

**This Opinion is Not a  
Precedent of the TTAB**

Mailed: September 11, 2018

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board  
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*Biker Clothing Company, LLC*

*v.*

*Worldwide Dynamics Inc.*  
—————

Cancellation No. 92064143  
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Ava K. Doppelt and Allison R. Imber of Allen, Dyer, Doppelt,  
Milbrath & Gilcrest PA,  
for Biker Clothing Company, LLC.

Alan Heimlich of Heimlich Law PC,  
for Worldwide Dynamics, Inc.

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Before Wellington, Shaw and Hightower,  
Administrative Trademark Judges.

Opinion by Wellington, Administrative Trademark Judge:

Biker Clothing Company, LLC (“Petitioner”) has filed a petition to cancel Worldwide Dynamics Inc.’s (“Respondent”) registration on the Principal Register for the mark BIRTHPLACE OF THE AMERICAN BIKER (in standard characters) for

“Clothing, namely, t-shirts, sweaters, scarves, bandanas, jackets” in International Class 25.<sup>1</sup>

In the Petition for Cancellation, Petitioner alleges that in 1947 numerous motorcyclists converged on the small town of Hollister, California, “wreaking havoc on the town and its inhabitants” and that, since that time, Hollister “has been known by the nickname ‘Birthplace of the American Biker.’”<sup>2</sup> Petitioner further alleges that “[t]o commemorate the events that took place in 1947, Hollister has held an annual motorcycle rally, where many different people use the geographically descriptive phrase ‘Birthplace of the American Biker’ on and in connection with various types of merchandise, including clothing, and the sale thereof.”<sup>3</sup> As grounds for cancellation, Petitioner set forth three distinct counts:<sup>4</sup>

- “Count I” Respondent committed fraud on the USPTO under Section 14(3) of the Act;<sup>5</sup>
- “Count II” Respondent’s registered mark is merely descriptive of the identified goods under Section 2(e)(1) of the Act;<sup>6</sup> and

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<sup>1</sup> Registration No. 4773301 issued on the Principal Register on July 14, 2015 from an application filed February 17, 2013. The original application was filed based on an allegation of use in commerce under Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a); the filing basis was later amended to Section 1(b) of the Act (intent to use).

<sup>2</sup> 1 TTABVUE 3-4 (¶ 1).

<sup>3</sup> *Id.* at 4 (¶ 2).

<sup>4</sup> Petitioner listed other grounds on the Electronic System for Trademark Trials and Appeals (ESTTA) filing cover page of its Petition for Cancellation (1 TTABVUE 1-2); however, the pleading itself does not contain allegations to support the additional claims. Moreover, the additional grounds were not argued in Petitioner’s brief and are considered waived.

<sup>5</sup> *Id.* at 4-6 (¶¶ 5-13).

<sup>6</sup> *Id.* at 6-7 (¶¶ 14-19).

- “Count III” Respondent’s registered mark is primarily geographically descriptive or geographically deceptively misdescriptive under Section 2(e)(1) of the Act.<sup>7</sup>

In terms of standing, Petitioner alleges that it is a “Florida limited liability company ... [and] believes that it will be damaged by the continued registration of [Respondent’s registered mark]”; that it “is one of many using the phrase ‘Birthplace of the American Biker’ on or in connection with a variety of goods, including but not limited to clothing, sold in connection with the motorcycle rally that takes place annually at the Birthplace of the American Biker, Hollister, California”;<sup>8</sup> and that “Respondent will continue to use Respondent’s Registration to assert trademark rights in the geographically descriptive phrase ‘Birthplace of the American Biker,’ and will maintain at least a prima facie exclusive right to use Respondent’s Mark in the United States, thereby causing damage and injury to Petitioner, which also desires to use the phrase to continue selling merchandise, including clothing, along with many others.”<sup>9</sup>

In its answer, Respondent denies many of the salient allegations of the petition. However, Respondent admits that “Petitioner is using the phrase ‘Birthplace of the American Biker’ on its goods”<sup>10</sup> and that “Exhibit A [to the Petition for Cancellation]

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<sup>7</sup> *Id.* at 8 (¶¶ 20-26).

