

ESTTA Tracking number: **ESTTA302226**

Filing date: **08/21/2009**

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

Proceeding	91183317
Party	Plaintiff Golfino AG
Correspondence Address	Joseph R. Dreitler Bricker & Eckler LLP 100 S. Third Street Columbus, OH 43215-4291 UNITED STATES trademarks@bricker.com
Submission	Plaintiff's Notice of Taking Testimony
Filer's Name	Mary R. True
Filer's e-mail	mtrue@bricker.com, trademarks@bricker.com
Signature	/Mary R. True/
Date	08/21/2009
Attachments	Golfino Testimony.PDF (38 pages)(8968591 bytes)

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

IN THE MATTER OF: TRADEMARK APPLICATION NO. 77/104,364 –
GOLF SPORT

DATE OF PUBLICATION: November 27, 2007

GOLFINO AG	:	
	:	
	:	
Opposer,	:	
	:	
v.	:	Opposition No.: 91183317
	:	
GADY DESLER	:	
	:	
	:	
Applicant.	:	

TESTIMONY DEPOSITION UPON WRITTEN QUESTIONS

Pursuant to Rules 703.02(a)(2) and 703.02(c) of the Trademark Trial and Appeal Board Manual of Procedure and 37 C.F.R. §§ 2.123(a)(2) and 2.124(b)(1), Opposer GOLFINO AG (“Opposer”) submits the following written questions to Mr. Christian Gesing, Opposer’s Chief Operating Officer, Managing Director, to be answered fully and under oath, for use as testimony in the above referenced Opposition proceeding:

DEFINITIONS AND INSTRUCTIONS

1. The term “Opposer” shall mean and refer to Golfino AG, and its related companies and affiliates, including its subsidiaries, predecessors, past and present officers, directors, employees, agents, representatives and attorneys.
2. The term “GOLFINO Marks” shall mean and refer to the following marks:

GOLFINO & design- Registration No. 2,612,951, registered August 27, 2002, for clothing, namely, hats, visors, caps, shoes, socks, stockings, leggings, knickers, pants, shorts, gloves, scarves, jumpers, sweaters, vests, shirts, T-shirts, skirts, vests, undershirts, underpants, sweatshirts, golf shirts, jackets, rain jackets and tank tops;

GOLFINO & design- Registration No. 2,294,869, registered November 30, 1999, for golf articles, golf equipment, namely, golf putters, golf balls, golf bags and golf clubs; and

GOLFINO & design - Registration No. 2,788,307, registered December 2, 2003, for Leather and imitation leather sold in bulk; articles made from leather and imitation leather, namely trunks for traveling, travel bags, purses, pocket wallets, key cases; garment bags for travel, knapsacks, backpacks, cosmetic cases sold empty, handbags; brief cases; book bags, shopping bags, overnight travel cases.

3. The term "GOLFINO Design" shall mean and refer to Opposer's stylized logo of a golfer, as follows:



WRITTEN TESTIMONY QUESTIONS

QUESTION NO. 1:

Please state your name and the position(s) you have held with Opposer, including the dates you have served in such position(s).

RESPONSE:

I am Christian Gesing, Director Operations (COO) of Golfino AG since March 4, 2005. Before, I was Managing Director of GOLFINO Moden Design Handelsgesellschaft mbH & Co KG (from October 1, 1998).

QUESTION NO. 2:

Please describe Opposer's use of the GOLFINO Marks and the GOLFINO Design on the goods described in the GOLFINO Marks, and attach examples of such use.

RESPONSE:

The use of the Golfino Marks and the Golfino Design on the goods covered by the registrations are exemplary shown by

- *attached samples taken from three brochures showing Golfino- products from the years 2006 and 2007 (Annexure 1) and*
- *depictions of a cap including hangtags showing the Golfino-mark and a jacket from the collections spring/summer 2005 and other hangtags showing the Golfino- mark (Annexure 2)*

QUESTION NO. 3:

Please describe Opposer's current advertising, marketing and promotion of goods bearing the GOLFINO Marks and/or GOLFINO Design, in the United States and worldwide, and attach examples of Opposer's advertising, marketing and promotional materials.

RESPONSE:

Golfino distributes its clothing and other products via its own retail-shops in many countries. The goods are distributed via retailers in the United States and worldwide. Golfino is present in the internet via its Domain "golfino.com".

