

This Opinion is Not a  
Precedent of the TTAB

Mailed: March 13, 2019

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board  
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*In re DashAmerica, Inc., dba Pearl Izumi USA, Inc.*

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Serial No. 87564276  
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Rod S. Berman of Jeffer Mangels Butler & Mitchell LLP,  
for DashAmerica, Inc.

Jonathan R. Falk, Trademark Examining Attorney, Law Office 111,  
Chris Doninger, Managing Attorney.

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Before Cataldo, Wellington and Lynch,  
Administrative Trademark Judges.

Opinion by Cataldo, Administrative Trademark Judge:

Applicant, DashAmerica, Inc., dba Pearl Izumi USA, Inc., seeks registration on  
the Principal Register of the mark BIKESTYLE (in standard characters), identifying

Cycling apparel, namely, gloves, socks, arm and leg warmers, pants, tights, shorts, jerseys, shirts, t-shirts, vests, sweaters, jackets, warm-up suits, rain suits; anoraks, singlets, tank-tops, cycling shorts, underwear, knickers, warm-up pants, skirts, skorts, pullovers, rainwear, cycling jerseys, cycling bib shorts, sports bras, crop tops, balaclavas, visors being headwear; baselayers, namely, tops, bottoms and underwear; headwear, hats, caps being headwear, headbands in Class 25.<sup>1</sup>

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<sup>1</sup> Application Serial No. 87564276 was filed on August 10, 2017, pursuant to Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b), based upon Applicant's allegation of a bona fide intention to use the mark in commerce.

The Trademark Examining Attorney refused registration of Applicant's mark under Section 2(e)(1) of the Trademark Act, 15 U.S.C. § 1052(e)(1), on the ground that Applicant's BIKESTYLE mark is merely descriptive of the identified goods.<sup>2</sup> The Examining Attorney argues:

In this case, both the individual components and the composite result are descriptive of applicant's goods and do not create a unique, incongruous, or nondescriptive meaning in relation to the goods. Specifically, the wording merely describes that it is a particular fashion of clothing made for bicycling. This combined wording creates no unique, incongruous, or otherwise nondescriptive meaning in relation to such cycling clothes.<sup>3</sup>

When the refusal was made final, Applicant appealed. Applicant and the Examining Attorney have filed briefs. For the reasons discussed below, we affirm the refusal of registration.

#### **I. Request for Judicial Notice or to Reopen Prosecution**

Applicant attached to its reply brief evidence in the form of copies of third-party registrations retrieved from the USPTO's Trademark Examination Search System (TESS) database.<sup>4</sup> Applicant requests the Board to take judicial notice of these third-party registrations or, in the alternative, to suspend the instant appeal and reopen prosecution in order to allow their introduction.<sup>5</sup>

The Board does not take judicial notice of applications or registrations; they must be proved by competent evidence. *See, e.g., In re Jonathan Drew Inc.*, 97 USPQ2d

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<sup>2</sup> Examining Attorney's Brief, 9 TTABVUE 2.

<sup>3</sup> 9 TTABVUE 7.

<sup>4</sup> Applicant's reply brief; 10 TTABVUE 10-96.

<sup>5</sup> 10 TTABVUE 6-7, FN 3.

1640, 1644 n.11 (TTAB 2011) (stating that “the Board’s well-established practice is not to take judicial notice of registrations that reside in the USPTO”); *Beech Aircraft Corp. v. Lightning Aircraft Co.*, 1 USPQ2d 1290, 1293 (TTAB 1986) (“[W]e do not take judicial notice of application and registration files that reside in the Patent and Trademark Office.”).

Applicant’s request for judicial notice is denied.

The proper procedure for an applicant or examining attorney to introduce evidence after an appeal has been filed is to submit a timely written request with the Board to suspend the appeal and remand the application for further examination. *See* Trademark Rule 2.142(d), 37 C.F.R. § 2.142(d). *See also* Trademark Trial and Appeal Board Manual of Procedure (TBMP) § 1207.02 and authorities cited therein. The request must include a showing of good cause therefor, which may take the form of a satisfactory explanation as to why the evidence was not filed prior to appeal.