<sup>8</sup> *Id.* (¶ 3).

<sup>9</sup> *Id.* at 9 (¶ 27).

<sup>10</sup> 4 TTABVUE 2 (Answer ¶ 3).

is a cease and desist letter sent to Petitioner by Respondent while noting the letter is misdated as 2013 when it was in fact 2016.”<sup>11</sup>

## I. Petitioner’s Burden

Petitioner was the only party to introduce evidence and file a trial brief.<sup>12</sup>

In its brief, Petitioner notes Respondent’s “lack of evidence” and asserts that Respondent, aside from filing an answer, “did nothing to participate in this action.”<sup>13</sup> Respondent does not necessarily need to come forward with evidence; under Section 7(b) of the Trademark Act, 15 U.S.C. § 1057(b), Respondent is entitled to prima facie presumptions that it is the owner of the registered mark and has an right to exclusive use of the mark in commerce in connection with the identified goods. Petitioner, as plaintiff in this inter partes proceeding, bears the burden of proving by a preponderance of the evidence both its standing to petition for cancellation of the subject registration and at least one valid pleaded ground for cancellation.

## II. The Record

As far as evidence, the record consists of the pleadings and, by operation of Trademark Rule 2.122(b), 37 C.F.R. § 2.122(b), the file of Registration No. 4773301.

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<sup>11</sup> *Id.* (Answer ¶ 4). Generally, exhibits or materials attached to pleadings, such as the referenced “Exhibit A,” are not of record unless otherwise properly introduced at trial. See Trademark Trial and Appeal Board Manual of Procedure (TBMP) § 704.05 (2018) with authority and further explanation therein.

<sup>12</sup> 13 TTABVUE.

<sup>13</sup> *Id.* at 15.

Petitioner filed the deposition testimony transcript and exhibits of its sole witness, Mr. Michael Corbin, who is CEO of Corbin Pacific, Incorporated, a manufacturer of motorcycle accessories.<sup>14</sup> Mr. Corbin testified that Corbin Pacific is located in the town of Hollister, California, that he and Corbin Pacific are involved in Hollister community organizations and activities, and that he is the “original organizer of the Hollister [motorcycle] Rally.”<sup>15</sup> Mr. Corbin further testified, inter alia:

- A motorcycle rally was held in Hollister in 1997 to commemorate the 50<sup>th</sup> anniversary of an episode involving motorcycle bikers converging on the town of Hollister.<sup>16</sup>
- The phrase “Hollister ... Birthplace of the American Biker,” was used at the 1997 rally and has been used since then on various clothing goods and in banners as a moniker for the town of Hollister, including on Corbin Pacific company t-shirts.<sup>17</sup>
- The following image is a Corbin Pacific t-shirt bearing the phrase “Birthplace of the American Biker”:<sup>18</sup>

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<sup>14</sup> 12 TTABVUE. Petitioner also filed a notice of reliance (11 TTABVUE) on the involved registration and its underlying application file, as well as the Corbin deposition exhibits. As noted supra, the registration file is automatically of record by way of Rule 2.122(b) and thus it was unnecessary to submit a copy under a notice of reliance. Likewise, the Corbin deposition exhibits were properly introduced with the filing of the deposition transcript.

<sup>15</sup> 12 TTABVUE 10 (Corbin dec. 8:5-10).

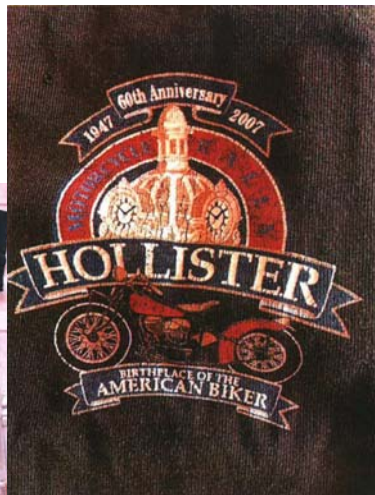
<sup>16</sup> *Id.* at 10-13 (Corbin dec. 8:18-11:20). Mr. Corbin explained that the initial incident in 1947 involved fistfights between biker gangs and served as the basis for the plot of the 1954 Marlon Brando movie “The Wild One.”