Golfino offers a membership card with certain advantages for members and runs online as well as offline ads and campaigns via several magazines and websites indicated to the golfing community and the golf industry.

Enclosed as Annexure 3 are screenshots taken from the website "golfino.com". In the down-right corner of the first screenshot one can see as example the front of a Golfino-Store, located in Paris, France.

QUESTION NO. 4:

Please describe Opposer's plans for future advertising, marketing and promotion of goods bearing the GOLFINO Marks and/or GOLFINO Design in the United States.

RESPONSE:

Golfino intends to conduct mailing-order campaigns directed to wholesalers in the USA for season 2009/2010 in order to generate increased turnovers.

QUESTION NO. 5:

Please provide information detailing Opposer's advertising and marketing expenditures for goods bearing the GOLFINO Marks and/or GOLFINO Design in the United States and worldwide.

RESPONSE:

As already stated in response no 3, Golfino's website "golfino.com" is directed to the international golfing community as well as to an international clientele that is interested in functional golf wear that can also be worn outside of the golf course. It is available in German as well as in English, Spanish and French. Prospectively from May 1, 2009, it will be possible – in a first step from Germany and EU-countries – to order directly Golfino-products via an online shop under the international website "golfino.com".

The current media plan of Golfino foresees expenses for online banner-ads on several German and international websites targeting the golfing community amounting to more than EUR 20,000.

I.a. also a print ad campaign is planned in several German and international golf-magazines covering a budget of more than EUR 10,000 which would result in a circulation of about 350,000 issues.

QUESTION NO. 6:

Please provide information detailing the outlets where Opposer's goods bearing the GOLFINO Marks and/or GOLFINO Design are sold or have been sold in the United States, the number of units sold, and the dollar amounts of such sales.

RESPONSE:

With goods bearing the Golfino-marks as exemplarily shown in Annexures 1 and 2, Golfino achieved a turnover in the USA for the period from October 1, 2001 until September 30, 2007 of about EUR 56,000 in total.

QUESTION NO 7:

Please provide information regarding any offers to sell Opposer's goods bearing the GOLFINO Marks and/or GOLFINO Design in the United States, including sales presentations made to United States. retailers, attendance at trade shows in the United States, and/or sponsorship of events in the United States

RESPONSE:

*Costumers from the USA are allowed to obtain a club-membership of Golfino. Golfino has several costumers residing in the USA. A list of regular costumers residing in the USA is enclosed as **Annexure 4**. Owners of a club-member card are marked with color. Surnames, addresses and email-contact-data are left out for reasons of confidentiality.*

*As **Annexure 5** we enclose an extract of email correspondence with a representative of the popular US-american onlineshop "ladygolf.com" and a list of contacts made with retailers residing in the USA in the course of the fair "Golf Europe".*

QUESTION NO. 8:

Please provide information regarding Opposer's website, www.golfino.com, including any U.S. sales generated by the website, inquiries from U.S. residents and/or retailers, and data evidencing the number of "hits" received from the United States.

RESPONSE:

*The enclosed screenshot (**Annexure 6**) provided by Google Analytics shows that alone from 1 December 2008 until 9 March 2009 269 residents from the USA have visited Golfino's website.*

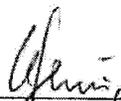
QUESTION NO. 9:

Please prove a list of all periodicals in which Opposer advertises its goods bearing the GOLFINO Marks and/or GOLFINO Design, and indicate which of the periodicals are available in the United States.

RESPONSE:

Golfino advertises its products intensively in German and European golf-magazines. However, I have no reliable information about their availability in the USA.

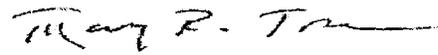
I declare under penalty of perjury that the foregoing responses are true and accurate to the best of my knowledge, information and belief.



