

8/9/01

**THIS DISPOSITION
IS NOT CITABLE AS PRECEDENT
OF THE T.T.A.B.**

Paper No. 15
TJQ

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re **Callaway Golf Company**

Serial No. 75/389,003

Michael A. Catania for applicant.

Jeffery C. Coward, Trademark Examining Attorney, Law Office
106 (Mary I. Sparrow, Managing Attorney).

Before Hanak, Quinn and Wendel, Administrative Trademark
Judges.

Opinion by Quinn, Administrative Trademark Judge:

An application was filed by Callaway Golf Company to register the term STEELHEAD for "golf clubs."¹ Applicant claims, pursuant to Section 2(f) of the Trademark Act, that its mark has acquired distinctiveness.

The Trademark Examining Attorney has refused

¹ Application Serial No. 75/389,003, filed November 12, 1997, based on an allegation of a bona fide intention to use the mark in commerce. Applicant subsequently filed an amendment to allege use setting forth first use dates of August 12, 1998.

registration under Section 2(e)(1) of the Trademark Act on the ground that STEELHEAD, when used on golf clubs, is generic and, thus, incapable of functioning as a source identifying mark. The Examining Attorney further contends that even if the term STEELHEAD is found not to be generic, it is merely descriptive and the evidence of acquired distinctiveness is insufficient to support registration on the Principal Register.

When the refusal was made final, applicant appealed. Applicant and the Examining Attorney submitted briefs. An oral hearing was not requested.

The Examining Attorney maintains that the term sought to be registered is generic. More specifically, the Examining Attorney asserts that the term is the name of a type or category of golf club, namely a golf club with a head made of steel (that is, according to the Examining Attorney, a "steel head"). In support of the refusal, the Examining Attorney submitted excerpts from printed publications in the golf equipment field; and excerpts of articles retrieved from the NEXIS database showing uses of "steel head" (and variations thereof), "titanium head" and "metal head" in connection with golf clubs.

Applicant argues that the term STEELHEAD is not generic, but rather is no more than just merely

descriptive, and that the term has acquired distinctiveness when used in connection with its golf clubs. Applicant asserts that consumers associate the term with applicant, and that competitors do not need to use the term to describe their golf clubs. To show that STEELHEAD is recognized as a trademark rather than a generic name, applicant commissioned a survey, the results of which are of record. In connection with its claim of acquired distinctiveness, applicant submitted sales and advertising figures covering use of the mark since August 11, 1998; examples of promotional efforts, including trade show appearances, catalogs, and brochures; two dealer declarations;² and examples of unsolicited publicity regarding golf clubs marketed under the term STEELHEAD.

The record reveals that new technology and new ideas continue to change the equipment with which golf is played. The Examining Attorney submitted an excerpt from the book *David Graham's Guide to Golf Equipment* (1993), wherein this professional golfer summed up golf clubhead materials as follows:

Golf equipment comes in a bewildering array of shapes and materials providing golfers of all abilities with the club that is right

² Although applicant refers to "several executed Dealer declarations," only two are in the record.

for them, while making selection more difficult. The quest for more distance off the tee in particular has led manufacturers to experiment with new materials for clubheads, although classic woods are still used today.

Among the most popular woods are those now made of steel. Graphite is increasingly being used, titanium has emerged and there are even some ceramic- and plastic-headed woods about.

With these new materials comes a variety of clubhead designs because, as opposed to wood, weight distribution can be varied enormously.

Also of record is an "Equipment Glossary" found in *Golf Illustrated* (February 1993) which defines the term "clubhead" as "the component of a club that is attached to the shaft and contacts the ball" and "steel" as "a popular material for making iron and metal wood heads, and also shafts."

The Examining Attorney also introduced 30 excerpts of articles retrieved from the NEXIS database which, according to the Examining Attorney, are representative of the 420 stories identified by his search for uses of "steel head" in the golf field. Examples of the stories highlighted by the Examining Attorney include the following:

According to Liquidmetal research, only 40 percent of the impact is transferred by steel-head clubs. Titanium

transfers 60 percent of the impact energy.

The Tampa Tribune, April 1, 1999

Suggested retail price for the steel-head clubs (with steel shafts) is \$679 per set.

The Palm Beach Post, February 3, 1999

"We're seeing a lot of our customers going to the smaller sizes and the steel heads."

Asheville Citizen-Times (Asheville, NC), December 18, 1998

John Daly junks titanium woods, opts for steel head.

