

THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT
OF THE TTAB

Mailed: November 10, 2004

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Head Sport AG

v.

Dennis W. Ross

Opposition No. 91155623
to application Serial No. 76387413
filed on March 25, 2002

David M. Kelly of Finnegan, Henderson, Farabow, Garrett and
Dunner for Head Sport AG.

Dennis W. Ross, pro se.

Before Hanak, Quinn and Drost, Administrative Trademark
Judges.

Opinion by Hanak, Administrative Trademark Judge:

Dennis W. Ross (applicant) seeks to register in typed
drawing form HED GOLF for "golf clubs." The intent-to-use
application was filed on March 25, 2002. At the request of

the Examining Attorney, applicant agreed to disclaim what the Examining Attorney referred to as "the descriptive portion of [applicant's] mark," namely, the word GOLF.

Head Sport AG (opposer) filed a timely Notice of Opposition in which opposer alleged that since long before March 25, 2002, opposer both registered and extensively used its mark HEAD for a wide variety of sporting equipment and other goods, including in particular golf clubs. Continuing, opposer alleged that "in view of the similarity of the parties' marks and the identical and/or closely related nature of the parties' goods," the use of applicant's mark HED GOLF is likely to cause confusion with opposer's HEAD mark. In addition, opposer alleged that the use of applicant's mark HED GOLF is likely to dilute the distinctive quality of opposer's famous mark HEAD. (Notice of Opposition paragraphs 8 and 9). In particular, opposer made the following allegation in paragraph 6 of the Notice of Opposition: "Moreover, Opposer's HEAD mark became famous well prior to the filing date of Application No. 76/387,413."

In its answer, applicant stated that it had "no opinion" as to whether the use of his mark HED GOLF would be likely to cause confusion with or to dilute the distinctive quality of opposer's HEAD mark. However,

applicant did concede that the allegations set forth in paragraphs 1, 3, 4, 5, 6 and 7 of the Notice of Opposition were "true." Thus, applicant has conceded that prior to his application filing date, opposer had both used and registered HEAD for a wide array of goods including golf clubs. Furthermore, applicant conceded as "true" that opposer's mark HEAD had become famous prior to March 25, 2002, applicant's Intent-to-Use filing date.

Opposer and applicant have filed briefs. Neither party requested a hearing. The record in this case is set forth at pages 3-5 of opposer's brief. In particular, opposer notes at page 5 of its brief that "applicant has taken no testimony and has offered no evidence." In his brief, applicant does not challenge opposer's description of the record and in particular, applicant acknowledges at page 1 of his brief that he "did not submit any testimony to the Board." Moreover, the record reflects that applicant did not submit any other evidence.

We note that opposer has properly made of record by means of a Notice of Reliance various of its registrations for the mark HEAD. One registration is particularly pertinent in this proceeding in that it depicts opposer's mark HEAD in typed drawing form, and the goods are "golf clubs and golf bags." Registration No. 1,762,980. Thus,

priority is not an issue in this proceeding in that it rests with opposer, and applicant has in his answer conceded this fact.

We will consider first opposer's likelihood of confusion claim pursuant to Section 2(d) of the Trademark Act. In any likelihood of confusion analysis, two key, although not exclusive, considerations are the similarities of the marks and the similarities of the goods. Federated Foods, Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976) ("The fundamental inquiry mandated by the Section 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks.").

Considering first the goods, while opposer has registered its mark HEAD for a wide array of goods, we will focus our likelihood of confusion analysis simply upon the goods set forth in opposer's Registration No. 1,762,980 because such goods encompass, besides golf bags, golf clubs, the very goods for which applicant seeks to register his mark HED GOLF. In other words, because opposer enjoys superior rights in its mark HEAD for the identical goods for which applicant seeks to register HED GOLF, there is no point in considering the other goods for which opposer has registered its mark HEAD. In an effort to distinguish his

golf clubs from opposer's golf clubs, applicant makes the following argument at page 2 of his brief: "The applicant's product is a specialized golf club, a putter, with unique special guidelines and specifications set forth by the United States Golf Association."

Applicant's argument is misplaced. Opposer's Registration No. 1,762,980 includes, besides golf bags, "golf clubs," a term broad enough to encompass golf clubs of all types including putters. Thus, for the purposes of this Board proceeding, the goods of the parties are absolutely identical. See Canadian Imperial Bank v. Wells Fargo Bank, 811 F.2d 1490, 1 USPQ2d 1813, 1815 (Fed. Cir. 1987)(It is well settled that in Board proceedings, "the question of likelihood of confusion must be determined based on an analysis of the mark as applied to the goods and/or services recited in applicant's application vis-à-vis the goods and/or services recited in opposer's registration, rather than what the evidence shows the goods and/or services to be.").