Christian Gesing
Chief Operating Officer and Managing
Director
GOLFINO AG

Respectfully submitted,

BRICKER & ECKLER, LLP



Joseph R. Dreitler
Mary R. True
100 South Third Street
Columbus, Ohio 43215-4291
Telephone: 614.227.2300
Facsimile: 614-227.2390
E-mail: jdreitler@bricker.com
E-mail: mtrue@bricker.com

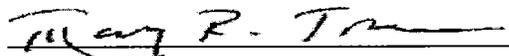
Attorneys for Opposers
GOLFINO AG

Dated: February 18, 2009

CERTIFICATE OF SERVICE

This will certify that on the 21st day of August, 2009, a true and correct copy of the foregoing was served via e-mail to gady2007@gmail.com and by first class mail, postage prepaid thereon, to the Applicant as follows:

Gady Desler
P.O. Box 8196
Ramat Gan 52181
Israel

A handwritten signature in black ink, appearing to read "Mary R. True", is written over a horizontal line.

Mary R. True

ANNEXURE 1





Collection 2000

Autumn • Spring • Summer • Autumn • Winter

Exclusive Advantages offered by the GOLFINO Customer Card

Do you want to know the advantages of the GOLFINO Club Member Card? The GOLFINO Club Member Card offers you many advantages. The advantages of the GOLFINO Club Member Card are listed below. You can also find out more about the GOLFINO Club Member Card on our website.

Advantages of the GOLFINO Club Member Card include:

- 10% discount on the Club Member Dry Hire
- 10% discount on the Club Member Golf Hire
- 10% discount on the Club Member Golf Hire
- 10% discount on the Club Member Golf Hire
- 10% discount on the Club Member Golf Hire
- 10% discount on the Club Member Golf Hire
- 10% discount on the Club Member Golf Hire
- 10% discount on the Club Member Golf Hire
- 10% discount on the Club Member Golf Hire
- 10% discount on the Club Member Golf Hire

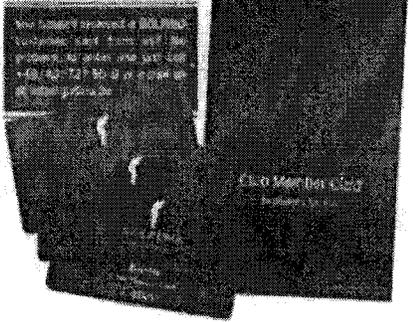
Benefits of the GOLFINO Club Member Card include:

- an invitation to the GOLFINO Club Member Card
- a personal Checklist of your GOLFINO Club Member Card
- an invitation to the GOLFINO Club Member Card
- an invitation to the GOLFINO Club Member Card
- an invitation to the GOLFINO Club Member Card
- an invitation to the GOLFINO Club Member Card
- an invitation to the GOLFINO Club Member Card
- an invitation to the GOLFINO Club Member Card
- an invitation to the GOLFINO Club Member Card
- an invitation to the GOLFINO Club Member Card

The Club Member Card (Gold and Platinum) are given to particularly good customers. Please ask for further details about terms and conditions to your GOLFINO Shop.

I have returned the completed application form in order to receive your GOLFINO customer card. If not card will only come and send the application to GOLFINO AG, Burkholzstraße 10, D-70599 Gilsen.

Please don't forget to fill in the card number on the application form.



