

This is in response to the Office Action dated March 7, 2019, in which the Examining Attorney preliminarily refused registration on the basis of a likelihood of confusion with the mark shown in Reg. No. 3,987,006, RIPTIDE & Design for “*Amusement products, namely inflatable balls; Athletic equipment, namely guards for wrist, elbow; Boards used in the practice of water sports; Body boards; Children’s multiple activity toys; Hockey gloves; Hockey goals; Hockey pucks; Hockey sticks; Ice skate blades; Ice skates; In-line roller skates; In-line skates; Kites; Knee pads for athletic use; Roller skates; Skateboard decks; Skateboard wheels; Skateboards; Skating boots exclusively for use with attached skating blades; Skating boots with skates attached; Snowboards; Surfboards; Swim fins; Swimming boards; Swimming flippers.*” Applicant respectfully disagrees and in light of the comments below, requests that the Examining Attorney reconsider and withdraw the refusal.

In the instant case, the goods are issue are not sufficiently related or marketed in a manner likely to lead to confusion. In other words, the parties’ goods will not be encountered under circumstances leading to a likelihood of confusion. Initially, the Examining Attorney is reminded that Applicant’s goods are golf club *shafts*. These are not golf clubs or sets of golf clubs of the sort found in general sporting goods stores. Applicant’s golf club shafts are component parts of golf clubs, which consist of a club head, shaft, and grip.

Additionally, as evidence that the parties’ goods are related, the Examining Attorney submitted evidence from three online retailers. Only two of these retailers sell goods like Applicant’s (that is, golf club *shafts*). Consequently, the refusal rests on evidence consisting of one third party website.

Significant Differences in Goods

In the Office Action, the Examining Attorney relies on excerpts from third party websites—in particular, excerpts from the websites of three large, general sporting goods retailers—as evidence that “the same entities commonly provide the relevant goods and market the goods under the same mark, the relevant goods are sold and provided through the same trade channels and used by the same classes of consumers in the same fields of use and the goods are similar and complementary in terms of purposes and function.” While the excerpts from Dick’s Sporting Goods do at least show that Dick’s sells golf club shafts, the evidence from Academy and Wilson are irrelevant: neither sells golf clubs shafts.

The link to Academy shows results for a search for “golf club shafts.” None of the goods are golf club shafts. The results are golf clubs, club sets, head covers, umbrellas, etc. Academy does not sell golf club shafts.

The link to Wilson shows complete golf club sets. This is to be expected, as Wilson sells clubs, sets of clubs, bags, and golf balls. Wilson does not sell golf club shafts.

Accordingly, the only relevant evidence that Applicant’s goods are meaningfully related to Registrant’s are links to Dick’s. This is not sufficient and will be discussed in detail below. Applicant respectfully asserts that there is little likelihood of confusion between its goods (*i.e.*,

golf club shafts) and those of the Registrant. As the Examining Attorney is aware, the mere possibility that there might be confusion is not a sufficient basis for a Section 2(d) refusal. Instead, “likelihood of confusion is synonymous with a probability of confusion, which is *more* than a mere possibility of confusion.” *Elvis Presley Enters. Inc. v. Capece*, 141 F.3d 188, 193, 46 USPQ2d 1737 (5th Cir. 1998 (emphasis added)). Applicant’s mark is not likely to cause confusion as to the source of goods. Applicant’s goods are distinct, priced differently, and sold to different groups of purchasers in different channels of commerce than those of the Registrant.

The mere fact that goods or services may belong to the same general class is not sufficient to establish that they are related for purposes of a likelihood of confusion determination. *Cooper Indus, Inc. v. Repcoparts USA, Inc.*, 218 USPQ 81 (TTAB 1983). Rather, the goods in question must be related in a viable manner and marketed in a way that is likely to lead to purchaser confusion. *Merritt Foods v. Assoc. Citrus Packers, Inc.*, 222 USPQ 255, 256 (TTAB 1984). That is, while it is true that the goods and services need not be identical or directly competitive to find a likelihood of confusion, the Examining Attorney must nevertheless establish that *the goods are related in such a manner that they would be encountered by the same persons in situations that would create the incorrect assumption that they originate from the same source.* See, e.g., *Local Trademarks, Inc. v. Handy Boys Inc.*, 16 USPQ2d 1156 (TTAB 1990); *Quartz Radiation Corp. v. Comm/Scope Co.*, 1 USPQ2d 1668 (TTAB 1986).

a) The Goods are Different

Applicant’s mark is not likely to lead to source confusion with the cited mark because Applicant’s goods are not related to Registrants goods in a meaningful way. The mere fact that goods or services may belong to the same general class is not sufficient to establish that they are related for purposes of a likelihood of confusion determination. *Cooper Ind., Inc. v. Repcoparts USA, Inc.*, 218 USPA 81 (TTAB 1983).

Applicant goods are limited to “golf club *shafts*,” which are component parts of golf clubs. In contrast, Registrant’s goods include general sporting goods articles, and do not claim any golf-related products. Registrant’s list of goods also lacks other component parts such as sticks or shafts (for example, hockey sticks or shafts). Registrant sells finished products that are ready to use.

