

THIS OPINION IS NOT A
PRECEDENT OF THE TTAB

Mailed: June 27, 2025

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Buckeye Custom E-Bikes, LLC

Serial No. 98321088

Andrew P. Lycans of Critchfield Critchfield & Johnston Ltd.,
for Buckeye Custom E-Bikes, LLC.

Tasneem Hussain,¹ Trademark Examining Attorney, Law Office 118,
Michael Baird, Managing Attorney.

Before Wellington, Pologeorgis, and Stanley,
Administrative Trademark Judges.

Opinion by Pologeorgis, Administrative Trademark Judge:

Buckeye Custom E-Bikes, LLC (“Applicant”) seeks registration on the Principal Register of the standard character mark BUCKEYE CUSTOM E-BIKES based on acquired distinctiveness of the mark, as a whole, for “On-line retail store services

¹ Examining Attorney Rebecca Choi handled the prosecution of the involved application on behalf of the Office; however, Examining Attorney Tasneem Hussain was substituted as the assigned Examining Attorney subsequent to the filing of the request for reconsideration.

featuring electric bicycles and electric bicycle accessories; Retail store services featuring electric bicycles and electric bicycle accessories” in International Class 35.²

The Trademark Examining Attorney refused registration of Applicant’s mark under Section 2(e)(2) of the Trademark Act, 15 U.S.C. § 1052(e)(2), on the ground that Applicant’s proposed mark is primarily geographically descriptive of the identified services and lacks acquired distinctiveness under Section 2(f) of the Trademark Act, 15 U.S.C. § 1052(f).

When the refusal was made final, Applicant appealed and requested reconsideration. When the request for reconsideration was denied, the appeal resumed. The appeal is fully briefed.

² Application Serial No. 98321088, filed on December 19, 2023, based on an allegation of use in commerce under Section 1(a) of the Trademark Act, U.S.C. § 1051(a), claiming February 2018 as both the date of first use and the date of first use in commerce. Applicant did not seek registration under Section 2(f) of the Trademark Act for the mark, as a whole, when the application was originally filed. Applicant amended its application to seek registration under Section 2(f), in whole, during the prosecution of its application. *See* Applicant’s July 30, 2024 Response to Office Action.

Generally, when an applicant seeks registration under Section 2(f), in whole, it has conceded that its mark, as whole, is descriptive in some manner. *Yamaha Int’l Corp. v. Hoshino Gakki Co., Ltd.*, 840 F.2d 1572, 1577 (Fed. Cir. 1988) (“reliance by the applicant on Section 2(f) assumes that the mark has been shown or conceded to be merely descriptive”). In such situations, the only issue to determine is usually whether the Section 2(f) evidence is sufficient to demonstrate acquired distinctiveness and, if so, allow the mark to register. *Id.* at 1577 (“Where, as here, an applicant seeks a registration based on acquired distinctiveness under Section 2(f), the statute accepts a lack of inherent distinctiveness as an established fact. ... The only remaining issue under Section 2(f) relating to the proposed mark itself is acquired distinctiveness.”). Here, however, both the Examining Attorney and Applicant argued the merits of the Section 2(e)(2) refusal throughout prosecution and in their respective appeal briefs. In view thereof, we construe Applicant’s amendment to seek registration under Section 2(f), in whole, to have been a request in the alternative. *See In re Engineering Sys. Corp.*, Ser. No. 73507205, 1986 WL 83295, at *1 (TTAB 2018) (“Notwithstanding the fact that its application was filed pursuant to the provisions of Section 2(f), it is applicant’s basic position, argued quite strenuously, that its mark is not merely descriptive as applied to its goods. Accordingly, we construe applicant’s claim of distinctiveness as having been offered in the alternative.”)

