

THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT OF THE TTAB

JUNE 21, 99

U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Laser Golf Corporation, by mesne changes of
name from Ram Golf Corporation

v.

Tom Cunningham

Cancellation No. 26,054

James P. Ryther of Rudnick & Wolfe for Laser Golf
Corporation.

Robert D. Fish of Crockett & Fish for Tom Cunningham.

Before Seeherman, Hairston and Chapman, Administrative
Trademark Judges.

Opinion by Hairston, Administrative Trademark Judge:

Laser Golf Corporation has petitioned to cancel the
registration owned by Tom Cunningham for the mark LASERSWING
for golf clubs.¹

As grounds for cancellation, petitioner alleges that
since at least as early as 1982, petitioner and its licensee

¹ Registration No. 2,025,118 issued December 24, 1996; alleging a
date of first use of January 29, 1993 and a date of first use in
commerce of June 18, 1993.

Cancellation No. 26,054

have used the registered mark LASER for golf clubs² and golf balls³; that respondent's mark, when used in connection with his goods, so resembles petitioner's previously used and registered mark as to be likely to cause confusion; and that respondent has not used the mark LASERSWING in connection with the goods recited in the registration, namely, golf clubs.⁴

Respondent, in his answer, has denied the salient allegations of the petition for cancellation.

The record consists of the pleadings; the file of the registration sought to be canceled, trial testimony (with exhibits) taken by both parties; petitioner's notice of reliance on status and title copies of its pleaded registrations and the discovery deposition of respondent, Tom Cunningham; and several excerpts taken from the NEXIS data base and the Internet which were submitted by stipulation of the parties.⁵

² Registration No. 1,243,793 issued June 28, 1983; Sections 8 & 15 affidavit filed.

³ Registration No. 1,247,799 issued August 9, 1983; Sections 8 & 15 affidavit filed.

⁴ The ground of non-use on the goods recited in the registration was added by an amended petition for cancellation.

⁵ This evidence consists of excerpts of articles taken from the NEXIS data base which refer to "laser golf club[s];" an article which appeared at the CNN website with the headline "Laser-straight drive at No. 16 saved day for Love;" an advertisement which appeared on the Internet for an electronic flying disc known as the "Ultimate Laser Disc;" information about respondent's product from respondent's web site; and a listing of products, one of which is respondent's, that may be ordered from the web site of "GolfAidMall." There is nothing in the stipulation as to the relevance of any of these materials, and

Cancellation No. 26,054

According to the record, petitioner markets a full range of golf products including golf clubs, putters, wedges, woods, golf training aids, golf balls, golf clothing, caps, rain wear, and umbrellas. Petitioner's president, James Hansberger, testified that petitioner and its licensee have continuously used the LASER mark on golf clubs and golf balls since the dates set forth in its registrations. Petitioner's products are sold in golf shops and sporting goods stores throughout the United States. Petitioner has a sales force of approximately 500 sales representatives who call on the trade. Petitioner advertises its products in golfing publications and through regular television commercials and infomercials. Also, petitioner's LASER golf clubs and golf balls have appeared in catalogues and sales brochures. According to Mr. Hansberger, the promotion of golf products is cyclical in nature, i.e., different lines of products are promoted during different time periods. Mr. Hansberger testified that petitioner heavily promoted its LASER golf clubs and golf balls from 1988 to 1991. Petitioner's sales of LASER golf clubs totaled approximately \$9 million in 1990; \$8 million in 1991, and \$5 million in 1992.⁶

although it appears that it was respondent who submitted the stipulation, he did not make reference to any of these materials in his brief on the case.

⁶ Petitioner offered sales figures for these years only.

Cancellation No. 26,054

Respondent's product, which is designed to improve a golfer's swing, is a device which has the appearance of a

golf club since it has a head and a shaft. However, it is not intended to be used to hit golf balls. The head of respondent's product is hollow and a battery and light emitting diodes are mounted therein. A user, when swinging this device, can track the form of his or her swing by observing the path of movement of light during the swing and comparing that path with a preferred path. When asked how he came up with the mark LASERSWING, Mr. Cunningham testified that he thought of probably a dozen different names and decided on LASERSWING because "[i]t just seemed to describe the product . . . [and] the product itself gives the appearance of a laser to the user, and it's a swinging club, so Laserswing just seemed logical." (Discovery dep., p. 18). According to Mr. Cunningham, a "couple [of] people" have bought the LASERSWING product. (Testimony dep., p. 15). He testified that the product sells for between \$100 and \$200.

