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THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT OF THE TTAB FEB. 23, 99

U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Taylor Made Golf Company, Inc.

v.

James I. Park

Opposition No. 98,369 to application Serial No. 74/557,038,
filed on August 4, 1994

Mark R. Galis, Robert E. Browne and Thomas C. McDonough of
Alzheimer & Gray for Taylor Made Golf Company, Inc.

Henry W. Leeds and Kristine M. Kivacik of Tucker, Flyer & Lewis,
P.C. for James I. Park.

Before Cissel, Quinn and Hohein, Administrative Trademark Judges.

Opinion by Hohein, Administrative Trademark Judge:

James I. Park has filed an application to register the
mark "TOUR MADE" for "golf clubs, golf club shafts, golf club
head covers, golf bags and golf gloves".¹

Taylor Made Golf Company, Inc. has opposed registration
on the ground that it "has, since 1979, been in the business of
manufacturing, selling and distributing golf equipment, including
golf clubs, golf bags, golf head covers and other golf related

¹ Ser. No. 74/557,038, filed on August 4, 1994, which alleges a bona fide intention to use the mark in commerce.

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items"; that, in connection with such business, it "has adopted and used ..., in the advertising and sale of its golf clubs and other golf related items, the mark 'TAYLOR MADE' as well as a series of marks distinguished by the word 'TOUR'," including such "TOUR" marks as "TOUR SPOON, TOUR DRIVER, TOUR BURNER, TOUR CLEEK and TOUR PREFERRED (hereinafter collectively referred to as the 'TOUR' family marks)"; that "[t]he 'TAYLOR MADE' mark and the 'TOUR' family marks have been used on Opposer's line of golf clubs and other golf related items for many years" prior to the filing date of applicant's application; that, in connection with "golf clubs," opposer is the owner of valid and subsisting registrations for the mark "TAYLOR MADE"² and its "TOUR" family marks "TOUR SPOON,"³ "TOUR DRIVER,"⁴ "TOUR CLEEK,"⁵ "TOUR BURNER"⁶ and "TOUR PREFERRED";⁷ that applicant's mark "is confusingly similar to both the 'TAYLOR MADE' mark and members of Opposer's family of 'TOUR' marks"; that applicant's goods "would be sold in

² Reg. No. 1,200,542, issued on July 6, 1982, which sets forth dates of first use of January 26, 1979; combined affidavit §§8 and 15.

³ Reg. No. 1,276,343, issued on May 1, 1984, which sets forth a date of first use anywhere of February 22, 1981 and a date of first use in commerce of February 28, 1981; combined affidavit §§8 and 15. The word "SPOON" is disclaimed.

⁴ Reg. No. 1,276,354, issued on May 1, 1984, which sets forth a date of first use anywhere of May 4, 1981 and a date of first use in commerce of May 5, 1981; combined affidavit §§8 and 15. The word "DRIVER" is disclaimed.

⁵ Reg. No. 1,270,032, issued on March 13, 1984, which sets forth dates of first use of December 22, 1982; combined affidavit §§8 and 15. The word "CLEEK" is disclaimed.

⁶ Reg. No. 1,275,348, issued on April 24, 1984, which sets forth dates of first use of December 17, 1982; combined affidavit §§8 and 15.

the same channels of trade and in direct competition with Opposer's products"; and that applicant's mark, when used in connection with his goods, "so resembles Opposer's registered marks" as to be likely to cause confusion, mistake or deception.

Applicant, in his answer, has denied the salient allegations of the notice of opposition.

The record includes the pleadings; the file of the involved application; and, as opposer's case-in-chief, the testimony, with exhibits, of its president and chief operating officer, George Montgomery.⁸ Applicant, however, did not take testimony or introduce any other evidence in his behalf. Briefs have been filed⁹ and an oral hearing was held.

⁷ Reg. No. 1,272,937, issued on April 3, 1984, which sets forth dates of first use of December 3, 1982; combined affidavit §§8 and 15.