The Denver Post, August 17, 1998

Lockenvitz said he sold only a half-dozen titanium drivers so far compared with "hundreds" of steel-headed clubs.

The Houston Chronicle, March 3, 1996

Four of the other articles include references to golf clubs made by applicant, although the references are to "steel head" in small letters.

Also of record are other representative NEXIS excerpts which show, according to the Examining Attorney, that "golf clubs are routinely classified and referred to by the material composition of their club heads." (Office action, April 21, 2000, p. 2) The articles show uses of "titanium head club," "titanium-headed club," "metal head club," and "metal-headed club."

On the other side of the ledger is applicant's evidence submitted in support of its claim that the term STEELHEAD is a source indicator functioning to identify golf clubs originating from applicant. The evidence is in the form of numerous exhibits, but no declaration or affidavit accompanied them.³

As indicated above, applicant's first use of the term was on August 12, 1998. As of December 22, 1999, applicant shipped throughout the United States almost \$134.5 million (at wholesale) of golf clubs bearing the term STEELHEAD. This dollar amount equates to about 924,000 units.

During the first year of use of the term STEELHEAD, applicant spent over \$2.5 million in advertising in the United States. Applicant placed advertising on national television (e.g., ESPN, ABC, CBS, NBC, CNN and TBS). Applicant also ran advertisements in printed publications with nationwide circulation (e.g., *Golf Digest*, *Sports Illustrated*, *Golf Magazine* and *Golf Week*), and the record includes numerous examples of these advertisements. Applicant further displayed its clubs at two annual major trade shows for the golf industry.

³ The Examining Attorney did not view this as a problem, treating all of applicant's evidence to be credible and properly of record.

Applicant has provided retailers with various point-of-sale displays, catalogs and brochures for promotional use. In addition, some of these retailers distribute their own mail-order catalogs wherein applicant's golf clubs are sold under the term STEELHEAD. Annual circulation of these catalogs numbers in the tens of millions, and sample pages showing promotion of applicant's golf clubs were submitted.

Two golf club dealers (who sell, among others, applicant's particular golf clubs) have submitted declarations wherein each states that "[a]s a retailer of golf clubs and golf accessories and having been in contact with many purchasers of golf clubs, [I] state that a substantial number of these purchasers would recognize the subject mark [STEELHEAD] for a metal wood golf club head as originating with [applicant]."

Applicant's golf clubs also have been the subject of widespread, unsolicited publicity. Applicant claims that it is the largest manufacturer of golf equipment in the world, and that any new product launch by it creates an impact in the industry. Its golf clubs sold under the term STEELHEAD were no exception, and the clubs have received a good deal of coverage in magazines and newspapers (including *USA TODAY* and *The New York Times*). Numerous articles attesting to this publicity were submitted.

Last, but by no means least, applicant commissioned a telephone survey, and the survey report was submitted. The survey is patterned after a popular genericness survey, also conducted by telephone, that has come to be known as a "Teflon Survey." *E.I. du Pont de Nemours & Co. v. Yoshida International, Inc.*, 393 F.Supp. 502, 185 USPQ 597 (E.D.N.Y. 1975). This type of survey has been accepted by various courts, and we see no major problem (nor has the Examining Attorney identified any problem) with the version submitted in this case.⁴ See generally: J. T. McCarthy, 2 *McCarthy on Trademarks and Unfair Competition*, §12:16 (4th ed. 2001).

The telephone survey was run in October 1999 by Dr. Gerald L. Ford of Ford, Bubala & Associates of Huntington Beach, California. The survey was conducted among a random sample of individuals who subscribe to the publication *Golf Digest* and who had played one or more rounds of golf during the year prior to the survey. According to the survey synopsis, the survey "focused on the understanding of the principal significance, with respect to golf, of the word "Steelhead." (p. 1) The sampling frame for the

⁴ Having said this, we would add the often repeated observation that "no survey is perfect." Indeed, one might view the survey universe here to be inappropriately limited to individuals more likely to have been heavily exposed to applicant's advertising.

survey was the total list of subscribers to the magazine (1.5 million), and the survey sample was based on a random selection of approximately 5,000 subscribers from this list. The survey consisted of 326 telephone interviews. The report indicates that the survey "provides results at a 95% level of confidence with a precision variance of +/- 5.43%."

