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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re KGEM Golf, Inc.

Serial No. 88148572

Erik M. Pelton of Erik M. Pelton & Associates PLLC,
for KGEM Golf, Inc.

David I, Trademark Examining Attorney, Law Office 114,
Laurie Kaufman, Managing Attorney.

Before Shaw, Coggins and Lebow,
Administrative Trademark Judges.

Opinion by Lebow, Administrative Trademark Judge:

Applicant, KGEM Golf, Inc., applied to register the mark GOLFSUITES, in standard characters, on the Principal Register for the following services:[1]

> Providing golf facilities; Golf club services; Golf instruction; Conducting workshops and seminars in the field of golf; Entertainment in the nature of golf tournaments; Golf driving range services; Entertainment services, namely, amusement arcade services; Entertainment and amusement centers, namely, interactive play areas, in International

[1] Application Serial No. 88148572 was filed on October 9, 2018 under Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b), based upon Applicant's allegation of a bona fide intention to use the mark in commerce. The application also includes goods and services in International Classes 25 and 35, which are not at issue in this appeal.

Class 41; and

Restaurant and bar services; Rental of rooms for social functions, in International Class 43.

The Trademark Examining Attorney refused registration under Section 2(e)(1) of the Trademark Act, 15 U.S.C. § 1052(e), on the ground that the mark is merely descriptive of the identified services. When the refusal was made final, Applicant requested reconsideration, which was denied. Applicant then filed an appeal to this Board. The appeal is fully briefed.

We affirm the refusal.

I. Applicable Law

Section 2(e)(1) of the Trademark Act prohibits registration on the Principal Register of "a mark which, (1) when used on or in connection with the goods [or services] of the applicant is merely descriptive … of them," unless the mark has been shown to have acquired distinctiveness under Section 2(f) of the Trademark Act, 15 U.S.C. § 1052(f). A mark is "merely descriptive" within the meaning of Section 2(e)(1) "if it immediately conveys information concerning a feature, quality, or characteristic of the goods or services for which registration is sought." *In re N.C. Lottery*, 866 F.3d 1363, 123 USPQ2d 1707, 1709 (Fed. Cir. 2017) (citing *In re Bayer AG*, 488 F.3d 960, 82 USPQ2d 1828, 1831 (Fed. Cir. 2007)). "A mark need not immediately convey an idea of each and every specific feature of the goods [or services] in order to be considered merely descriptive; it is enough if it describes one significant attribute, function or property of the goods [or services]." *In re Fat Boys Water Sports LLC*, 118 USPQ2d 1511, 1513 (TTAB 2016) (citing *In re Gyulay*, 820 F.2d 1216, 3 USPQ2d

1009, 1010 (Fed. Cir. 1987)).

Whether a mark is merely descriptive is "evaluated 'in relation to the particular [services] for which registration is sought, the context in which it is being used, and the possible significance that the term would have to the average purchaser of the [services] because of the manner of its use or intended use,'" *In re Chamber of Commerce of the U.S.*, 675 F.3d 1297, 102 USPQ2d 1217, 1219 (Fed. Cir. 2012) (quoting *Bayer*, 82 USPQ2d at 1831), and "not in the abstract or on the basis of guesswork." *Fat Boys*, 118 USPQ2d at 1513 (citing *In re Abcor Dev. Corp.*, 588 F.2d 811, 200 USPQ 215, 218 (CCPA 1978)). We ask "whether someone who knows what the goods and services are will understand the mark to convey information about them." *Real Foods Pty Ltd. v. Frito-Lay N. Am., Inc.*, 906 F.3d 965, 128 USPQ2d 1370, 1374 (Fed. Cir. 2018) (quoting *DuoProSS Meditech Corp. v. Inviro Med. Devices, Ltd.*, 695 F.3d 1247, 103 USPQ2d 1753, 1757 (Fed. Cir. 2012) (internal quotation omitted)). A mark is suggestive, and not merely descriptive, if it requires imagination, thought, and perception on the part of someone who knows what the goods or services are to reach a conclusion about their nature from the mark. *See, e.g., Fat Boys*, 118 USPQ2d at 1515.