⁸ Applicant, in its brief, contends that opposer's main brief "refers to a number of alleged facts which are not in the record, are without proper foundation, and/or which are mere hearsay." In consequence thereof, applicant "objects to the Board considering any of these alleged facts". Most of applicant's contentions, however, relate essentially to whether particular facts have been proven or the weight to be given to certain asserted facts, rather than to whether the evidence is properly admissible or not. Suffice it to say that, to the extent that particular facts have not been proven by opposer or otherwise established, such as by stipulation in the briefs, they have not been given any consideration; those facts which have been so proven or established have been given appropriate weight; and any hearsay evidence not subject to an admissibility exception has been excluded from consideration. We further note, in this regard, that although Mr. Montgomery offered testimony with respect to opposer's Exhibits 10, 13 and 15, there were no such exhibits submitted, just as the record contains no exhibits numbered 12, 14 and 16, and the exhibit index to the deposition transcript does not list any exhibits numbered 10 through 16 other than Exhibit 11, which is of record. Accordingly, since Exhibits 10, 13 and 15, as well as those numbered 12, 14 and 16 (which apparently do not exist), were never made of record, they cannot be given any consideration.

⁹ Opposer's motions on consent to extend the time for filing its reply brief are granted.

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Opposer's priority of use of the marks which are the subjects of its pleaded registrations is not in issue. This is despite the fact that opposer failed to prove the status of and

title to each of such registrations. Specifically, through the testimony of its witness, opposer introduced only plain copies of its pleaded registrations, together with corresponding copies of acknowledgments, made by the Patent and Trademark Office many years ago, of declarations submitted pursuant to Sections 8 and 15 of the Trademark Act. Furthermore, the testimony of Mr. Montgomery indicated only that opposer is the owner of its pleaded registration for the mark "TAYLOR MADE" and is silent as to whether opposer is presently the owner of its pleaded registrations for its "TOUR"-formative marks. Thus, while opposer failed to prove that each of its pleaded registrations is both currently subsisting and that it is presently the owner thereof, applicant nevertheless has conceded in his brief that opposer "is the owner of incontestable federal ... registrations" for its pleaded marks and that opposer, therefore, "has priority". See King Candy Co. v. Eunice King's Kitchen, Inc., 496 F.2d 1400, 182 USPQ 108, 110 (CCPA 1974). The record in any event establishes that, as further admitted by applicant in its brief, opposer "has used [the mark] TAYLOR MADE in connection with golf clubs and other golf related goods since 1979."¹⁰ Since applicant also admits that "the goods of the parties can be considered identical," the only real issue to be determined is whether applicant's "TOUR MADE" mark, when used in connection

¹⁰ Applicant, having failed to take testimony or otherwise present evidence in his behalf, is limited to the August 4, 1994 filing date of his application as the earliest date on which he can rely in this proceeding. See, e.g., Lone Star Manufacturing Co., Inc. v. Bill Beasley, Inc., 498 F.2d 906, 182 USPQ 368, 369 (CCPA 1974) and Columbia Steel Tank Co. v. Union Tank & Supply Co., 277 F.2d 192, 125 USPQ 406, 407 (CCPA 1960).

with golf clubs, golf club shafts, golf club head covers, golf bags and golf gloves, so resembles one or more of opposer's pleaded marks for golf clubs that confusion is likely as to the source or sponsorship of the parties' respective goods.¹¹

¹¹ The parties, however, maintain that the only question before the Board is whether there is a likelihood of confusion from the contemporaneous use of the marks "TOUR MADE" and "TAYLOR MADE". Although opposer, in this regard, refers in its main and reply briefs to the fact that its "TOUR"-formative marks are federally registered and asserts that they constitute a "family of marks," opposer does not argue at the briefing stage that applicant's mark is likely to cause confusion either with opposer's asserted family of "TOUR" marks or any of such marks individually. Instead, opposer asserts, and applicant essentially concurs, that the sole issue before the Board is whether there is a likelihood of confusion between applicant's mark and opposer's "TAYLOR MADE" mark.