For the reasons explained below, we reverse the Section 2(e)(2) refusal and, as a result, deem the construed request to seek registration under Section 2(f) in the alternative as moot. However, as discussed more fully below, the application may not proceed without a disclaimer of the wording CUSTOM E-BIKES.³

I. Primarily Geographically Descriptive – Applicable Law

Section 2(e)(2) of the Trademark Act prohibits the registration of a mark which, when used on or in connection with the goods or services of an applicant, is primarily geographically descriptive of them.⁴ “That is to say, where there is an indication that the purchasing public would expect [an] applicant’s goods [or services] to have their origin in the place named by the mark, registration should be refused.” *In re Cambridge Digital Sys.*, Ser. No. 73508576, 1986 WL 83330, at *1 (TTAB 1986). The test for determining whether a mark is primarily geographically descriptive is whether:

1. the mark sought to be registered (or a portion thereof) is the name of a place generally known to the public;
2. the source of the goods or services is the geographic region named in the mark; and

³ The TTABVue and Trademark Status and Document Retrieval (TSDR) citations refer to the docket and electronic file database for the involved application. All citations to the TSDR database are to the downloadable .pdf version of the documents.

⁴ Section 2(e)(2) of the Trademark Act, 15 U.S.C. § 1052(e)(2), reads in relevant part:

No trademark by which the goods of the applicant may be distinguished from the goods of others shall be refused registration on the principal register on account of its nature unless it -

(e) Consists of a mark which ... (2) when applied to the goods of the applicant is primarily geographically descriptive

3. the public would make an association between the goods or services and the place named in the mark, that is, believe that the goods or services for which the mark is sought to be registered originate in that place.

In re The Newbridge Cutlery Co., 776 F.3d 854, 860-61 (Fed. Cir. 2015); *see also In re Societe Generale des Eaux Minerals de Vittel S.A.*, 824 F.2d 957, 959 (Fed. Cir. 1987).

The relevant public is the purchasing public in the United States of the types of goods or services identified in the application. *Newbridge Cutlery*, 776 F.3d at 861. In instances where a geographic location is generally known, and the term's geographic significance is its primary significance, and the goods or services do, in fact, originate from the named location, a goods/place association can be presumed. *Id.*

Additionally, in order to refuse registration, “the geographical meaning [must be] perceived by the relevant public as the *primary* meaning and that the geographical significance of the mark is to be assessed as it is used on or in connection with the goods [or services].” *Id.* at 859 (emphasis in the original). Thus, alternative non-geographic significance is relevant to a primarily geographically descriptive analysis. *Id.* at 860. That a term has other meanings, both geographical and nongeographical, makes it less likely that the public will generally consider the term as the name of a place. *Id.* at 863.

With regard to geographic nicknames, they are treated the same as the actual name of the geographic location, if it is likely to be perceived as such by the purchasing public. *See In re Spirits of New Merced, LLC*, Ser. No. 78710805, 2007 WL 4365811, at *3 (TTAB 2007) (finding “Yosemite” -- a well-recognized and frequently used shorthand reference to Yosemite National Park and the Yosemite region in

general -- conveys a readily recognizable geographic significance); *In re Carolina Apparel*, Ser. No. 74658141, 1998 WL 785303, at *1 (TTAB 1998) (holding CAROLINA APPAREL primarily geographically descriptive of retail clothing store services, where the evidence showed that “Carolina” is used to indicate either the state of North Carolina or South Carolina); *In re Charles S. Loeb Pipes, Inc.*, Ser. No. 73030134, 1975 WL 20760, at *8 (TTAB 1976) (holding OLD DOMINION is “the accepted nickname for the State of Virginia”). *Cf. In re Broken Arrow Beef & Provision, LLC*, Ser. No. 87334198, 2019 WL 854687, at *2 (TTAB 2019) (finding “the letters ‘BA’ in the applied-for mark have no obvious, generally known geographic significance, much less as a known abbreviation for Broken Arrow, Oklahoma” and thus did not identify a place known generally to the purchasing public); *In re Trans Cont’l Records, Inc.*, Ser. No. 75628844, 2002 WL 448738, at *4 (TTAB 2002) (finding O-TOWN “relatively obscure term” that would not be perceived by a significant portion of the purchasing public as a geographic reference to Orlando, Florida).