We "must consider the commercial impression of a mark as a whole." *Real Foods*, 128 USPQ2d at 1374 (quoting *DuoProSS*, 103 USPQ2d at 1757 (citation omitted)). "In considering [a] mark as a whole, [we] 'may not dissect the mark into isolated elements,' without 'consider[ing] … the entire mark.'" *Id.* (quoting *DuoProSS*, 103 USPQ2d at 1757). But we "may weigh the individual components of the mark to

determine the overall impression or the descriptiveness of the mark and its various components." *Id.* (quoting *In re Oppedahl & Larson LLP*, 373 F.3d 1171, 71 USPQ2d 1370, 1372 (Fed. Cir. 2004)). Indeed, we are "required to examine the meaning of each component individually, and then determine whether the mark as a whole is merely descriptive." *DuoProSS*, 103 USPQ2d at 1758.

If the words in the proposed mark are individually descriptive of the identified services, we must then determine whether their combination "conveys any distinctive source-identifying impression contrary to the descriptiveness of the individual parts." *Fat Boys*, 118 USPQ2d at 1515-16 (quoting *Oppedahl & Larson*, 71 USPQ2d at 1372). If each word instead "retains its merely descriptive significance in relation to the goods [or services], the combination results in a composite that is itself merely descriptive." *Id.* at 1516 (citing *In re Tower Tech., Inc.*, 64 USPQ2d 1314, 1317-18 (TTAB 2002)); *see also In re Mecca Grade Growers, LLC*, 125 USPQ2d 1950, 1953-55 (TTAB 2018).

"Evidence of the public's understanding of [a] term . . . may be obtained from any competent source, such as purchaser testimony, consumer surveys, listings in dictionaries, trade journals, newspapers[,] and other publications." *Real Foods*, 128 USPQ2d at 1374 (quoting *Royal Crown Co. v. Coca-Cola Co.*, 892 F.3d 1358, 127 USPQ2d 1041, 1046 (Fed. Cir. 2018)). "These sources may include [w]ebsites, publications and use 'in labels, packages, or in advertising material directed to the goods [or services].'" *N.C. Lottery*, 123 USPQ2d at 1710 (quoting *Abcor Dev.*, 200 USPQ at 218).

II. Examining Attorney's Evidence and Argument

The Examining Attorney relies on the following dictionary definitions of the words in the mark to support his argument that "Applicant has merely formed their [sic] mark by combining two descriptive terms, GOLF and SUITES":[2]

- Golf: "A game played on a large outdoor course with a series of 9 or 18 holes spaced far apart, the object being to propel a small, hard ball with the use of various clubs into each hole with as few strokes as possible"; and

- Suite: "A series of connected rooms, as in a hotel or office building, used as a single unit."

The Examining Attorney also relies on Applicant's promotional literature, which includes the following statements describing Applicant's services, to support his descriptiveness argument:

- We want players of every skill level to improve their game using our intended state-of-the-art launch monitor technology that provides a highly realistic golf simulation in a comfortable suite….

  Each facility will consist of 60-100 climate controlled semi-private and private suites that will offer comfortable seating, special computer tracking to monitor golf gaming and ball flight data, tee boxes, and large screen monitors to watch the big game or your favorite show.[3]

- Our intended use of state-of-the-art launch monitor technology will allow you to simulate your training session or a round of golf from the comfort of your suite, instead of having to worry about having inclement weather out on the course.[4]

According to the Examining Attorney, the following statement in Applicant's brief

[2] 15 TTABVUE 5 (Examining Attorney's Brief); 7 TTABVUE 5-8 (American Heritage dictionary definitions provided with Denial of Request for Reconsideration);

[3] January 22, 2020 Request for Reconsideration, TSDR 8.

[4] September 9, 2019 Office Action, TSDR 7.

regarding the Examining Attorney's dictionary evidence concedes descriptiveness of the mark in relation to Applicant's Class 41 services: "Applicant does not dispute that this meaning, if stood alone, would be merely descriptive of the relevant services in international class 041."[5]

III. Applicant's Evidence and Argument

Applicant argues that GOLFSUITES is not merely descriptive of its services because it is "a creative double entendre that has multiple interpretations, which are readily apparent to the potential consumer":[6]

