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

Proceeding	91183317
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

IN THE MATTER OF:

Trademark Application Serial No. 77/104,364
GOLF SPORT

DATE OF PUBLICATION:

November 27, 2007

GOLFINO AG

Opposer,

v.

GADY DESLER

Applicant.

OPPOSITION NO.: 91183317

OPPOSER'S TRIAL BRIEF

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OPPOSER'S TRIAL BRIEF

TO THE HONORABLE UNITED STATES TRADEMARK TRIAL AND APPEAL BOARD:

Opposer, Golfino AG (“Golfino” or “Opposer”), in support of its Opposition No. 91183317 to Application No. 77/104,364 (GOLF SPORT and design) of Gady Desler, (“Applicant”), would respectfully show the Board as follows:

I. RECORD EVIDENCE

The evidence of record consists of:

1. Golfino’s Notice of Reliance Pursuant to 37 C.F.R. §2.122(e) dated August 21, 2009 which includes U.S. Registration Nos. 2,294,869 GOLFINO (and design), 2,612,951 GOLFINO (and design) and 2,788,307 GOLFINO (and design) (“Opposer’s August 21 Notice of Reliance”)
2. Golfino’s Notice of Reliance Pursuant to 37 C.F.R. §2.122(e) dated September 10, 2009, which includes the Testimony of Mary R. True and attachments comprised of written discovery served on Applicant and Applicant’s Response. (“September 10 Notice of Reliance”)
3. Golfino’s Notice of Taking Testimony Pursuant to 37 C.F.R. §2.124 dated August 21 2009, which includes the Testimony Deposition upon Written Questions of Christian Gesing and attachments (“Gesing Testimony”)

II. PROCEDURAL HISTORY

On March 26, 2008, Opposer filed its Notice of Opposition to Applicant’s application Serial No. 77/104364 (GOLF SPORT and design). On April 18, 2008, Applicant filed his Answer. On February 18, 2009, Opposer served Applicant with its Notice of Intention to Take Testimonial Deposition Upon Written Questions of Opposer’s Chief Operating Officer and Managing Director, Christian Gesing, who resides in Germany. Applicant made no objection to the written questions, nor did he submit any additional questions to Mr. Gesing. Opposer filed Mr. Gesing’s testimony deposition with the Board on August 21, 2009.

Opposer opposes the above-referenced application based on the priority of its Registration Nos. 2,612,951, 2,294,869, and 2,788,307 for GOLFINO & design, and the likelihood for confusion between Opposer's GOLFINO & design mark for clothing, and Applicant's GOLF SPORT & design mark for clothing.

III. STATEMENT OF THE CASE

Golfino is an internationally-recognized brand of sportswear and golf clothing. Golfino sportswear has been sold in countries around the world since 1986, including the United States since 2001 under the trade name and trademark GOLFINO as well as use with a distinctive stylized logo of a golfer:



On February 10, 2007, Applicant filed application Serial Number 77/104364 - GOLF SPORT & design for "Dress shirts; Golf shirts; Polo shirts; Shirts; Short-sleeved or long-sleeved t-shirts; Short-sleeved shirts; Sport shirts"



As the evidence and controlling legal authorities set forth herein make clear, there exists a likelihood of confusion between the parties' marks; thus, Applicant's application to register Serial Number 77/104364 (GOLF SPORT & design) should be refused under Section 2(d) of the Lanham Act, 15 U.S.C. §1052(d).

IV. STATEMENT OF THE ISSUES

Opposer's ownership of valid trademarks in the GOLFINO trademark and distinctive golfer logo, and its priority in use of those marks is well-established, including by its U.S. trademark registrations. Registration Nos. 2,294,869 and 2,788,307 are incontestable. Thus, the only issue before the Board is whether Applicant's mark, when applied to the goods in the challenged application, is likely to cause confusion with Opposer's use of its marks as used in connection with the goods in Opposer's registrations, and hence should be canceled and refused registration pursuant to Section 2(d) of the Lanham Act, 15 U.S.C. §1052(d).

