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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Karsten Manufacturing Corporation

Serial No. 77170356

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Manufacturing Corporation.

Angela Micheli, Trademark Examining Attorney, Law Office
101 (Ronald R. Sussman, Managing Attorney).

Before Quinn, Drost and Bergsman, Administrative Trademark
Judges.

Opinion by Quinn, Administrative Trademark Judge:

Karsten Manufacturing Corporation filed an application
to register the mark shown below



for "golf clubs" in International Class 28.¹ The application includes the following description of the mark sought to be registered:

The mark consists of a golf putter head having curved sides that extend rearward from the heel and toe ends of the club face, tapering into a central portion that extends rearward from the mid-portion of the club face and protrudes rearward beyond the intersection of the central portion with the two sides. Two arcuate cut-outs separate the sides of the club from the central portion. The dotted outline of the face and hosel are not part of the mark, and are merely intended to show the position of the mark.

The trademark examining attorney refused registration under Section 2(e)(5) of the Trademark Act, 15 U.S.C. §1052(e)(5), on the ground that applicant's proposed mark is functional.

When the refusal was made final, applicant appealed. Applicant and the examining attorney filed briefs.

The examining attorney maintains that applicant's five utility patents for a golf putter head with a visual alignment aid and an increased moment of inertia ("MOI") are strong evidence of functionality. According to the

¹ Application Serial No. 77170356, filed May 1, 2007, alleging first use anywhere and first use in commerce on February 18, 2004.

examining attorney, the configurations of the putter heads for which the patents were issued are identical to applicant's proposed mark. The examining attorney also asserts that advertisements for applicant's putters tout the advantages of the utilitarian aspects of the putter design. As to alternative designs for golf putter heads, the examining attorney recognizes their existence, but insists that the number of alternatives available to competitors is limited. Lastly, the examining attorney states that the method of manufacture of applicant's putter head appears to be normal for the industry. In support of the refusal, the examining attorney submitted, as just noted, applicant's relevant patents and advertisements for the goods.

Applicant argues that the underside of its golf putter is distinctive and should be registered.² Although applicant "does not dispute that its utility patents contain claims that recite features of the configuration for which registration is sought," applicant goes on to

² Because the subject matter sought to be registered is a product design, it is not inherently distinctive and, assuming it were not functional, it is registrable only with a showing of acquired distinctiveness. *Wal-Mart Stores, Inc. v. Samara Brothers, Inc.*, 529 U.S. 205, 54 USPQ2d 1065, 1067 (2000). Accordingly, applicant's argument that the underside of its putter head is distinctive is irrelevant to the determination of whether the product feature is functional.

argue that these features should be protected "in spite of being found in a utility patent claim." (Brief, p. 6).

More specifically, applicant asserts the following: "The through-holes and the arms of applicant's golf club head are recited in the utility patent claims, but nothing in the patent suggests that the arms must be curved just so or that the through-holes must be a particular size or shape to accomplish the claimed improvement." Id. Further, applicant contends, the examining attorney's reliance on applicant's advertisements is misplaced inasmuch as applicant's "generalized statements concerning the geometric shape and the perimeter weighting are descriptive of the function of any high MOI putter, not just the unique shape of Applicant's configuration with its recurved arms and airfoil-shaped through-holes." (Brief, p. 10).

Applicant also states that its configuration is "only one of many equally feasible, efficient and competitive designs" and that there are numerous alternative putters, "all of which have high MOI and all of which look radically different from [applicant's] configuration." (Brief, p. 11). According to applicant, applicant's and its competitors' designs demonstrate that the concept of moving mass from the center of the golf club head to its perimeter is functional because it increases the moment of inertia of

the club head, but that "the configurations that results [sic] from this mass movement can be accomplished in a multitude of equally feasible, efficient and competitive ways." (Brief, p. 12). Lastly, applicant asserts that its putter head design is not the result of a comparatively simple or inexpensive method of manufacture as compared with other high moment of inertia putter heads.

Section 2(e)(5) of the Trademark Act precludes registration of "any matter that, as a whole, is functional." The Supreme Court has stated: "In general terms, a product feature is functional if it is essential to the use or purpose of the article or if it affects the cost or quality of the article." *Inwood Laboratories, Inc. v. Ives Laboratories, Inc.*, 456 U.S. 844, 214 USPQ 1, 4 n.10 (1982). The Supreme Court has called this "*Inwood* formulation" the "traditional rule" of functionality. *TraFFix Devices Inc. v. Marketing Displays Inc.*, 532 U.S. 23, 58 USPQ2d 1001, 1006 (2001).