In this case, Applicant’s request for remand, embedded in a footnote in Applicant’s reply brief, does not include any showing of good cause or other explanation for Applicant’s failure to introduce the evidence during prosecution of its involved application. *See, e.g., In re Adlon Brand GmbH & Co.*, 120 USPQ2d 1717, 1725 (TTAB 2016) (applicant’s request for remand, included in applicant’s brief, denied, explaining that proper procedure “was to file with the Board, after the filing of the appeal but before briefing, a request for remand with a showing of good cause.”); *In re Luxuria s.r.o.*, 100 USPQ2d 1146, 1147 (TTAB 2011) (applicant’s request for remand denied for failure to show good cause).

Applicant's request for remand is denied.

We turn then to consideration of the issue under appeal.

## **II. Mere Descriptiveness**

In the absence of acquired distinctiveness, Section 2(e)(1) of the Trademark Act prohibits registration on the Principal Register of “a mark which, (1) when used on or in connection with the goods of the applicant is merely descriptive . . . of them.” 15 U.S.C. § 1052(e)(1). As noted above, a term is “merely descriptive” within the meaning of Section 2(e)(1) 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)). “On the other hand, 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.” *In re Tennis in the Round, Inc.*, 199 USPQ 496, 498 (TTAB 1978); see also *In re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009, 1009 (Fed. Cir. 1987).

A term need only describe a single feature or attribute of the identified goods to be descriptive. *In re Dial-A-Mattress Operating Corp.*, 240 F.3d 1341, 57 USPQ2d 1807, 1812 (Fed. Cir. 2001). Whether a mark is merely descriptive cannot be determined in the abstract or on the basis of guesswork. Descriptiveness must be 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.” *Chamber of Commerce of the U.S.*, 102 USPQ2d at 1219 (quoting *In re Bayer AG*, 82 USPQ2d at 1831). In other words, we evaluate whether someone who knows what the goods or services are will understand the mark to convey information about them. *DuoProSS Meditech Corp. v. Inviro Med. Devices, Ltd.*, 695 F.3d 1247, 103 USPQ2d 1753, 1757 (Fed. Cir. 2012); *In re Tower Tech Inc.*, 64 USPQ2d 1314, 1316-17 (TTAB 2002).

1. *Evidence of Record*

The components of Applicant’s proposed mark are defined as follows:

The word “bike” is defined, *inter alia*, as “a bicycle.”<sup>6</sup>

The term “style” is defined, *inter alia*, as “the fashion of the moment, especially of dress; vogue: *clothes that are in style*” “a particular fashion,” and to design or fashion in a certain way.”<sup>7</sup>

The Examining Attorney further introduced printouts of pages from sixteen third-party commercial and informational websites featuring clothing items for use in connection with bicycles and cycling, identified as follows:<sup>8</sup>

Backcountry.com offers men’s bike apparel, including bike jerseys, bike shorts and bibs, bike jackets and vests, bike tights and knickers, bike baselayers, bike casual wear and bike compression shorts;

Competitivecyclist.com offers men’s road bike clothing, including road bike tops, road bike bottoms, road bike accessories and road bike shoes;

Goreapparel.com offers men’s and women’s bike wear;

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<sup>6</sup> November 15, 2017 first Office Action at .pdf 6, definition from The American Heritage Dictionary of the English Language, Fifth ed. (2017).

<sup>7</sup> *Id.* at .pdf 7.

<sup>8</sup> December 29, 2017 final Office Action at .pdf 47-50; July 30, 2018 Office Action denying Applicant’s Request for Reconsideration at .pdf 3-14.

Steepandcheap.com offers mountain bike apparel;

Trieverysthingstore.com offers bike and cycling apparel including cycling jerseys;

Bicycling.com discusses independent bike apparel companies;

Rivbike.com offers bike clothing;

Dakine.com offers bike apparel;

Jandd.com offers bike clothing;

Bikeradar.com discusses the best road bike clothing;

Pocsports.com offers mountain biking apparel;

Scott-sports.com offers bike apparel for men;

Evo.com offers bike clothing for men and women;

Ems.com offers bike clothing and shoes, including bike jerseys; bike jackets and vests, bike shorts, bike pants and tights, bike shoes, bike socks, bike gloves and bike headwear;

Patagonia.com offers mountain bike clothing and gear for men and women; and

Trek.com offers bike clothing and cycling clothing.