V. FACTS

A. Opposer's Rights in the GOLFINO & Design Mark

1. Adoption and Use of the GOLFINO & Design Mark

Based in Germany, Opposer has been selling golfing apparel and sportswear in the United States since 2001. Examples of Opposer's use of the GOLFINO & Design mark on apparel, including sport shirts, is shown on Annexures 1 and 2 to the Gesing Testimony. Opposer's products are distributed via retailers, such as golf pro shops, in the United States. Between October 1, 2001 and September 30, 2007, Opposer's U.S. sales totaled EUR 56,000 (USD \$76,000). Gesing Testimony, Response to Question 6. Opposer offers a membership card to U.S. customers that provides loyalty discounts and other advantages to members. Annexure 4 to the Gesing Testimony is a list of regular U.S. customers, including membership card holders. Opposer's website, www.golfino.com, is directed to the international golfing community as well

as to an international clientele that is interested in golf apparel. The website is available in German, English, Spanish and French. Opposer also spends more than EUR 30,000 (USD \$40,500) per year in advertising, including placement of banner ads on websites targeting the golfing community and a print ad campaign being planned in several German and international golf magazines. Gesing Testimony, Response to Question 5.

2. *Opposer's Federal Registrations of the GOLFINO & Design Mark*

Opposer is the owner of, among others, the following federally registered GOLFINO trademarks for use in connection with clothing:

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.

Registration Nos. 2,294,869 and 2,788,307 are incontestable, which provides conclusive evidence of their validity under 15 U.S.C. §1115(b).

B. *Applicant's GOLF SPORT & Design Mark*

On February 10, 2007, Applicant filed an intent-to use application Serial Number 77/104364 - GOLF SPORT for "Dress shirts; Golf shirts; Polo shirts; Shirts; Short-sleeved or long-sleeved t-shirts; Short-sleeved shirts; Sport shirts." Applicant stated that shirts bearing the GOLF SPORT mark were first offered for sale in the U.S. on September 18, 2007 on cafepress.com, but stated that as of September 17, 2008, no shirt bearing the GOLF SPORT

mark has been sold. Interrogatory Responses, Ex. D. to September 10 Notice of Reliance. Applicant produced no documents in response to Opposer's Requests for Production of Documents.

Finally, while Applicant acknowledged receipt of the following Requests for Admission, served November 25, 2008, he never responded. September 10 Notice of Reliance, True Testimony at ¶¶ 6-8. Accordingly, the following Requests should be deemed admitted under Fed. R. Civ. P. 36.¹ *Giersch, et al. v. Scripps Networks, Inc.*, Cancellation No. 92045576 (TTAB. June 6, 2007).

1. Admit that the Applicant's Mark is virtually identical to Opposer's Marks in sound, appearance, and meaning.
2. Admit that Applicant intends to use Applicant's Mark on clothing intended to be worn by consumers while playing golf.
3. Admit that Applicant's intended consumers for clothing on which it plans to use Applicant's Mark include consumers who play or watch golf.
4. Admit that Applicant intends to use Applicant's Mark in the United States on clothing sold in golf stores and/or golf pro shops.
5. Admit that Applicant intends to use Applicant's Mark in the United States on clothing sold in general merchandise stores and/or department stores.
6. Admit that Applicant intends to distribute in the United States clothing with Applicant's Mark through wholesalers, distributors, and/or suppliers that regularly distribute clothing to golf stores and golf pro shops.

¹ The Requests for Admission were made of record in the September 10 Notice of Reliance. 37 C.F.R. §2.120(j).

7. Admit that Applicant intends to distribute in the United States clothing with Applicant's Mark through wholesalers, distributors, and/or suppliers that regularly distribute clothing to general merchandise stores and department stores.

8. Admit that Applicant uses the Internet to promote and sell clothing with Applicant's Mark to consumers.

9. Admit that Applicant promotes and sells clothing with Applicant's Mark to consumers through third parties' websites.

10. Admit that Applicant promotes and sells clothing with Applicant's Mark through third parties' catalogues.

11. Admit that Applicant has not spent significant money on advertising or promotion of clothing bearing Applicant's Mark in the United States.

