

### **OFFICE ACTION RESPONSE**

Applicant's mark is **GHOST GOLF** (standard characters), U.S. Trademark Application Serial No. 88/924,265, for use in connection with: "Golf accessories, namely, carriers and dispensers for golf balls; Golf bags; Golf balls; Golf club covers; Golf divot repair tools; Golf putter covers; Golf tees" in International Class 28 ("Applicant's Mark"). Registration of Applicant's Mark has been refused in part under Section 2(d) based on a finding of likelihood of confusion with Reg. No. 4,025,990 for the mark **GHOST** (standard characters) for use in connection with "golf clubs" in International Class 28 (the "Cited Mark").

Applicant respectfully disagrees with the Examining Attorney's finding of a likelihood of confusion and submits this response in support of registration.

### **THE MARKS ARE NOT SIMILAR**

The Examining Attorney found Applicant's Mark is likely to cause confusion with the Cited Mark because both marks "begin with the identical wording **GHOST**". Applicant respectfully disagrees.

In the likelihood of confusion analysis, the marks are compared for similarities in their appearance, sound, meaning and commercial impression. TMEP §§1207.01, 1207.01(b). When comparing compound word marks which share a literal element, the addition or deletion of other matter in the marks may be sufficient to avoid a likelihood of confusion if the marks in their entireties convey significantly different commercial impressions. TMEP §1207.01(b)(iii); *see Bass Pro Trademarks, L.L.C. v. Sportsman's Warehouse, Inc.*, 89 USPQ2d 1844, 1857-58 (TTAB 2008) (finding that, although petitioner's and respondent's marks were similar by virtue of the shared descriptive wording "SPORTSMAN'S WAREHOUSE," this similarity was outweighed by differences in terms of sound, appearance, connotation, and commercial impression created by other matter and stylization in the respective marks); *In re Farm Fresh Catfish Co.*, 231 USPQ 495, 495-96 (TTAB 1986) (holding CATFISH BOBBERS (with "CATFISH" disclaimed) for fish, and BOBBER for restaurant goods, not likely to cause confusion, because the word "BOBBER" has different connotation when used in connection with the respective goods and goods); *See, e.g., Shen Manufacturing Co. v. Ritz Hotel Ltd.*, 393 F.3d 1238, 73 USPQ2d 1350 (Fed. Cir. 2004) (RITZ and THE RITZ KIDS create different commercial impressions); *In re Shawnee Milling Co.*, 225 USPQ 747 (TTAB 1985) (GOLDEN CRUST for flour held not likely to be confused with ADOLPH'S GOLD'N CRUST and design

(with “GOLD’N CRUST” disclaimed) for coating and seasoning for food items); *In re S.D. Fabrics, Inc.*, 223 USPQ 54 (TTAB 1984) (DESIGNERS/FABRIC (stylized) for retail fabric store goods held not likely to be confused with DAN RIVER DESIGNER FABRICS and design for textile fabrics).

First, the meaning and commercial impression of the marks are completely different when the marks are properly analyzed in the context of their respective goods. *See, e.g., In re British Bulldog, Ltd.*, 224 USPQ 854 (TTAB 1984) (PLAYERS for men’s underwear held not likely to be confused with PLAYERS for shoes, the Board finding that the term PLAYERS implies a fit, style, color and durability adapted to outdoor activities when applied to shoes, but “implies something else, primarily indoors in nature” when applied to men’s underwear); *In re Sydel Lingerie Co., Inc.*, 197 USPQ 629 (TTAB 1977) (BOTTOMS UP for ladies’ and children’s underwear held not likely to be confused with BOTTOMS UP for men’s clothing, the Board finding that the term connotes the drinking phrase “Drink Up” when applied to men’s suits, coats and trousers, but does not have this connotation when applied to ladies’ and children’s underwear).