In further support of the refusal of registration, the Examining Attorney has submitted copies of fourteen third-party registrations of BIKE-formative marks, and four third-party registrations of STYLE-formative marks, all issued on the Principal Register with respective disclaimers of, inter alia, “BIKE” and “STYLE,” identifying various clothing items. The following examples are illustrative (all marks in standard characters unless otherwise noted):<sup>9</sup>

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<sup>9</sup> December 29, 2017 final Office Action at .pdf 7-46; 51-64.

BIKE BARN and design, identifying various items of bicycling clothing in Class 25 (Reg. No. 3919222);

BIKE RELIGION, identifying various items of athletic apparel, including cyclists' jerseys in Class 25 (Reg. No. 4047966);

DURANGO MUSIC CITY STYLE, identifying "footwear" in Class 25 (Reg. No. 5330701); and

STYLE DU MONDE (in stylized form), identifying "men's and women's jackets, coats, vests" in Class 25 (Reg. No. 5342247).

## *2. Discussion*

The evidence introduced into the record by the Examining Attorney indicates, and Applicant acknowledges, that the goods identified in the involved application may be described by the terms "bike clothing," "bike apparel," "bike wear," "cycling wear" and "cycling clothing". The record also indicates that, individually, the terms "BIKE" and "STYLE" have been disclaimed in connection with clothing items, including athletic clothing used for bicycling.

The internet and registration evidence excerpted above clearly indicates that third parties discuss, offer for sale, and register marks for various clothing items specifically intended for use while bicycling. In addition, "Applicant does not dispute, and has never disputed, that 'bike' is used by third parties as part of their description of apparel that can be worn for biking or cycling."<sup>10</sup> Thus, there is no question that the term "bike" merely describes a feature of Applicant's goods, which are cycling apparel. The evidence of record also supports a finding that the term "style" describes clothing items of a particular fashion or clothing that is designed or fashioned in a

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<sup>10</sup> 10 TTABVUE 6, n 2.

certain way, namely, for riding bikes. Indeed, as described in the application, Applicant's goods are specifically prefaced as "cycling apparel" and include cycling shorts and jerseys. Viewed in the context of these goods, Applicant's mark merely describes goods that are designed or fashioned for people riding bikes. The dictionary definitions also indicate that particularly in the clothing context, the term "style" may refer to something fashionable or a particular type of fashion, which in this case could be what is fashionable in bicycle clothing.

When two or more merely descriptive terms are combined, as is the case with the terms BIKE and STYLE comprising the mark at issue herein, the determination of whether the composite mark BIKESTYLE also has a merely descriptive significance turns on whether the combination of terms evokes a new and unique commercial impression. "In considering a mark as a whole, the Board may weigh the individual components of the mark to determine the overall impression or the descriptiveness of the mark and its various components." *In re Oppedahl & Larson LLP*, 71 USPQ2d 1370, 1372 (Fed. Cir. 2004) (PATENTS.COM merely descriptive of computer software for managing a database of records that could include patents and for tracking the status of the records by means of the internet). *See also In re Petroglyph Games Inc.*, 91 USPQ2d 1332, 1337 (TTAB 2009) (BATTLECAM merely descriptive for computer game software); *In re Phoseon Tech., Inc.*, 103 USPQ2d 1822, 1823 (TTAB 2012) (SEMICONDUCTOR LIGHT MATRIX merely descriptive of light and UV curing systems composed primarily of light-emitting diodes for industrial and commercial applications). In this case, the evidence of record establishes that Applicant's



BIKESTYLE mark merely describes clothing of a particular fashion, i.e., bike fashion, or clothing fashioned for bicycling. Thus, the mark BIKESTYLE immediately describes a characteristic of feature of Applicant's various items of cycling apparel, namely, that it is apparel fashioned for bicycling or bike fashion, without the need for multistage reasoning.

Applicant argues that “‘style’ has numerous meanings, many of which could apply here.”<sup>11</sup> However, as noted above we determine whether a term is merely descriptive not in the abstract, but in relation to the goods or services for which registration is sought, the context in which it is being used on or in connection with those goods or services, and the possible significance that the term would have to the average purchaser of the goods or services because of the manner of its use. That a term may have other meanings in different contexts is not controlling. *In re Bright-Crest, Ltd.*, 204 USPQ at 593. Moreover, “[t]he question is not whether someone presented with only the mark could guess what the goods or services are. Rather, the question is whether someone who knows what the goods or services are will understand the mark to convey information about them.” *In re Tower Tech Inc.*, 64 USPQ2d at 1316-17. *See also In re Patent & Trademark Services Inc.*, 49 USPQ2d 1537 (TTAB 1998); *In re Home Builders Association of Greenville*, 18 USPQ2d 1313 (TTAB 1990). The evidence of record establishes that BIKESTYLE has a descriptive meaning – apparel fashioned for or fashionable for bicycling – in connection with the identified goods. The fact that

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<sup>11</sup> Applicant's Brief, 7 TTABVUE 7.

the term “style” may possess additional meanings in other contexts does not diminish the descriptive significance of the term in connection with the goods at issue herein.