12. Admit that consumer purchases of golf-related clothing are not sophisticated purchases made after careful deliberation.

13. Admit that Applicant's use of Applicant's Mark will cause both potential customers and customers to assume, erroneously, and to be confused, misled and/or deceived, that the Applicant's GOLF SPORT clothing is affiliated with, endorsed, licensed, authorized or sponsored by Opposer and its GOLFINO clothing.

14. Admit that Applicant's application of GOLF SPORT for clothing is likely to cause confusion with Opposer's GOLFINO mark for the same.

VI. ARGUMENT

A. Applicable Legal Standards

The party opposing registration of a mark must prove that it has standing and that there are valid grounds for or refusing registration in an opposition proceeding. *Lipton Industries, Inc. v. Ralston Purina Company*, 670 F.2d 1024, 213 USPQ 185 (CCPA 1982); *Cunningham v. Laser*

Golf Corp., 222 F.3d 943, 55 USPQ2d 1842 (Fed. Cir. 2000); *Herbko Intern. v. Koppa Books, Inc.*, 308 F.3d 1156, 64 USPQ2d 1375 (Fed. Cir. 2002). To prevail on its likelihood of confusion claim, Opposer must show priority of use, which may be established by proving prior use or ownership of valid and subsisting registrations, and a likelihood of confusion between its GOLFINO & Design Marks and Applicant's GOLF SPORT & Design Mark. See 15 U.S.C. §1052(d); TBMP §309.03(c)(A)-(B). In determining likelihood of confusion, the Board applies the factors in *In re E.I. du Pont de Nemours & Co.*, 177 USPQ 563, 567 (CCPA 1973). Different factors may play dominant roles in determining likelihood of confusion in different cases. *Nina Ricci S.A.R.L. v. E.T.F. Enters., Inc.*, 12 USPQ 2d 1901, 1903 (Fed. Cir. 1989). In assessing whether a likelihood of confusion exists, all doubts must be resolved in favor of the prior user. *Id.*, 12 USPQ2d at 1904; *Hancock v. Am. Steel & Wire Co.*, 97 USPQ 330, 333 (CCPA 1953).

B. Opposer Has Established Standing

Opposer has standing to oppose Applicant's Mark because Opposer has (1) a "real interest" in the proceedings; and (2) a reasonable basis for the belief that Opposer will suffer damage if registration of the Applicant's GOLF SPORT & Design mark is allowed. *Ritchie v. Simpson*, 50 USPQ2d 1023, 1025-26 (Fed. Cir. 1999); see also *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842 (Fed. Cir. 2000). Opposer has made the registrations of its GOLFINO & Design Marks of record in these proceedings and has also presented evidence of its prior use in connection with goods that are confusingly similar to those listed in Applicant's application. The similarity of the marks and the potential for overlap in the goods support a reasonable basis for Opposer's claims of likelihood of confusion and Opposer's real interest in opposing the application of Applicant's GOLF SPORT & Design Mark to prevent damage to Opposer's GOLFINO & Design Marks, goodwill and reputation.

C. Opposer Has Established Ownership of Valid Marks and its Prior Use and Registration of its GOLFINO & Design Marks

To establish priority, Opposer must show proprietary rights in its GOLFINO & Design Marks arising from “a prior registration, prior trademark or service mark use, prior use as a trade name, prior use analogous to trademark or service mark use, or any other use sufficient to establish proprietary rights.” *Herbko Int’l, Inc., supra*, 64 USPQ2d at 1378; *see also Otto Roth & Co. v. Universal Foods Corp.*, 209 USPQ 40, 43 (CCPA 1981) (must prove “proprietary rights in the term [opposer] relies upon . . . whether by ownership of a registration, prior use of a technical ‘trademark’, prior use in advertising, prior use as a trade name, or whatever other type of use may have developed a trade identity”).

