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Paper No. 16
TEH

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Caddy Girls USA, Inc.

Serial No. 75/619,824

Eric D. Paulsrud for Caddy Girls USA, Inc. for Caddy Girls USA, Inc.

Tracy L. Fletcher, Trademark Examining Attorney, Law Office 115 (Tomas Vlcek, Managing Attorney).

Before **Cissel**, Wendel and Holtzman, Administrative Trademark Judges.

Opinion by **Holtzman**, Administrative Trademark Judge:

An application has been filed by Caddy Girls USA, Inc. to register CADDY GIRLS for "golf caddie services in the nature of accompanying players on a round of golf and providing information and club selection and transportation assistance."¹ The application is based on a claim of first use and first use in commerce on September 20, 1994.

¹ Serial No. 75/619,824, filed January 12, 1999.

The Trademark Examining Attorney refused registration under Section 2(e)(1) of the Trademark Act on the ground that applicant's mark is merely descriptive of its services and, in view of the highly descriptive nature of applicant's mark, applicant's evidence is insufficient to show acquired distinctiveness of the mark under Section 2(f) of the Act.

In support of her position, the Examining Attorney pointed to the descriptive use of CADDY GIRLS on applicant's specimens and made of record dictionary definitions of the words "caddy" and "girl," a NEXIS excerpt from a British publication containing a reference to "caddy girls," a page from the third-party website of Caddy Services of Arizona referring to "Arizona Caddy Girls," and a number of NEXIS excerpts showing use of such terms as "girl caddies" or "female caddies." The following are representative of these stories (emphasis added):

The most famous **female caddie** in golf has switched bags for the second time in a year. *The Washington Post* (April 8, 2000).

The greatest concentration of **female caddies** can be found on the Buy.com Tour, where players on tight budgets can save money by enlisting wives and girlfriends to shoulder their bags. *USA Today* (April 5, 2000).

'We found some great early pictures, the newsreel stills of the **girl caddies**, old photos of the Tap Room....' *The San Francisco Examiner* (December 5, 1999).

Most of those named started their work lives with low-paying first jobs,.... One was the first **girl caddy** at the Findlay Country Club. *Business First-Columbus* (September 17, 1999).

The 40 **teen-age boys and girls who caddy** under the burning July and August sun at St. Albans Country Club in Franklin County, for instance, will earn between \$ 20 and \$ 25 from each golfer they help. *St. Louis Post-Dispatch* (May 23, 1999).

'To solve the caddy shortage, the Flossmoor Country Club of Illinois employed **girls and older men as caddies....**' *Newsday (New York, NY)* (March 29, 1998).

In response to the refusal to register the mark as merely descriptive, and without any argument that the mark is inherently distinctive, applicant amended the application to seek registration under Section 2(f). Applicant based its claim of acquired distinctiveness on a declaration by Mark S. Anderson, applicant's CEO/CFO, that the mark has been in substantially exclusive and continuous use in commerce for five years. In addition, applicant pointed to its specimens of use which include gift certificates, newspaper advertisements and an "informational article that appeared in a newspaper." Applicant submitted a further declaration of Mr. Anderson referring to a number of advertisements offering a CADDY GIRLS "business opportunity," expenditures totaling \$27,375 from March 1999 through October 2000 relating to those advertisements, and a report of "access statistics" to show the impact of the advertising expenditures on the number of visitors to applicant's web site. Applicant also relied on the file history for a third-party registration of VALET GIRLS for "vehicle parking and valet parking" arguing that said

registration is a "comparable application to the present application." (Brief, p. 12).

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

The Examining Attorney argues that CADDY GIRLS is merely descriptive of golf caddy services performed by girl caddies and that in fact the record shows that CADDY GIRLS is highly descriptive of applicant's services. The Examining Attorney maintains that applicant's evidence is insufficient to show that CADDY GIRLS has acquired distinctiveness contending that applicant's use of the mark is not "substantially" exclusive and that applicant's advertising expenditures are "minimal and insufficient." The Examining Attorney further notes that applicant's advertising expenditures do not relate to advertisements for caddy services but rather for the offer of a "business opportunity." As a result, the Examining Attorney concludes that neither this evidence nor the evidence of increased hits on applicant's website shows that the consuming public has come to recognize the mark as an indication of source for the identified services.

Applicant, on the other hand, contends that the Examining Attorney's evidence is insufficient to establish that its use of CADDY GIRLS is not substantially exclusive. Applicant argues that

the appearance of the term in a foreign newspaper and on a single website does not undermine its claim of substantially exclusive use. Applicant also explains that it has been monitoring the website for infringing use but has found that the use on that site appears to be inconsequential. Applicant notes that the phrase CADDY GIRLS has no known dictionary meaning and that there is no evidence that the phrase is used by competitors or by the public. Applicant points out that none of the NEXIS stories contain the phrase "caddy girls" (or variants such as "caddie girls") and argues that the use of a different phrase, "girl caddies," in those stories is not relevant. It is applicant's position that its targeted advertising has been effective in creating a link in the consumers' minds between the mark and the source of the services. Finally, applicant argues that the registration of a "comparable" mark VALET GIRL justifies registration of the present mark.

