

**This Opinion is Not a
Precedent of the TTAB**

Mailed: November 22, 2017

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board
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In re Russell Ortiz
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Serial No. 86817718
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Steven J. Laureanti of Jackson White, PC for
Russell Ortiz.

Dominic J. Ferraiuolo, Trademark Examining Attorney, Law Office 102,
Mitchell Front, Managing Attorney.

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Before Wellington, Lykos and Kuczma,
Administrative Trademark Judges.

Opinion by Wellington, Administrative Trademark Judge:

Russell Ortiz (“Applicant”) seeks registration on the Principal Register of the mark **GOLF WITH PURPOSE**, in standard character format, for “golf caps; golf shirts; hats; polo shirts; shirts; sports caps and hats” in International Class 25 and “golf ball markers; golf tee markers” in International Class 28.¹ The word GOLF has been disclaimed.

¹ Application Serial No. 86817718 was filed on November 12, 2015, based on Applicant’s allegation of an intent to use the mark in commerce, under Trademark Act Section 1(b), 37 C.F.R. § 1051(b).

The Trademark Examining Attorney has refused registration of Applicant's mark on the ground of a likelihood of confusion under Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d), in view of the registered mark **GOLF WITH A PURPOSE**, in standard characters, for "caps, golf shirts, hats, headwear, neckties, pants, rainwear, shirts, shorts, socks, sport shirts, sweaters, sweatshirts, sweatsuits, sun visors, T-shirts, warm-up suits, wind resistant jackets, vests" in International Class 25.² The word GOLF is disclaimed.

When the refusal was made final, Applicant filed concurrently an appeal and a request for reconsideration. The request for reconsideration was denied by the Examining Attorney and the appeal has been briefed. For the following reasons, we affirm the refusal.

Likelihood of Confusion

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.*, 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 or services. *See Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24

² Registration No. 2203793 issued on November 17, 1998, renewed.

(CCPA 1976); *see also In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997).

Identity and Relatedness of Goods and Trade Channels

We first consider the *du Pont* factors involving the relatedness of goods and their established, likely to continue trade channels. It is settled that in making our determinations, we must look to the goods as identified in the application vis-à-vis the goods recited in the cited registration. *See Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1161 (Fed. Cir. 2014); *Octocom Sys., Inc. v. Houston Computers Servs., Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990); *In re Giovanni Food Co.*, 97 USPQ2d 1990, 1991 (TTAB 2011).

As to Applicant's goods listed in International Class 25, some are identical to those in the registration, namely, golf shirts, shirts and hats. In addition, Registrant's "caps ... [and] shirts ..." which are not limited to any particular type, encompass the remaining goods identified in the application, namely, "golf caps ... polo shirts ... sports caps," and thus these goods are legally identical. Because the involved goods in International Class 25 are either identical or legally identical, we must presume that the channels of trade and classes of purchasers of these goods are also the same. *Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1161 (Fed. Cir. 2014); *In re Fat Boys Water Sports LLC*, 118 USPQ2d 1511, 1518-19 (TTAB 2016); *see also In re Viterra Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012) (finding Board entitled to rely on this legal presumption in determining likelihood of confusion).

As to the goods in International Class 28 of the application, namely, “golf ball markers” and “golf tee markers,” the Examining Attorney has submitted evidence demonstrating a relationship between Registrant’s golf shirts and Applicant’s golf ball and tee markers inasmuch as these are items featured in retail stores that specialize in golf-related goods. Specifically, there are physical and online stores, like the Forest Dunes Golf Club golf shop, that sell men’s apparel, including golf shirts, as well as golf “ball markers.”³ The evidence also shows the same mark and/or logo on golf ball markers and polo shirts, with these goods appearing next to each other on the same web page.⁴ Other online golf specialty stores, like the “Discount Golf World” and the “PGA Tour Superstore,” offer golf polo shirts and golf-related accessories, such as golf tees.⁵ Golf clothing and other golf-related goods, such as golf ball and tee markers bearing the same trademark will be found in the same trade channel and will be offered to the same class of consumers, namely, golfers.

Accordingly, the *du Pont* factors involving the relatedness of the goods and trade channels weigh in favor of finding a likelihood of confusion with respect to Applicant’s goods in both Classes 25 and 28.

Similarity of the Marks

We move now to the *du Pont* likelihood of confusion factor focusing on “the similarity or dissimilarity of the marks in their entirety as to appearance, sound,

³ Attached to Office action issued on October 13, 2016, at pp. 5-6.

⁴ Internet printouts from the Los Angeles Rams football team website (www.ramsfanshop.com) attached to Office action issued on May 4, 2017 at pp. 5-16.