collection 2006

LEGGING • TURTLE NECK • ANIMATED • MESH



GOLFINO

ROMA





AUTUMN AND WINTER 2007



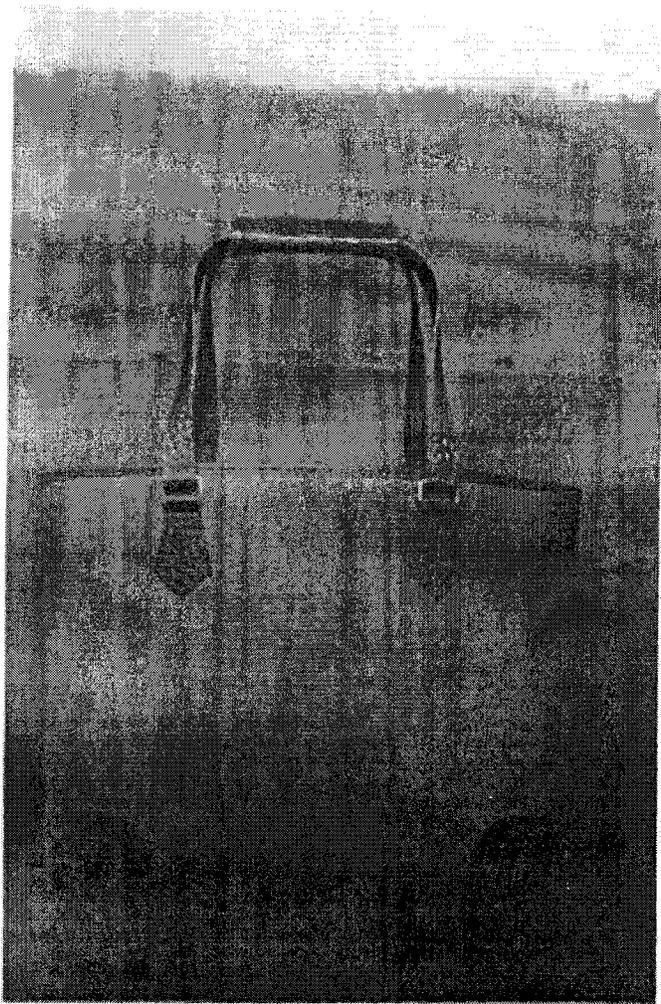




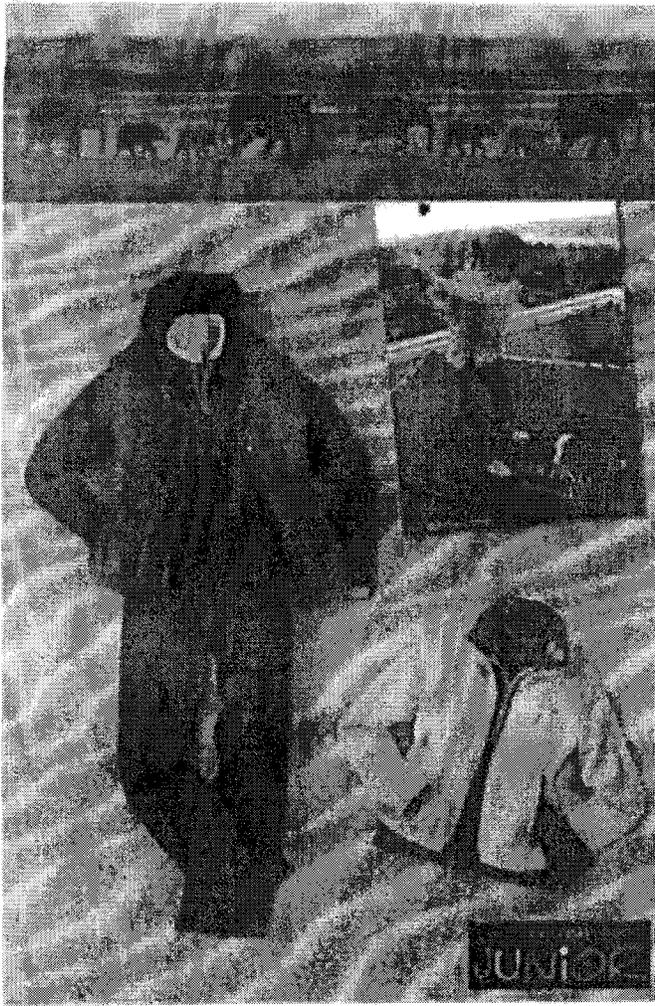










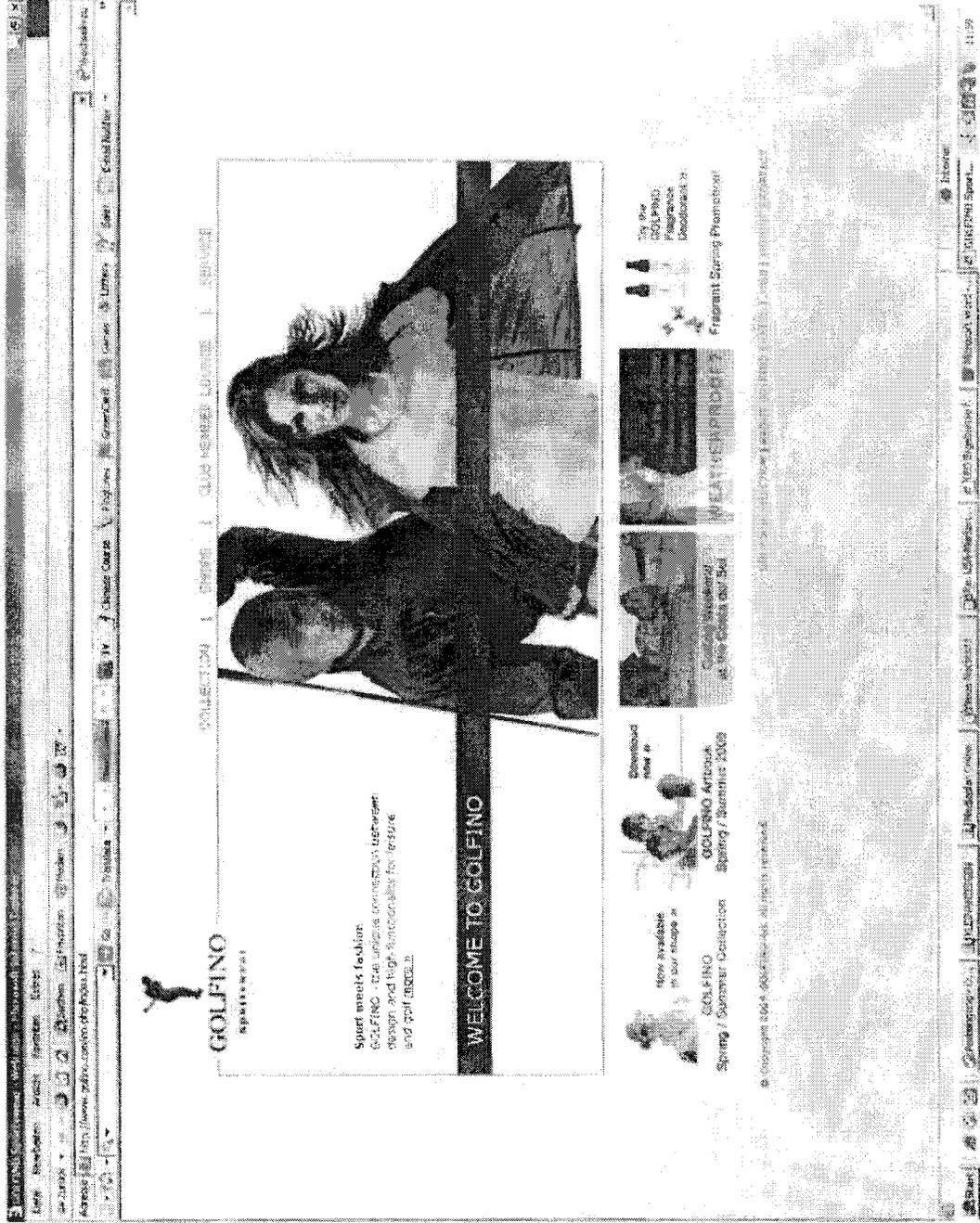


ANNEXURE 2





Auszüge aus der GOLFINO Website



Auszüge aus der GOLFINO Website

The screenshot displays the GOLFINO website interface. At the top, there is a navigation menu with links for 'COLLECTIBLES', 'GOLF', 'GOLF MEMBER LOUNGE', and 'GOLFINO'. The main content area features a 'Child Member Lounge' section. This section includes a large image of a dark-colored t-shirt with a logo. Below the image, the text reads: 'The Club Member Cards for GOLFINO is our way of saying thank you and of showing your appreciation for your loyalty. The customer card is free for you and offers you many exclusive privileges. The new Club Member Card replaces the current GOLFINO Customer Card.' To the right of this text are several smaller images: a child holding a golf club, a child in a golf outfit, and a child in a golf uniform. Below these images are the following text elements: 'New available in our stores', 'GOLFINO Spring / Summer Collection', 'Download your', 'GOLFINO ACTION Spring / Summer 2008', and 'To see GOLFINO products, visit our website'. At the bottom of the page, there is a footer with the text: '© 2008 GOLFINO. All rights reserved.' The browser's address bar shows the URL 'http://www.golfino.com/childmemberlounge.htm'.

Auszüge aus der GOLFINO Website

The screenshot shows a web browser window displaying the GOLFINO website. The browser's address bar shows the URL <http://www.golfino.com>. The website has a dark header with the text "COLLECTOR'S | GOLFERS | CLUB MEMBER LOUNGE | JOURNAL".

The main content area features a large white box with the following text:

GOLFINO SERVICE
 GOLFINO offers an especially comfortable, ultra-personalized shopping and modest customer service.
 We value your opinion please get in touch with what are questions and suggestions for us!
 We look forward to hearing from you!

