

This Opinion is Not a  
Precedent of the TTAB

Mailed: September 21, 2016

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board  
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*In re British Customs, LLC*  
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Serial Nos. 86154804 and 86154813<sup>1</sup>  
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Jayson M. Lorenzo, Esq.  
for K & G Concepts LLC.

Michelle E. Dubois, Trademark Examining Attorney, Law Office 107,  
J. Leslie Bishop, Managing Attorney.

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Before Wellington, Lykos and Lynch,  
Administrative Trademark Judges.

Opinion by Lykos, Administrative Trademark Judge:

On December 30, 2013, British Customs, LLC (“Applicant”) filed applications to register the mark **British Customs** in standard characters on the Principal Register for, as amended, “motorcycle parts, components and accessories, namely, wheels, rearview mirrors, engine rebuild kits sold as a unit, hub caps, brake cylinders, wheel

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<sup>1</sup> Because we deem the cases to have common questions of fact and of law, and the records are largely identical, we have consolidated the appeals. *See, e.g., In re Country Music Association Inc.*, 100 USPQ2d 1824, 1827 (TTAB 2011). *See also* Trademark Trial and Appeal Board Manual of Procedure (“TBMP”) § 1214 (“Consolidation”) (2016). Unless otherwise indicated, citations to the record in this opinion are to Serial No. 86154804.

bearing kits, fork crown covers, fork joints, gas caps, turn signals, sprockets, handlebar grips, clutch springs and fenders” in International Class 12<sup>2</sup> and “[o]n-line wholesale and retail store services featuring motorcycle parts and accessories” in International Class 35.<sup>3</sup>

Applicant has appealed the Trademark Examining Attorney’s final refusals to register the mark under Section 2(e)(1) of the Trademark Act, 15 U.S.C. § 1052(e)(1), on the ground that the mark is merely descriptive of Applicant’s identified goods and services, or, alternatively, that Applicant’s mark is merely descriptive, and that Applicant has failed to show acquired distinctiveness under Section 2(f) of the Trademark Act, 15 U.S.C. § 1052(f).<sup>4</sup>

The appeals are now briefed. For the reasons set forth below, we affirm the refusals to register.

*Whether the Mark is Merely Descriptive?*

Section 2(e)(1) of the Trademark Act precludes registration of a mark that, when used in connection with the goods or services of the applicant, is merely descriptive

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<sup>2</sup> Application Serial No. 86154813, filed pursuant to Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a), alleging October 1, 2004, as the date of first use anywhere and in commerce.

<sup>3</sup> Application Serial No. 86154804, filed pursuant to Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a), alleging August 19, 2014 as the date of first use anywhere and in commerce.

<sup>4</sup> It is clear from the prosecution history and briefing that Applicant asserts its claim of acquired distinctiveness in the alternative, meaning that Applicant does not concede that its mark is merely descriptive in related to its identified goods and services. *See In re Thomas Nelson, Inc.*, 97 USPQ2d 1712, 1713 (TTAB 2011). *Compare In re Country Music Association Inc.*, 100 USPQ2d at 1834 (“Applicant has admitted that the words are merely descriptive by seeking registration pursuant to Section 2(f).”).

of them. 15 U.S.C. § 1052(e)(1).<sup>5</sup> “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 Chamber of Commerce of the U.S.*, 675 F.3d 1297, 102 USPQ2d 1217, 1219 (Fed. Cir. 2012) (quoting *In re Bayer Aktiengesellschaft*, 488 F.3d 960, 82 USPQ2d 1828, 1831 (Fed. Cir. 2007)). The determination of whether a mark is merely descriptive must be made in relation to the goods or services for which registration is sought, not in the abstract. *In re Chamber of Commerce*, 102 USPQ2d at 1219; *In re Bayer*, 82 USPQ2d at 1831. This requires consideration of the context in which the mark is used or intended to be used in connection with those goods or services, and the possible significance that the mark would have to the purchasers of the goods or services in the marketplace. *In re Chamber of Commerce*, 102 USPQ2d at 1219; *In re Bayer*, 82 USPQ2d at 1831; *In re Omaha Nat’l Corp.*, 819 F.2d 1117, 2 USPQ2d 1859 (Fed. Cir. 1987). Evidence that a term is merely descriptive to the relevant purchasing public “may be obtained from any competent source, such as dictionaries, newspapers, or surveys.” *In re Bayer*, 82 USPQ2d at 1831 (quoting *In re Bed & Breakfast Registry*, 791 F.2d 157, 229 USPQ 818, 819 (Fed. Cir. 1986)).

