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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re *Green Keepers, Inc.*

Serial No. 75554047

Jim Zegeer, Esq. for *Green Keepers, Inc.*

Linda E. Blohm, Trademark Examining Attorney, Law Office 110
(*Chris A.F. Pedersen*, Managing Attorney).

Before *Hohein, Bottorff* and *Drost*, Administrative Trademark
Judges.

Opinion by *Hohein*, Administrative Trademark Judge:

Green Keepers, Inc. has filed an application to
register the phrase "SIDE GRIPPING ACTION" for "golf shoe
cleats."¹

Registration has been finally refused under Section
2(e)(1) of the Trademark Act, 15 U.S.C. §1052(e)(1), on the
ground that, when used in connection with applicant's goods, the
phrase "SIDE GRIPPING ACTION" is merely descriptive of them.
Registration also has been finally refused under Sections 1, 2

¹ Ser. No. 75554047, filed on September 16, 1998, based on an
allegation of a bona fide intention to use such phrase in commerce.
By an amendment to allege use filed on August 28, 2001, the
application was amended to allege a date of first use anywhere of
March 26, 1998 and a date of first use in commerce of April 24, 1998.

and 45 of the Trademark Act, 15 U.S.C. §§1051, 1052 and 1127, on the basis that, as used by applicant in the manner indicated by the specimens, the phrase sought to be registered does not function as a trademark to identify and distinguish applicant's goods.

Applicant has appealed. Briefs have been filed, but an oral hearing was not requested. We affirm the refusals to register.

Turning first to the refusal on the ground of mere descriptiveness, it is well settled that a phrase or term is considered to be merely descriptive of goods or services, within the meaning of Section 2(e)(1) of the Trademark Act, if it forthwith conveys information concerning any significant ingredient, quality, characteristic, feature, function, purpose, subject matter or use of the goods or services. See, e.g., In re Gyulay, 820 F.2d 1216, 3 USPQ2d 1009, 1009 (Fed. Cir. 1987) and In re Abcor Development Corp., 588 F.2d 811, 200 USPQ 215, 217-18 (CCPA 1978). It is not necessary that a phrase or term describe all of the properties or functions of the goods or services in order for it to be considered to be merely descriptive thereof; rather, it is sufficient if the phrase or term describes a significant attribute or idea about them. Moreover, whether a phrase or term is merely descriptive is determined not in the abstract but in relation to the goods or services for which registration is sought, the context in which it is being used or is intended to be used on or in connection with those goods or services and the possible significance that the phrase or term

would have to the average purchaser of the goods or services because of the manner of such use. See *In re Bright-Crest, Ltd.*, 204 USPQ 591, 593 (TTAB 1979). Thus, "[w]hether consumers could guess what the product [or service] is from consideration of the mark alone is not the test." *In re American Greetings Corp.*, 226 USPQ 365, 366 (TTAB 1985).

Applicant, while conceding in its initial brief that the goods "sold under appellant's mark have outward angled traction teeth," asserts that its "mark, SIDE GRIPPING ACTION, for golf shoe cleats is not merely descriptive." Specifically, applicant contends that "[j]ust because the terms 'side', 'gripping' and 'action' have dictionary definitions, which in some ways individually may suggest an attribute of applicant's golf shoe cleats, [that] does not make the term [or phrase] SIDE GRIPPING ACTION merely descriptive." Such phrase, applicant urges, "is not the name of the goods and does not immediately tell potential purchasers only what the goods are." Moreover, applicant notes, "the mark is not in common usage in the trade." Applicant maintains in view thereof that "the mark, at best, is suggestive in that it requires imagination, thought and perception to reach a conclusion of the nature of the goods on which the mark is used" and thus it "does not immediately convey an immediate idea of applicant's golf shoe cleats to a purchaser."

The Examining Attorney, on the other hand, argues that the phrase "SIDE GRIPPING ACTION" is merely descriptive because it "describes a desirable feature/characteristic" of applicant's

goods. In particular, she contends that such phrase "immediately describes the manner or action of the golf shoe cleats" inasmuch as "the sides of [applicant's] golf shoe cleats grip the turf on which the golfer stands" and the "[p]rotruding cleats provide the action of gripping."

In support of her position, the Examining Attorney relies upon the definitions of record from The American Heritage Dictionary of the English Language (3rd ed. 1992) of the words "side," "grip" and "action." Such definitions include the following:

(a) "**side**," which as a noun is defined as "2. A surface of an object, especially a surface joining a top and bottom: *the four sides of a box.* 3. A surface that extends more or less perpendicularly from an observer standing in front: *the side of the ship.* 4. Either of the two surfaces of a flat object: *the front side of a piece of paper; the two sides of a record*" and as an adjective is set forth as "1. Located on a side: *a side door.* 2. From or to one side; oblique: *a side view*";

(b) "**grip**," which as a verb is listed as "1. To secure and maintain a tight hold on; seize firmly"; and

(c) "**action**," which as a noun is defined as "1. The state or process of acting or doing. 7. a. The operating parts of a mechanism. b. The manner in which such parts operate."