The term “GHOST GOLF” in Applicant’s Mark clearly distinguishes the mark in meaning and commercial impression from the term “GHOST” in the Cited Mark as the Applicant’s Mark is clearly meant to used in connection with a wide range of golf-related accessories and products (such as balls, club covers, tees, etc.) to create an entire golf lifestyle brand that is associated with the mark, while the Registrant clearly only uses the Cited Mark specifically in connection with golf clubs (even more specifically, putters). Further, based on the specimens of record, the Registrant only uses the mark in connection with other terms for the putters (such as Ghost Manta, Ghost Tour) and none of the specimens of record show the mark used in connection with anything other than golf putters and make no reference to any other golf-related accessories or products or golf lifestyle. Based on the specimens of record, the registrant clearly uses the mark as a very small subset of the overall TAYLOR MADE brand and does not intend for the mark to be used in a way that is associated with a broader golf lifestyle. Simply put, consumers will not attribute the same meanings to the marks and will not confuse them for at least this reason.

Further, the registrant’s use of “GHOST” in connection with putters gives the meaning and commercial impression that the putter helps the golfer move and place the ball where he

would like to on the putting green with precision as if an actual ghost were assisting the golfer. The Applicant's Mark has no such commercial impression and is merely intended to be a fanciful and fun term to be associated with the game of golf. Finally, golfers are not likely to make their purchase of a putter due to the use and association of the word "GHOST" in connection with it, but will make their purchasing decision based on their faith in the goodwill of the registrant's overarching Taylor Made brand, while the Applicant is attempting to establish an entire "GHOST GOLF" brand that encompasses several different golf-related accessories and products in connection with a golf lifestyle. Thus, the marks are completely different in meaning and overall commercial impression.

Second, the marks are markedly different in appearance. The Applicant's Mark GHOST GOLF contains the word "GOLF" while the Cited Mark "GHOST" does not. The marks are therefore different in appearance.

Last, the marks are different in sound because the Applicant's Mark GHOST GOLF contains the word "GOLF" while the Cited Mark "GHOST" does not. Applicant's Mark is two words consisting of two (2) syllables, while the Cited Mark is one word consisting of one (1) syllable. The marks are therefore different in appearance.

Overall, when the differences between the marks are considered and are afforded the proper analysis, the marks are significantly different in appearance, sound, meaning, and commercial impression, weighing heavily against a finding of a likelihood of confusion.

### **THE GOODS ARE NOT RELATED**

The Examining Attorney found that "applicant's and registrant's goods are considered related for likelihood of confusion purposes." Applicant respectfully disagrees.

The Examining Attorney must provide evidence showing that the goods are related to support a finding of likelihood of confusion. *See, e.g., In re White Rock Distilleries Inc.*, 92 USPQ2d 1282, 1285 (TTAB 2009). The relatedness of goods or goods may not be assumed, and the Examining Attorney must show "something more" than that different goods or goods are in the same environment or trade channels to demonstrate that the goods are sufficiently related to weigh in favor of a finding of likelihood of confusion. *See In re Coors Brewing Co.*, 343 F.3d 1340, 1345, 68 USPQ2d 1059, 1063 (Fed. Cir. 2003) (quoting *Jacobs v. Int'l Multifoods Corp.*, 668 F.2d 1234, 1236, 212 USPQ 641, 642 (C.C.P.A. 1982)); *see also In re Giovanni Food Co.*, 97 USPQ2d 1990, 1991 (TTAB 2011).

Here, Applicant is in the business of selling several different golf-related accessories and products which is completely different from Registrant's very specific golf putters as shown in its specimens of record, and there is no evidence in the record showing these goods are related. The target audiences and channels of trade for the goods associated with each mark are completely different, as golfers in the market for a specific putter are going to be looking in very different places than they would for other various golf-related accessories and products. Further, golfers are not likely to make their purchase of a putter due to the use and association of the word "GHOST" in connection with it, but will make their purchasing decision based on their faith in the goodwill of the registrant's overarching Taylor Made brand, while the Applicant is attempting to establish an entire "GHOST GOLF" brand that encompasses several different golf-related accessories and products in connection with a golf lifestyle.

Overall, in view of the differences between the marks and the goods, the marks are significantly different in appearance, sound, meaning, and commercial impression, weighing heavily against a finding of a likelihood of confusion.

#### **CONCLUSION**

Based on the foregoing, Applicant's Mark is not likely to cause confusion with the Cited Marks. WHEREFORE, Applicant respectfully requests that the Section 2(d) refusal be withdrawn and that Applicant's Mark be published for opposition.