The functionality doctrine is intended to encourage legitimate competition by maintaining the proper balance between trademark law and patent law. As the Supreme Court observed in *Qualitex Co. v. Jacobson Products Co.*, 514 U.S. 159, 34 USPQ2d 1161, 1163-64 (1995):

The functionality doctrine prevents trademark law, which seeks to promote competition by protecting a firm's reputation, from instead inhibiting legitimate competition by allowing a producer to control a useful product feature. It is the province of patent law, not trademark law, to encourage invention by granting inventors a monopoly over new product designs or functions for a limited time, after which competitors are free to use the innovation. If a product's functional features could be used as trademarks, however, a monopoly over such features could be obtained without regard to whether they qualify as patents and could be extended forever (because trademarks may be renewed in perpetuity). That is to say, the Lanham Act does not exist to reward manufacturers for their innovation in creating a particular device; that is the purpose of the patent law and its period of exclusivity. The Lanham Act, furthermore, does not protect trade dress in a functional design simply because an investment has been made to encourage the public to associate a particular functional feature with a single manufacturer or seller.

The Federal Circuit, our primary reviewing court, looks at four factors when it considers the issue of functionality: (1) the existence of a utility patent disclosing the utilitarian advantages of the design; (2) advertising materials in which the originator of the design touts the design's utilitarian advantages; (3) the availability to competitors of functionally equivalent designs; and (4) facts indicating that the design results

in a comparatively simple or cheap method of manufacturing the product. *Valu Engineering Inc. v. Rexnord Corp.*, 278 F.3d 1268, 61 USPQ2d 1422, 1426 (Fed. Cir. 2002), citing *In re Morton-Norwich Products, Inc.*, 671 F.2d 1332, 213 USPQ 9, 15-16 (CCPA 1982). These are known as the "Morton-Norwich factors." The determination of functionality is a question of fact, and depends on the totality of the evidence presented in each particular case. *In re Udor U.S.A. Inc.*, 89 USPQ2d 1978, 1979 (TTAB 2009). The Supreme Court's decision in *TrafFix* has not altered the *Morton-Norwich* analysis. See *Valu Engineering, Inc. v. Rexnord Corp.*, 61 USPQ2d at 1427.

The first *Morton-Norwich* factor is the existence of a utility patent disclosing the utilitarian advantages of the design. Regarding the evidentiary value of utility patents in the functionality determination, the Supreme Court has instructed as follows:

A prior patent, we conclude, has vital significance in resolving the trade dress claim. A utility patent is strong evidence that the features therein claimed are functional. If trade dress protection is sought for those features the strong evidence of functionality based on the previous patent adds great weight to the statutory presumption that features are deemed functional until proved otherwise by the party seeking trade dress protection. Where the expired

patent claimed the features in question, one who seeks to establish trade dress protection must carry the heavy burden of showing that the feature is not functional, for instance by showing that it is merely an ornamental, incidental or arbitrary aspect of the device.

TraFFix Devices Inc. V. Marketing Displays Inc., 58 USPQ2d at 1005.

The particular golf club in question is applicant's PING CRAZ-E putter, which is one of a class of high moment of inertia putters. High moment of inertia putters are characterized by the way they have more mass located farther away from the center of the front face of the putter head, thereby giving higher moment of inertia, resulting in resistance to twisting as compared with conventional blade and cavity-backed putters. According to applicant, most golf club manufacturers sell at least one high MOI putter.

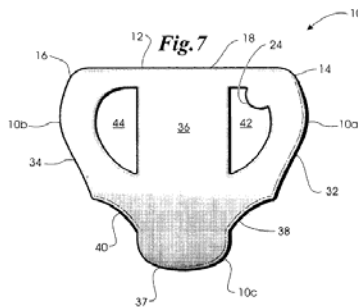
As indicated by one of applicant's patents covering its putter head, "recent developments in golf equipment have resulted in golf putter heads with high moments of inertia." The "Background of the Invention" states that it relates "to a golf putter head with a visual alignment aid and an increased moment of inertia." The "Summary of the Invention" reads, in pertinent part, as follows:

The present invention provides a golf putter head including a face member having a heel end, a toe end, a top rail, a front surface arranged for impacting a golf ball, and a back surface. A first arm extends substantially rearwardly from the heel end of the face member, and a second arm extends substantially from the toe end of the face member. A central member extends rearwardly from the face member intermediate the heel and toe ends thereof. The central member is connected to the first and second arms rearwardly of the face member. The central member and the first arm define a first opening there between adjacent the heel end of the face member while the central member and the second arm define a second opening there between adjacent the toe end of the face member. A first cavity is formed in an upper surface of the central member between the first and second openings, and a second cavity is formed in the upper surface of the central member rearwardly of the first cavity and rearwardly of the first and second openings.

The central member includes a substantially U-shaped wall at one end thereof that merges with the back surface of the face member. The substantially U-shaped wall has a top edge, and a middle portion of the wall top edge protrudes above the top rail of the face member. The wall top edge has opposed side portions which slope downwardly from the middle portion as the wall extends away from the face member. The first and second arms have top surfaces that slope downwardly as the first and second arms extend away from the face member, and the central member has a thickened portion at the other end thereof opposite the wall.

As the "Description of the Preferred Embodiment" indicates, the openings in the putter head cause more weight to be located near the end portions and the back portion of the putter head "which increases the moment of inertia" of the putter head. The central member of the putter head includes a thickened back portion that also causes more weight to be located near the back portion of the putter head "further increasing the putter head moment of inertia."

Figure 7 as shown in applicant's patent is an illustration of a bottom view of applicant's putter head.



In pertinent part, the patent includes the following descriptions:

A first arm 32 extends substantially rearwardly from the heel end 14 of the face member 12 while a second arm 34 extends substantially rearwardly from the toe end 16 of the face member 12. A central member 36 extends rearwardly from the face member 12 intermediate the heel and toe ends 14, 16 thereof.

The central member 36 includes a pair of wing portions 38, 40 connecting the

central member 36 to the first and second arms 32, 34 rearwardly of the face member 12. A first opening 42 is defined between the central member 36 and the first arm 32 adjacent the heel end 14 of the face member 12, and a second opening 44 is defined between the central member 36 and the second arm 34 adjacent the toe end 16 of the face member 12. These openings 42, 44 cause more weight to be located near end portions 10a, 10b and back portion 10c of the putter head 10 which increases the moment inertia of the putter head 10. The central member 36 includes a thickened portion 37 adjacent putter head back portion 10c. This thickened portion 37 also causes more weight to be located near the back portion 10c of the putter head 10 further increasing the putter head moment of inertia.

We find that the utility patents comprise strong evidence in support of the examining attorney's position that the design sought to be registered is functional. The elements comprising the mark, as set forth in the description of the mark sought to be registered, are included in the patent's claims and serve a utilitarian function.

Although as earlier noted applicant "does not dispute that its utility patents contain claims that recite features of the configuration for which registration is sought," applicant latches on to certain of the Supreme Court's language in *TraFFix* in support of its main

argument. The Court offered this observation in cautioning that a thoughtful analysis of a utility patent and its effect on the question of functionality is required:

In a case where a manufacturer seeks to protect arbitrary, incidental, or ornamental aspects of features of a product found in the patent claims, such as arbitrary curves in the legs or an ornamental pattern painted on the springs, a different result might obtain. There the manufacturer could perhaps prove that those aspects do not serve a purpose within the terms of the utility patent. [The patent and its prosecution history must be examined] to see if the feature in question is shown as a useful part of the invention.

TrafFix Devices Inc. v. Marketing Displays Inc., 58 USPQ2d at 1007. Based on this language, applicant argues the following:

[T]he arms of applicant's golf club head are functional because they have mass and are located away from the club face for increased perimeter weighting (MOI), but the recurved shape, taper and step in the arms is arbitrary. Likewise the through-holes of applicant's golf club head are functional because they have no mass and therefore allow the mass that would have been present to be redistributed to other parts of the club head for increased perimeter weighting. The through-holes are, however, arbitrarily shaped, and therefore non-functional for the purpose of trademark registration. [footnote omitted].

(Brief, p. 7). Applicant points out that "[t]he recurved shape of the arms is not the most efficient way to redistribute the mass for increased moment of inertia. Instead, the ideal way to redistribute the mass would be to locate it in a ring of constant radius with no taper and no central member." Id.

