

THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT OF THE TTAB 11/19/98

U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re **H-D Michigan, Inc.**

Serial No. 74/423,828

Thomas P. Arden of McBride Baker & Coles for applicant.

Odette Bonnet, Trademark Examining Attorney, Law Office 109
(**Deborah S. Cohn**, Managing Attorney).

Before Cissel, Quinn and Chapman, Administrative Trademark
Judges.

Opinion by Quinn, Administrative Trademark Judge:

An application has been filed by H-D Michigan, Inc. to register the mark BIKER BLUES for "clothing, namely, shorts, gloves, hats, caps, boots, shoes, skirts, underwear, pajamas, belts, chaps, socks, scarves, suspenders, sweaters, rain suits, mittens and neckties."¹

¹ Application Serial No. 74/423,828, filed August 10, 1993, alleging a bona fide intention to use the mark in commerce. Pursuant to applicant's request to divide the application, a "child" application, Serial No. 74/802,222, was set up covering "clothing, namely, shirts, pants, jeans, vests, jackets and

The Trademark Examining Attorney has refused registration under Section 2(e)(1) of the Act on the ground the applicant's mark, if applied to applicant's goods, would be merely descriptive of them.

When the refusal was made final, applicant appealed.² Applicant and the Examining Attorney have filed briefs.³

The Examining Attorney asserts, in refusing registration, that the mark sought to be registered is merely descriptive of applicant's clothing inasmuch as the clothing is made of blue denim fabric and is sold to bikers. More specifically, the Examining Attorney contends that the term "biker" identifies the intended users of applicant's clothing, and the term "blues" is descriptive of blue colored clothing, particularly that made of blue denim. The Examining Attorney maintains that the combination of the two terms does not result in an inherently distinctive mark. In support of the refusal, the Examining Attorney submitted excerpts retrieved from

bandannas." That application matured into Registration No. 1,993,625, issued August 13, 1996, pursuant to Section 2(f) of the Trademark Act.

² Pursuant to the remands granted to applicant and the Examining Attorney, all of the evidence submitted in this case has been considered as part of the appeal record. This evidence is entitled, of course, to varying degrees of probative value.

³ Although an oral hearing originally was requested, the request later was withdrawn.

the NEXIS database,⁴ copies of third-party registrations, an advertisement of a third party, excerpts from one of applicant's clothing catalogs, and a copy of applicant's previously issued registration.

Applicant argues that its mark is inherently distinctive, contending that the mark "at most implies a sad or depressed mood experienced by 'bikers' or twelve bar music written about or by bikers." (brief, p. 6) In urging that the refusal be reversed, applicant relied upon dictionary and thesaurus listings for the terms "bike" and "blues," two declarations from individuals experienced in the clothing industry, excerpts from the *Official Gazette*, copies of third-party registrations and applications, and the file history of a third-party registration.⁵

Although applicant submitted a dictionary listing for the term "bike" (and "bicycle"), the Board takes judicial notice of the listing in *The Random House Dictionary of the English Language* (2d ed. 1987) for the term "biker": "a

⁴ Several excerpts are from foreign publications. As pointed out by applicant, there is no evidence that these stories were circulated in this country. Thus, we cannot infer that these foreign uses have had any material impact on the perceptions of the relevant public in this country. In re Men's International Professional Tennis Council, 1 USPQ2d 1917, 1918-19 (TTAB 1986). Accordingly, these particular excerpts are irrelevant to the issue in this appeal.

⁵ A third declaration, that of Thomas Arden, applicant's attorney, was submitted in connection with the third-party registrations and applications.

person who rides a bicycle, motorcycle, esp. in competition or as a hobby; *informal*, a member of a motorcycle gang."⁶

The term "blues," as defined in *Webster's Third New International Dictionary* (1986), means

low spirits, mental depression, usually used with *the*; a song sung or composed in a style originating among the American Negroes, characterized typically by the use of the three-line stanzas in which the words of the second line repeat the first, expressing a mood of longing or melancholy, and marked by continual occurrence of blues notes in melody and harmony; the blue uniform of the U.S. Navy; unreserved seats at the two far ends of a circus tent usually painted blue.