Nevertheless, we note in any event that opposer has failed to prove that it currently has a family of marks which is based on the word "TOUR," although it appears from a brochure submitted as its Exhibit 17 that it had such a family as late as sometime in 1988. As stated in *J & J Snack Foods Corp. v. McDonald's Corp.*, 932 F.2d 1460, 18 USPQ2d 1889, 1891-92 (Fed. Cir. 1991):

A family of marks is a group of marks having a recognizable common characteristic, wherein the marks are composed and used in such a way that the public associates not only the individual marks, but the common characteristic of the family, with the trademark owner. Simply using a series of similar marks does not of itself establish the existence of a family. There must be a recognition among the purchasing public that the common characteristic is indicative of a common origin of the goods.

Recognition of the family is achieved when the pattern of usage of the common element is sufficient to be indicative of the origin of the family. It is thus necessary to consider the use, advertisement, and distinctiveness of the marks, including assessment of the contribution of the common feature to the recognition of the marks as of common origin.

On this record, it simply cannot be said that opposer, as noted above, has demonstrated the present existence of a family of "TOUR"-formative marks. The evidence fails to show that such marks have continued to be promoted in a manner sufficient to create a recognition or awareness among the purchasing public of the common ownership thereof so that a family of marks, characterized by the term "TOUR" as its distinguishing element, in fact currently exists. See, e.g., *La Maur, Inc. v. Bagwells Enterprises, Inc.*, 199 USPQ 601, 606 (TTAB 1978) and *Polaroid Corp. v. American Screen Process*

According to the record, opposer has been in the golf equipment business since at least 1979. Opposer manufactures and sells golf clubs. Although it does not manufacture golf club shafts, opposer designs such shafts and has them manufactured for it. Opposer also sells golf club head covers, golf bags, golf umbrellas and golf clothing. At one time, opposer additionally sold golf gloves, although it does not do so currently. All of the products presently marketed by opposer are sold under the house mark "TAYLOR MADE, which opposer has used since 1979.

In terms of numerical sales, opposer currently is "No. 2 in the market in size. And in terms of reputation, Taylor Made is an absolute premier brand." (Montgomery dep. at 12.) Mr. Montgomery also testified that opposer "has been a market leader from the start" of its business and has "been known for innovations[,] for superior product quality and for the market presence which includes 'Tour Support' of the product line." (Id.) Opposer based the foundation of its early success upon its popularizing the metal-headed golf club in the United States

Equipment Co., 166 USPQ 151, 154 (TTAB 1970). Moreover, the mere ownership of a number of marks sharing a common feature, or even ownership of many registrations therefor, is alone insufficient to demonstrate that a family of marks presently exists. See, e.g., Hester Industries, Inc. v. Tyson Foods, Inc., 2 USPQ2d 1646, 1647 (TTAB 1987); Consolidated Foods Corp. v. Sherwood Medical Industries Inc., 177 USPQ 279, 282 (TTAB 1973); Polaroid Corp. v. American Screen Process Equipment Co., supra; and Polaroid Corp. v. Richard Mfg. Co., 341 F.2d 150, 144 USPQ 419, 421 (CCPA 1965). Accordingly, since opposer has not established its assertion of an existing family of "TOUR"-formative marks, the issue of likelihood of confusion must be determined, as applicant correctly acknowledges in his brief, by comparing applicant's mark for his goods with each of opposer's pleaded marks for its products and not with just its "TAYLOR MADE" mark alone.

along with its establishment of a market in its "TOUR PREFERRED" dimpled-appearing golf club.

