

This Opinion is Not a
Precedent of the TTAB

Mailed: March 5, 2024

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Moto Club International, LLC

Serial No. 90715523

Andrew M. Smith of Resonate IP, LLC, for Moto Club International, LLC.

Patrick Carr, Trademark Examining Attorney, Law Office 125, Robin Mittler,
Managing Attorney.

Before Lykos, Thurmon and Lebow, Administrative Trademark Judges.

Opinion by Thurmon, Administrative Trademark Judge:

Moto Club International, LLC (“Applicant”) seeks registration on the Principal Register of the mark MOTO CLUB INTERNATIONAL, in standard characters, for “decals; sticker; bumper stickers” in International Class 16 and “beanies; headwear; pants; shirts; sweaters; sweatshirts; t-shirts; hooded sweatshirts; jackets; long-sleeved shirts; tank tops” in International Class 25.¹ The Examining Attorney refused

¹ Application Serial No. 90715523, filed May 17, 2021, based on an intent to use the mark in commerce, pursuant to Section 1(b) the Trademark Act, 15 U.S.C. § 1051(b). The application was later amended to allege use in commerce, which converted the filing basis to Section 1(a), 15 U.S.C. § 1051(a). Applicant disclaimed “MOTO” or “INTERNATIONAL”.

registration of the mark for being merely descriptive of the goods in both Classes 16 and 25 under Section 2(e)(1) of the Act, 15 U.S.C. § 1052(e)(1).² Applicant appealed and requested reconsideration, which was denied. The appeal is fully briefed and ready for decision. We reverse the refusal.

I. Section 2(e)(1) – Merely Descriptive – Analysis

Trademark Act Section 2(e)(1), 15 U.S.C. § 1052(e)(1), precludes registration of a mark on the Principal Register which, when used in connection with the applicant's goods, is merely descriptive of them in the absence of acquired distinctiveness. "A term is deemed to be merely descriptive of goods or services, within the meaning of Section 2(e)(1), if it forthwith conveys an immediate idea of an ingredient, quality, characteristic, feature, function, purpose or use of the goods or services." *In re Zuma Array Ltd.*, 2022 USPQ2d 736, at *5 (TTAB 2022) (internal quotations and citations omitted). By contrast, a mark is suggestive if it "requires imagination, thought, and perception to arrive at the qualities or characteristics of the goods." *In re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009, 1009 (Fed. Cir. 1987). Suggestive marks, like fanciful and arbitrary marks, are registrable on the Principal Register without proof of acquired distinctiveness. *See Nautilus Grp., Inc. v. Icon Health & Fitness, Inc.*, 372 F.3d 1330, 1340, 71 USPQ2d 1173, 1180 (Fed. Cir. 2004). "Placement of a term on the fanciful-suggestive-descriptive-generic continuum is a question of fact." *In re Dial-A-Mattress Operating Corp.*, 240 F.3d 1341, 57 USPQ2d 1807, 1810 (Fed. Cir. 2001).

² The Examining Attorney at one point found the mark was either merely descriptive or deceptively misdescriptive, as we explain below. In the final Office Action, however, only the merely descriptive refusal was maintained.

“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].” *Zuma Array*, 2022 USPQ2d 736, at *5 (quoting *In re Fat Boys Water Sports LLC*, 118 USPQ2d 1511, 1513 (TTAB 2016) (citing *In re Gyulay*, 3 USPQ2d at 1010). In addition, “a mark need not be merely descriptive of all recited goods or services in an application. A descriptiveness refusal is proper ‘if the mark is descriptive of any of the [goods or] services for which registration is sought.’” *Id.* at *5-6 (quoting *In re Chamber of Commerce of the United States*, 675 F.3d 1297, 102 USPQ2d 1217, 1219 (Fed. Cir. 2012) (quoting *In re Stereotaxis Inc.*, 429 F.3d 1039, 77 USPQ2d 1087, 1089 (Fed. Cir. 2005)).