We also observe that the record contains the following pertinent excerpts from a search of the "Nexis" database (emphasis added):

"Sweepers typically slide on one foot and push with the gripper foot while scrubbing the ice floor in front of the moving stone. Players keep their grip by wearing special **shoes**, one of which has a Teflon bottom to enhance sliding while the

other has **gripping action.**" -- N.Y. Times, March 1, 1998 (article on the sport of curling); and

"The rubber sole gives a nice, stable **gripping action**, and it's so thin, its indistinguishable from a fine leather sole." -- Prevention, May 1993 (article headlined: "Commuter **shoes!**").

In addition, the specimen of use submitted by applicant, which appears to be a photocopy of an advertisement for applicant's goods, contains the following paragraph of text beneath the prominently displayed (in bold type) heading "The number one spike on the Senior PGA Tour" (emphasis added):

Green Keepers Spikeless cleats took over as the No. 1 spike on the Senior PGA Tour at the PGA Seniors' Championship. Green Keepers' offers aggressive outward-angle traction teeth which provide lateral stability during play and **side-gripping action** on uneven terrain.

We further notice that the record contains a second piece of advertising literature, which appears to be directed to distributors and retailers of applicant's goods and bears the slogan "Traction by Design." Such literature refers to applicant's "Green Keepers Spikeless Golf Cleats" in relevant part as follows (emphasis added):

The purpose of alternative spikes is to control damage to greens resulting in better playing surfaces.

....
But what about traction? Is it possible to achieve superior traction in an alternative spike?

Absolutely. Green Keepers' "Traction by Design" offers aggressive outward-angle traction teeth which provide lateral stability during play and **side-gripping action** on uneven terrain.

Lastly, we also notice that the record contains a third example of advertising, consisting of a printout of a page from applicant's website <http://www.gkspikes.com/introducing.html>,² which in reference to applicant's "Green Keepers Spikeless Golf Cleats" likewise states in pertinent part as follows (emphasis added):

In this new age of alternative cleats, the quest for superior traction and effective damage control ends here. Green Keepers "Traction by Design™" has set the standard with our aggressive outward-angled traction teeth that provide lateral stability during play and **side gripping action** on uneven terrain.

In view of the above evidence, we agree with the Examining Attorney that consumers would immediately understand that the phrase "SIDE GRIPPING ACTION" merely describes a significant characteristic or feature of applicant's goods. Specifically, such term conveys forthwith, without speculation or conjecture, that applicant's golf shoe cleats, when worn while playing the game of golf, provide a player's shoes with side gripping action on uneven terrain, such as in the rough or the edge of a bunker. Clearly, as pointed out by the Examining Attorney, the protrusions on the sides of applicant's golf shoe cleats provide the action of gripping the turf on which the golfer stands. There is thus nothing in the combination of the

² Although applicant, when it submitted such copy, "proposed [it] as a substitute specimen, if acceptable to the Examining Attorney," the printout cannot be considered as a substitute specimen inasmuch as applicant failed to furnish the required affidavit or declaration attesting to the use thereof in commerce as of a date at least as early as the filing of its amendment to allege use. Trademark Rule 2.59(b)(1).

constituent words "side," "gripping" and "action" into the phrase "SIDE GRIPPING ACTION" which is incongruous, ambiguous or suggestive of a double entendre, nor is there anything about such phrase which requires imagination, thought and perception to reach a conclusion as to characteristic or feature of the goods in connection with which the phrase is used. Moreover, while there is no evidence that the phrase "SIDE GRIPPING ACTION" is commonly used in the trade for golf shoe cleats, it nonetheless is well settled that the fact that an applicant may be the first and/or sole user of a merely descriptive phrase does not entitle it to registration thereof where, as here, the phrase projects only a merely descriptive significance in the context of applicant's goods. See, e.g., In re National Shooting Sports Foundation, Inc., 219 USPQ 1018, 1020 (TTAB 1983); and In re Mark A. Gould, M.D., 173 USPQ 243, 245 (TTAB 1972). In a similar vein, it is well established that the fact that a phrase is not found in the dictionary is not controlling on the question of registrability. See, e.g., In re Gould Paper Corp., 834 F.2d 1017, 5 USPQ2d 1110, 1112 (Fed. Cir. 1987); and In re Orleans Wines, Ltd., 196 USPQ 516, 517 (TTAB 1977).

