

THIS OPINION IS NOT A
PRECEDENT OF THE
T.T.A.B.

Mailed: July 12, 2010

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Golfino AG
v.
Gady Desler

Opposition No. 91183317
to application Serial No. 77104364
filed on February 10, 2007

Joseph R. Dreitler of Bricker & Eckler LLP for Golfino AG
Gady Desler, pro se

Before Hairston, Kuhlke and Bergsman, Administrative
Trademark Judges.

Opinion by Kuhlke, Administrative Trademark Judge:

Applicant, Gady Desler, seeks registration of the mark shown below for goods identified in the application as "dress shirts; golf shirts; polo shirts; shirts; short-sleeved or long-sleeved t-shirts; short-sleeved shirts; sport shirts" in International Class 25.¹ The application

¹ Serial No. 77104364, filed February 10, 2007, alleging a bona fide intent to use the mark in commerce under Section 1(b) of the Trademark Act, 15 U.S.C. §1051(b). The application was originally filed under Section 44(d) based on a foreign application filed on November 12, 2006. Although the basis has

includes a disclaimer for the wording GOLF SPORT and a statement that color is not claimed as a feature of the mark.



Opposer, Golfino AG, has opposed registration of applicant's mark on the ground that, as applied to applicant's goods, the mark so resembles opposer's previously used GOLFINO trade name, and previously used and registered GOLFINO trademarks for a variety of clothing items as to be likely to cause confusion under 2(d) of the Lanham Act, 15 U.S.C. §1052(d). Notice of Opposition ¶¶ 12-13.

Applicant has filed an answer denying the salient allegations.

The evidence of record consists of the pleadings herein and the file of the opposed application. In addition, opposer submitted, under a notice of reliance, certified copies of opposer's three pleaded registrations, which show that the registrations are subsisting and owned by opposer, and opposer's discovery requests, including requests for

been amended applicant retains the foreign filing date as the priority date. 37 C.F.R. 2.35(b)(3) and (4); TMEP Section 806.03(d) (6th ed. rev. 2010).

admissions and an accompanying declaration from counsel for opposer that no responses to the requests were served by applicant. The requests for admissions are therefore deemed admitted because of applicant's failure to respond. See Fed. R. Civ. P. 36. Opposer also submitted the testimony deposition upon written questions of Mr. Christian Gesing, opposer's Chief Operating Officer, Managing Director. Applicant did not take any testimony, file a notice of reliance or file a brief.²

STANDING, PRIORITY AND LIKELIHOOD OF CONFUSION

The pleaded registrations made of record, which are in full force and effect and are owned by opposer, are summarized as follows:

Registration No. 2612951 for the mark shown below



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" in International Class

² The material attached to applicant's answer is not evidence on behalf of the party to whose pleading the exhibit is attached unless identified and introduced in evidence as an exhibit during the period for the taking of testimony. Trademark Rule 2.122(c), 37 C.F.R. §1.122(c). See also Republic Steel Co. v. M.P.H. Mfg, Corp., 312 F.2d 940, 136 USPQ 447, 448 (CCPA 1963) and Hard Rock Cafe Intl (USA) Inc. v. Elsea, 56 USPQ2d 1504, 1511 (TTAB 2000).

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25, filed on December 31, 1997, issued on August 27, 2002, Section 8 declaration accepted;³ and

Registration No. 2788307 for the mark shown below for "handbags" in International Class 18, filed on July 25, 2002, issued on December 2, 2003, Section 8 and 15 combined declaration accepted and acknowledged.⁴



Because opposer has made the pleaded registrations summarized above properly of record, opposer has established its standing to oppose registration of applicant's mark and its priority is not in issue. See *King Candy Co., Inc. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974).

Our likelihood of confusion determination under Section 2(d) 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 and 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). Two

³ We note the Section 8 affidavit specifically deleted "shoes, stocking, leggings, rain jackets" from the registration but the deletion does not appear in the listing of the goods in TARR.

⁴ Opposer's third pleaded Registration No. 2294869 was just recently cancelled for failure to file a declaration of continued use under Sections 8 and 9 of the Trademark Act.

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key considerations are the similarities between the marks and the similarities between the goods. See *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976). We confine our analysis to opposer's mark in Registration No. 2612951.