“Whether a mark is merely descriptive is evaluated in relation to the particular goods 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 goods because of the manner of its use or intended use,” *In re Fallon*, 2020 USPQ2d 11249, at *7 (TTAB 2020) (quoting *Chamber of Commerce*, 102 USPQ2d at 1219), and “not in the abstract or on the basis of guesswork.” (quoting *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.” *Id.* (quoting *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)).

“Whether a mark is merely descriptive or not is determined from the viewpoint of the relevant purchasing public.” *Zuma Array*, 2022 USPQ2d 736, at *8 (quoting *In re Omniome, Inc.*, 2020 USPQ2d 3222, at *5 (TTAB 2020) (quoting *Stereotaxis*, 77 USPQ2d at 1090)). The relevant purchasers of the goods identified in the application are consumers of motorcycle-themed clothing, decals and stickers.³

“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.” *Id.* (quoting *Fallon*, 2020 USPQ2d 11249, at *7 (quoting *Real Foods*, 128 USPQ2d at 1374)). “These sources may include [w]ebsites, publications and use in labels, packages, or in advertising materials directed to the goods.” *Id.* (quoting *Fallon*, 2020 USPQ2d 11249, at *7-8 (quoting *In re N.C. Lottery*, 866 F.3d 1363, 123 USPQ2d 1707, 1710 (Fed. Cir. 2017) (internal quotation omitted))).

“It is the Examining Attorney’s burden to show, prima facie, that a mark is merely descriptive of an applicant’s goods or services.” *Id.* (internal quotation and quotation marks omitted). “If such a showing is made, the burden of rebuttal shifts to the applicant.” *Id.* (internal quotation and quotation marks omitted). “The Board resolves

³ The evidence of record shows a consistent motorcycle theme in the marketing of the goods and in the images presented on many of the goods (e.g., a person riding a motorcycle). Applicant describes its marketing “as being inspired by a ‘motorcycle lifestyle’”

doubts as to the mere descriptiveness of a mark in favor of the applicant.” *Id.* (internal quotation and quotation marks omitted).

This appeal requires us to determine whether the mark MOTO CLUB INTERNATIONAL, as a whole, is merely descriptive or suggestive of decals, stickers and clothing, notwithstanding Applicant’s disclaimer of MOTO or INTERNATIONAL.⁴

In the complex world of etymology, connotation, syntax, and meaning, a term may possess elements of suggestiveness and descriptiveness at the same time. No clean boundaries separate these legal categories. Rather, a term may slide along the continuum between suggestiveness and descriptiveness depending on usage, context, and other factors that affect the relevant public’s perception of the term.

In re Nett Designs, Inc., 236 F.3d 1339, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001). In this case, we find the connection between the asserted descriptive meaning(s) and the mark is too tenuous, and for that reason, we must reverse the refusal to register.

We begin by noting the obvious. This mark, MOTO CLUB INTERNATIONAL, does not directly describe the goods. The decals, stickers and clothing identified in the Application are not issued or sold by or to members of an international motorcycle club. Applicant is not a club. Applicant sells clothing and related promotional goods (i.e., decals and the like).⁵ So, the mark does not directly describe the goods or the

⁴ We refer to the International Class 16 goods as “decals and stickers,” which is meant to include “bumper stickers.” We refer collectively to the International Class 25 goods as “clothing.”

⁵ 8 TTABVue 11 (“Applicant is a purveyor of leisure and lifestyle clothing and does not offer any association, membership, or organization services which could be construed as a ‘club,’ let alone a ‘motorcycle club.’”).

seller of the goods because it requires multi-step reasoning on the part of the consumer and does not immediately convey the nature of the goods. “A term is merely descriptive if it immediately conveys knowledge of a quality, feature, function, or characteristic of the goods or services with which it is used.” *In re Bayer Aktiengesellschaft*, 488 F.3d 960, 82 USPQ2d 1828, 1831 (2007). *See also In re MBNA America Bank N.A.*, 340 F.3d 1328, 67 USPQ2d 1778, 1780 (Fed. Cir. 2003). We have our doubts that consumers will conclude that MOTO CLUB INTERNATIONAL immediately describes the goods.