The problem with applicant's argument is that the exact same features *claimed* in the utility patent are included in the description of the trademark sought to be registered. So as to be clear, the patent includes the following *claims*:

What is claimed is:

A golf putter head comprising: a face member having a heel end, a toe end, a top rail, and a front surface arranged for impacting a golf ball; a first arm extending substantially rearwardly from the heel end of said face member; a second arm extending substantially rearwardly from the toe end of said face member; a central member extending rearwardly from said face member intermediate the heel and toe ends thereof, said central member being connected to said first and second arms rearwardly of said face member, said central member having an upper surface; said central member and said first arm defining a first opening there between adjacent the heel end of said face member; said central member and said second arm defining a second opening there between adjacent the toe end of said face member; said central member including a first cavity in its upper

surface located between said first and second openings; and said central member including a second cavity in its upper surface located rearwardly of said first cavity and rearwardly of said first and second openings.

The golf putter head of claim 1, wherein said central member includes a pair of wing portions connecting said central member to said first and second arms rearwardly of said face member.

The golf putter head of claim 1, wherein said central member includes a substantially U-shaped wall at one end thereof that merges with a back surface of said face member.

As Professor McCarthy has pointed out, non-functional elements of an invention, such as "arbitrary curves" or a painted "ornamental pattern," should not and do not appear in the *claims* of a utility patent as asserted by the Supreme Court in the quoted language; "[t]herefore, the Court must have been referring to non-functional features that appear in a patent disclosure." J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition*, §7:89 (4th ed. 2006).

Professor McCarthy further notes in this regard: "Prior case law cautions that a utility patent must be examined in detail to determine whether the disclosed configuration is really primarily functional or is just a non-functional *shape* that happens to be described or

pictured as an incidental detail in a patent disclosure."

J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition*, §7:89 (4th ed. 2006). Similarly, as Professor McCarthy notes at §7:89.1, the Court of Customs and Patent Appeals has stated that "[a] patent may not be evidence of functionality in regard to things of a 'purely arbitrary' or 'mere design' nature which happen to be disclosed in the patent but which are not attributed any functional significance therein." *Best Lock Corp. v. Schlage Lock Co.*, 413 F.2d 1195, 162 USPQ 552, 556 (CCPA 1969). However, if the patent discloses the functionality of the design,

... this evidence is particularly entitled to great weight if the patent was applied for by the same person who now asserts trademark significance in the same configuration. A kind of estoppel arises. That is, one cannot argue that a shape is functionally advantageous in order to obtain a utility patent and later assert that the same shape is non-functional in order to obtain trademark protection. Functional patent protection and trademark protection are mutually exclusive. As one court stated, when the configuration is disclosed in a functional patent, and the patent expires, the public "now has its inning."

McCarthy, supra, at §7:89.1.

In the present case, the utility patent includes *claims* covering the very same functional features of the putter head that, as set forth in the description, comprise the applied-for mark. Accordingly, the utility patent is strong evidence of functionality.

The second factor in the *Morton-Norwich* analysis involves a consideration of whether applicant's advertisements tout the utilitarian advantages of applicant's design. Applicant submitted an advertisement run by a third party for applicant's putters, and the examining attorney introduced three advertisements run by third parties. The advertisements include the following statements:

The CRAZ-E features strategic weight placement near the heel, toe and rear of the putter through its geometric shape and use of lightweight urethane inserts...The result, Solheim said, is an extremely high moment of inertia and a center of gravity positioned low and away from the face to ensure accuracy and consistency.
(www.pga.com)

Additional performance comes from the increased perimeter weighting and lower center of gravity achieved through redistribution of the mass removed to create the insert cavity.
(www.bhmgolf.com)

Designed with a geometric shape for increased inertia and easy alignment...the head is designed with a

center of gravity (CG) that is very low and away from the face. This helps get the ball rolling sooner and straighter for more consistent putts. The strategic weight placement near the heel, toe and center of the putter, creates an extremely high moment of inertia (MOI) for increased accuracy and consistency. The crescent shapes and extra-long sight line contrast with the blue urethane inserts to create an Optigraphic Effect - a visual aid that helps golfers square up and stroke the putter along the intended target line. (www.iwantgolf.com)