<sup>17</sup> *Id.* at 15 (Corbin dec. 13:18-21).

<sup>18</sup> *Id.* at 17-18 (Corbin dec. 14:23-15:5), Corbin Exhibits 1-2.



[t-shirt]



[close-up image of same t-shirt].

- There “was never any licenses [sic]” to use the phrase “Birthplace of the American Biker” and “everybody just uses it arbitrarily. I just use it on my own t-shirts. Corbin brand Corbin company t-shirts. I am not a t-shirt manufacturer or seller. I just have t-shirts [ ] that have my brand on them for my customers, you know, but I use it frequently.”<sup>19</sup>
- A t-shirt made by a different entity and commemorating the 2008 “61<sup>st</sup> Anniversary” Hollister motorcycle rally appears as follows (with the logo in the same position on the shirt as the t-shirt shown supra):<sup>20</sup>



<sup>19</sup> *Id.* at 15-16 (Corbin dec. 13:22-14:4).

<sup>20</sup> *Id.* at 19 (Corbin dec. 16:11-20), Corbin Exhibits 4-5.

- The phrase “Birthplace of the American Biker” has also been used on posters advertising the Hollister motorcycle rallies, including the following from 2002:<sup>21</sup>



- The phrase “Birthplace of the American Biker” has also been used on at least one website to promote Hollister as a destination, which asks: “How did Hollister become known as the *Birthplace of the American Biker*?”<sup>22</sup>

### III. Standing

A threshold issue in every inter partes case is the plaintiff’s standing to challenge registration. See *Empresa Cubana Del Tabaco v. Gen. Cigar Co.*, 753 F.3d 1270, 111 USPQ2d 1058, 1062 (Fed. Cir. 2014); *John W. Carson Found. v. Toilets.com Inc.*, 94 USPQ2d 1942, 1945 (TTAB 2010). With respect to cancellation proceedings, “[a] petitioner is authorized by statute to seek cancellation of a mark where it has ‘both a “real interest” in the proceedings as well as a “reasonable” basis for its belief of damage.’” *Empresa Cubana Del Tabaco*, 111 USPQ2d at 1062 (quoting *ShutEmDown*

<sup>21</sup> *Id.* at 20 (Corbin dec. 18:9-15), Corbin Exhibit 8.

<sup>22</sup> *Id.* at 24-25 (Corbin dec. 22:16-24:14, Corbin Exhibit 19 -- Mr. Corbin was uncertain as to the source of the material and suggested that it “could be the Chamber of Commerce or Downtown Hollister Association”).

*Sports, Inc. v. Lacy*, 102 USPQ2d 1036, 1041 (TTAB 2012) and citing *Ritchie v. Simpson*, 170 F.3d 1092, 50 USPQ2d 1023 (Fed. Cir. 1999).

Petitioner's only witness, Mr. Corbin, is not affiliated with Petitioner but stated that he is "familiar" with Petitioner. Cross-examination, however, indicated that Mr. Corbin's knowledge regarding Petitioner's activities was limited:<sup>23</sup>

A. Biker Clothing Company [Petitioner] is a new company. And the principal of the company died. And he had been a friend of mine for years. In fact, I sold him a building in Daytona Beach, Florida. And they have had t-shirt tents on my properties over the years.

Q. Okay. How far back did you know the owner of the Biker Clothing Company?

A. Probably 25 years.

Q. During that time has the Biker Clothing Company -- are you aware of the Biker Clothing Company using the phrase "Birthplace of the American Biker" on t-shirts?

A. I'm not sure about the Biker Clothing Company. That is the new company since the principal passed away. The old company was Biker Design, and I'm pretty sure they did use it.