The Examining Attorney, however, argues “the applied-for mark merely describes a feature and the intended user or provider of applicant’s goods.”⁶ We agree that if the mark, as a whole, describes either a feature of the goods, the intended or expected users/purchasers of the goods, or something significant about the source of the goods, the mark may be merely descriptive *Zuma Array*, 2022 USPQ2d 736, at *5 (“it is enough if [the mark] describes one significant attribute, function or property of the goods”). So, what is it about these goods that is described by this mark?

The Examining Attorney identifies two features of the goods relevant to this inquiry. First, Applicant’s goods have a motorcycle theme, and “moto” is often used as shorthand for motorcycle, a point Applicant concedes.⁷ An example of the manner in which Applicant’s goods are sold is provided below.

⁶ 10 TTABVUE 3.

⁷ *Id.* at 8; 8 TTABVUE 11 (“Applicant markets itself as being inspired by a ‘motorcycle lifestyle,’ ...”).



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The images below are taken from Applicant's website, where it markets and sells its goods. These images also confirm the motorcycle theme Applicant associates with its goods.

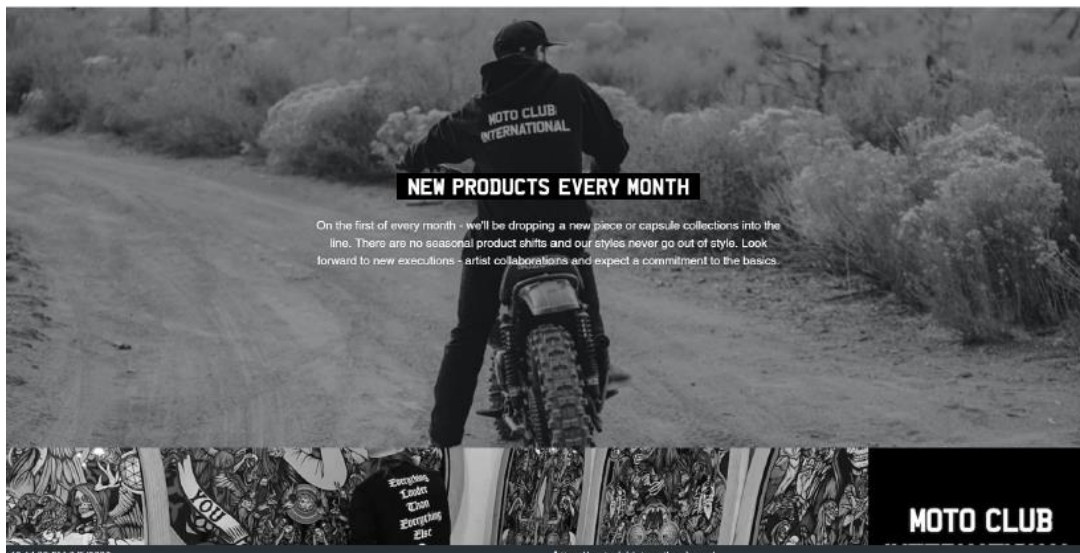
⁸ Response to Office Action dated December 14, 2022, at 12.

Basic Shit for Motorcycle Nerds.

Moto Club International is a motorcycle lifestyle inspired - basics line - of softgoods and accessories. It's clean and simple style-right stuff that's meant to be easy to wear and probably become your favorite oil rag one day. It's basic shit for motorcycle nerds and the posers that love us. If that's enough for you - welcome to the Club.



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The MOTO element of the mark, therefore, describes the motorcycling theme found in the goods and Applicant's marketing of the goods.¹¹

⁹ Office Action dated August 9, 2022, at 21.

¹⁰ *Id.* at 22.