As demonstrated by an early catalog, by 1984 opposer was offering a product line of "TAYLOR MADE" golf clubs which included such clubs as a "TOUR DRIVER," "TOUR SPOON," "TOUR CLEEK" and "TOUR BURNER". Another catalog, from 1988, shows that for 1989 opposer was offering such "TAYLOR MADE" golf clubs as its "TOUR BRASSIE," "TOUR DRIVER," "TOUR SPOON," "TOUR BURNER" and "<TOUR PREFERRED>" models. The catalog also touts opposer's "Taylor Made Tour Preferred Metalwood clubs" as including, inter alia, the following features:

- New in '89. Available in Taylor Made Tour Gold (high-modulus graphite) shafts. Club comes with Taylor Made custom designed Tour Gold™ shaft protection head cover.
- Available in Taylor Made Tour Silver™ (titanium) shafts. Club comes with Taylor Made custom designed Tour Silver headcover.

(Opposer's Exhibit 17.) Similarly, the same catalog advertises that, for 1989, opposer's "Tour Cleek Metalwood clubs" are "[a]vailable in Taylor Made Tour Gold (high-modulus graphite) and Taylor Made Tour Silver (titanium) shafts," while its "Taylor Made Tour Preferred irons" are likewise "[a]vailable in Taylor Made Tour Silver (titanium) shafts." (Id.)

According to Mr. Montgomery, opposer at present continues to use its "TAYLOR MADE" mark as well as its "TOUR DRIVER" and "TOUR SPOON" marks. His testimony, however, is conflicting as to whether opposer is still using its "TOUR

CLEEK," "TOUR BURNER" and "TOUR PREFERRED" marks. Specifically, while indicating that opposer's "TOUR CLEEK" and "TOUR PREFERRED" marks "are not in our current product line" and that opposer presently offers irons only under its "BURNER" mark, Mr. Montgomery also stated that "[b]oth the 'Tour Cleek' and the whole wide range of 'Tour Preferred' clubs are still on the market, still in use, and in some cases, still for sale in certain golf shops." (Montgomery dep. at 16.)

Opposer utilizes its marks by applying them to the sole plates and shafts of its golf clubs. Opposer also uses its "TAYLOR MADE" mark in all of its advertising and promotional materials, including print and television ads, displays, catalogs, posters and banners. In particular, Mr. Montgomery characterized opposer as having made use of an "extensive print and television advertising campaign and extensive affiliation with PGA Tour players," although only samples of television commercials were provided. (Id. at 17.) While specific sales figures were not furnished, Mr. Montgomery noted that for 1995 and 1996, opposer spent "a minimum of \$8 million each year" on advertising its "TAYLOR MADE" mark and that, in 1992, opposer's "advertising budget was closer to \$3 million." (Id. at 20.) According to Mr. Montgomery, "[f]or the past several years, Taylor Made has been a heavy advertiser in almost every single golf publication of any size at all" and, since the early 1980s, "has been a consistent advertiser in all the major golf publications using the Taylor Made mark." (Id. at, respectively, 18 and 20.) Independently conducted marketing research studies,

commissioned by opposer in the two years preceding Mr. Montgomery's January 10, 1997 deposition, reveal furthermore that, to both consumers and retailers, "Taylor Made is a premier brand name that's very strong, both in market strength and in quality." (Id. at 26.)

Although opposer "sells high performance golf equipment at premium prices," it markets its products to golfers of all economic levels. (Id. at 21.) Specifically, opposer "sells golf clubs to a wide variety of golfers, ... [including] golfers of all handicaps and all ages and both genders." (Id. at 24-25.) Thus, it is "absolutely true" that opposer is selling its products "to such a wide variety of golfers that we are ... marketing to the same group" as would be customers for applicant's "TOUR MADE" golf equipment. (Id. at 25.) Opposer's products are widely available in the United States and are sold through over 6,000 golf retailers.