II. Arguments and Evidence

With regard to the first prong of the primarily geographically descriptiveness test, the Examining Attorney argues that the term BUCKEYE is a commonly used nickname for the U.S. state of Ohio.⁵ In support of her argument, the Examining Attorney submitted the following dictionary definitions and online articles concerning the word “buckeye”:⁶

⁵ Examining Attorney’s Appeal Brief, 6 TTABVUE 3-4.

⁶ July 24, 2024 Office Action, TSDR pp. 6-28, 65-69.

- Collins Dictionary (American English): 1. any of various trees (genus *Aesculus*) of the horse-chestnut family with large capsules enclosing shiny brown seeds; 2. the seed; and 3. a person born or living in Ohio, called the Buckeye State.
- Merriam Webster Dictionary: 1. Any various shrubs or trees (genus *Aesculus*) of the horse-chestnut family also: the large nutlike seed of such a shrub or tree; 2. A native or resident of Ohio - used as a nickname"
- Americaexplained.org: "Why is Ohio Called the Buckeye State?"

Ohio's decision to call itself the "Buckeye State" is a natural choice. The hardy tree with the distinctive seeds used to dot much of the landscape during the colonial acquisition of this territory, and it still does. Adding to the symbolic weight of the name, the Indian word for buckeye nuts, *hetuck* or "buck eye," was once applied by the local Indians to an early pioneer as a seemingly sincere term of endearment.

Colonists began to settle the Northwest Territories in the late 18th century, landing at the first outpost in what is now Marietta, Ohio. One of that city's founders, Ebenezer Sproat, reportedly became known as *Hetuck* to the natives. Some historians believe this is the first connection of Ohio to the nickname "Buckeye State." Though historians often note that this was due to

- States Symbols USA: "Ohio's nickname is 'The Buckeye State'..."

Ohio State Nickname



Ohio buckeyes photo © [Jim Crotty](#) (used by permission).

Nickname for Ohio

Ohio's nickname is "The Buckeye State" partially because many buckeye trees once covered Ohio's hills

Nickname for Ohio

Ohio's nickname is "The Buckeye State" partially because many buckeye trees once covered Ohio's hills and plains. [All State Nicknames](#)

The name "buckeye" stems from Native Americans, who called the nut "*hetuck*," which means "buck eye" (because the markings on the nut resemble the eye of a deer). But the national association between Ohio and the buckeye was born during William Henry Harrison's 1840 presidential campaign (Harrison was a Virginia-born Ohioan and military hero). Harrison's opponents claimed he was "better suited to sit in a log

cabin and drink hard cider." Harrison's supporters turned this intended criticism into a promotion, dubbing him "the log cabin candidate." They fashioned Harrison's campaign emblem as a log cabin made of buckeye timbers with a long string of buckeyes decorating the walls (Harrison's backers also walked with buckeye canes and rolled whisky barrels in parades).

- Ohio government website: “Ohio is known as the Buckeye State”

Ohio.gov / Government / Resources / What is a Buckeye?

What is a Buckeye?

Ohio is known as the Buckeye State. But what exactly is a buckeye?

The buckeye tree (*aesculus glabra*) is native to North America. In late summer and early fall, the trees bear fruit that contain a large nut. The nut gives the tree its name because it is dark brown with a light spot, resembling the shape and color of a deer's eye. The buckeye was named the state tree of Ohio in 1953.

The term buckeye has widely been used to describe residents of Ohio in general since the mid 1800s. It became popular when supporters of William Henry Harrison's successful presidential campaign carved souvenirs out of buckeye wood.

The word buckeye also appears in the names of many geographic areas including the community of Buckeye in Jackson county, Buckeye Lake in Fairfield and Licking Counties, and the Buckeye Trail, which is a hiking trail that loops around the state.

The buckeye is used in the names of many Ohio-based companies and organizations. It is the official mascot of The Ohio State University, where current students and alumni refer to themselves as Buckeyes.

The buckeye also lends its name to a popular confection. Chocolate buckeyes are peanut butter bonbons partially dipped in chocolate. Part of the light-colored filling is left un-coated giving the candy the appearance of a buckeye nut. While the buckeye nut is poisonous, the buckeye treat is delicious.