The issue before the Board is whether Applicant’s mark **British Customs**, as a whole, is merely descriptive of the identified goods and services. Based on the evidence of record, we find that Applicant’s mark immediately conveys to prospective

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<sup>5</sup> “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, (1) when used on or in connection with the goods of the applicant is merely descriptive or deceptively misdescriptive of them. ...”

purchasers a significant feature of the identified goods and services, namely that Applicant's motorcycle parts and accessories sold and featured for sale via its on-line wholesale and retail stores are for "customs" – in other words, a type of motorcycle that has been customized to the user's personal preferences, and that these parts and accessories are for a particular category of motorcycle – British bikes.

The word "customs" is a designation used in the motorcycle industry to refer to a motorcycle that has been customized, or personalized, for the user by adding and/or removing certain parts. An excerpt from the *Beginner's Guide to Motorcycling* (totalmotorcycle.com) attached to the October 28, 2014 Office Action defines "customs" as one of several "basic styles of motorcycles" and explains that

Cruisers/Customs are the pinnacle of "customable" motorcycles in their looks....With acres of chrome and accessories available (and imaginable) you can make a cruiser look any way you want it....

The following entry from "Motorcyclist's Dictionary" (bikerenews.com) also uses the term "customs" in the same manner to designate a certain type of motorcycle customized to the user's tastes:

For many motorcyclists, the choices provided by the motorcycle manufacturers do not provide enough variety to match the personalities of the riders. For this reason, many customize their bikes or hire customizers to do the work for them. Many of these *customs* are entered in shows and win prizes. *Customs* can easily cost twice the selling price of the original bike."<sup>6</sup>

As additional evidence that "customs" is merely descriptive of the identified goods in International Class 12, the Examining Attorney submitted third-party registrations

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<sup>6</sup> October 28, 2014 Office Action.

where the term “customs” has been disclaimed in relation to the motorcycle parts and accessories. “Such third party registrations show the sense in which the word is used in ordinary parlance and may show that a particular term has descriptive significance as applied to certain goods or services.” *Inst. Nat’l des Appellations D’Origine v. Vintners Int’l Co.*, 958 F.2d 1574, 22 USPQ2d 1190, 1196 (Fed. Cir. 1992) (internal citations omitted). We note the following examples:

Registration No. 4197844 for the mark **Thunder Creek Customs** (standard characters) on the Principal Register for “[m]otorcycle-mounted accessory storage assemblies and accessory racks for motorcycle equipment; motorcycle trailers” in International Class 12, with a disclaimer of “customs”;

Registration No. 4523701 for the mark **White Iron Customs** (standard characters) on the Supplemental Register for “parts of motorcycles, namely, white iron motorcycle riser assemblies” in International Class 12, with a disclaimer of “customs”; and

Registration No. 4721894 for the mark **LOWBROW CUSTOMS** (standard characters) on the Principal Register for “[m]otorcycle accessories, namely, fenders, handlebar grips, seats, oil filter mounts, gas tanks, brake cable guides, front forks, seat mounts, seat springs, mounting tabs, and gas caps” in International Class 12, with a disclaimer of “customs”.<sup>7</sup>

The record further shows that the term “British” refers to a category of motorcycles originating from or originally manufactured in Great Britain. It is not uncommon for third parties to use the terms “British” and “customs” or synonyms thereof in the same context to denote a motorcycle made from vintage British parts.

By way of illustration, we highlight the following:

Cleveland CycleWerks (clevelandcyclewerks.com) “We specialize in general service, customization and aftermarket parts sales for CCW,

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<sup>7</sup> July 17, 2015 Office Action.