Turning to a consideration of the marks, we note at the outset when the goods of the parties are legally identical as is the case here, "the degree of similarity [of the marks] 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 considering the marks, we recognize that we are obligated to compare the marks "in their entirety." In re National Data Corp., 753 F.2d 1056, 224 USPQ 749, 750 (Fed. Cir. 1985). However, in comparing the marks in their entirety, it is completely appropriate to give less weight to a portion of a mark that is merely descriptive of the relevant goods or services. National Data, 224 USPQ at 751 ("That a particular feature is descriptive ... with respect to the relevant goods or services is one commonly accepted rationale for giving less weight to a portion of the mark."). As previously noted, in response to the Examining Attorney, applicant conceded that the GOLF portion of its mark is, at a minimum, merely descriptive of its goods, golf clubs. Indeed, we find that the word "golf" as applied to golf clubs is at the very least extremely descriptive of golf clubs.

In addition, we note that applicant seeks to register his mark HED GOLF in typed drawing form. Of course, opposer's mark HEAD is likewise registered in typed drawing form for golf clubs. This means that applicant's mark is not limited to being "depicted in any special form," and hence we are mandated to "visualize what other forms the

mark might appear in." Phillips Petroleum Co. v. C.J. Webb Inc., 442 F.2d 1376, 170 USPQ 35, 36 (CCPA 1971). See also INB National Bank v. Metrohost Inc., 22 USPQ2d 1585, 1588 (TTAB 1992).

If applicant were to obtain a typed drawing registration of his mark HED GOLF for golf clubs, then he would be free to depict the HED portion of his mark in large lettering on one line, and depict the extremely descriptive GOLF portion of his mark on a second line in far smaller lettering. As so depicted, applicant's mark would be highly similar in terms of visual appearance to opposer's mark HEAD. Indeed, given the extremely descriptive nature of the GOLF portion of applicant's mark, if applicant's mark were used on golf clubs in a manner in which the HED portion of applicant's mark were depicted on one line in extremely larger lettering and the GOLF portion of applicant's mark were depicted on a second line in far smaller lettering, consumers of golf clubs may well not even notice the GOLF portion of applicant's mark. Even if the consumers did notice, they could well assume that HED per se was the "trademark" and that the word GOLF depicted in far smaller lettering merely indicated the obvious, namely, that the goods were golf clubs.

In sum, when taking into consideration the teachings of Phillips Petroleum, we find that the two marks are, at a minimum, extremely similar in terms of visual appearance. While opposer's mark HEAD consists of four letters, and the source-identifying portion of applicant's mark (HED) consists of three letters, the presence of one additional internal letter could easily be overlooked.

In terms of pronunciation, we find that opposer's mark HEAD and the source-identifying portion of applicant's mark (HED) are phonetically identical. In this regard, we note that in his brief applicant has not even articulated how HED might be pronounced other than as the word "head." Of course, it must be remembered that there is no correct pronunciation of a trademark. In re Belgrade Shoe Co., 411 F.2d 1352, 162 USPQ 227 (CCPA 1969). In sum, we find that opposer's mark and the source-identifying feature of applicant's mark are phonetically identical.

Finally, in terms of connotation, we find that as applied to golf clubs, both marks have the same connotation in that they bring to mind the "head" of a golf club.

In concluding our Section 2(d) likelihood of confusion analysis, we find that there clearly exists a likelihood of confusion given the fact that opposer's goods and applicant's goods are identical, and the additional fact

that the two marks are, at a minimum, extremely similar in terms of visual appearance, pronunciation and connotation. Accordingly, we sustain the opposition on the basis that applicant's possible use of HED GOLF for golf clubs is likely to cause confusion with opposer's mark HEAD for golf clubs.

We make this finding regardless of whether or not opposer's mark HEAD is famous for golf clubs. While applicant, as previously noted, admitted the allegation of paragraph 6 of the Notice of Opposition, said paragraph merely alleges that "opposer's HEAD mark became famous well prior to" applicant's filing date. Thus, applicant did not admit that opposer's mark HEAD was famous, in particular, for golf clubs. Moreover, opposer has not otherwise established that its mark HEAD is famous for golf clubs or for that matter, any type of product.

Having sustained the opposition pursuant to opposer's Section 2(d) claim of likelihood of confusion, we elect not to consider opposer's claim that applicant's use of HED GOLF is "likely to dilute the distinctive quality of opposer's mark." (Notice of Opposition paragraph 9).

Decision: The opposition is sustained solely pursuant to opposer's Section 2(d) likelihood of confusion claim.