The listings in *Roget's International Thesaurus* (1977) of synonyms for the term "bike" are "bicycle" and "ride," while synonyms for the term "blues" are "folk music," "ill humor," "sadness" and "song."

The record includes various excerpts retrieved from the NEXIS database which show, according to the Examining Attorney, that the term "biker" describes a particular type or style of clothing. The following are examples:

Thieves stole leather biker clothing,
valued at \$900....
Los Angeles Times, July 1, 1993

⁶ Dictionary definitions are proper subject matter for judicial notice. *University of Notre Dame du Lac v. J. C. Gourmet Food Imports Co.*, 213 USPQ 594 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983).

Leather motorcycle fashion designers John Bowman, Richard Stark and Leonard Kamhout, recent winners of a prestigious fashion design award, discuss their line of biker clothing which runs between \$3,000-5,000.
CNN News, June 7, 1993

....their favorite symbols tend to be crude tattoos, biker clothing,....
Los Angeles Times, June 4, 1993

The suspect, described as a tall, heavy-set man dressed in leather biker clothing....
St. Petersburg Times, February 29, 1992

....obscured by a gas station, a Jack Roberts outlet, a discount divorce office and the Hot Stuff biker clothing store.
The Seattle Times, March 1, 1991

....when I ride I wear mostly Biker Blues, denim jeans with a functional boot cut and relaxed fit that gives me more room....
Los Angeles Times, July 14, 1994

The record also includes excerpts showing uses of the term "blues" in connection with clothing:

Holiday Blues; Denim's one fabric that's never out of season....denim is being upgraded and paired with street looks--racing stripes in high-top sneakers, baggy jeans and biker caps.
The Houston Chronicle, December 15, 1994

Denim treatments: R.E. Denim attempted to "dress up" its blues with silver lame paneling on front and back.
The Houston Post, September 14, 1994

Chasing The Blues--Finding the perfect pair of denims a stretch for shoppers. *The Cincinnati Enquirer*, September 6, 1994

The blues: Denim still is the fabric of choice among teens. *Star Tribune*, August 24, 1994

Look who's wearin' the blues! Denim. *Teen*, September 1993

Lose Your Blues: Feeling blue? Here's a chance to lose your blues (as in blue jeans), courtesy of Dillard's stores and the Perry Ellis clothing company. *Orlando Sentinel Tribune*, November 13, 1992

Matteson stocks Biker Blues (blue jeans),.... *Anchorage Daily News*, October 9, 1995

Applicant and the Examining Attorney submitted third-party registrations and applications of marks which include, as a portion thereof, either the term "biker" or the term "blues." The registrations and applications cover clothing items. Suffice it to say that some registrations or applications include disclaimers of the terms "biker" or "blues" apart from the marks, while others do not include such disclaimers. Other registrations issued under Section 2(f) or on the Supplemental Register.

Also of record is an excerpt from a catalog of J. Crew which shows the following phrase superimposed on a pair of denim jeans: "Jeans. True blues and beyond."

The Examining Attorney also submitted a catalog of applicant's which covers clothing items and various accessories. The catalog includes items described as "biker trench coat," "biker jacket," "men's exhaust biker jacket," "biker open-tip gloves," "biker buckles," and "biker wallet." The catalog also includes clothing items sold under the mark BIKER BLUES. The catalog reveals that several items sold under the mark are made of denim. In the catalog, applicant describes its denim pants sold under the mark as follows:

On Biker Blues™ jeans, the coin pocket's on the left side. That way, you can dig for toll change with your left hand, and keep your right hand on the brake. You may not notice these road-smart details the first time you slip on a pair. You'll just know they feel right.