Below this text are four small images with captions:

- New arrivals in our shops** - GOLFINO Spring / Summer Collection
- Checklist** - GOLFINO ARTWORK
- By the GOLFINO** - Program Spiel tag Profiteure
- Photo of a golfer** - at the Club del Golf

At the bottom of the page, there is a copyright notice: "© Copyright 2004 GOLFINO.COM. All rights reserved." and a language selection menu with options for "English", "Deutsch", and "Español".

STRENG VERTRAULICH

MRS.	ELIN	ATLANTA	USA	1900-01-25
Mr	Sheridan	Morristown, NJ	USA	1900-02-12
Mr	John	New York, N.Y.	USA	1900-01-21
Mrs	Ronda	New York	USA	
Mrs	Susan	New York	USA	1900-01-26
Mrs	Fanelle	New York	USA	
Mr	Cardie	East Hills, New York	USA	
Mrs	Valerie A.	Jonestown, NY	USA	1900-01-03
Mrs	Christina	Bethesda, MD	USA	2006-11-27
Mr	Peter	Virginia Beach, VA	USA	1900-01-03
Mr	K. French	Hillsborough, NC	USA	1900-01-23
Mrs	Mary	North Carolina	USA	
Mrs	Laune	Florida	USA	1900-01-22
Mrs	Jody	Wilmette, IL	USA	
Mr	Lance	Hinsdale	USA	2006-09-08
Mr	Anthony	Arizona	USA	1900-01-03
Mrs	Dr. Ann	Nevada	USA	
Mrs	Nancy	California	USA	1900-02-13
Mrs	Alexia	Huntington Beach	USA	1900-01-28
Mrs	Elizabeth	San Francisco	USA	
Mr	Mike	Carmel, CA	USA	
Mrs	Delores	Oakland, CA	USA	
Mrs	Pat	Scituate, MA	USA	
Mrs	Lanai	Auburndale, MA	USA	1900-01-16
Ms	Debi	Westport, CT	USA	
Mrs	Elizabeth	Cliffside Park, NJ	USA	
		07172-4185 Ocean, NJ	USA	
		California	USA	1900-01-03

STRICTLY CONFIDENTIAL!

ANNEXURE 5

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

From: Lady Golf / www.ladygolf.com

To: Philippa Wall

Sent: Thursday, June 05, 2008 8:40 PM

Subject: Re: Article in the San Francisco Chronicle with quotes from Karen and Lady Golf photo black Golfino dress

Fehler! Textmarke nicht definiert.

Will you be at the Fall GOLF Europe?

Karen Can'trell -----Original Message-----

From: Philippa Wall Date: 6/4/2008 10:43:49 PM To: Lady Golf / www.ladygolf.com Subject: Re: Article in the San Francisco Chronicle with quotes from Karen and Lady Golf photo black Golfino dress

Hi Karen,

unfortunately we will not be attending the Golf Europe as it is too early for us this year. We will be having our special VIP days here at our head office on 12 & 13th July where you are also very welcome. I think it would be a great opportunity for us to meet.

Best regards

Philippa Sarah Wall

Sales Assistant

GOLFINO AG

Tel.0049/40 727 55 151

Fax:0049/40 727 55 100

wall@golfino.com

www.golfino.com

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

From: Lady Golf / www.ladygolf.com

To: Philippa Wall

Sent: Wednesday, June 04, 2008 6:26 PM

Subject: Re: Article in the San Francisco Chronicle with quotes from Karen and Lady Golf photo black Golfino dress

Fehler! Textmarke nicht definiert.

We are coming to Germany in July 4-15th. We also will be at Golf Europe. Will you be there?