Japanese, British, European and American motorcycles. Our staff at the shop has a wide variety of expertise from changing tires to building complete, ground up customs.”<sup>8</sup>

Atom Bomb Custom Motorcycles (atombombcustoms.com) “...Atom Bomb specializes in the construction of fully custom vintage British motorcycles built from discarded, damaged and forgotten Triumph and BSA relics. Atom Bomb has a wide range of in house custom capability including frame design, modification and fabrication...and much more. ... Atom Bomb has some exciting and different projects in the workshop. From street trackers to dirt bikes to rigid customs...”<sup>9</sup>

Corn Pie Classics (www.cornpieclassics.com) “Customs, bobbers, street trackers: Whatever you call them they are a fun ride and a flash back to the days when Triumph’s [a British brand] were the hot bike to customize for the street or the racetrack.”<sup>10</sup>

It is also not uncommon for third parties to use the designation “British” in advertising the retail sale of motorcycle parts.<sup>11</sup> Indeed, Applicant’s own social media page<sup>12</sup> touts its products and retail services as featuring aftermarket parts and accessories for the Triumph motorcycle, a British brand that “ruled the roost” in the 1950s and 1960s.<sup>13</sup> This evidence shows that the nature and quality of the motorcycle parts and accessories as well as the country of origin are important features to prospective consumers.

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<sup>8</sup> October 28, 2014 Office Action.

<sup>9</sup> *Id.*

<sup>10</sup> *Id.*

<sup>11</sup> *See, e.g.*, excerpts from web sites entitled Raber’s Parts Mart with heading “British Only Motorcycles and Parts” and Barnyard Scraps Restoration: Customizing and Restoring Antique British Motorcycles attached to February 17, 2016 Final Office Action.

<sup>12</sup> *See* excerpt from Applicant’s Facebook page attached to October 28, 2014 Office action.

<sup>13</sup> *The British Motorcycle Story* (Introduction) attached to February 17, 2016 Final Office Action.

Applicant contends that consumers will know that its mark is not the descriptive or generic designation for a motorcycle part or a type of store. Applicant's argument reflects a misunderstanding of the descriptiveness analysis. A descriptiveness refusal is not limited to a term which constitutes a designation for the actual good or service itself; rather, it also applies to a "quality, feature, or characteristic" of a good or service. *See In re Chamber of Commerce*, 102 USPQ2d at 1219. As explained above, it is sufficient for a finding of mere descriptiveness that a mark indicates the purpose or use of the goods or a feature of the services; in this case, Applicant's mark describes a purpose of the goods in that they are for British customs, and the retail store services feature the same. *See In re Dial-A-Mattress Operating Corp.*, 240 F.3d 1341, 57 USPQ2d 1807, 1812 (Fed. Cir. 2001) (1-888-MATRESS descriptive of retail services featuring mattresses).

Applicant also argues that "British customs" is a double entendre such that the mark is not merely descriptive but instead inherently distinctive and therefore registrable on the Principal Register without a claim of acquired distinctiveness under Section 2(f). Applicant contends that the mark evokes different meanings; for example, that "the goods are made with a certain standard quality associated with Britain" or "the goods are made by individuals with British descent." Applicant's Brief, p. 6.

In evaluating whether a mark is a double entendre and therefore not merely descriptive, we note the guidance provided by the Board in *In re The Place Inc.*, 76 USPQ2d 1467, 1470 (TTAB 2005):

“Double entendre” is defined as “ambiguity of meaning arising from language that lends itself to more than one interpretation.” *Webster’s Third New International Dictionary* (1993) at p. 678. As stated in TMEP § 1213.05(c), “A ‘double entendre’ is a word or expression capable of more than one interpretation. For trademark purposes, a ‘double entendre’ is an expression that has a double connotation or significance as applied to the goods or services. ... The multiple interpretations that make an expression a ‘double entendre’ must be associations that the public would make fairly readily.”

A mark thus is deemed to be a double entendre only if both meanings are readily *apparent from the mark itself*. If the alleged second meaning of the mark is apparent to purchasers only after they view the mark in the context of the applicant’s trade dress, advertising materials or other matter separate from the mark itself, then the mark is not a double entendre. See *In re Wells Fargo & Company*, 231 USPQ 95 (TTAB 1986).

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A mark is not a double entendre if the second meaning is grasped by purchasers only when the mark is used with “other indicia,” even if that other indicia is itself not merely descriptive.