Assuming that the individual contacted by telephone met the survey's qualifications, the respondent was then told⁵:

The research we are conducting today is on common names and brand names.

Most products or services have both common names and brand names. Common names tell what type of product it is; for example, beer, automobile, or instant coffee. Brand names tell what brand it is; for example, Budweiser, Chevrolet, or Maxwell House.

Now, if I were to ask you "Do you understand the name washing machine to be a common name or a brand name?," what would you say?

1. common name **CONTINUE**
2. brand name **TERMINATE. THANK RESPONDENT.**
3. other **TERMINATE. THANK RESPONDENT.**

Now, I am going to read you some names and ask you to tell me whether

⁵ Any bold and underlining herein appears as in the original survey report.

you understand each name to be a common name, that is, the name that tells what type of product it is, or a brand name, that is, the name that tells what brand it is.

For any of the names, if you don't have an opinion or don't know, that is an acceptable answer.

The respondent was then asked the following: "Now, for each of the following ten names, would you please tell me whether you understand the name to be a common name or a brand name?" The list was read randomly. The response distribution results are shown below in percent:

	<u>Common Name</u>	<u>Brand Name</u>	<u>Both</u>	<u>Don't Know</u>
STP	2.76	92.64	--	4.60
Windsurfer	64.72	19.94	1.23	14.11
Margarine	97.24	2.15	--	0.61
Teflon	52.15	44.48	1.23	2.15
Jell-O	26.69	70.86	1.84	0.61
Refrigerator	98.77	0.92	--	0.31
Aspirin	89.57	8.90	1.53	--
Coke	8.90	89.57	1.23	0.31
American Airlines	2.15	97.55	--	0.31
Gas Station	98.77	--	--	1.23

After, the respondent was asked: "With respect to golf, for each of the following names, would you please tell me whether you understand the name to be a common name or a brand name?"⁶

	<u>Common Name</u>	<u>Brand Name</u>	<u>Both</u>	<u>Don't Know</u>
Steelhead	43.25	48.16	0.61	7.98
Footjoy	1.53	96.93	--	1.53
Graphite	96.63	3.07	--	0.31

The issues on appeal are whether the term STEELHEAD is merely descriptive or generic for applicant's golf clubs and, alternatively, if such term is not generic but rather merely descriptive, whether it has acquired distinctiveness. As indicated earlier, applicant has conceded the mere descriptiveness of the term sought to be

⁶ This follow-up question presents a twist on a typical "Teflon Survey." In this connection, we take judicial notice of the dictionary definition of the term "steelhead": "a large-sized silvery anadromous rainbow trout." *Webster's New International Dictionary* (unabridged ed. 1993) Given the fact that "steelhead" is a name of a fish, some respondents may well have classified the term as a common name if the term appeared in the first list of terms. By way of example, the same likely would be true of the term "Arrow." Although the term is a common name (as in "bow and arrow"), it is also a brand name as applied to shirts. Thus, inasmuch as "steelhead" is a dictionary term, we see no problem with the follow-up question that directs the respondents' attention to the significance of "Steelhead" as it pertains to golf.

Ser No. 75/389,003

registered, both in its brief (p. 3) and by its resort to Section 2(f). In re Leatherman Tool Group, Inc., 32 USPQ2d 1443 (TTAB 1994).

We turn first to the issues of whether the term STEELHEAD is generic, or whether it is just merely descriptive, when used on golf clubs. A mark is merely descriptive if, as used in connection with the goods, it describes, i.e., immediately conveys information about, an ingredient, quality, characteristic, feature, etc. thereof, or if it directly conveys information regarding the nature, function, purpose, or use of the goods. See: In re Abcor Development Corp., 588 F.2d 811, 200 USPQ 215 (CCPA 1978); In re Eden Foods Inc., 24 USPQ2d 1757 (TTAB 1992); and In re American Screen Process Equipment Co., 175 USPQ 561 (TTAB 1972). The issue is not determined in a vacuum, but rather the mere descriptiveness of the mark is analyzed as the mark is used in connection with the goods. A mark is a generic name if it refers to the class or category of goods on or in connection with which it is used. In re Dial-A-Mattress Operating Corp., 240 F.3d 1341, 57 USPQ2d 1807 (Fed. Cir. 2001), citing H. Marvin Ginn Corp. v. International Association of Fire Chiefs, Inc., 782 F.2d 987, 228 USPQ 528 (Fed. Cir. 1986). The test for determining whether a mark is generic is its primary