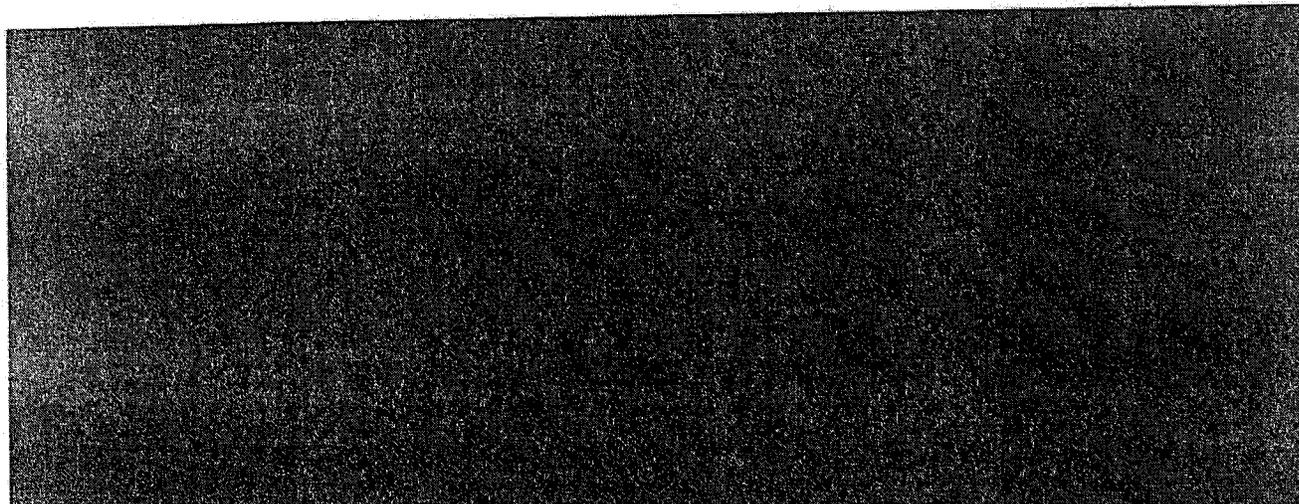
Karen Can'trell -----Original Message-----

From: Philippa Wall Date: 6/4/2008 12:42:17 AM To: Lady Golf / www.ladygolf.com Subject: Re: Article in the San Francisco Chronicle with quotes from Karen and Lady Golf photo black Golfino dress

Hi Karen,

Thank you for sending us a copy of the add it looks GREAT.

I hope you are well.



STRENG VERTRAULICH

USA Kontakt Golf Europe (Messe)

Professional Athlete, Inc.		5907 N.E. 27th Avenue,	USA	33308	Lauderdale
Stefan Kaelin Ski & Golf Corporate Office Kaelin Enterprises, Inc. www.stefanraelin.com		450 So Galena, Suite 202	USA	81611	Aspen, CO

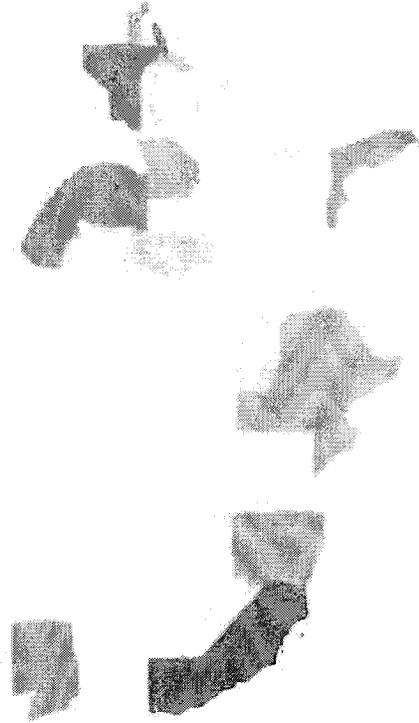
Sedakat Eyiengin
Teamleader Sales Service
Info: 05.03.2009

USA_Markenwiderspruch - Golf Europe Kontakt

STRENG VERTRAULICH
STRICTLY CONFIDENTIAL!

ANNEXURE 6

01.12.2008 - 09.03.2009



Aus diesem Land/Gebiet kamen 269 Besuche über 40 Regionen

Land/Gebiet - Details:

Übersicht

Benchmarking

Neu und wiederkehrend

Sprachen

Besuchertrend

Besuchertreue

Browerfunktionen

Netzwerkeigenschaften

Benutzerdefiniert

Zugriffsquellen

Content

Ziele

Benutzerdefinierte Berichterstellung

Elternteilungen

Erweiterte Segmente

E-Mail

Hilfeschichten

Info zu diesem Bericht

Conversion University

Häufige Fragen

Überblick

Linker States

Analytics

Verkleinern

Seiten

1

Stadt | Region

Keine

Ziel-Content-Slots