> Here, there is no clear meaning of a "Golf Suite" as it is not a thing that is common or used by anyone, and there is no evidence of use from the Examining Attorney. Because golf is generally played "on a large outdoor course," and suites are inherently indoors, the meaning of Applicant's coined GOLFSUITES mark is not readily descriptive of anything; at a minimum, a multi-step reasoning process is required to make the leap between Applicant's goods and services and the meaning of Applicant's mark….
>
> [T]he combined term GOLFSUITES suggests more than just a group of rooms for golfing. **The suffix "SUITES" carries a double meaning as it potentially relates to both "a group of rooms" as well as the "sweet spot" of hitting a golf ball.** For example, the "sweet spot" is "the spot on the face where the greatest transfer of energy is going to occur between the club and the ball." A golfer seeks to find the "sweet spot" to maximize the distance of his strike and increase accuracy of the shot. … Given that Applicant also "conducts workshops and seminars in the field of golf," **it is quite possible that Applicant discusses the "sweet spot" in these seminars and coaches clients on how to consistently hit the "sweet spot."** Accordingly, use of the term "SUITES" refers not only to "a group of rooms," but also to "the spot on the face where the greatest transfer of energy is going to occur between the club and the ball." This secondary meaning is enhanced with respect to Applicant's Class 41 and 43 services.

[5] 15 TTABVUE 8-9 (Examining Attorney's Brief);

[6] 13 TTABVUE 11-13 (Applicant's Brief) (emphasis added, internal citations omitted).

> A "SUITE" is an indoor space, whereas "GOLF" is widely known as an outdoor game. Hence, there is a disconnect between "GOLF" and "SUITES" in the Applicant's mark. The terms "GOLF" and "SUITE" are incongruous and not immediately descriptive of any service....
>
> Applicant's GOLFSUITES mark is inventive and incorporates a clever suffix, being an obvious play on a "sweet spot," so that consumers are forced to take a mental leap in drawing a connection to Applicant's mark and services.

To support its argument that GOLFSUITES is a double-entendre, Applicant provided evidence of 17 third-party registrations (shown below) for marks that have the term "SUITE" as a suffix or term without a disclaimer covering services in Class 41.[7] According to Applicant, these registrations for marks that are all double-entendres "show how the term 'SUITE' has the ability to be interpreted as the term 'SWEET,' particularly when the context of the applied-for services caters to such a meaning, such as Applicant's golf related services."[8]

Mark	**Reg. No.**	**Relevant Services**
SOUNDSUITE	5651443	Music composition and production services, composition of music soundtracks and songwriting for television, film, radio, web broadcasts, video, video games and podcasts
SuiteSoulTV	5574845	Entertainment, namely, a continuing music video show broadcast over television, satellite, internet, radio
AUTOSUITES	5151763	Entertainment services in the nature of automobile racing and exhibitions
SUITECONNECT	5547315	Arranging and conducting educational conferences

[7] *Id*. at 14-15; August 1, 2019 Response to Office Action, TSDR 25-43.

[8] 13 TTABVUE 17 (Applicant's Brief).

SUITESKILLS	5475027	Training services in the fields of cloud computing, and management, maintenance, and integration of cloud-based software
SUITETRAINING	5559261	Inter alia, classes, webinars and online on-demand courses in the fields of cloud computing, accounting and finance, inventory management, marketing and sales automation, data analysis, business process automation, and management, maintenance, and integration of cloud-based software …
SUITEANSWERS	5474224	Providing a website featuring non-downloadable articles, technical support documentation, and training videos in the fields of SaaS and cloud computing; online training courses and webinars in the fields of SaaS and cloud computing.
SWING SUITE	5478520	Providing temporary use of non-downloadable video games; providing golf simulator systems facilities; golf instruction; rental of golf equipment; arranging and conducting of golf competitions; golf simulation games; providing online non-downloadable computer game software for use in golf simulator systems
SUITE SEATS	4757558	Premium seating at movie theatres which includes luxury reclining, heated leather seats with leg rests, food trays and cup holders
SUITE MUSIC	5053454	Music lessons in a music studio, music lessons to corporate employees on company premise
THE SHE-SUITE	5049312	Conducting online and live seminars, conferences, workshops and classes in a variety of fields
SUITESNAPS	4968324	Rental of portable photography / videography booths for taking of pictures and videos
LIFE IS SUITE	4724493	Musical performances; organization of disc-jockey events, music events; disc jockey services; providing non downloadable prerecorded music and music videos; production of sound recordings;
WORDSUITE	4221703	Editorial consultation
INFOSUITE	4473246	Training services, workshops, seminars, and classes in the field of financial instruments and securities
MAPPING SUITE	3048879	Training in the use of computers, namely, data processing

ACTIVESUITE	2983788	Training in the use and operation of internet based tracking systems

IV. Discussion

Applicant argues that "imagination or thought is required by prospective consumers to discern the purpose of Applicant's services, particularly as the game of golf is traditionally an outdoor sport and the idea of going to a driving range is an outdoor activity."[9] However, the question is not whether someone presented only with the mark could guess the services listed in the identification. Rather, the question is whether someone who knows what the services are will understand the mark to convey information about them. *DuoProSS,* 103 USPQ2d at 1757 (quoting *In re Tower Tech,* 64 USPQ2d at 1316-17; *In re Patent & Trademark Servs. Inc.*, 49 USPQ2d 1537, 1539 (TTAB 1998).