We turn first to a consideration of the goods, channels of trade and class of purchasers. We must make our determinations under these factors based on the goods as they are recited in the registrations and application. See *In re Elbaum*, 211 USPQ 639 (TTAB 1981). The goods need not be identical or directly competitive in order for there to be a likelihood of confusion. Rather, the respective goods need only be related in some manner or the conditions surrounding their marketing be such that they could be encountered by the same purchasers under circumstances that could give rise to the mistaken belief that the goods come from a common source. *In re Martin's Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 223 USPQ 1289 (Fed. Cir. 1984).

The "golf shirts" and "shirts" listed in the identifications in both the subject application and Registration No. 2612951 are identical. In addition, the "shirts" and "t-shirts" in Registration No. 2612951 encompass respectively applicant's "polo shirts," "sport shirts" and "short-sleeved shirts," and applicant's "short-

sleeved or long-sleeved t-shirts," and, as such, are legally identical.

Considering the channels of trade and classes of purchasers, because the goods are identical and there are no limitations as to channels of trade or classes of purchasers in either the application or opposer's registration, we must presume that applicant's and opposer's goods will be sold in the same channels of trade and will be bought by the same classes of purchasers. See *Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d 1261, 62 USPQ2d 1001 (Fed. Cir. 2002); *Canadian Imperial Bank v. Wells Fargo Bank*, 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987); *Genesco Inc. v. Martz*, 66 USPQ2d 1260, 1268 (TTAB 2003) and *In re Smith and Mehaffey*, 31 USPQ2d 1531 (TTAB 1994). The record also establishes that all of the involved goods are general clothing items that would be sold in golf stores, golf pro shops, general merchandise stores, and department stores. See Admission Nos. 4-5. The effective admissions are sufficient to excuse opposer from having to prove this element of its claim of priority and likelihood of confusion under Section 2(d). See *Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 396 F.3d 1369, 73 USPQ2d 1689 (Fed. Cir. 2005).

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In view of the above, the du Pont factors of the similarity of the goods, the channels of trade and classes of purchasers favor a finding of likelihood of confusion.

With regard to the conditions of sale, these goods include general clothing products that would not be purchased with a great deal of care or require purchaser sophistication, which increases the likelihood of confusion. See Admission No. 12. *Recot Inc. v. M.C. Becton*, 214 F.3d 1322, 54 USPQ2d 1894, 1899 (Fed. Cir. 2000) ("When products are relatively low-priced and subject to impulse buying, the risk of likelihood of confusion is increased because purchasers of such products are held to a lesser standard of purchasing care") (citations omitted). Moreover, since we are bound by the description of goods in the application and registration and since the descriptions of goods are not restricted as to price, the goods at issue must include inexpensive as well as expensive clothing. See *In re Bercut-Vandervoort & Co.*, 229 USPQ 763, 764 (TTAB 1986) (evidence that relevant goods are expensive wines sold to discriminating purchasers must be disregarded given the absence of any such restrictions in the application or registration). Thus, this factor also favors opposer.

We now consider the similarity or dissimilarity of the marks when compared in their entireties in terms of appearance, sound, connotation and commercial impression,

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keeping in mind that "when marks would appear on virtually identical goods or services, the degree of similarity necessary to support a conclusion of likely confusion declines." *Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 23 USPQ2d 1698, 1701 (Fed. Cir. 1992).

As noted above, for purposes of our determination we may rely on the admissions alone. By Admission No. 1, applicant has admitted that "the Applicant's Mark is virtually identical to Opposer's Marks in sound, appearance, and meaning." We also find that the design of the golfer in each mark is similar and that the design in applicant's mark predominates over the descriptive wording GOLF SPORT. *Parfum de Coeur Ltd. v. Lazarus*, 83 USPQ2d 1012, 1016 (TTAB 2007); *In re Hamilton Bank*, 222 USPQ 174, 179 (TTAB 1984). We further note that the marks are similar in sound and connotation in that both begin with the word GOLF.

Thus, we find the marks to be similar in appearance, sound, connotation and commercial impression and this factor weighs in favor of a likelihood of confusion.

Thus, considering the marks in their entirety, we conclude that the evidence and admissions of record as they pertain to the relevant du Pont factors support a finding of a likelihood of confusion as between applicant's GOLF SPORT and design mark and opposer's GOLFINO and design mark, such

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that registration of applicant's mark is barred under Trademark Act Section 2(d). As noted above, applicant has not submitted any evidence, taken any testimony or presented any legal argument to rebut opposer's showing and is deemed to have admitted the most relevant du Pont factors.

Decision: The opposition is sustained as to opposer's claim of priority and likelihood of confusion under Section 2(d) of the Trademark Act.