- Columbia Gazetteer: “Ohio is nicknamed the ‘Buckeye State’ because of the many Buckeye trees that once covered its hills and plains.”

Additionally, the Examining Attorney submitted the following third-party registrations for marks that include the term BUCKEYE, where “buckeye” has either been disclaimed or registered under Section 2(f) of the Trademark Act and where the registrant offers its goods or services in the U.S. state of Ohio:⁷

Reg. No.	Mark	Goods/Services
7343105 Registered: 4/2/2024	BUCKEYE FARMS (standard character; BUCKEYE disclaimed)	“Bags specifically adapted for dust collector machines”
7128367 Registered: 8/1/2023	THE BUCKEYE LADY (standard character; BUCKEYE disclaimed)	“Candy; Chocolate confections, namely, chocolate and peanut butter candies, chocolate and peanut butter candies stuffed

⁷ January 22, 2025 Denial of Request for Reconsideration, TSDR pp. 6-17.

Reg. No.	Mark	Goods/Services
		with one or more other confections” in Cl. 30; and “On-line retail store services featuring candy and confections; Online retail candy and confection store services featuring in-store order pickup; Retail store services featuring candy and confections; Retail candy and confection stores,” in Cl. 35.
6155003 Registered: 9/15/2020	BUCKEYE BUILT (standard character; BUCKEYE disclaimed)	“Fitted protective covers specially adapted for outdoor furniture”
3480157 Registered: 8/5/2008	THE ORIGINAL BUCKEYE GOURMET BARBECUE SAUCE (standard character; 2(f), in whole, BARBECUE SAUCE disclaimed)	“Barbecue sauce”
6689198 Registered: 4/5/2022	BUCKEYE FIRE DEPARTMENT (standard character; 2(f), in whole, FIRE DEPARTMENT disclaimed)	“Fire extinguishing compositions; Fire extinguishing preparations,” in Cl 1; and “Fire-extinguishing systems; Fire extinguishers; Fire extinguishing apparatus,” in Cl. 9
6079092 Registered: 6/16/2020	BUCKEYE PUPPIES (standard character; 2(f), in whole, PUPPIES disclaimed)	“Providing a website featuring on-line classified ad listings posted by users for puppies that are for sale,” in Cl. 35.

The Examining Attorney additionally submitted screenshots from various third-party websites with retail businesses located in Ohio who use the term BUCKEYE in a purported geographically descriptive manner. The third-party websites are as follows:⁸

- Buckeye Bike;
- The Buckeye Bike Hub;
- Buckeye City Motorsports;
- Harley-Davidson Ohio location styled as Buckeye Harley-Davidson;
- The Buckeye Corner by Lids;
- Buckeye Furniture & Mattress Center; and
- Buckeye Charm.

Based on the foregoing evidence, the Examining Attorney argues that relevant consumers would view the term BUCKEYE as the nickname of the geographic location known as the U.S. state of Ohio.⁹

With respect to the second prong, the Examining Attorney notes that Applicant's address is located in Fredericksburg, Ohio which in turn indicates that Applicant's services originate in Ohio.¹⁰ The Examining Attorney maintains that Applicant appears to concede that the services originate in Ohio as it did not argue or address

⁸ *Id.*, TSDR pp. 18-47.

⁹ Examining Attorney's Appeal Brief, 6 TTABVue 4.

¹⁰ *Id.*

this factor throughout the proceedings.¹¹

As to the third prong, the Examining Attorney contends that “[b]ecause Ohio, the ‘Buckeye state,’ is generally known to the purchasing public as a state in the United States and applicant’s services do originate there, there is a presumption of a services-place association by the public.”¹²

Finally, the Examining Attorney argues that the addition of the wording CUSTOM E-BIKES in Applicant’s mark does not diminish the geographic significance of the mark because it is merely descriptive/generic wording when used in connection with the identified services.¹³ The Examining Attorney contends that the wording CUSTOM E-BIKES merely names the types of goods offered by Applicant’s retail store services as demonstrated by Applicant’s identification and specimen.¹⁴ The Examining Attorney further notes that the evidence of record demonstrates that it is common for retailers providing e-bikes to provide customizable electronic bikes.¹⁵ Additionally, the Examining Attorney contends that Applicant concedes that CUSTOM E-BIKES wording is descriptive of Applicant’s services.¹⁶ As such, the Examining Attorney concludes that the mark BUCKEYE CUSTOM E-BIKES is geographically descriptive of the Ohio-based custom e-bike retail store services and

¹¹ *Id.*, 6 TTABVUE 4-5.