Opposer is the owner of three registrations for the mark GOLFINO & Design, two of which are incontestable, and which are of record in this case. (Opposer’s August 21 Notice of Reliance). Under Section 33(b) of the Lanham Act, 15 U.S.C. §1115, an incontestable registration is ‘conclusive evidence of the validity of the registered mark and of the registration of the mark, of the registrant’s ownership of the mark, and of the registrant’s exclusive right to use the registered mark in commerce.’ Opposer’s GOLFINO & Design Registrations issued long before Applicant’s claimed priority date of February 10, 2007 for its GOLF SPORT & Design application. This in itself is sufficient to show Opposer’s priority. *Herbko, supra*, 64 USPQ2d at 1378; *Otto Roth, supra*, 209 USPQ at 43; *see also King Candy Co. v. Eunice King’s Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974).

Moreover, Opposer has offered undisputed evidence of its prior common law rights in and continuous use of its ALARIS Marks in the U.S. since 2001 (*see, e.g., Gesing Testimony*), well before Applicant’s claimed priority date. This evidence of earlier use also establishes Opposer’s priority. *Herbko, supra*, 64 USPQ2d at 1378; *Otto Roth, supra*, 209 USPQ at 43.

Based on these undisputed facts, Opposer has priority over Applicant for the mark at issue in this proceeding.

D. Likelihood of Confusion Has Been Conclusively Established Under Fed. R. Civ. P. 36(b)

The Board is clear on the effect of a failure of a party to respond to requests for admission:

If a party on which requests for admission have been served fails to file a timely response thereto, the requests will stand admitted unless the party is able to show that its failure to timely respond was the result of excusable neglect; or unless a motion to withdraw or amend the admissions is filed pursuant to Fed. R. Civ. P. 3(b) and is granted by the Board. . . It is clear that applicant has not answered the requests for admission and has not requested withdrawal or amendment of the admissions. Fed. R. Civ. P. 36(a) provides that a matter is admitted unless a response is timely served or ‘the [Board] on motion permits withdrawal or amendment of the admission’. In that applicant has not responded to opposer’s requests for admission, nor filed a motion to withdraw or amend those admissions, those matters are thus ‘conclusively established’. Fed. R. Civ. P. 36(b)

E. & J. Gallo Winery v. Fine Spirits Distribution, LLC, Opposition No. 91175854 (May 22, 2008); *Hobie Designs Inc. v. Fred Hayman Beverly Hills Inc.*, 14 USPQ2D 2064 (TTAB 1990) (Applicant's failure to timely respond to opposer's request for admissions, without any showing of excusable neglect, must be deemed to constitute admission of matters set forth).

Thus, the record evidence establishes that the parties’ respective marks are virtually identical in sound, appearance and meaning (RFA No. 1), that they are intended to be used on goods that are related and competitive (golfing sportswear) (RFA No. 2-3); that the products sold under Applicant’s mark will be distributed in the same trade channels (RFA Nos. 4-7); that Applicant’s use of its GOLF SPORT & Design mark will cause both potential customers and customers to assume, erroneously, and to be confused, misled and/or deceived, that the Applicant's GOLF SPORT clothing is affiliated with, endorsed, licensed, authorized or sponsored by Opposer and its GOLFINO clothing (RFA No. 13), and that Applicant’s

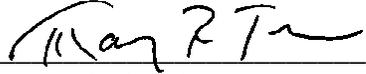
application of GOLF SPORT for clothing is likely to cause confusion with Opposer's GOLFINO mark for the same. (RFA No. 14).

CONCLUSION

Under the uncontested record evidence, Applicant's GOLF SPORT & Design Mark so closely resembles Opposer's prior used and registered GOLFINO & Design Marks as to be likely, when used on or in connection with Applicant's goods and services, to cause confusion, or to cause mistake, or to deceive, and hence, registration of its GOLF SPORT & Design application should be refused under Section 2(d) of the Lanham Act; 15 U.S.C. §1052(d).

Respectfully submitted,

Date: March 1, 2010



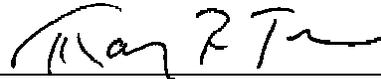
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CERTIFICATE OF SERVICE

I hereby certify that a true copy of the foregoing was served upon the following attorney of record for Applicant by email and First Class Mail, this 1st day of March 2010:

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