The record does not contain any information relating to applicant or his activities.¹²

¹² Although opposer, among other things, introduced two exhibits to represent how applicant could use his "TOUR MADE" mark on a golf club shaft and on a club head, together with testimony that the use shown on the club head "is very similar in location, in size and in color to the way Taylor Made is marked on our golf club heads" (Montgomery dep. at 23), there is nothing in the record which indicates that applicant has in fact commenced use of his mark in any manner. Moreover, while opposer also introduced as an exhibit a copy of what Mr. Montgomery identified as "a letter from the Department of the Treasury, U.S. Customs Service, relating to a seizure of clubs in Anchorage, Alaska in September of 1996" (id. at 26-27) bearing the marks "BALLON SHAFT" and "TOUR MADE," such letter indicates that it is actually a response to a Freedom of Information Act ("FOIA") request initiated by an attorney at opposer's law firm. Applicant, in his brief, has properly objected to consideration of such letter as constituting inadmissible hearsay. Opposer's argument, in its reply brief, that the letter is within the hearsay exception established by Fed. R. Evid. 803(8), which provides in relevant part

Turning, therefore, to the issue of likelihood of confusion, we find upon consideration of the pertinent factors set forth in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973), that confusion as to source or affiliation is likely to occur. As a starting point, we note with respect to the parties' goods that applicant's goods are broadly identified in his application as "golf clubs, golf club shafts, golf club head covers, golf bags and golf gloves". Applicant's goods, as so described, plainly are identical in part and are otherwise closely related to the "golf clubs" set forth in opposer's registrations. Applicant, in fact, concedes in his brief that "it can be assumed that the goods of the parties are the same, that the channels of trade are the same, and that the circumstances under which the goods are purchased are the same." Likewise, we observe, the classes of purchasers would also be identical. It consequently is clear that, if such identical or closely related items of golf equipment were to be sold under the same or similar marks, confusion as to the origin or affiliation thereof would be likely to occur.

Applicant contends, however, that when considered in their entirety, his "TOUR MADE" mark "is not confusingly

for the admissibility of "[r]ecords, reports, statements, or data compilations, in any form, of public offices or agencies, setting forth ... in civil actions and proceedings ..., factual findings resulting from an investigation made pursuant to authority granted by law, unless the sources of information or other circumstances indicate lack of trustworthiness," is not persuasive. The letter, being a FOIA response, does not appear to fall within the purview of the hearsay exception relied upon by opposer and, in any event, there is no indication as to the circumstances under which the U.S. Customs Service made the asserted seizure. Accordingly, such letter has not been given further consideration.

similar to the Opposer's TAYLOR MADE mark nor to any of the Opposer's TOUR[-]formative marks as applied to golf clubs and golf related equipment." In particular, applicant asserts that his "TOUR MADE" mark neither sounds nor looks like opposer's "TAYLOR MADE" mark and that such marks engender significantly different commercial impressions, since the former "gives the commercial impression of making a journey or fulfilling a round of engagements, such as a series of golf competitions," while the latter projects "the commercial impression ... that the product is made by an entity named TAYLOR, or that the goods are custom made, e.g., 'tailor made.'"

Although, concededly, differences are apparent upon a side-by-side comparison of applicant's mark with each of opposer's marks,¹³ our principal reviewing court has nevertheless pointed out that, as a general proposition, "[w]hen marks would appear on virtually identical goods ..., 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). Considering the respective marks in their entirety, and with due regard to the

¹³ A side-by-side comparison, however, is not the proper test to be used in determining the issue of likelihood of confusion since it is not the ordinary way that consumers will be exposed to the marks. Rather, it is the similarity of the general overall commercial impression engendered by the marks which must determine, due to the fallibility of memory and the consequent lack of perfect recall, whether confusion as to source or sponsorship is likely. The proper emphasis is thus on the recollection of the average purchaser, who normally retains a general rather than a specific impression of trademarks or service marks. *See, e.g., In re United Service Distributors, Inc.*, 229 USPQ 237, 239 (TTAB 1986); and *In re Solar Energy Corp.*, 217 USPQ 743, 745 (TTAB 1983).