Also of record is an article about applicant's line of clothing sold under the mark BIKER BLUES. The headline reads "Harley-Davidson Swaps Its Black Leather for Blue Jeans." The article reads as follows:

Motorcycle legend Harley-Davidson will put its name on another all-American product when it rolls nationally a line of jeans under the Biker Blues brand. H-D hopes to broaden its appeal beyond bikers, targeting Generation Xers with ads in alternative newspapers.... Harley-Davidson's MotorClothes division has begun testing a line of denim jeans branded Biker Blues and intends to roll

out the brand nationally in July...the
jeans line is new, as is the Biker
Blues name created for it.
Adweek, May 30, 1994.

The record includes the declaration of Karen Davidson, manager, clothing design, for applicant. Ms. Davidson states, in pertinent part, that the phrase "biker clothing" does not indicate a type or classification of clothing in the clothing industry, and that such term is not used in the industry; and that the term "blues" does not indicate a type or classification of clothing in the clothing industry, and that such term is not used to indicate blue jeans or other denim clothing items. Ms. Davidson further asserts that applicant's BIKER BLUES line of clothing contains items of various colors and that the line does not include leather clothing for motorcyclists. In this connection, Ms. Davidson states that the BIKER BLUES clothing line is targeted to both men and women of various age groups, income and social status, and that the advertising was designed to reach a large audience beyond the motorcycling public. Ms. Davidson maintains that applicant chose the term "blues" in that it is suggestive

of the blues musical style, and that no one else has used the mark sought to be registered here.⁷

The second declaration is from Alyssa Gallender, a retail clothing store manager for The Gap, Inc. Ms. Gallender has an undergraduate degree in "marketing of textiles and apparels" and has worked in the clothing industry since 1991. Ms. Gallender maintains, in pertinent part, that "biker clothing" is not a classification of any kind of clothing in the clothing industry, and that such phrase is not used in the trade; that clothing worn by motorcyclists would typically be made of leather; that the term "blues" is not used in the industry to refer to blue jeans, but rather the term is used in conjunction with the term "denim" or "jeans" to describe the color of the clothing; and that jeans are made in several colors other than blue. Ms. Gallender also states that she has never heard the phrase "biker blues" used in the clothing industry, and that the mark sought to be registered does not convey any readily understood meaning.

Lastly, the Examining Attorney submitted a copy of applicant's Registration No. 1,993,625, issued August 13, 1996, for the mark BIKER BLUES for "clothing, namely,

⁷ Ms. Davidson also sets forth a sales figure of "almost \$10 million" and advertising expenditures of "well over \$1.7

shirts, pants, jeans, vests, jackets, and bandannas." The registration issued pursuant to a claim of acquired distinctiveness under Section 2(f) (which was made as an alternative claim to applicant's position that the mark is inherently distinctive). See: *Trademark Manual of Examining Procedure* §1212.02(c). The underlying application, serial no. 74/802,222, was a "child" application created as a result of applicant's request to divide filed in connection with the present "parent" application. Trademark Rule 2.87.

It is well settled that a term is considered to be merely descriptive of goods, within the meaning of Section 2(e)(1) of the Trademark Act, if it immediately describes an ingredient, quality, characteristic or feature thereof or if it directly conveys information regarding the nature, function, purpose or use of the goods. In re Abcor Development Corp., 588 F.2d 811, 200 USPQ 215, 217-18 (CCPA 1978). It is not necessary that a term describe all of the properties or functions of the goods in order for it to be considered to be merely descriptive thereof; rather, it is sufficient if the term describes a significant attribute about them. Moreover, whether a term is merely descriptive is determined not in the abstract, but in relation to the

million."

goods for which registration is sought. In re Bright-Crest, Ltd., 204 USPQ 591, 593 (TTAB 1979). In this connection, registration must be refused if the term is descriptive of any of the goods for which registration is sought. In re Quik-Print Copy Shop, Inc., 616 F.2d 523, 205 USPQ 505, 507 (CCPA 1980); and In re Richardson Ink Co., 511 F.2d 559, 185 USPQ 46, 47 (CCPA 1975).