Although Mr. Corbin's testimony reveals that he is more familiar with Petitioner's predecessor's use of the phrase "Birthplace of the American Biker" on clothing and is "not sure" about Petitioner's use, Petitioner's interest in this proceeding is evidenced by key admissions made by Respondent in its Answer. *See Estate of Ladislao Jose Biro v. Bic Corp.*, 18 USPQ2d 1382, 1383 & n.2 (TTAB 1991) (standing established by defendant's admission in its answer). Specifically, as noted above, Respondent admitted that Petitioner is using the phrase "Birthplace of the American Biker" on

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<sup>23</sup> *Id.* at 34-35 (Corbin dec. 32:22-33:16).



its goods and that Respondent sent a cease and desist letter sent to Petitioner. Such admissions, in conjunction with Mr. Corbin's testimony, demonstrate Petitioner has a relevant commercial interest in this matter and standing to petition for cancellation. *Lipton Indus., Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185, 189 (CCPA 1982).

Having determined that Petitioner has standing, we now address the substantive claims.

#### IV. Petitioner's Unpleaded Failure to Function Argument

In its trial brief, Petitioner asserts for the first time that Respondent's mark should be cancelled on the ground of failure to function. The failure to function claim was neither pleaded by Petitioner nor tried by the parties.<sup>24</sup> We do not infer from Respondent's failure to submit a brief that it consents to trial of the issue of failure to function. There is no indication that Respondent provided any implied consent to the trial of this unpleaded issue. It is well-settled that a plaintiff may not rely upon an unpleaded claim. See Trademark Board Manual of Procedure ("TBMP") § 314 (2018) and authorities cited therein. Because Petitioner's petition to cancel was not amended or deemed amended pursuant to Fed. R. Civ. P. 15(a) or (b) to include a claim of the involved registered mark's failure to function, Petitioner's argument will be given no further consideration.

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<sup>24</sup> The Petition for Cancellation, including the ESTTA cover page (see Note 4), does not identify a failure to function claim and the testimony of Mr. Corbin does not include any specific reference to such a claim.

## V. Fraud

Petitioner argues:<sup>25</sup>

Given the fame of the Hollister rally and the number of annual [motorcycle] rallies held since 1996, and [Respondent's] efforts to cash in on that fame, it is not conceivable that when it authorized its attorney to sign the [underlying application] declaration it was unaware of any prior use. [Respondent] knew at the time of its application that the sworn statements asserting it was the owner of the mark, and that no one else had the right to use it, were both material and false. These statements were made with the intent to mislead the USPTO into granting it a registration for a mark to which it knew it was not entitled...

As Petitioner acknowledges in its brief, a party seeking to cancel a registration on the basis of fraud bears a heavy burden of proof. *In re Bose*, 580 F.3d 1240, 91 USPQ2d 1938, 1939 (Fed. Cir. 2009) (citing *W.D. Byron & Sons, Inc. v. Stein Bros. Mfg. Co.*, 377 F.2d 1001, 153 USPQ 749, 750 (CCPA 1967)). Indeed, “the very nature of the charge of fraud requires that it be proven ‘to the hilt’ with clear and convincing evidence. There is no room for speculation, inference or surmise and, obviously, any doubt must be resolved against the charging party.” *Id.* (quoting *Smith Int’l, Inc. v. Olin Corp.*, 209 USPQ 1033, 1044 (TTAB 1981)). Subjective intent to deceive is

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<sup>25</sup> 13 TTABVUE 18-19. We further note that Petitioner appears to argue fraud based on the manner in which Respondent prosecuted the underlying application and setting forth its dates of first use of the mark. *Id.* In particular, Petitioner notes that Respondent initially filed the use-based application on February 17, 2013, then amended the application to an intent-to-use filing basis, and eventually filed a statement of use alleging a date of first use of the mark on July 4, 2013 and a date of first use in commerce on August 4, 2013. However, pursuant to TMEP § 806.03(c) (October 2017), for applications filed under §1(a), “if the §1(a) basis fails, either because the specimens are unacceptable or because the mark was not in use in commerce when the application was filed, the applicant may substitute §1(b) as a basis and the application will retain the original filing date.” Thus, Respondent was within its right to amend the filing basis of the underlying application in the manner it did and there is no evidence to suggest that this was done with an intent to make a fraudulent misrepresentation to the USPTO.