As Applicant has noted, its golf club shafts are component parts of golf clubs. There are basically two ways to buy golf clubs: as standard, completed clubs generally sold by size (consisting of a shaft, club head, and grip) or as custom clubs, in which the golfer selects and is fitted for a type of shaft/club head/ grip, the shaft is cut to the golfer’s specification, and the club is built. The club may be built by a specialty fitter (as affiliated with golfing stores and pro shops) or by golf enthusiasts who build their clubs at home. Applicant has attached information detailing how golf clubs are built using component parts: a shaft, club head, and grip:

Guides and videos abound on sites like Golfworks.com and Hireko.com on how to cut a shaft to the proper length, how to use the right amount of solvent to slide a grip over an extra wrap of double-sided tape, how to line up a ferrule flush against

a clubhead. But attention to detail is as mandatory as breathing. Any mistake, and you'll likely be starting over.

Consequently, Applicant's goods are not immediately useful off the shelf; they require a home workshop or a professional in order to incorporate the shafts into a finished club.

To the extent that a sporting goods store like Dick's sells Applicant's golf club shafts, they are located in the golf section of the store, and are sold to enthusiasts who build their own clubs. Upon information and belief, Dick's does not offer specialty, custom golf club fitting and building services. Consequently, there is no way to purchase Applicant's component parts and arrange for the entire club to be built by Dick's.

Therefore, while the Examining Attorney has submitted evidence of three websites, only one is relevant (Dick's) and its relevance to the likelihood of confusion inquiry must be weighed against factors relevant to: (1) Applicant's specialized goods (golf club shafts), (2) the further work required to finish the product (golf clubs), and (3) that these are not finished products like Registrant's.

Accordingly, Applicant's goods are distinct from Registrant's general purpose, ready to use sporting goods articles.

b) The Goods are Sold in Different Channels of Commerce

The Examining Attorney correctly notes that compared goods do not need to be identical or even competitive to find likelihood of confusion and only need to be related in some manner and/or if the circumstances surrounding their marketing are such that they could give rise to the mistaken belief that the goods emanate from the same source. While the Examining Attorney attaches website evidence of single companies—large, sporting goods retailers Dicks Sporting Goods, Academy, and Wilson (of which only the first even sells goods like Applicant's)—that sell all types of general sporting goods, the Examining Attorney is reminded that this is not the inquiry for likelihood of confusion purposes. The inquiry is not whether some companies sell the same goods and two of the three do not, but whether such entities sell the same goods under the same trademark, and whether the goods are marketed in such a way that confusion is likely.

The golf industry is a discrete market within the larger category of sporting goods. While customers can walk into sporting goods stores and buy the same basketballs, baseballs, baseball gloves, etc. used by professional players, this is not the case for golf. First, a lot of equipment is required to play golf, and second, that equipment is usually custom. "According to the USGA [United States Golf Association], a golfer is allowed to have 14 clubs in his bag. This may include three woods (driver, 3-wood and 5-wood), eight irons, (3-9 iron and pitching wedge), and putter. These are the standard 12 clubs in many golf bags." (Attached). Each club serves a different purpose, in terms of type of shot and how far the ball will go, from drivers meant to hit a club more than 100 yards through the air, to putters meant for roll a ball along short grass. And then, each one of those 12+ clubs is likely specific to that golfer, with much of that variance due to the golf shafts themselves (in terms of material, rigidity, etc.).

Moreover, anyone purchasing component golf club products like Applicant's is an OEM manufacturer of golf clubs, a player using a custom fitter to build clubs, or an enthusiast building their own clubs at home.

Therefore, while it is possible to find Applicant's golf shafts in at least one general sporting goods store like Dick's, the conditions surrounding the sale of the parties' goods are different, and they are marketed to different types of customers than Registrant's, who are able to buy a product off the shelf and use it immediately.

c) Applicant's Goods are Part of Expensive Sets

Applicant's goods are also expensive, as they are part of larger sets. When goods are expensive, purchasers use more care and are less likely to be confused. As described above, one golf club shaft or even one completed golf club are not going to do a player much good. While Applicant True Temper Sports is a global leader in golf shaft technology, in marked contrast, Registrant appears to sell general purpose sporting goods like skateboards geared towards younger users. The costs of these items are different. Customers purchasing Applicant's golf shafts (or, frankly, any customer buying golf *shafts* rather than completed clubs) are invested in the sport and are also purchasing or have purchased 11+ other clubs and components and a bag. This will cost hundreds to thousands of dollars. As the Examining Attorney is aware, the courts have held that "other things being equal, confusion is less likely where goods are expensive and are purchased after consideration than where they are purchased casually." *Magnaflux Corp. v. Sonoflux Corp.*, 109 U.S.P.Q. 313 (C.C.P.A. 1956).

CONCLUSION

The Trademark Trial and Appeal Board has stated, "[w]e are not concerned with mere theoretical possibilities of confusion, deception, or mistake or with de minimis situations, but with the practicalities of the commercial world with which the trademark law deal." *MTD Prod. Inc. v. Universal Tire Corp.*, 193 USPQ 56 (TTAB 1976) (quoting *Witco Chem. Co. v. Whitfield Chem. Co.*, 164 USPQ 43 (CCPA 1969)). Applicant maintains that the instant refusal, based on evidence from only one store, asserts a mere theoretical possibility of confusion and should be withdrawn.

In light of the above arguments and evidence of record, Applicant asserts that the Examining Attorney has not meet the initial evidentiary burden to establish a likelihood of confusion and even assuming *arguendo* that the Examining Attorney has met this burden, clear differences in the parties' goods, channels of commerce, and price points obviates any potential confusion. Reconsideration and withdrawal of the Section 2(d) Refusal is therefore respectfully requested.