¹² *Id.*, 6 TTABVUE 5.

¹³ *Id.*

¹⁴ *Id.*

¹⁵ July 24, 2024 Office Action, TSDR 29-64.

¹⁶ Applicant’s Appeal Brief, 4 TTABVUE 11 (“There is no apparent basis for making the Applicant (who combined the term ‘buckeye’ with the **descriptive phrase ‘custom e-bikes’**”) (emphasis added by the Board).

that the refusal is supported by case law and evidence.

As for Applicant's claim of acquired distinctiveness under Section 2(f) of the Trademark Act, the Examining Attorney argues that Applicant's allegation of five years' use was woefully insufficient to show acquired distinctiveness of Applicant's mark, as a whole, particularly since the wording CUSTOM E-BIKES in the mark is highly descriptive, if not generic, of Applicant's retail services.¹⁷

In contesting the refusal, Applicant argues that the word "BUCKEYE" would not be perceived by the relevant purchasing public as primarily a geographic location.¹⁸ In support of its argument, Applicant maintains the Examining Attorney attached numerous definitions of "buckeye" that invariably define the term first as a tree or shrub, and second the seed produced by such a tree or shrub.¹⁹

Applicant also maintains that, as demonstrated by the Examining Attorney's own evidence, the term "buckeye" is used to refer to people from Ohio, not the U.S. state itself.²⁰ Additionally, Applicant points to the Examining Attorney's evidence that demonstrates that the phrase "the Buckeye State" is the actual geographic nickname for the state of Ohio, not the term "buckeye" standing alone.²¹

In further support of its position, Applicant submitted the following third-party registrations, each owned by registrants from the state of Ohio, and which were

¹⁷ Examining Attorney's Appeal Brief, 6 TTABVUE 8-9.

¹⁸ Applicant's Appeal Brief, 4 TTABVUE 4.

¹⁹ *Id.*, 4 TTABVUE 6.

²⁰ *Id.*, 4 TTABVUE 7.

²¹ *Id.*

issued on the Principal Register without a disclaimer of the term BUCKEYE or a claim of acquired distinctiveness;²²

Reg. No.	Mark	Goods/Services
7308134 Registered: 2/20/2024	BUCKEYE SWIMMING (standard character; SWIMMING disclaimed)	“Swimming instruction”
3312403 Registered: 10/16/2007	BUCKEYE RESUMES (standard character; RESUMES disclaimed)	“Employment outplacement services and resume preparation”
7050491 Registered: 5/9/2023	BUCKEYE BALM (standard character; BALM disclaimed)	“Lipstick, lip balms; lip gloss; lip stains”
6442450 Registered: 8/3/2021	BUCKEYE MASK (standard character; MASK disclaimed)	“Dust masks; Non- medical respiratory mask filters; Protecting masks; Respiratory masks for non-medical purposes”

²² Applicant’s December 4, 2024 Request for Reconsideration, TSDR pp. 56-366. In addition to the third-party registrations identified in the chart, Applicant also submitted copies of Registration Nos. 5579673 and 2884319 for the marks BUCKEYE AMBULANCE (standard character; AMBULANCE disclaimed) and BUCKEYE APPRAISING INC. and design (APPRAISING INC. disclaimed), respectively. These third-party registrations, however, are canceled and, therefore, have no probative value. *See Made in Nature, LLC v. Pharmavite LLC*, Opp. No. 91223352, 2022 WL 2188890, at *15 (TTAB 2022) (“A cancelled or expired registration has no probative value other than to show that it once issued and it is not entitled to any of the statutory presumptions of Trademark Act Section 7(b).”) (citations omitted). Thus, we have given them no consideration in our analysis.