difficult to prove, but it remains an indispensable element in the analysis. Of course, “because direct evidence of deceptive intent is rarely available, such intent can be inferred from indirect and circumstantial evidence. But such evidence must still be clear and convincing, and inferences drawn from lesser evidence cannot satisfy the deceptive intent requirement.” *Star Scientific, Inc. v. R.J. Reynolds Tobacco Co.*, 537 F.3d 1357, 88 USPQ2d 1001, 1007 (Fed. Cir. 2008). When drawing an inference of intent, “the involved conduct, viewed in light of all the evidence ... must indicate sufficient culpability to require a finding of intent to deceive.” *Kingsdown Med. Consultants, Ltd. v. Hollister Inc.*, 863 F.2d 867, 9 USPQ2d 1384, 1392 (Fed. Cir. 1988) (en banc). Finally, fraud based on a purportedly false declaration statement in an application may be even more difficult to establish given the subjective nature of these statements. See 6 J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition* § 31.75-76 (5<sup>th</sup> ed. 2018); see also, e.g., *Daniel J. Quirk, Inc. v. Village Car Co.*, 120 USPQ2d 1146, 1149 (TTAB 2016) (“Fraud will not lie against an applicant who holds an honest, good faith belief in its right to register a mark and signs an application with the statutorily prescribed ownership statement, which is phrased in terms of subjective belief.”).

Here, Petitioner’s evidence falls far short of the necessary ‘clear and convincing’ evidence for us to conclude that any of Respondent’s representations made to the USPTO in acquiring the involved registration are materially false or that Respondent intended to deceive the USPTO in making such statements. Specifically, Petitioner has not demonstrated any falsity in Respondent’s declaration that it “is the owner” of

the registered mark and that “to the best of the signatory’s knowledge and belief, no other person has the right to use the mark in commerce, either in the identical form or in such near resemblance as to be likely, when used on or in connection with the goods/services of such other person, to cause confusion or mistake, or to deceive; and the specimen(s) shows the mark as used on or in connection with the goods/services in commerce.”<sup>26</sup>

Petitioner’s case rests entirely on the testimony of Mr. Corbin which establishes that others in the motorcycle community have routinely used the phrase “Birthplace of the American Biker” in connection with the motorcycle rally being held in the town of Hollister; however, there is no evidence, including Mr. Corbin’s testimony, showing that others have asserted trademark rights in the phrase. To the contrary, Mr. Corbin testified that third parties, including his own company, have used the phrase on clothing, but he expressly stated that he did not believe anyone had rights in the phrase. This testimony, and the record as whole, does not demonstrate that Respondent’s registration was executed fraudulently because Respondent knew of and failed to disclose other prior superior rights in the mark. Simply put, Petitioner has not shown that another person had rights superior to Respondent’s rights at the time Respondent signed the declaration and that Respondent knew of such rights. Accordingly, Petitioner’s fraud claim fails.

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<sup>26</sup> Statement of Use filed April 15, 2015, TSDR p. 1.

## VI. Mere Descriptiveness of the Registered Mark

“Whether a mark is descriptive is a question of fact.” *Towers v. Advent Software Inc.*, 16 USPQ2d 1039, 1040 (Fed. Cir. 1990). A term is considered descriptive within the meaning of Section 2(e)(1) of the Trademark Act, 15 U.S.C. § 1052(e)(1), “if it immediately conveys knowledge of a quality, feature, function, or characteristic of the goods or services with which it is used.” *Coach Servs. Inc. v. Triumph Learning LLC*, 101 USPQ2d 1713, 1728 (Fed. Cir. 2012); *see also In re Bayer Aktiengesellschaft*, 82 USPQ2d 1828, 1831 (Fed. Cir. 2007); *In re MBNA Am. Bank N.A.*, 340 F.3d 1328, 67 USPQ2d 1778, 1780 (Fed. Cir. 2003).

Petitioner argues:<sup>27</sup>

As shown in its specimen of use, Worldwide is using the phrase to describe the fact that its goods commemorate or otherwise promote or reference the motorcycle rally that takes place in Hollister, California, the “Birthplace of the American Biker.” The mark immediately conveys the idea of a characteristic or feature of these goods, namely, that they reference, promote, and/or commemorate the motorcycle rally that occurs annually at the “Birthplace of the American Biker.” Consumers viewing the mark will readily understand that it conveys this information about those goods.