When added to the aluminum body, the tungsten weights maximize the perimeter weighting to earn it the distinction of being PING'S highest MOI putter (and thus most forgiving) to date. (www.edwinwattsgolf.com)

Although the advertisements were not run by applicant itself, it does not dispute the above statements. In each instance, the advertisement touts the advantages of perimeter weighting to increase moment of inertia, thereby increasing the likelihood of accuracy and consistency. This weighting is accomplished by the specific design of applicant's putter head. Thus, we find that the advertisements tout the utilitarian advantages of applicant's putter design. See *In re Caterpillar Inc.*, 43 USPQ2d 1335 (TTAB 1997). Moreover, we find that the specificity with which the advertisements discuss particular characteristics of applicant's putters belies

applicant's contention that the advertisements are merely "generalized statements concerning the geometric shape and the perimeter weighting [that] are descriptive of the function of any high MOI putter." Finally, we agree with the examining attorney's assessment that "[t]he advertising does not call attention to the putter head design as a trademark, rather it merely stresses the functional aspects of the design and the advantage it provides over other similar types of equipment." (Brief, p. 9). This factor weighs in favor of a finding of functionality.

The third *Morton-Norwich* factor involves consideration of alternative designs. The Federal Circuit has indicated that consideration of this factor remains part of the analysis. *Valu Engineering, Inc. v. Rexnord Corp.*, 61 USPQ2d at 1427. In connection with its argument that there are "many equally feasible, efficient and competitive designs," applicant submitted photographs of what it considers to be eighteen alternative designs of high moment of inertia putter heads manufactured by competitors. Applicant contends that these designs "demonstrate that the concept of moving mass from the center of the golf club head to its perimeter is functional because it increases the MOI of the club head. Nevertheless, the configurations that results [sic] from the mass movement can be

accomplished in a multitude of equally feasible, efficient and competitive ways." (Brief, p. 12).

Although this evidence shows a variety of designs that are specifically different, all are similar in design and involve the same utilitarian features: perimeter weighting accomplished by through-holes to increase moment of inertia. These other designs presumably work equally well, but the number of alternatives to increase the moment of inertia in a putter head is relatively limited. Moreover, although the putter heads are available in somewhat different designs, each of these designs would appear to be likewise functional because utility, not source identification, dictates the shape of each of the alternatives. The grant of an exclusive trademark right to applicant or any competitor for its design will impair free competition. See *In re Bose Corp.*, 772 F.2d 866, 227 USPQ 1 (Fed. Cir. 1985); and *Greenhouse Systems Inc. v. Carson*, 37 USPQ2d 1748 (TTAB 1995). See also *In re Edward Ski Products Inc.*, 49 USPQ2d 2001 (TTAB 1999) (a design need not be the superior design, so long as it is a superior design or one of a few superior designs). As explained by the Federal Circuit, "*Morton-Norwich* does not rest on total elimination of competition in the goods." *In re Bose Corp.*, 27 USPQ at 6. On balance, this factor weighs

against a finding of functionality. It is important to note, however, that the availability of alternative designs does not convert a functional design into a non-functional design. *TraFFix Devices Inc. v. Marketing Displays Inc.*, 58 USPQ2d at 1007 ("Here, the functionality of the spring design means that competitors need not explore whether other spring juxtapositions might be used. The dual-spring design is not an arbitrary flourish in the configuration of MDI's product; it is the reason the device works. Other designs need not be attempted.").

The fourth and final factor is a consideration of whether applicant's design results from a comparatively simple or cheap method of manufacture. Applicant submitted the declaration of David Jones, a design engineer for applicant. In pertinent part, Mr. Jones states that applicant's putter head is manufactured by a lost wax casting process similar to the process used to manufacture many conventional putter heads and iron heads. The shape of the putter, according to Mr. Jones, "does not result from a comparatively simple or inexpensive method of manufacture as compared with other high moment of inertia putter heads." The advertisements of record show that applicant's putter and those of competitors are comparatively priced in the \$100-\$150 range. This factor

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weighs in favor of a finding that the design is not functional.

In summary, the shape of the putter head is dictated by the desire to move additional weight to the perimeter to create high motion of inertia for greater forgiveness for miss-hits. Applicant's putter head has through-holes designed to apportion the putter weight to the front of the putter, the ends closest to the striking face, and the back end central member. This design increases the moment of inertia of the putter head, thereby rendering the design functional.

Decision: The refusal to register is affirmed.