Applicant also submitted a status and title copy of pending application Serial No. 98412003 for the standard character mark BUCKEYE BROWNIES (BROWNIES disclaimed) for “brownies; bakery goods.” *See* Request for Reconsideration, Ex. Z, TSDR pp. 357-366. However, evidence of a pending application has little to no probative value as the application is evidence only that the application has been filed. *In re Team Jesus LLC*, 2020 USPQ2d 11489, Ser. No. 88105154, 2020 WL 7313021, at *7 n.29 (TTAB 2020) (an application is evidence only of the fact that it was filed, and therefore has no probative value). That being said, we note that this application was approved for publication by the assigned examining attorney without a requirement to disclaim the term BUCKEYE or seek registration under Section 2(f).

Reg. No.	Mark	Goods/Services
5284573 Registered: 9/12/2017	BUCKEYE POOLS (standard character; POOLS disclaimed)	“Construction of swimming pools; Installation, maintenance and repair of swimming pools; Installation, repair and replacement of swimming pools; Swimming pool cleaning services”
4442854 Registered: 12/2/2013	BUCKEYE GOLD (standard character; GOLD disclaimed)	Providing monetary exchange services, namely, providing cash to others in exchange for precious metals, coins, jewelry, diamonds, flatware, and other valuable metals; providing monetary exchange services, namely, exchanging gold, gold coins, gold jewelry, and gold flatware for cash
5475830 Registered: 5/22/2018	BUCKEYE DOLLAR (standard character; DOLLAR disclaimed)	“Retail discount store services in the field of general consumer merchandise”
3097646 Registered: 5/30/2006	BUCKEYE CAM (standard character; CAM disclaimed)	“automatic cameras”
3074405 Registered: 3/28/2006	BUCKEYE BURGER (standard character; BURGER disclaimed)	“meat patties”

Applicant also submitted an additional eleven third-party registrations for marks comprising the term BUCKEYE, in whole or in part, where the registrant is not

located in Ohio.²³ Applicant argues that if the primary significance of “buckeye” is a generally known location, i.e., the state of Ohio, then all of these previously allowed registrations are presumptively geographically misdescriptive, in that they suggest to consumers that the products or services originate from Ohio when they do not.²⁴ Applicant further contends that “the most obvious explanation for why so many registrations for buckeye have been allowed to issue to applicants outside the state of Ohio is that the primary significance of the term is the botanical reference, with the reference to Ohio being a tertiary reference, i.e., the third most common reference.”²⁵

Applicant also relies on the Board’s prior decision in *Univ. Book Store v. Bd. of Regents of the Univ. of Wis. Sys.*, Opp. No. 91084223, 1994 WL 747886 (TTAB 1994) to support its position that its mark is not primarily geographically descriptive. In that decision, the applicant sought to register the mark WISCONSIN BADGERS used in connection with a number of clothing items and educational services. *Id.* at *1. The opposer, among other things, contended that WISCONSIN BADGERS should

²³ Applicant’s December 4, 2024 Request for Reconsideration, Exhs. D-N, TSDR pp. 42-55. Applicant also submitted an abstract listing of third-party registrations for marks comprising the term BUCKEYE alone or with other terms where Applicant purports the term BUCKEYE is not disclaimed or registered under Section 2(f) of the Trademark Act and where the registrant is located in Ohio. *Id.*, Ex. C, TSDR pp. 24-41. While the listing identifies the registrants, the marks, and the attendant goods/services, as well as indicate that the registrations are live and subsisting, the listing nevertheless is extremely limited inasmuch as there is no indication as to whether the third-party registrations issued on either the Principal Register, with or without resort of a disclaimer of the term BUCKEYE or to the provisions of Section 2(f) of the Trademark Act, 15 U.S.C. §1052(f), or the Supplemental Register, and the Board does not take judicial notice of third-party registrations. *See, e.g., In re Duofold Inc.*, Ser. No. unknown, 1974 WL 20125, at *2 (TTAB 1974). As such, this evidence has limited probative value.