Applicant further argues:

Here, there is no evidence of record that any third party uses “bikestyle,” “bike style,” “bicycle style,” “cycling style,” to describe any apparel, footwear, or any other goods to be used for either the sport of cycling or riding a bicycle in general. Instead, the evidence submitted by the Examining Attorney shows that third parties are using the phrases “bike apparel,” “bike clothing,” “bike wear,” “bike gear,” “biking apparel,” to describe clothing sold specifically for the purposes of cycling.<sup>12</sup>

There is no need for the Examining Attorney to demonstrate that others have used the mark BIKESTYLE at issue or that they need to use the term “bike style” to describe cycling apparel, although such proof might be highly relevant to an analysis under Section 2(e)(1). *In re Fat Boys Water Sports LLC*, 118 USPQ2d at 1515. In addition, “[t]here is no requirement that the Office prove actual competitor use or need; it is well established that even if an applicant is the only user of a merely descriptive term, this does not justify registration of that term.” *In re Carlson*, 91 USPQ2d 1198, 1203 (TTAB 2009).

Applicant further argues:

Consumers are likely to understand the coined term as a play on the similar sounding word “lifestyle,” but with an eye towards the bicycling community in particular, as well as the term “freestyle” – a type of bicycle competition and a term conveying the absence of rules or restrictions.<sup>13</sup>

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<sup>12</sup> 7 TTABVUE 8-9.

<sup>13</sup> 7 TTABVUE 9.

Although the application at issue is based on intent-to-use, Applicant submitted screenshots from its website in support of its position that it “supplies its ‘captivating products to help promote the *bicycle...culture*’”<sup>14</sup> and that its BIKESTYLE mark “refers to all aspects that embody the interests of cyclists, and, in turn, the cyclists’ way of life.”<sup>15</sup> However, Applicant’s evidence that its products are intended to promote cycling culture does not diminish the descriptiveness of BIKESTYLE in relation to cycling apparel. Simply put, there is insufficient evidence that consumers will view BIKESTYLE as suggesting bicycle culture given the plain meaning of the mark as applied to various items of clothing to be worn while bicycling. Similarly, there is little, if any, evidence to support Applicant’s contention that consumers will view BIKESTYLE, applied to its cycling apparel, as evocative of a bike lifestyle or freestyle bicycling when the common meanings of the terms BIKE and STYLE comprising the mark immediately describe apparel fashioned for bicycling. *See In re Fat Boys Water Sports LLC*, 118 USPQ2d at 1516 (TTAB 2016) (“The two component words of the mark combine in a manner and order that would be easily interpreted by persons familiar with the English language and the goods. They would be immediately understood ....”); *In re Petroglyph Games Inc.*, 91 USPQ2d at 1341 (TTAB 2009) (“[B]ecause the combination of the terms does not result in a composite that alters the meaning of either of the elements, refusal on the ground of descriptiveness is appropriate.”).

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<sup>14</sup> June 17, 2018 request for Reconsideration at .pdf 6, 8-13, emphasis supplied by Applicant.

<sup>15</sup> June 17, 2018 Request for Reconsideration at .pdf 6.

*3. Summary and Conclusion*

Based upon all arguments and evidence of record, including any not specifically discussed, we find the Examining Attorney has met the burden of showing that BIKESTYLE is merely descriptive of the goods identified in Applicant's application under Section 2(e)(1) of the Trademark Act.<sup>16</sup>

**Decision:** The refusal to register Applicant's mark BIKESTYLE is affirmed.

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<sup>16</sup> We note that our determination herein does not preclude Applicant from attempting to show that BIKESTYLE has acquired distinctiveness as a mark for these goods, or that BIKESTYLE is capable of registration on the Supplemental Register, in a subsequent application.