of an appeal, and that the Board will ordinarily not consider additional evidence filed with the Board after the appeal is filed. See TBMP §1207.01 (2d ed. rev. 2004). Accordingly, the evidence accompanying applicant's appeal brief does not form part of the record on appeal, and we have not considered the evidence in reaching our decision herein.

cited registration that cannot be entertained. In response to applicant's assertion that applicant's and registrant's golf clubs are different, the examining attorney submitted third-party registrations to show that a single entity has registered a single mark for various types of golf clubs, and Internet evidence to show that various types of golf clubs move in the same trade channels.

Our determination of the issue of likelihood of confusion is based on an analysis of all of the probative facts in evidence that are relevant to the factors set forth in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). See also *In re Majestic Distilling Co., Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003). In any likelihood of confusion analysis, however, two key considerations are the similarities between the marks and the similarities between the goods and/or services. See *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976).

We first turn to consider the goods. It is well settled that the question of likelihood of confusion must be determined based on an analysis of the goods recited in applicant's application vis-à-vis the goods identified in the cited registration. *In re Shell Oil Co.*, 992 F.2d 1204, 26 USPQ2d 1687, 1690 n. 4 (Fed. Cir. 1993); and

Canadian Imperial Bank v. Wells Fargo Bank, 811 F.2d 1490, 1 USPQ2d 1783 (Fed. Cir. 1992). Where the goods in the application at issue and/or in the cited registration are broadly identified as to their nature and type, such that there is an absence of any restrictions as to the channels of trade and no limitation as to the classes of purchasers, it is presumed that in scope the identification of goods encompasses not only all the goods of the nature and type described therein, but that the identified goods are offered in all channels of trade which would be normal therefore, and that they would be purchased by all potential buyers thereof. *In re Elbaum*, 211 USPQ 639, 640 (TTAB 1981). Further, it is not necessary that the respective goods be identical or competitive, or even that they move in the same channels of trade to support a holding of likelihood of confusion. It is sufficient that the respective goods are related in some manner, and/or that the conditions and activities surrounding the marketing of the goods are such that they would or could be encountered by the same persons under circumstances that could, because of the similarity of the marks, give rise to the mistaken belief that they originated from the same producer. *In re Melville Corp.*, 18 USPQ2d 1386 (TTAB 1991).

Both applicant and registrant have identified their goods as "golf clubs." Thus, applicant's claim that its "golf clubs" (sand wedges) are different from registrant's "golf clubs" ("trouble woods") is irrelevant to our likelihood of confusion analysis.

In view of the legal identity between applicant's and registrant's "golf clubs," we presume that they travel in the same trade channels (e.g., golf equipment stores and online retailers, sporting goods stores, and the like) and are bought by the same classes of purchasers, including ordinary ones. Further, as shown by the examining attorney's evidence, golf clubs are not necessarily expensive. Given the absence of any limitation in the respective identifications of goods relating to cost, we must assume that applicant's and registrant's "golf clubs" include those that are relatively inexpensive. As such, they may be subject to purchases made with nothing more than ordinary care.

The identity between the goods, and the overlap in purchasers and trade channels weigh heavily in favor of a finding of likelihood of confusion. Likewise, the fact that inexpensive golf clubs may be subject to an impulse purchase favors a finding of likelihood of confusion.

We next turn to consider the *du Pont* factor of the similarity between the marks. We must compare the marks in their entireties as to appearance, sound, connotation and commercial impression to determine the similarity or dissimilarity between them. *Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689 (Fed. Cir. 2005). The test, under the first *du Pont* factor, is not whether the marks can be distinguished when subjected to a side-by-side comparison, but rather whether the marks are sufficiently similar in terms of their overall commercial impression that confusion as to the source of the goods and/or services offered under the respective marks is likely to result. The focus is on the recollection of the average purchaser, who normally retains a general rather than a specific impression of trademarks. See *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106 (TTAB 1975).

Finally, where, as in the present case, the marks are used on identical goods, the degree of similarity between the marks that is necessary to support a finding of likely confusion declines. *Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 23 USPQ2d 1698 (Fed. Cir. 1992).

Applicant's mark ESCAPE and registrant's mark THE GREAT ESCAPE are similar in sound and appearance. As to meaning, the marks convey similar ideas, namely that the club will allow a player to "escape" a tough situation, as in escaping from a bunker (in the case of a sand wedge) or the rough (in the case of a "trouble wood"). Registrant's mark merely adds a superlative, "THE GREAT," to emphasize the quality of the "escape" golf shot by using registrant's club. We are entirely not persuaded by applicant's argument that registrant's mark conjures up the motion picture of the same title. The meaning of a mark must be determined in the context of the goods, in this case, golf clubs and the game of golf. Given the similarities between the marks, ESCAPE and THE GREAT ESCAPE engender very similar overall commercial impressions.

The *du Pont* factor of the similarity/dissimilarity between the marks weighs in favor of a finding of a likelihood of confusion.