²⁴ Applicant’s Appeal Brief, 4 TTABVUE 6.

²⁵ *Id.*, 4 TTABVUE 7.

be refused registration because it is primarily geographically descriptive. *Id.* at *3. The Board noted that Wisconsin is nicknamed the “Badger State” and recounted how that name originated in the 1830s. *Id.* at *9. Despite this, the Board went on to hold that “it is plain that the mark ‘WISCONSIN BADGERS’ would not be perceived as naming or specifying a particular geographic location and thus fails to signify a place generally known to the public.” *Id.* While “suggestive of the State of Wisconsin, due not only to the state name but also to the long association of the word ‘badger’ as a nickname for residents of the ‘Badger State’ and the fact that the badger is the official state animal, we agree with applicant that, based upon the undisputed material facts, the mark ‘WISCONSIN BADGERS’ is not primarily geographically descriptive of applicant’s goods and services as a matter of law.” *Id.*

Applicant argues that the present ex parte appeal is not factually distinguishable from the *University Book Store* case.²⁶ Specifically, Applicant maintains that although Ohio residents have long been referred to as “buckeyes,” this does not mean consumers would perceive BUCKEYE CUSTOM E-BIKES as naming or specifying a particular geographic location, and thus fails to name a place generally known to the public.²⁷

Finally, with regard to its construed request for registration under Section 2(f) of the Trademark Act, Applicant maintains that its allegation of five years’ use is

²⁶ Applicant’s Appeal Brief, 4 TTABVUE 8.

²⁷ *Id.*

sufficient evidence of acquired distinctiveness.²⁸

III. Analysis

As previously noted, under Section 2(e)(2) of the Trademark Act, a mark may not be registered on the Principal Register if the mark, when used on or in connection with the goods or services of the applicant is primarily geographically descriptive of them and has not acquired distinctiveness. Based on the totality of the evidence of record, we agree with Applicant that its mark BUCKEYE CUSTOM E-BIKES is not primarily geographically descriptive of the identified services.

As demonstrated by the dictionary and website article evidence of record, the term ‘buckeye,’ standing alone, is primarily defined as a tree or shrub or the seed from such tree or shrub. The record also shows that the nickname for the state of Ohio is not “buckeye” but the “Buckeye State.” And while the tertiary dictionary definition of “buckeye” is “a native of Ohio,” that definition primarily defines a person, not a geographic location.

Moreover, while the Examining Attorney submitted six third-party registrations for marks containing the term BUCKEYE where the term “buckeye” has been disclaimed or registered under Section 2(f) and where the registrant is located in Ohio, the record does not show whether the registrants voluntarily disclaimed the term or sought registration under Section 2(f) on their own initiative. Nevertheless, Applicant submitted countervailing evidence in the nature of nine third-party registrations where the term BUCKEYE is not disclaimed or registered under Section

²⁸ *Id.*, 4 TTABVue 14.

2(f) and where the registrant is located in Ohio.²⁹

Quite simply, while the term “buckeye” may be suggestive of the state of Ohio, the evidence of record demonstrates that the term’s primary significance is not that of a geographic location. Since the mark BUCKEYE CUSTOM E-BIKES does not consist of a geographically descriptive term combined with a highly descriptive, generic, or highly suggestive and laudatory term, the mark, as a whole, is not primarily geographically descriptive. As such, the mark is inherently distinctive and proof of acquired distinctiveness is not required. Accordingly, it is not necessary for us to decide the issue of acquired distinctiveness because it is moot.