(Emphasis in original).

The record does not support a finding that any of Applicant’s proffered alternative meanings would be perceived by consumers, thus creating a double entendre or separate significance. Other than the dictionary definition of the word “customs,” Applicant has not introduced evidence that “British customs” has a well-known separate meaning to consumers that might be called to mind by this mark. Thus, on the record before us, we cannot find any other relevant meanings “apparent from the mark itself.” *Id.* See, e.g., *In re RiseSmart Inc.*, 104 USPQ2d 1931, 1933 (TTAB 2012) (“We do not find TALENT ASSURANCE to present a double entendre such that ‘the merely descriptive significance of the term [TALENT] is lost in the mark as a whole.’”).

We acknowledge other instances where this Board has found that a double entendre obviated a descriptiveness refusal. *See, e.g., In re Colonial Stores Inc.*, 394 F.2d 549, 157 USPQ 382 (CCPA 1968) (SUGAR & SPICE not merely descriptive for bakery products because it immediately calls to mind “sugar and spice and everything nice” from the well-known nursery rhyme); *In re Tea and Sympathy Inc.*, 88 USPQ2d 1062 (TTAB 2008) (THE FARMACY not merely descriptive because it is a play on the “farm-fresh” characteristics of applicant’s herbs and organic products used for medicinal purposes.); *In re Delaware Punch Co.*, 186 USPQ 63 (TTAB 1975) (THE SOFT PUNCH for noncarbonated soft drink not merely descriptive because it projects a double entendre of a non-alcoholic drink as well as having a pleasing hit or soft impact); *In re Priefert Mfg. Co. Inc.*, 222 USPQ 731, 733 (TTAB 1974) (HAY DOLLY not merely descriptive of self-loading trailers for hauling bales; “phonetically the term is equivalent to the expression ‘Hey Dolly,’ giving the mark a commercial impression which transcends that which emerges as a result of legal analysis.”). However, in each of the aforementioned cases, the double entendre was readily apparent to prospective consumers from the mark itself. Such is not the case here, where we lack evidence showing that “British customs” would call to mind anything other than the merely descriptive significance of parts for British customized motorcycles.

In sum, we find that Applicant’s proposed mark **British Customs** for “motorcycle parts, components and accessories, namely, wheels, rearview mirrors, engine rebuild kits sold as a unit, hub caps, brake cylinders, wheel bearing kits, fork crown covers, fork joints, gas caps, turn signals, sprockets, handlebar grips, clutch

springs and fenders” in International Class 12 and “[o]n-line wholesale and retail store services featuring motorcycle parts and accessories” in International Class 35 is merely descriptive.

*Whether the Mark has Acquired Distinctiveness?*

Having determined that Applicant’s mark BRITISH CUSTOMS is merely descriptive of the identified goods and services in both applications, we now turn to the question of whether Applicant’s mark has acquired distinctiveness under Section 2(f). Section 2(f) of the Trademark Act provides in relevant part:

Except as expressly excluded in subsections (a), (b), (c), (d), (e)(3), and (e)(5) of this section, nothing herein shall prevent the registration of a mark used by the applicant which has become distinctive of the applicant's goods in commerce. The Director may accept as prima facie evidence that the mark has become distinctive, as used on or in connection with the applicant's goods in commerce, proof of substantially exclusive and continuous use thereof as a mark by the applicant in commerce for the five years before the date on which the claim of distinctiveness is made.

The underlying rationale of Section 2(f) has been explained as follows:

[U]nlike the first five sections of 15 U.S.C. § 1052 which define the grounds upon which a trademark registration is to be refused, Section 2(f) serves as an exception to a rejection under the provisions of one of the other sections, Section 2(e) (citation omitted). Section 2(f) permits registration of marks that, despite not qualifying for registration in light of Section 2(e), have nevertheless “become distinctive of the applicant's goods in commerce.” Thus, “Section 2(f) is not a provision on which registration can be refused,” ... *but is a provision under which an applicant has a chance to prove that he is entitled to a federal trademark registration which would otherwise be refused.*