¹¹ 8 TTABVUE 11 ("The fact that Applicant markets itself as being inspired by a 'motorcycle lifestyle,' does not mean that its stickers and leisurewear clothing are specifically designed for use with motorcycles or that they are only marketed exclusively to those having a particular interest in motorcycles.").

Second, Applicant sells the goods via the Internet and does not exclude buyers from outside the United States.¹² The goods, therefore, are international in this respect. While it is true that Applicant sells some of its goods to consumers who reside outside the United States, there is no evidence that the goods are promoted as being international in nature and nothing about the motorcycle theme found in the goods appears international either. Nor is there any evidence that relevant consumers know Applicant sells to consumers outside the United States. For these reasons, we find the word “international” technically describes something about the goods, but there is no evidence relevant consumers are aware of this fact. Without that connection, we cannot find the word “international,” as used in this mark, is understood as descriptive by consumers. Applicant entered an alternative disclaimer that included the word “international,” but we do not find this term creates a merely descriptive meaning for the mark as a whole. Indeed, the evidence does not show that consumers are likely to attribute any particular significance to the word “international” in this mark.

The Examining Attorney’s analysis of the features of the goods results in two distinct findings, and only one is supported by the record. The “moto” element of the mark describes the motorcycle theme of the goods. The “international” element is technically descriptive of the fact that the goods are sold to persons outside the United States, but there is no evidence consumers are aware of this fact (except, of course, those consumers residing outside the United States who have purchased Applicant’s

¹² 10 TTABVue 7-8.

goods, and we have no evidence that these sales are significant).¹³ Without such evidence, we cannot find that consumers understand “international” to be descriptive of the goods. It is likely viewed as mere puffery by consumers.

We also find the structure of the mark undermines the Examining Attorney’s position concerning the word “international,” as used in the mark. MOTO, the first element of the mark, means motorcycle. A club is a type of organization, often formed for non-business reasons, and we know that motorcycle clubs are somewhat common.¹⁴ In the mark MOTO CLUB INTERNATIONAL, the word “international” modifies “moto club,” so relevant consumers are likely to understand the entire mark as a reference to an international motorcycle club. But that does not describe Applicant or its goods. The meaning the Examining Attorney ascribes to the word “international” makes little sense if the mark means an international motorcycle club, because the Examining Attorney’s position is that “international” refers to the fact that some purchasers of the goods reside outside the United States. This meaning of “international” is descriptive, but it describes something different from what the mark, as a whole, appears to mean. And it describes something wholly distinct from

¹³ The Examining Attorney’s analysis would appear to make the word “international” merely descriptive of any goods sold via an Internet retail business that does not refuse to ship goods to consumers outside the United States. Consider, for example, a person with a small business operated out of her home. If this person sells goods, via the Internet, to someone in Canada, Denmark or Brazil, the goods would be international. As we noted above, this is technically correct. But unless the business promotes that it sells internationally, how would consumers know this? Are we to take as fact that consumers now assume any Internet retail site is international in nature? Perhaps our Internet age has reached this point, but we need evidence to support taking such a step. There is no such evidence in the record of this appeal.

¹⁴ The Examining Attorney submitted evidence of many motorcycle clubs. Office Action dated February 1, 2022 at 31-32; Office Action dated August 9, 2022 at 27-40.

the meaning of “moto” as used in the mark. There is nothing wrong with considering the meaning of each word within the mark, but the meanings ascribed to those words must coalesce into a single meaning that works for the mark as a whole. The Examining Attorney’s analysis does not show how the meanings of “moto” and “international” combine to support a single meaning for the entire mark.

The Examining Attorney also argues the MOTO CLUB INTERNATIONAL mark describes the “provider of applicant’s goods.”¹⁵ We disagree. Applicant is not a club, as we noted above. It is a business that sells clothing, decals and stickers. The Examining Attorney argues that Applicant is “an organization dedicated to an interest in motorcycles.”¹⁶ Perhaps, but it is a business organization that sells clothing, decals and stickers with a motorcycle theme. That is what the evidence shows. The mark, as a whole, does not describe Applicant.