The meanings of the terms "biker" and "blues" convince us that the mark sought to be registered, BIKER BLUES, is merely descriptive when applied to applicant's clothing items. We find that the record supplies ample support to show that the term "biker" identifies a particular style of clothing or clothing that is intended to appeal to bikers, that is, motorcyclists. Given the uses of "biker" in printed publications, and most especially in applicant's own catalog, we are somewhat surprised at Ms. Davidson's and Ms. Gallender's claims relative to the term "biker" in the industry. One need look no further than applicant's description of its "BIKER" clothing in terms of "road-smart details" to discern that in no insignificant way the clothing is directed to bikers. See, e. g., In re Camel Manufacturing Co., Inc., 222 USPQ 1031 (TTAB 1984)[mark is merely descriptive if it describes type of individuals to whom appreciable number of goods are directed]. Although,

as applicant points out, its BIKER BLUES line of clothing is marketed to appeal to a broader group of potential purchasers than just motorcyclists, the undeniable fact remains that bikers represent a large segment of that group.

With respect to the term "blues," the record is sufficient for us to find that the term has a particular meaning when applied to clothing. Although the dictionary does not list denim clothing as a definition of the term "blues," the uses of "blues" in printed publications show that the term has been used to refer to clothing made of denim fabric which, according to the evidence of record, is the fabric used in applicant's line of BIKER BLUES clothing. In saying this, we recognize that some of these uses are ambiguous or in the nature of a double entendre (e.g., "holiday blues" or "feeling blue"). However, other uses are clear references to blue denim clothing (e.g., "'dress up' its blues" and "the blues: denim still is the fabric....").

Contrary to applicant's arguments, the combination of the two words results in a composite mark that is merely descriptive when applied to applicant's clothing. That is to say, the combination of the individually descriptive words does not result in a mark that is incongruous or

otherwise just suggestive. We are not persuaded by applicant's contention that the mark suggests the melancholy of motorcyclists or music written about or by bikers. The test of mere descriptiveness is not done in a vacuum, but rather the proposed mark must be evaluated in the context of its application to the goods. When analyzed in such a fashion here, the term BIKER BLUES merely describes applicant's clothing line, that is, denim clothing intended to be worn by bikers, or denim clothing in a style worn by bikers.

The third-party registrations and/or applications are of little help in determining the registrability of the mark at issue in this case. As often noted by the Board, each case must be decided on its own set of facts, and we are not privy to the facts involved with these official records. While uniform treatment under the Trademark Act is highly desirable, it is apparent from the evidence submitted by applicant and the Examining Attorney that the Office has been inconsistent in its treatment of the terms comprising applicant's mark. Indeed, as correctly characterized by applicant, the register reveals a "mixed bag." In any event, our task here is to determine, based upon the record before us, whether applicant's mark is registrable.

Insofar as the probative value of applicant's prior Section 2(f) registration of BIKER BLUES for shirts, pants, jeans, vests, jackets and bandannas is concerned, this evidence has been considered, but it is not dispositive. Applicant makes much of the fact that the claim of acquired distinctiveness in its registration was made in the alternative, arguing that this alternative reliance on the benefits of Section 2(f) does not constitute an admission of mere descriptiveness. Indeed, applicant is correct in maintaining that an alternative claim of acquired distinctiveness under Section 2(f) does not constitute an admission that the proposed mark is not inherently distinctive. In re E S Robbins Corp., 30 USPQ2d 1540, 1542 (TTAB 1992); and *Trademark Manual of Examining Procedure*, §1212.02(c). The same holds true here, notwithstanding the fact that applicant accepted a Section 2(f) registration.

In sum, the evidence of record shows that the mark BIKER BLUES, as applied to applicant's clothing items, immediately conveys information about the goods, namely that they are made of denim fabric and are in the style of biker clothing, or that the denim clothing is designed to be worn by bikers. The fact that applicant may have intended to be the first entity to use the term in the field is not dispositive where, as here, the term BIKER

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BLUES unequivocally conveys a merely descriptive connotation. In re MBAssociates, 180 USPQ 338, 339 (TTAB 1973).

Decision: The refusal to register is affirmed.

R. F. Cissel

T. J. Quinn

B. A. Chapman
Administrative Trademark
Judges, Trademark Trial
and Appeal Board

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