Contrary to Applicant's contention that "[the terms 'GOLF' and 'SUITE[S]' are incongruous and not immediately descriptive of any services,"[10] we find that the terms have a clear meaning that is merely descriptive in relation to Applicant's services, and that when combined as GOLFSUITES, the wording "retains its merely descriptive significance in relation to the [services]" and "results in a composite that is itself merely descriptive." *Fat Boys*, 118 USPQ2d at 1516.

The dictionary evidence alone demonstrates that Applicant's mark GOLFSUITES immediately conveys the idea of a business establishment that provides suites in the

[9] 16 TTABVUE 9-10 (Applicant's Reply Brief).

[10] 13 TTABVUE 12 (Applicant's Brief).

nature of golf facilities to render golf club services, golf instruction, golf tournaments, golf driving range services, amusement arcades, and interactive play areas (Class 41), and which may be rented for social functions relating to golf (Class 43). *Chamber of Commerce of the U.S.*, 102 USPQ2d at 1219 ("If a mark is descriptive of any of the services in a class for which registration is sought, it is proper to refuse registration as to the entire class.").

Providing additional support to the descriptive meaning of Applicant's mark are the repeated references in Applicant's own promotional materials explaining and promoting its golf related activities and functions in within various "suites." *See N.C. Lottery*, 123 USPQ2d at 1710 (explanatory text on the applicant's website made it clear that the applied-for mark FIRST TUESDAY described that the applicant's lottery games appeared on the first Tuesday of each month); *In re Abcor Dev.*, 200 USPQ at 218 (in a descriptiveness case, "[e]vidence of the context in which a mark is used in labels, packages, or advertising materials directed to the goods is probative of the reaction of prospective consumers to the mark."); *In re Omniome, Inc.*, 2020 USPQ2d 3222, *4 (TTAB 2020) (descriptiveness evidence may come from an applicant's own use).

Furthermore, as noted by the Examining Attorney, Applicant has effectively conceded the mark's descriptiveness in Class 41 by acknowledging that the mark's meaning, as expressed by the ordinary definitions of the words in the mark, standing alone, are merely descriptive of Applicant's Class 41. Applicant's argument that "[t]he Examining Attorney focuses only on the first of the two clearly relevant meanings as

applied to only one of the classes of services" misses the point.[11] The possibility that a term has multiple meanings is not determinative of the mere descriptiveness inquiry. *In re Franklin Cnty. Historical Soc'y*, 104 USPQ2d 1085, 1087 (TTAB 2012) (citing *In re Bright-Crest, Ltd.*, 204 USPQ 591, 593 (TTAB 1979)). *See also* TRADEMARK MANUAL OF EXAMINING PROCEDURE (TMEP) § 1209.03(e) (Oct. 2018). The question is whether any of the multiple meanings is merely descriptive of the relevant services. If so, "the term may be considered to be merely descriptive." *In re Mueller Sports Med., Inc.*, 126 USPQ2d 1584, 1590 (TTAB 2018) (quoting *In re Chopper Indus.*, 222 USPQ 258, 259 (TTAB 1984)).

We reject Applicant's argument that the mark is a double entendre. For trademark purposes, a "double entendre" is an expression that has a double connotation or significance as applied to the goods or services. *See* TMEP § 1213.05(c). While terms comprising a double entendre will not be found merely descriptive, the multiple interpretations that make an expression a "double entendre" must be associations that the public would make fairly readily, and must be readily apparent from the mark itself. *See In re Calphalon Corp.*, 122 USPQ2d 1153, 1163-64 (TTAB 2017); *In re Wells Fargo & Co.*, 231 USPQ 95, 99 (TTAB 1986) (holding EXPRESSERVICE merely descriptive for banking services despite applicant's argument the term also connotes the Pony Express, the Board finding that, in the relevant context, the public would not make that association). *See also In re Ethnic Home Lifestyles Corp.*, 70 USPQ2d 1156, 1158 (TTAB 2003) (holding ETHNIC

[11] 13 TTABVUE 11 (Applicant's Brief).