Turning to the remaining basis for refusal, we note that, as stated by the Court in In re Bose Corp., 546 F.2d 893, 192 USPQ 213, 215 (CCPA 1976): "The Trademark Act is not an act to register mere words, but rather to register trademarks. Before there can be registration, there must be a trademark, and unless words have been so used they cannot qualify. In re Standard Oil Co., 47 CCPA 829, 275 F.2d 945, 125 USPQ 227

(1960)."³ The court, noting that "the classic function of a trademark is to point out distinctively the origin of the goods to which it is attached," further indicated that (footnote omitted):

An important function of specimens in a trademark application is, manifestly, to enable the PTO to verify the statements made in the application regarding trademark use. In this regard, the manner in which an applicant has employed the asserted mark, as evidenced by the specimens of record, must be carefully considered in determining whether the asserted mark has been used as a *trademark* with respect to the goods named in the application.

Id. at 215-16. Moreover, as pointed out by the Board in *In re Remington Products, Inc.*, 3 USPQ2d 1714, 1715 (TTAB 1987):

[T]he mere fact that [an] applicant's slogan [or phrase] appears on the specimens, even separate and apart from any other indicia which appear on them, does not make it a trademark. To be a mark, the term, or slogan, must be used in a manner calculated to project to purchasers or potential purchasers a single source or origin for the goods in question. Mere intent that a term function as a trademark is not enough in and of itself, any more than attachment of the trademark symbol would be, to make a term a trademark.

A critical element in determining whether a term is a trademark is the impression the term makes on the relevant public. In this case, the inquiry becomes would the term be perceived as a source indicator or merely an informational slogan [or phrase]?

³ In this regard, Section 45 of the Trademark Act, 15 U.S.C. §1127, defines the term "trademark" in relevant part as including "any word, name, symbol, or device, or any combination thereof ... used by a person ... to identify and distinguish his or her goods, including a unique product, from those manufactured or sold by others and to indicate the source of the goods, even if that source is unknown."

Applicant argues, in its supplemental brief, that the "submitted specimen is in the form of point-of-sale advertising and was a printout of an internet page." Such advertising, applicant submits, "constitutes use in commerce within the meaning of the statute." However, the Internet-page specimen, which applicant submitted with the intention that it serve as a substitute for the specimen originally filed with its amendment to allege use, has not been properly verified (see footnote 2) and thus cannot be treated as a substitute specimen.⁴ Rather, the only specimen which is properly before us and which forms the basis for the refusal to register consists, as indicated previously, of a photocopy of an advertisement for applicant's goods which contains, beneath the prominently displayed (in bold type) heading "The number one spike on the Senior PGA Tour," the following paragraph of text:

Green Keepers Spikeless cleats took over as the No. 1 spike on the Senior PGA Tour at the PGA Seniors' Championship. Green Keepers' offers aggressive outward-angle traction teeth which provide lateral stability during play and side-gripping action on uneven terrain.

None of the words in such text, including the hyphenated phrase "side-gripping action," is set-off or otherwise differentiated

⁴ It appears that applicant was attempting to overcome the additional objection to the originally filed specimen. Specifically, as stated in the final refusal, objection was made to such specimen on the further ground that it was "unacceptable as evidence of actual trademark use because [it] is merely promotional literature." However, on appeal, the Examining Attorney has not maintained the objection as to the nature of the originally filed specimen; instead, the sole basis argued in her brief is that, as used therein, the phrase which applicant seeks to register fails to function as a mark for applicant's goods.

from any of the other words therein; instead, all of the wording appears in the same size of type (except for capital letters, which are slightly larger) and style.

We agree with the Examining Attorney that the specimen originally filed with the amendment to allege use fails to show that the phrase "SIDE GRIPPING ACTION" functions as a trademark to identify and distinguish applicant's goods. Leaving aside the matter of the presence of a hyphen therein, it is still the case that, rather than being used in a manner calculated to project to consumers a single source or origin for applicant's golf shoe cleats, the phrase "SIDE GRIPPING ACTION" is buried in the text of the advertising for such goods. As so used, the impression made by the phrase on the purchasing public is simply that of an informational or descriptive statement about a characteristic or feature of applicant's goods and, thus, it would not be perceived as an indicator of source.⁵

Decision: The refusals under Section 2(e)(1) and Sections 1, 2 and 45 are affirmed.

⁵ We hasten to add that, since the same is true with respect to the Internet-page which applicant attempted to submit as a substitute specimen, the result herein would be the same even if applicant had furnished proper verification of such specimen as required by Trademark Rule 2.59(b)(1).