*See Yamaha Int’l Corp. v. Hoshino Gakki Co. Ltd.*, 840 F.2d 1572, 6 USPQ2d 1001, 1006 (Fed. Cir. 1988) (quoting *In re Capital Formation Counselors, Inc.*, 219 USPQ 916, 917 n.2 (TTAB 1983)) (emphasis added). To establish acquired distinctiveness,

an applicant must show that “in the minds of the public, the primary significance of a product feature or term is to identify the source of the product rather than the product itself.” *Inwood Labs, Inc. v. Ives Labs.*, 456 U.S. 844, 214 USPQ 1, 4 n.11 (1982). “The statute is silent as to the weight of evidence required for a showing under Section 2(f) ‘except for the suggestion that substantially exclusive use for a period of five years immediately preceding filing of an application may be considered prima facie evidence.’” *In re Owens-Corning Fiberglas Corp.*, 774 F.2d 1116, 227 USPQ 417, 422 (Fed. Cir. 1985) (internal citation omitted). Trademark Rule 2.41, 37 C.F.R. § 2.41, entitled “Proof of distinctiveness under section 2(f),” fills in this gap, stating in relevant part:

*Subsection (a)* ... applicant may, in support of registrability, submit with the application, or in response to a request for evidence or to a refusal to register, affidavits or declarations in accordance with § 2.20, depositions, or other appropriate evidence showing duration, extent and nature of use in commerce and advertising expenditures in connection therewith (identifying types of media and attaching typical advertisements), and affidavits, or declarations in accordance with § 2.20, letters or statements from the trade or public, or both, or other appropriate evidence tending to show that the mark distinguishes such goods or services.<sup>14</sup>

*Subsection (b)* In appropriate cases, ownership of one or more prior registrations on the Principal Register or under the Act of 1905 of the same mark may be accepted as prima facie evidence of distinctiveness. Also, if the mark is said to have become distinctive of applicant's goods by reason of substantially exclusive and continuous use in commerce thereof by applicant for the five years before the date on which the claim of distinctiveness is made, a showing by way of statements which are verified or which include declarations in accordance with § 2.20, in the application, may in appropriate cases, be accepted as prima facie evidence of distinctiveness. In each of these situations, however, further evidence may be required.

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<sup>14</sup> The Trademark Manual of Examining Procedure (“TMEP”) § 1212 (April 2016) uses the term “actual evidence” of acquired distinctiveness in referencing Trademark Rule 2.41(a).

*See also In re Steelbuilding.com*, 415 F.3d 1293, 75 USPQ2d 1420, 1424 (Fed. Cir. 2005) (“the Board may examine copying, advertising expenditures, sales success, length and exclusivity of use, unsolicited media coverage, and consumer studies linking the name to a source.”). Applicant has the burden of establishing that its mark has become distinctive, and that the more descriptive the term, the greater the evidentiary burden to establish acquired distinctiveness. *See Yamaha Int’l Corp.*, 6 USPQ2d at 1006. The kind and amount of evidence necessary to establish that a mark has acquired distinctiveness in relation to goods or services depends on the nature of the mark and the circumstances surrounding the use of the mark in each case. *Id.* at 1008.

Based on the record before us, Applicant has failed to establish acquired distinctiveness of its mark for the identified goods and services. At the outset we note that Applicant’s cancelled registration, Registration No. 3188840, cannot serve as a basis for establishing acquired distinctiveness. *See In re Koninklijke Philips Elecs. N.V.*, 112 USPQ2d 1177, 1186 (TTAB 2014).

In addition, Applicant failed to submit a properly executed statement to support a claim of acquired distinctiveness based on at least five years use of the mark **British Customs** in interstate commerce for either the goods identified in International Class 12 or services in International Class 35. The only statement submitted by Applicant that could be possibly construed as such is the declaration of

James Panther, General Manager of British Customs, LLC (“Panther Decl.”).<sup>15</sup> In the declaration, he states in relevant part that

British Customs has exclusively and continuously managed an online retail store since August 19, 2004. In total, the online retail store has been active for over 10 years. Panther Decl. ¶ 3.

British Customs has exclusively and continuously sold and manufactured aftermarket motorcycle parts since 2003. In total, the sale and manufacture of motorcycle parts under the “British Customs” brand has been active for over 11 years. *Id.* at ¶ 4.