fallibility of consumers' recollection of marks, it is apparent that applicant's "TOUR MADE" mark structurally is similar in sight and sound to opposer's "TAYLOR MADE" mark, in that both marks feature the word "MADE" preceded by a term beginning with the letter "T," and is also aurally and visually similar in structure to each of opposer's "TOUR"-formative marks, due to the presence of the shared word "TOUR". More importantly, as opposer points out, "there is no evidence in the record of any other mark in the golf industry which uses [the term 'MADE']" nor, we observe, is there likewise any evidence of record showing that others in the golf field utilize marks which incorporate the word "TOUR". When used in connection with golf clubs, applicant's "TOUR MADE" mark on the whole is thus quite similar in sound, appearance and commercial impression to opposer's "TAYLOR MADE" mark and to each of its "TOUR"-formative marks.

Additionally, while we cannot agree with opposer that, on this record, its "TAYLOR MADE" mark is a famous mark, opposer has sufficiently established that it has appreciably promoted such mark by advertising its products, since at least the early 1980s, in publications directed to those interested in the sport of golf; running television commercials featuring the mark; and expending approximately \$3 million in 1993 and a minimum of \$8 million in 1995 and 1996 to advertise its products under its "TAYLOR MADE" mark. Furthermore, while devoid of actual sales figures, the record nevertheless reveals that opposer currently commands second place in terms of the market size of its sales; its products are widely available through over 6,000 retailers in

the United States; and recent independently conducted marketing research studies have shown that the mark "TAYLOR MADE" is one of the premier brand names in the golf industry. In view thereof, such mark must be considered to be relatively well known and, having achieved a measure of strength and recognition as an indication of source and quality of product, is correspondingly entitled to a broader scope of protection.

Applicant further asserts, however, that confusion is not likely to occur because careful consideration is typically involved in the purchase of golf clubs and other golf equipment. Specifically, applicant contends that because opposer's "TAYLOR MADE" golf clubs are a premier brand and are sold at premium prices, the products "are expensive and [would be] purchased by a discriminating purchaser." Such facts, applicant maintains, "weigh against any likelihood of confusion with Applicant's TOUR MADE clubs." While admittedly, it appears from the record that the purchase of golf clubs typically is not inexpensive and thus is not an impulsive transaction subject to relatively little care, that many golfers may arguably be knowledgeable and discriminating consumers when it comes to selecting their golf clubs or other items of relatively expensive golf equipment does not mean that they necessarily are highly sophisticated or otherwise knowledgeable in the field of trademarks or that they are immune from confusion as to source or sponsorship. See, e.g., *Wincharger Corp. v. Rinco, Inc.*, 297 F.2d 261, 132 USPQ 289, 292 (CCPA 1962); *In re Decombe*, 9 USPQ2d 1812, 1814-15 (TTAB

1988); and In re Pellerin Milnor Corp., 221 USPQ 558, 560 (TTAB 1983).

Furthermore, and in any event, we note that even if buyers and prospective purchasers of golf clubs were to notice the differences between applicant's "TOUR MADE" mark and either opposer's "TAYLOR MADE" mark or any of its "TOUR"-formative marks, they could still reasonably assume, due to the overall similarities in sound, appearance and commercial impression in the respective marks, that applicant's "TOUR MADE" goods constitute a new or additional product line from the same source as the "TAYLOR MADE," "TOUR SPOON," "TOUR DRIVER," "TOUR BURNER," "TOUR CLEEK" and/or "TOUR PREFERRED" golf clubs with which they are acquainted or familiar. Especially, to those knowing of opposer's "TAYLOR MADE" house mark and who also are aware of, for example, its use of its "TOUR DRIVER" or "TOUR SPOON" marks for golf clubs, it would be reasonable to believe, upon encountering applicant's similar "TOUR MADE" mark for golf clubs and other golf equipment, that such items are a separate or expanded line of goods emanating from or sponsored by opposer.

Decision: The opposition is sustained and registration to applicant is refused.

R. F. Cissel

T. J. Quinn

G. D. Hohein

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Administrative Trademark Judges,
Trademark Trial and Appeal Board