The final basis for the Examining Attorney’s refusal is the argument that the mark describes “the intended user” of the goods. The goods have a motorcycle theme, and it follows that persons who want motorcycle-themed clothing, stickers or decals are within the “intended user” group.¹⁷ The MOTO element of the mark confirms this connection to motorcycles, as the Examining Attorney notes.¹⁸ This much is not

¹⁵ 10 TTABVUE 3.

¹⁶ *Id.* at 4.

¹⁷ We defined the relevant consumer group above as “consumers of motorcycle-themed clothing, decals and stickers.” *See* p.3, *supra*.

¹⁸ “This evidence clearly shows that consumers would understand the wording MOTO to be the equivalent of ‘motorcycle’” *Id.* at 11.

disputed: MOTO means motorcycle in this mark and the goods have a motorcycling theme.

But from this well-supported position, the Examining Attorney finds “that consumers would perceive the wording MOTO CLUB as merely conveying that these goods are intended for use by individuals or organizations with an interest in motorcycles, or a MOTO CLUB”¹⁹ There is evidence of motorcycle clubs, or moto clubs, but these are clubs of riders. Where is the evidence that persons interested in motorcycle-themed clothing, stickers and decals consider themselves part of a MOTO CLUB? If anything, the evidence of so many motorcycle clubs shows that relevant consumers are familiar with such organizations and likely know whether or not they are members of such a club. There is simply nothing in the record that shows consumers of motorcycle-themed goods consider themselves part of some informal club, let alone an international motorcycle club.²⁰

It is at this point that the Examining Attorney’s “intended user” analysis fails. It is undisputed that Applicant’s goods have a motorcycle theme and that some of Applicant’s goods are sold to consumers outside the United States, though we discount the latter fact given the lack of evidence the goods are marketed as being

¹⁹ *Id.*

²⁰ There is substantial evidence of third parties who use “club” descriptively in their marks. Office Action dated August 9, 2022 at 42-375. The marks range from booster clubs for universities (NITTANY LION CLUB, a mark registered by Penn State University) to well-known organizations (ROTARY CLUB) to sports teams (baseball and soccer, primarily) to motorcycle clubs (Gandhi Motorcycle Club), all of which disclaimed the word “club” in their marks. The Examining Attorney submitted this evidence in connection with a deceptively misdescriptive refusal that was not maintained.

“international” in nature. But even if we accepted the Examining Attorney’s position concerning the meaning of “moto” and “international,” there is no evidence relevant consumers interested in motorcycles, or more precisely, in clothing, decals and stickers with a motorcycle theme, think of themselves are being part of a MOTO CLUB. That is a step too far.

The Applicant and Examining Attorney also disagree on whether the Examining Attorney engaged in multi-step reasoning. As can be seen from our analysis above, the Examining Attorney did focus on the meaning of each word in the mark. That is entirely appropriate, because each of the words in the mark have well-known meanings. It would be nonsensical to engage in a descriptiveness analysis of this mark without considering the meaning of the three words that make up the mark.

But such an approach can lead to overly loose analysis. That is, to an extent, what happened here. Each word in the mark has an established meaning, and each of those meanings could have some connection to the goods. Moto means motorcycle. Moto club means a motorcycle club, and there are such clubs. International means outside the U.S., and the some of the goods are sold to consumers outside the U.S.

If that is the end of the analysis, it falls short, though not because it involves multiple steps. There are three words in the mark. Defining each one constitutes three steps. The first two words “moto club,” when used together, have a known meaning, too. Now we’re up to four steps. The number of steps required to complete the Examining Attorney’s analysis is a sign the mark, as a whole, may be suggestive. But it is not the primary problem with that analysis.