That being said, the wording CUSTOM E-BIKES is generic, or at least highly descriptive, of Applicant’s identified services because Applicant provides custom e-bikes through its retail store services.³⁰ The Board has often held that a term that

²⁹ The “mixed” third-party registration evidence of record is simply insufficient to establish that the term BUCKEYE would be perceived primarily as a geographic location by relevant consumers. *Cf. Luxco, Inc. v. Consejo Regulador del Tequila, A.C.*, Opp. No. 91190827, 2017 WL 542344, at *21 (2017) (because record was mixed, evidence failed to show that certification mark had lost significance as designation of geographic origin); *In re Am. Online, Inc.*, Ser. No. 75460305, 2006 WL 236389, at *7 (TTAB 2006) (“the evidence of generic use is offset by Applicant’s evidence that shows not only a significant amount of proper trademark use but also trademark recognition [by third parties]”). Furthermore, the six third-party registrations for marks containing the term BUCKEYE where the term “buckeye” was disclaimed or registered under Section 2(f), as submitted by the Examining Attorney, span sixteen years, and the nine third-party registrations where the term BUCKEYE is not disclaimed or registered under Section 2(f) and where the registrant is located in Ohio, as submitted by Applicant, span eighteen years. Thus, there appears to be no established practice, or even trend, within the Office for how the term “buckeye” is treated.

³⁰ Applicant does not argue that the wording CUSTOM E-BIKES, standing alone, has acquired distinctiveness. In fact, as noted earlier, Applicant has conceded that the wording CUSTOM E-BIKES is descriptive. *See* Applicant’s Appeal Brief, 4 TTABVUE 11 (“There is no apparent basis for making the Applicant (who combined the term ‘buckeye’ with the descriptive phrase ‘custom e-bikes’ ...”). Furthermore, there is evidence of record that shows that the wording CUSTOM E-BIKES is generic for retail store services selling customized

names the “central focus” or “key aspect” of a service is generic for the service itself, and the Board’s principal reviewing court has approved this approach. *See In re Hotels.com LP*, 573 F.3d 1300, 1304-05 (Fed. Cir. 2009) (“hotels” identified the “central focus” of online lodging information and reservation services and therefore hotels.com found generic). *See also In re Meridian Rack & Pinion*, Ser. No. 85504151, 2015 WL 2159099, at *3 (TTAB 2015) (BUYAUTOPARTS.COM is generic for “on-line retail store services featuring auto parts”). *In re Tires, Tires, Tires Inc.*, Ser. No. 77091459, 2009 WL 4075360, at *5 (TTAB 2009) (where “tires” was the generic name of the goods sold in retail stores, being a “key aspect” of such services, TIRES TIRES TIRES was found generic for retail tire stores); *In re Candy Bouquet International, Inc.*, Ser. No. 78058216, 2004 WL 2202265, at *7 (TTAB 2004) (“candy bouquet” is generic name for a certain type of gift package; therefore, CANDY BOUQUET is generic for retail, mail, and computer order services in the field of gift packages of candy); *In re A La Vieille Russie, Inc.*, Ser. No. 75609153, 2001 WL 862510, at *6 (TTAB 2001) (a term that is generic for a particular class of goods is also deemed generic for the services of selling those goods; the mark RUSSIANART is generic for the services of selling such art).

Accordingly, although we find that Applicant’s mark is not primarily geographically descriptive, we conclude that the application may not proceed without

electric bicycles. *See* July 24, 2024 Office Action, TSDR p. 29-64 (Advertisements of companies selling “custom electric bikes”).

a disclaimer of the generic, or at least highly descriptive, wording CUSTOM E-BIKES.

Decision: The refusal to register Applicant's BUCKEYE CUSTOM E-BIKES mark under Section 2(e)(2) of the Trademark Act on the ground that the mark is primarily geographically descriptive is reversed and, as a result, Applicant's construed request to seek registration under Section 2(f) is deemed moot. However, the application may not proceed without a disclaimer of the wording CUSTOM E-BIKES for the reasons explained above.

Accordingly, the application is reopened and remanded to the Examining Attorney for entry of the disclaimer of the wording CUSTOM E-BIKES. *See* Trademark Rule 2.142(g), 37 C.F.R. § 2.142(g). A properly worded disclaimer should read as follows: "No claim is made to the exclusive right to use CUSTOM E-BIKES apart from the mark as shown." Upon entry of the disclaimer, the application may then proceed.