We turn first to the issue of priority. Petitioner's priority of use of its mark LASER for both golf clubs and golf balls is established by the testimony of its president, Mr. Hansberger.

Turning next to the issue of likelihood of confusion, it is essentially petitioner's position that confusion is likely because the goods of the parties as set forth in the

respective registrations are identical or otherwise closely related and the marks are substantially similar.

Respondent, however, argues that there has already been a determination by the Examining Attorney that there is no likelihood of confusion between respondent's mark and petitioner's mark and that petitioner has offered no facts in this proceeding which were not before the Examining Attorney. Further, respondent argues that the marks are not similar; that petitioner has failed to establish the fame of its mark; and that there have been no instances of actual confusion.

At the outset, we should point out that the Board is not bound by the decision of the Examining Attorney regarding the registrability of respondent's mark. This is particularly true in an inter partes proceeding such as this, where generally there is more evidence than was before the Examining Attorney on the issue of likelihood of confusion. See *McDonald's Corp. v. McClain*, 37 USPQ2d 1274 (TTAB 1995).

With respect to the goods, we note that they are identical in part (golf clubs) and otherwise closely related. Also, because neither petitioner nor registrant has limited the products identified in the respective registrations to any particular channels of trade or classes of purchasers, we must deem the goods to travel in all

appropriate trade channels to all potential purchasers of such goods. Thus, in our likelihood of confusion analysis, we must assume that petitioner's golf clubs and golf balls and registrant's golf clubs are sold in golf shops and sporting goods stores to beginning as well as experienced golfers.

Turning then to the marks, as our principal reviewing court, the Court of Appeals for the Federal Circuit has pointed out, "[w]hen 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, 1700 (Fed. Cir. 1992). In this case, due to the shared presence of the term LASER in both marks, there are consequent similarities in appearance and pronunciation. The addition of "SWING" in respondent's mark is insufficient to distinguish the two marks when applied to identical and closely related goods. In finding that the marks are similar, we have kept in mind the normal fallibility of human memory over time and the fact that the average consumer retains a general rather than a specific impression of trademarks encountered in the marketplace. Further, we note that the trial record is devoid of any evidence of third-party uses of LASER marks

for goods similar to the types of goods involved in this case.

With respect to respondent's argument that there is no evidence of actual confusion, aside from the fact that actual confusion is difficult to prove, we cannot conclude from the limited evidence of use of respondent's mark that there has been an opportunity for confusion to have occurred.

Also, a mark need not be "famous" in order to be entitled to protection under Section 2(d) of the Trademark Act.

We conclude that individuals familiar with petitioner's golf clubs and golf balls sold under the LASER mark, would be likely to believe, upon encountering respondent's mark LASERSWING for golf clubs, that the goods originate with or are associated with the same source.

We turn then to the issue of whether respondent has used the mark LASERSWING on the goods recited in the registration. It is petitioner's position that respondent's product is a golf training aid, not a golf club. In support of its position, petitioner relies on Mr. Cunningham's responses to questions posed to him by petitioner's counsel during his discovery deposition. While it is true that Mr. Cunningham stated that his mark is not used on golf clubs, this statement was predicated on petitioner's attorney

Cancellation No. 26,054

having defined the term "golf club" as "a product that is used to strike a golf ball." (Discovery dep., p. 37). As indicated previously, respondent's product is not intended to be used to hit a golf ball. However, Mr. Cunningham also testified that his product "looks like a golf club, feels like one and swings like one. It has [the] general characteristics of a golf club." (Testimony dep., p. 13). Inasmuch as it appears that respondent's product is a variation of a golf club and respondent only indicated that it was not a golf club in response to a question wherein petitioner's attorney narrowly defined a golf club, we cannot say that petitioner has not used his mark on goods which fall under the general category of golf clubs. Thus, the record herein does not establish that respondent has not used the mark on the goods recited in the registration.

Cancellation No. 26,054

Decision: The petition to cancel is granted under Section 2(d) of the Trademark Act.

E. J. Seeherman

P. T. Hairston

B. A. Chapman
Administrative Trademark
Judges, Trademark Trial and
Appeal Board