The Examining Attorney concludes that the intended or expected consumers of these goods are part of a “moto club,” but the evidence doesn’t support that conclusion. The evidence does not establish that consumers who, for example, want to buy or wear clothing with a motorcycle theme consider themselves part of a moto club, let alone an international moto club. We also find, however, that the multi-step analysis used by the Examining Attorney tends to undermine the basis for the refusal. While there is nothing wrong with considering the meaning of each of the three words in the mark, that analysis should begin to coalesce around one meaning of the mark as a whole. The Examining Attorney’s analysis doesn’t do that. Instead, the Examining Attorney focuses on each of the words individually and never provides a good explanation for how these words, as used together in the mark, combine to form a single, descriptive meaning. It is not clear from the record what this mark, taken as a whole, means to relevant consumers.

The Examining Attorney’s approach was not improper. It fails nonetheless because the meanings of the words in the mark do not come together. We must consider the mark as a whole. Consider, by way of contrast, the Board’s evaluation of the mark SEMICONDUCTOR LIGHT MATRIX, at issue in *In re Phoseon Tech., Inc.*, 103 USPQ2d 1822 (TTAB 2012). In that case, the Board provided definitions of each of the three words in the mark, and then found these words work together to support a single, descriptive meaning of the mark. *Id.* at 1823-24.

At the outset, definitions of the relevant terms are helpful for determining whether the mark is merely descriptive.

1. A ‘semiconductor’ is ‘a solid material that has electrical conductivity between that of a conductor and an

insulator.’ A light-emitting diode (also known as an LED) is a type of semiconductor which produces light.

2. ‘Light’ means, *inter alia*, ‘electromagnetic radiation: electromagnetic radiation that has wavelengths of any length.’

3. A ‘matrix’ is ‘an array of circuit elements (as diodes and transistors) for performing a specific function.’ Thus, two or more LEDs can be joined together in a matrix or array to produce more light than an individual LED.

In view of the foregoing, the term ‘Semiconductor Light Matrix’ would be understood as meaning a light emitting matrix utilizing semiconductors. We find that the evidence of record establishes that the words in the proposed mark SEMICONDUCTOR LIGHT MATRIX retain their dictionary meanings when used by applicant; and the proposed mark in its entirety is merely descriptive, because as the words are combined they do not create a meaning different from the individual elements.

Id. Notice how all three meanings are complementary when used together in the mark. It is the SEMICONDUCTOR LIGHT MATRIX mark, as a whole, that was found merely descriptive of the goods in the *Phoseon Tech.* case.

We cannot reach the same conclusion here. The meanings of “moto” and “club” and “international” do not come together to form a descriptive meaning of the mark as a whole. Instead, these words support different meanings in this case. When a multi-step analysis is used, that analysis must come together, it cannot continue to point in different directions. That is what happened here. It takes too much effort to tie together the disparate threads of analysis relied upon by the Examining Attorney in this case. *See In re Tennis in the Round, Inc.*, 199 USPQ 496, 498 (TTAB 1978) (“if one must exercise mature thought or follow a multi-stage reasoning process in order to determine what product or service characteristics the term indicates, the term is

suggestive rather than merely descriptive”); *see also, In re Shutts*, 217 USPQ 363, 364-65 (TTAB 1983).

For all the reasons set out above, we find the mark MOTO CLUB INTERNATIONAL is suggestive of the goods, not merely descriptive of them. The Examining Attorney has not carried the burden of making a prima facie showing that the MOTO CLUB INTERNATIONAL mark is merely descriptive. This case is close, and to the extent there is doubt, we must resolve that doubt in favor of the Applicant. *In re Merrill Lynch, Pierce, Fenner, & Smith, Inc.*, 828 F.2d 1567, 1571 (Fed. Cir. 1987) (“It is incumbent on the Board to balance the evidence of public understanding of the mark against the degree of descriptiveness encumbering the mark, and to resolve reasonable doubt in favor of the applicant, in accordance with practice and precedent.”).

Decision: The Section 2(e)(1) mere descriptiveness refusal is **reversed as to both International Classes 16 and 25.**