The declaration is devoid of the critical averment that the mark itself has been in substantially exclusive and continuous use in commerce for at least five years before the date of the statement. While the declaration states that the manufacture and sale of motorcycle parts under the mark **British Customs** has been “active” for 11 years, it does not state that use of the mark has been “substantially exclusive and continuous” as required by the statute. “The wording ‘substantially exclusive and continuous use of the mark in commerce’ is essential.” Trademark Manual of Examining Procedure (“TMEP”) § 1212.05(d) (“Form of the Proof of Five Years’ Use”) (April 2016). *See also* Trademark Rule 2.41, 37 C.F.R. § 2.41. Applicant had the opportunity to correct this defect but failed to do so.

In terms of actual evidence of acquired distinctiveness, James Panther, Applicant’s General Manager states in his declaration:

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<sup>15</sup> April 28, 2015 Request for Reconsideration. Despite being captioned with both Application Serial Nos. 86154804 and 86154813, the Panther Decl. is only of record in Application Serial No. 86154804.

Since 2004, British Customs has had marketing spending in excess of seven figures and actively participates in a number of social media platforms, industry partnerships and viral marketing. We have been featured in a number of publications, online media outlets, videos as well as sponsoring numerous motorcycle events and riders. British Customs has been featured in a number of prominent motorcycle websites, blogs, and YouTube channels, including: Motorcycle.com, Motorcycle USA, Silodrome Gasoline Culture, Triumph Bonneville and ICON Motosports. Attached to this declaration is a spreadsheet of a number of online publications featuring our brand as well as videos we have published. (§ 6)

Since inception we have had gross sales well into the eight figures. We sell our products online through our online store and have numerous retail and online distribution accounts throughout the motorcycle industry. We have also partnered with Triumph Motorcycles and have sponsored a number of events and motorcycle races. (§ 7)

British Customs is known in the motorcycle industry as an aftermarket parts and accessories vendor. Specifically, British Customs is known for selling and manufacturing motorcycle parts and accessories. (§ 8)

*See Panther Declaration attached to April 28, 2015 Request for Reconsideration.*

Applicant also submitted the declarations of Bryan Harley, Cruise Editor for the publication Motorcycle USA, Jason DiSalvo, a flat track and Grand Prix motorcycle racer, and Jessica J. Giesen, the North America Marketing Director for the OEM Triumph Motorcycles America, each stating their familiarity with British Customs as “the largest non OEM aftermarket parts manufacturer for Triumph motorcycles” and that in their “professional opinion...in the motorcycle industry British Customs is synonymous with an aftermarket motorcycle parts and accessories manufacturer and seller.” *See April 28, 2015 Request for Reconsideration.* In addition, Applicant submitted of printouts from the Internet Archive Wayback Machine capturing screenshots of Applicant’s website from prior years as well as printouts from other

online retail motorcycle parts stores featuring Applicant's **British Customs** brand name motorcycle parts and accessories. *See id.*

Having carefully reviewed the totality of the evidence of record, we find that Applicant's evidence falls short of establishing acquired distinctiveness of the proposed mark within the meaning of Section 2(f) for either the goods or services identified in each application. The marketing expenditures and sales data referenced in the Panther Declaration are vague and not even clearly and directly associated with the mark. In addition, in the absence of the actual articles themselves, we cannot glean from the spreadsheet attached to the Panther Declaration the extent of media recognition of Applicant's mark. And while Applicant did submit a handful of news articles discussing the **British Customs** brand name, we cannot conclude from such a small number that relevant consumers have come to view the designation as a source-identifier for Applicant's goods and services. The Harley, DiSalvo and Giesen Declarations are probative of consumer recognition; however, they are not enough to establish acquired distinctiveness. We would need to see a great deal more evidence than what Applicant has submitted in order to find that the designation **British Customs** has become distinctive of Applicant's goods and services.

**Decision:** The descriptiveness refusals under Section 2(e)(1) of the Trademark Act are affirmed for both Application Serial Nos. 86154804 and 86154813; alternatively, we affirm the Examining Attorney's determination that Applicant has failed to show acquired distinctiveness under Section 2(f) for both applications.