significance to the relevant public. Section 14(3) of the Act; *In re American Fertility Society*, 188 F.3d 1341, 51 USPQ2d 1832 (Fed. Cir. 1999); *Magic Wand Inc. v. RDB Inc.*, 940 F.2d 638, 19 USPQ2d 1551 (Fed. Cir. 1991); and *H. Marvin Ginn Corp. v. International Association of Fire Chiefs, Inc.*, supra. The United States Patent and Trademark Office has the burden of establishing by clear evidence that a mark is generic and thus unregistrable. *In re Merrill Lynch, Pierce, Fenner and Smith, Inc.*, 828 F.2d 1567, 4 USPQ2d 1141 (Fed. Cir. 1987). Evidence of the relevant public's understanding of a term may be obtained from any competent source, including testimony, surveys, dictionaries, trade journals, newspapers, and other publications. *In re Northland Aluminum Products, Inc.*, 777 F.2d 1556, 227 USPQ 961 (Fed. Cir. 1985).

With respect to genericness, the type or category of goods at issue is golf clubs or, more specifically, golf clubs with club heads composed of cast stainless steel. The record also shows that applicant uses the term STEELHEAD in connection with its woods, rather than irons, and such woods have been referred to as "stainless steel metal woods."

We next turn to the second step of the Ginn inquiry, that is, whether the relevant public understands the term

Ser No. 75/389,003

STEELHEAD to refer primarily to the type or category of goods. The relevant public here comprises golfers. Upon review of the entire record, we conclude that golfers do not understand the term STEELHEAD to refer primarily to a type of golf club.

At first glance, the present case might be viewed by some as a case falling within the parameters of *In re Gould Paper Corp.*, 834 F.2d 1017, 5 USPQ2d 1110 (Fed. Cir. 1987). That decision provides that where a term is a "compound word" (such as SCREENWIPE in that case, or STEELHEAD in the present case), the Office may satisfy its burden of proving a term to be generic by providing evidence that each of the constituent words is generic, and that "the separate words joined to form a compound have a meaning identical to the meaning common usage would ascribe to those words as a compound." *Id.* at 1110. The Gould test "is applicable only to 'compound terms formed by the union of words' where the public understands the individual terms to be generic for a genus of goods or services, and the joining of the individual terms into one compound word lends 'no additional meaning to the term.'" *In re Dial-A-Mattress Operating Corp.*, supra at 1810.

The Examining Attorney provided dictionary definitions of the words "steel" and "clubhead," as well as examples of

generic uses by the media. As pointed out by the Federal Circuit, such evidence *may* satisfy the burden of proving a term to be generic. In re Dial-A-Mattress Operating Corp., supra at 1810. In the present case, however, this evidence is contravened by the other evidence of record that, at the very least, presents a mixed record and that, moreover, raises doubt about the genericness of the term STEELHEAD when used in connection with golf clubs. We find this especially to be the case in light of the survey results. That is to say, the survey, which shows results that are pretty evenly divided, establishes that it is not clear cut as to whether the relevant public views STEELHEAD as a brand name or a generic term.

The record includes the Examining Attorney's evidence of thirty uses of "steel head" in a generic manner by the media. These uses include four references to applicant's golf clubs. The Examining Attorney's evidence is countered by applicant's evidence, including many uses by the print media of "Steelhead" (the first letter being capitalized) in making reference to applicant's golf clubs.

There are no instances of a competitor in the trade using "steel head" or "steelhead" in a generic manner. In point of fact, the record includes a comparative advertisement wherein a competitor, in comparing its golf

clubs to applicant's, specifically referred to applicant's model as "Steelhead®"; the bottom of the advertisement reads that "Steelhead is a registered trademark of the Callaway Golf Company."⁷

In addition, there is not a single instance where applicant has clearly used the term STEELHEAD in a generic fashion. Rather, the record is replete with applicant's advertisements and other materials showing prominent use of STEELHEAD in the manner of a trademark.⁸

Of considerable significance in the present case is the survey. As in the original "Teflon Survey," the respondents in applicant's survey were quite good at sorting out brand names from common names. Although the Examining Attorney is technically correct in viewing the survey results relating to STEELHEAD as a statistical tie (taking into account the precision variance), the simple fact is that a substantial part (over 48%) of the relevant purchasing public view the term STEELHEAD as a trademark, and not as a generic name. The survey by itself raises a

⁷ The reference to STEELHEAD as a registered trademark is, of course, incorrect at this juncture.