We now direct our attention to applicant's other arguments. As indicated above, there is no limitation on the "golf clubs" listed in either applicant's or registrant's identification of goods. Thus, we must assume, as earlier stated, that the golf clubs include those that are relatively inexpensive and bought with a

lesser degree of care than an expensive club bought by one who golfs on a regular basis. Applicant contends, however, that golf clubs are generally expensive, with single clubs costing \$200 and a set costing more than \$1000. We will assume, strictly for purposes of dispensing with this legally untenable argument, that golfers are careful in making their purchase of golf clubs. Nevertheless, even careful purchasers are likely to be confused when encountering identical products offered under similar marks. As stated by our primary reviewing court, "[t]hat the relevant class of buyers may exercise care does not necessarily impose on that class the responsibility of distinguishing between similar trademarks for similar goods. 'Human memories even of discriminating purchasers ... are not infallible.'" *In re Research and Trading Corp.*, 793 F.2d 1276, 230 USPQ 49, 50 (Fed. Cir. 1986) quoting *Carlisle Chemical Works, Inc. v. Hardman & Holden Ltd.*, 434 F.2d 1403, 168 USPQ 110, 112 (CCPA 1970). The similarity between the marks and the identity between the goods outweigh any sophisticated purchasing decision. See *HRL Associates, Inc. v. Weiss Associates, Inc.*, 12 USPQ2d 1819 (TTAB 1989), *aff'd*, *Weiss Associates, Inc. v. HRL Associates, Inc.*, 902 F.2d 1546, 14 USPQ2d 1840 (Fed. Cir. 1990) (similarities of goods and marks outweigh

sophisticated purchasers, careful purchasing decision, and expensive goods).

Applicant's assertion of no actual confusion between the marks is entitled to little weight. *In re Majestic Distilling Co.*, 65 USPQ2d at 1205 ("uncorroborated statements of no known instances of actual confusion are of little evidentiary value"). See *In re Bisset-Berman Corp.*, 476 F.2d 640, 177 USPQ 528, 529 (CCPA 1973) (stating that self-serving testimony of applicant's corporate president's unawareness of instances of actual confusion was not conclusive that actual confusion did not exist or that there was no likelihood of confusion). A showing of actual confusion would of course be highly probative, if not conclusive, of a high likelihood of confusion. The opposite is not true, however. The lack of evidence of actual confusion carries little weight, *J.C. Hall Co. v. Hallmark Cards, Inc.*, 340 F.2d 960, 144 USPQ 435, 438 (CCPA 1965), especially in an *ex parte* context. In any event, the record is devoid of probative evidence relating to the extent of use of registrant's and applicant's marks and, thus, whether there have been meaningful opportunities for instances of actual confusion to have occurred in the marketplace. See *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1847 (Fed. Cir. 2000); and *Gillette*

Canada Inc. v. Ranir Corp., 23 USPQ2d 1768, 1774 (TTAB 1992). Accordingly, the *du Pont* factor of the length of time during and conditions under which there has been contemporaneous use without evidence of actual confusion is considered neutral.

We also note applicant's claim that it is the prior user. To the extent that applicant's allegation constitutes a collateral attack on registrant's registration, it is impermissible. Section 7(b) of the Trademark Act, 15 U.S.C. §1057(b), provides that a certificate of registration on the Principal Register shall be *prima facie* evidence of the validity of the registration, of the registrant's ownership of the mark and of the registrant's exclusive right to use the mark in connection with the goods or services identified in the certificate. During *ex parte* prosecution, including an *ex parte* appeal, an applicant will not be heard on matters that constitute a collateral attack on the cited registration (e.g., applicant's claim of priority over the cited mark). *In re Dixie Restaurants, Inc.*, 105 F.3d 1405, 41 USPQ2d 1531, 1534 (Fed. Cir. 1997); and *In re Peebles Inc.*, 23 USPQ2d 1795, 1797 n.5 (TTAB 1992). See TMEP §1207.01(d)(iv) (6th ed. rev. 2 2010). Accordingly, no

consideration has been given to applicant's arguments in this regard.

We have taken into account applicant's ownership of its now-cancelled Registration No. 2033776. Although we appreciate applicant's situation as a result of its expired registration, it does not warrant a different result when the likelihood of confusion factors weigh in favor of a finding of likelihood of confusion. See *In re Perez*, 21 USPQ2d 1075, 1077 (TTAB 1991). See also *In re Davey Products Pty. Ltd.*, 92 USPQ2d 1198, 1206 (TTAB 2009). Applicant (assuming that it is the prior user) has an adequate remedy, that is, a petition for cancellation. However, there is nothing to indicate that applicant has sought to cancel the cited registration.

In arguing that there is no likelihood of confusion, applicant points to registrant's statements made during the prosecution of its underlying application when applicant's registration was cited as a Section 2(d) bar. Registrant stated that the marks conveyed different commercial impressions. Thus, applicant urges, "if the current registrant is not of the opinion that there is a likelihood of confusion between the two competing marks, such an admission is strong evidence of the lack of likelihood of confusion which cannot be overlooked." (Brief, p. 7).

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Although we have considered registrant's prior statements, suffice it to say that the other *du Pont* factors clearly outweigh their probative value. See *Interstate Brands Corp. v. Celestial Seasonings, Inc.*, 576 F.2d 926, 198 USPQ 151, 153 (CCPA 1978) (while the earlier statement respecting the issue of likelihood of confusion is "illuminative of shade and tone in the total picture confronting the decision maker," it does not "relieve the decision maker of the burden of reaching his own ultimate conclusion on the entire record.").

We conclude that consumers familiar with registrant's golf clubs sold under the mark THE GREAT ESCAPE would be likely to mistakenly believe, upon encountering applicant's mark ESCAPE for golf clubs, that these identical goods originated with or are somehow associated with or sponsored by the same entity.

Lastly, to the extent that any of the points raised by applicant raise a doubt about likelihood of confusion, that doubt is required to be resolved in favor of the prior registrant. *In re Martin's Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 223 USPQ 1289 (Fed. Cir. 1984).

Decision: The refusal to register is affirmed.