ACCENTS merely descriptive of "entertainment in the nature of television programs in the field of home décor" because the meaning in the context of the services is home furnishings or decorations that reflect or evoke particular ethnic traditions or themes, a significant feature of applicant's programs; viewers of applicant's programs deemed unlikely to discern a double entendre referring to a person who speaks with a foreign accent). "[T]hat applicant can take the dictionary definitions of the individual words in the term and come up with a meaning that makes no sense in connection with the [goods] recited in the application does not mandate a different conclusion on the issue of mere descriptiveness." *Id*. at 1159.

Applicant's contention that the "SUITES" in the mark "suggests more than just a group of rooms for golfing," and "carries a double meaning as it potentially relates to both "a group of rooms" as well as the "sweet spot" of hitting a golf ball" is far-fetched, not at all apparent from the mark itself, much less readily apparent, and unsupported by evidence. Not only would consumers need to jump through several mental hoops before arriving at Applicant's understanding, they might never arrive.

Applicant argues that it "presents numerous third-party registrations as evidence that the public would recognize that the term 'SUITE' as a playful double entendre":[12]

> For example, SuiteSoulTV (Reg. No. 5,574,845) playfully alludes to the feeling of soul music through the prefix "SUITE," which can be interpreted as "SWEET." Similarly, LIFE IS SUITE (Reg. No. 4,724,793) for entertainment services, namely live musical performances

[12] 16 TTABVUE 6 (Applicant's Reply Brief). Applicant asserts that the third-party registration evidence was presented not to show that its mark is not descriptive, but rather to show "that the term 'SUITE' has the ability to be interpreted as the term 'SWEET,' particularly when the context of the applied-for services caters to such a meaning, such as Applicant's golf related services."

> references the common phrase "LIFE IS SWEET." Other third-party registrations that play on the double entendre of "SUITE" include SUITESKILLS, SWING SUITE, SUITE SEATS, and SUITE MUSIC. These marks clearly play on the phonetic equivalent of "SUITE" and "SWEET" to suggest a double entendre. Applicant's GOLFSUITES mark, therefore, comprises a double entendre for similar reasons.

We find no probative value in the third-party registrations of record for other marks in establishing consumers would view the term "SUITES" in "GOLFSUITES" as a play on the word "sweet," and Applicant provides no evidence that they would. None of the registrations pertain to golf related services or activities save for one, SWING SUITE, and there is no evidence that the word "SUITE" in that mark would be perceived as "sweet" in the context of golf services. Applicant's suggestion that the term "potentially" relates to the "'sweet spot' of hitting a golf ball" strains credulity, particularly in the face of the clear meaning GOLFSUITES as providing suites for golfing related activities.

Applicant asserts that the "fact that the Examining Attorney cannot point to any use of the phrase 'GOLF SUITES' in connection with golf instruction and/or entertainment services in the field of golf indicates that Applicant's Mark is an incongruous word combination that requires some imagination on the part of a consumer."[13] However, that is not the test. That Applicant may be the first and only user of the term for such services does not obviate a mere descriptiveness refusal. "Being 'the first and only one to adopt and use the mark sought to be registered does not prove that the mark is not descriptive.'" *In re Swatch Group Mgmt. Servs. AG*,

[13] *Id*. at 10.

110 USPQ2d 1751, 1761 n.50 (TTAB 2014) (quoting *In re Bailey Meter Co.*, 102 F.2d 843, 26 C.C.P.A. 1136, 1939 Dec. Comm'r Pat. 524, 41 USPQ 275, 276 (CCPA 1939)); *see also In re Nat'l Shooting Sports Found., Inc.*, 219 USPQ 1018, 1020 (TTAB 1983).

V. Conclusion

We find that the terms GOLF and SUITES in the proposed mark have a descriptive meaning with respect to Applicant's services of Providing golf facilities; Golf club services; Golf instruction; Conducting workshops and seminars in the field of golf; Entertainment in the nature of golf tournaments; Golf driving range services; Entertainment services, namely, amusement arcade services; Entertainment and amusement centers, namely, interactive play areas, in International Class 41; and Rental of rooms for social functions, in International Class 43. We further find that when combined, the wording "retains its merely descriptive significance in relation to the [services]" and "the combination results in a composite that is itself merely descriptive." *Fat Boys*, 118 USPQ2d at 1516.

***Decision*:** The refusal to register Applicant's mark for the services in Classes 41 and 43 is affirmed. The application will proceed with respect to the services in Classes 25 and 35 only.