⁸ The Examining Attorney makes the point that applicant consistently uses the mark BIG BERTHA STEELHEAD, and that such use "would likely lead consumers to believe that STEELHEAD simply refers to the class or type of club (i.e., that the golf club has a steel head as opposed to a titanium head, etc.)." (brief, pp. 16-17) This point is unpersuasive given the fact that more than one mark may be used in connection with a single product.

doubt regarding genericness, and any doubt in determining registrability is resolved in favor of applicant. In re Volvo White Truck Corp., 16 USPQ2d 1417, 1421 (TTAB 1990).

As noted above, the Office bears the burden of proof and genericness must be shown by clear evidence. Genericness is a fact-intensive determination and the Board's conclusion must be governed by the record which is presented to it. We have serious concerns here about the genericness of applicant's term STEELHEAD. It is the record evidence about purchasers' perceptions, however, that controls the determination, not general legal rules or our own subjective opinions. The mixed record before us does not clearly place applicant's term STEELHEAD in the category of a generic name. In re Merrill Lynch, supra at 1143.

Inasmuch as the term STEELHEAD is merely descriptive when applied to golf clubs, a conclusion conceded by applicant, we turn to consider the sufficiency of the evidence in support of applicant's claim of acquired distinctiveness under Section 2(f). Whether a term has become distinctive is a question of fact that must be determined based on the evidence of record. G. H. Mumm & Cie Desnoes & Geddes, Ltd., 917 F.2d 1292, 16 USPQ 2d 1635 (Fed. Cir. 1990). Whether the quality and character of

evidence is sufficient to prove distinctiveness is necessarily a subjective determination that depends to a large extent on the nature of the term and the circumstances surrounding the use of the term. Roux Laboratories, Inc. v. Clairol, Inc., 427 F.2d 823, 166 USPQ 34 (CCPA 1970). While some terms may never acquire distinctiveness no matter how long they have been used, others may acquire such significance in a relatively short period of time, sometimes even less than five years. Hunter Publishing Co. v. Caulfield Publishing Ltd., 1 USPQ2d 1996, 1999 (TTAB 1986). See: McCarthy, *McCarthy on Trademarks and Unfair Competition*, supra at §15:56 ["With the advent of massive advertising campaigns on television and in the national news magazines, a new trademark may achieve wide usage and 'secondary meaning' within a matter of days or weeks, compared to the many years required in the days of more leisurely advertising."].

Although applicant has used the term STEELHEAD since only 1998, applicant has enjoyed considerable success with its golf clubs sold thereunder. Sales in the United States have exceeded \$134 million at wholesale, and advertising expenditures are in excess of \$2.5 million. The term has been used consistently by applicant as a trademark, prominently appearing on golf clubs and in nationwide

advertisements. The term has appeared annually in tens of millions of catalogs through which applicant's golf clubs are sold. Applicant's golf clubs bearing the term sought to be registered have been featured in numerous unsolicited articles in national publications. The record includes many of these articles and, except in a relatively few instances, the term STEELHEAD is used or referred to as a trademark of applicant. At least one competitor and two golf equipment dealers have recognized the term as a trademark of applicant.

Finally, although applicant's survey was submitted in connection with the issue of genericness, the acquired distinctiveness of the term STEELHEAD among the relevant purchasing public can be inferred from the results. The survey respondents were given the meanings of "brand name" and "common name." By categorizing the term STEELHEAD as a brand name, 48% of the respondents were saying, in effect, that they associated the term with the product of only one company. The fact that they were not asked to identify the company is of no moment given that consumers need only identify the term with one source, albeit anonymous. The substantial exposure to the relevant public of the term STEELHEAD as a trademark for applicant's golf clubs has

Ser No. 75/389,003

resulted in a significant number of these golfers viewing STEELHEAD as a brand name.

In view of applicant's continuous use (albeit less than five years), significant sales and advertising expenditures, substantial publicity in the national media, and brand name recognition among consumers, we find that applicant has established acquired distinctiveness of STEELHEAD as its mark for golf clubs.

Given the current record which is, at the very least, mixed, we find that this application is appropriate for publication. Any entity in the industry that believes it would be damaged by the registration will have an opportunity to oppose the registration of the term. On a different record, such as might be adduced by a competitor in an opposition proceeding, we might arrive at a different result.

Decision: The refusal to register is reversed.