There is no question that CADDY GIRLS is merely descriptive of applicant's services. Applicant has conceded the descriptive meaning of the designation² and moreover, it is clear from the

² The only issue on appeal is whether the evidence is sufficient to show that the proposed mark has acquired distinctiveness under Section 2(f). Unless the question of inherent distinctiveness is clearly reserved, which in this case it was not, a claim of acquired distinctiveness under Section 2(f) is tantamount to a concession that the mark is not inherently distinctive. See *Yamaha International Corp. v. Hoshino Gakki Co. Ltd.*, 840 F.2d 1572, 6 USPQ2d 1001, 1005 (Fed. Cir. 1988) and *General Foods Corporation v. MGD Partners*, 224 USPQ 479, 485 (TTAB 1984).

record, including the specimens, that purchasers would immediately, and without the exercise of any imagination, understand its meaning upon encountering the mark in connection with applicant's caddy services.

Applicant has based its claim of acquired distinctiveness of the mark on a declaration of five-years substantially exclusive and continuous use as well as evidence of actual use of the mark. To begin with, the evidence submitted by the Examining Attorney is not sufficient to affect applicant's claim of substantially exclusive use. See, e.g., *L.D. Kichler Co. v. Davoil Inc.* 192 F.3d 1349, 52 USPQ2d 1307 (Fed. Cir. 1999) (noting that the district court erred in suggesting that any use by others is sufficient to preclude an applicant's declaration of "substantially exclusive" use). In addition, the appearance of a term in a foreign publication, without evidence of substantial circulation of the publication in the United States, is not probative of consumer perception in this country. See *In re BDH Two Inc.*, 26 USPQ2d 1556 (TTAB 1993). Moreover, the appearance of "Arizona Caddy Girls" on the third-party website is not particularly meaningful. There is no use of that term on the webpage in relation to any service or activity. In fact, the term does not appear to be used at all by the owner of the website except as merely a link (among other links) to unidentified third-party websites.

On the other hand, we agree with the Examining Attorney that applicant's evidence of actual use of the mark is of no persuasive value. Acquired distinctiveness is an association in the consumer's mind between the mark and the source of goods or services. Thus, the evidence of acquired distinctiveness must not only relate to the specific mark for which registration is sought but the specific services set forth in the application. See *In re K-T Zoe Furniture Inc.*, 16 F.3d 398, 29 USPQ2d 1787 (Fed. Cir. 1994) citing *In re Failure Analysis Associates*, 1 USPQ2d 1144 (TTAB 1986). Applicant submitted no persuasive evidence of actual use relating to its caddy services, the services for which registration is sought. Although applicant has submitted advertisements for caddy services as specimens, there is no evidence as to the amount or extent of such advertising. The record shows only that \$27,375 was spent on advertisements, not for caddy services, but for the offer of a "business opportunity" under the CADDY GIRLS mark. Therefore, contrary to applicant's claim, it cannot be said that applicant's advertising activity has been successful in creating an awareness or recognition of CADDY GIRLS for caddy services in the minds of relevant consumers or, for that matter, that applicant's "web site metrics" reflect any connection of the mark with caddy services in the minds of consumers.

Therefore, the question is whether applicant's declaration of five-years use, the only relevant evidence in the record, is sufficient to establish prima facie that the mark has become distinctive of the identified services.³ The burden is on applicant to show acquired distinctiveness, and the more descriptive the term, the heavier that burden. *Yamaha International Corp. v. Hoshino Gakki Co.*, 840 F.2d 1572, 6 USPQ2d 1001 (Fed. Cir. 1988). A declaration of substantially exclusive and continuous use as a mark for five years is insufficient in and of itself to support registrability under Section 2(f) where the term sought to be registered is highly descriptive of the identified goods or services. See *In re Synergistics Research Corporation*, 218 USPQ 165 (TTAB 1983). The burden is on the Examining Attorney to establish that the term is highly descriptive of the services, and based on the evidence of record we are not convinced that this term is.

The dictionary and NEXIS references submitted by the Examining Attorney show that the individual words "girl" and "caddy" as well as phrases such as "girl caddies" may be highly descriptive for caddy services. However, the reverse order of the

³ What applicant refers to as an "informational article appearing in a newspaper" is unidentified as to author, source or date and has not been considered. The third-party registration for VALET GIRLS has no bearing on this case for reasons fully explained by the Examining Attorney.

words "girl caddy" is somewhat unusual and results in a mark which as a whole creates a slightly different impression than the highly descriptive phrase "girl caddy." There is no evidence that anyone else uses or needs to use the words CADDY GIRLS in that order to describe similar services or that CADDY GIRLS would be perceived by purchasers as nothing more than a highly descriptive term for applicant's services.

Accordingly, we find that although applicant's mark is merely descriptive of its services, the evidence is sufficient to establish prima facie that the mark has become distinctive of applicant's services under Section 2(f) of the Act.

Decision: The refusal to register is reversed.