⁵ *Id.* at pp. 17-26.

connotation and commercial impression.” *Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1691 (Fed. Cir. 2005) (quoting *du Pont*, 177 USPQ at 567). “The proper test is not a side-by-side comparison of the marks, but instead whether the marks are sufficiently similar in terms of their commercial impression such that persons who encounter the marks would be likely to assume a connection between the parties.” *Coach Servs. Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1721 (Fed. Cir. 2012) (citation omitted). The focus is on the recollection of the average purchaser, who normally retains a general rather than a specific impression of trademarks. *In re C.H. Hanson Co.*, 116 USPQ2d 1351, 1353 (TTAB 2015). With regard to the general articles of clothing and hats, the average purchaser is the general public; and, as to the golf-related goods and apparel, the average purchaser would be golfers or those interested in the sport.

When marks appear on goods that are identical, “the degree of similarity necessary to support a conclusion of likely confusion declines.” *Century 21 Real Estate Corp. v. Century Life of Am.*, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992); *Jansen Enters. Inc. v. Rind*, 85 USPQ2d 1104, 1108 (TTAB 2007). We keep this in mind with respect to the involved Class 25 goods because, as discussed *supra*, we have found them to be identical.

The involved marks in this case are extremely similar given that Applicant’s proposed mark, GOLF WITH PURPOSE, differs from the registered mark, GOLF

WITH A PURPOSE, solely by the omission of the short, indefinite article “A.” Indeed, the marks are nearly identical in terms of appearance and sound.

As far as the connotations conveyed by the marks, Applicant argues that the omission or addition of “A” in the marks is significant:

Regarding connotation, these marks have clear semantic differences as well. The differences in the use of the wording “purpose” instead of “a purpose” is not minor, and in fact distinguishes not only the appearance of Applicant’s mark from Registrant’s, but conveys a different meaning, as well. For example, to golf with purpose connotes the idea that there is a passion behind playing golf. In contrast, golf with “a purpose” connotes the idea that golf is for a specific charitable cause. ... A consumer viewing the wording “golf with” in connection with “a purpose” would find “a purpose” connotes the idea that the golf is to serve specific cause, use, function, or purpose. In other words, the golf serves a specific purpose. ... In this case, “a purpose” for Registrant[’s] mark is supporting a charitable organization for combatting cystic fibrosis.⁶

Applicant relies on dictionary definitions of the term “purpose,” including:⁷

- the reason why something is done or used: the or intention of something;
- the feeling of being determined to do or achieve something; and
- the aim or goal of a person : what a person is trying to do, become, etc.

as well as the definition of “Serve a Purpose”:⁸

- to have a particular use or function : to be useful or helpful in some way
<Everything on the boat *serves a purpose*.>

Applicant also points to printouts from Registrant’s website to support his argument that Registrant’s services have a charitable element.

⁶ 8 TTABVUE 8-9.

⁷ From Merriam-Webster online dictionary (www.merriam-webster.com); printouts submitted with Applicant’s request for reconsideration filed on April 13, 2017. 4 TTABVUE 17.

⁸ *Id.* at 18.

We disagree with Applicant. Rather, we find that consumers viewing the respective marks in connection with the identical golf clothing or related golf-accessories, will discern little, if any, different connotations conveyed by the marks. While Registrant's addition of the term "A" in its mark may infer that there is particular reason for playing golf, there is no reason to suggest that a "specific charitable cause" is being connoted. Indeed, a review of Registrant's website, reveals that Registrant is involved in building "purpose built communities" tied to or centered on the sport of golf and "Registrant[s] motto, 'Golf with a Purpose,' was coined ...after it was realized that golf would be the galvanizing element of the new East Lake community."⁹ Likewise, Applicant's mark certainly invokes the sport of golf and suggests some determination or dedication in connection with the sport, *i.e.*, that one is seriously engaged in the sport of golf. In both cases, consumers viewing the two extremely similar marks, will likely understand the marks in the same manner. That is, viewed in the context of identical clothes or related golf goods, the marks invoke a passion for or dedication to the sport of golf.

In sum, we find the marks to be overall extremely similar in sound, appearance, connotation and commercial impression. This *du Pont* factor therefore weighs in favor of finding a likelihood of confusion.

Conclusion

We have carefully reviewed the entire record and considered all relevant factors concerning the likelihood of confusion. Ultimately, in view of the identity of the

⁹ *Id.* at 15-16.

involved goods in Class 25 and relatedness of Applicant's goods in Class 28 with Registrant's golf shirts, and all of the aforementioned goods being presumed or demonstrated as traveling in the same trade channels to the same classes of consumers, as well as the overall strong similarity of the marks, we conclude there is a likelihood of confusion between Applicant's applied-for mark **GOLF WITH PURPOSE** and the registered marks, **GOLF WITH A PURPOSE**.

Decision: The refusal to register Applicant's mark is affirmed in both Classes 25 and 28.