The specimen of use to which Petitioner refers is described in the statement of use filed by Respondent as a “tag showing the mark as used on product offered at point of sale” and appears as follows:<sup>28</sup>

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<sup>27</sup> 13 TTABVUE 20.

<sup>28</sup> Statement of Use and Specimen filed on April 15, 2015, TSDR p. 1.



Mr. Corbin’s testimony and the accompanying exhibits show that the phrase “Birthplace of the American Biker” has been very closely associated with an annual motorcycle rally held in Hollister, California. As explained supra, the phrase is not only used as a moniker for the town of Hollister but has also become attached to the annual motorcycle rally held there ever since the “50<sup>th</sup> Anniversary” rally in 1997. The phrase is used on advertisements for the rally and ornamentally on clothing, including t-shirts, that are commonly used by purchasers to commemorate the annual rallies. Mr. Corbin testified that when motorcyclists attend a rally they want merchandise from the event (“When you come to a rally, you want to buy the t-shirt from that event”).<sup>29</sup> The attendees seek merchandise, such as clothing, to show they

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<sup>29</sup> 12 TTABVUE 18 (Corbin dec. 16:22-23).

were there (“They want to say ‘I was at that rally in ’08 and I got the t-shirt to prove it”).<sup>30</sup> The first Hollister annual commemorative motorcycle rally (the “50<sup>th</sup> anniversary rally” in 1997) had approximately “90,000 to 95,000 people” coming “from all over the world” and, today, it is the “largest [motorcycle rally] in California and one of the top ten in the United States.”<sup>31</sup>

As a result of the demonstrated close relationship of the phrase “Birthplace of the American Biker” with the annual Hollister motorcycle rally, and given the commemorative significance of this phrase in connection with clothing, we find the registered mark is merely descriptive of a key feature or characteristic of the goods. Specifically, consumers viewing “Birthplace of the American Biker” on or in connection with Respondent’s clothing, even on a hangtag or label, will immediately understand it as conveying the information that the clothing commemorates the annual Hollister motorcycle rally. The manner in which Respondent uses its mark helps corroborate the souvenir nature and commemorative meaning conveyed by the mark. *See In re N.C. Lottery*, 866 F.3d 1363, 123 USPQ2d 1707, 1710 (Fed. Cir. 2017) (Board “did not err by considering explanatory text of the specimens in the descriptiveness inquiry”). In particular, Respondent’s specimen of use shows the mark below the larger-font wording THE HOLLISTER RALLY and OFFICIAL BIKEWEEK MERCHANDISE.

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<sup>30</sup> *Id.* at 19 (Corbin dec. 17:7-11).

<sup>31</sup> *Id.* at 16 and 22 (Corbin dec. 11:5-9 and 37:16-21).

We make our finding regarding the mere descriptiveness of the registered mark bearing in mind, as discussed supra, that Petitioner's burden is to prove this ground by a preponderance of the evidence and the prima facie presumption that Respondent, as owner of the registration, has the exclusive right to use the mark in commerce in connection with the identified goods. In this case, however, Petitioner has rebutted that prima facie presumption and submitted evidence to show that the registered mark is merely descriptive of a feature or characteristic of the goods covered by the registration. Respondent has not argued to the contrary or submitted any evidence that may have supported its arguments.

## VII. Conclusion

We conclude that Petitioner has not established, by a preponderance of the evidence, that Respondent made fraudulent misrepresentations to the USPTO in connection with its registration. Petitioner, however, has demonstrated that the registered mark, BIRTHPLACE OF THE AMERICAN BIKER, is merely descriptive of the goods identified in the registration.<sup>32</sup>

**Decision:** The petition for cancellation is granted on the ground that Respondent's mark is merely descriptive of the goods identified in the registration. The registration will be cancelled in due course.

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<sup>32</sup> Because we have determined that Petitioner's mark should be cancelled on the mere descriptiveness ground, we need not reach the pleaded alternative grounds that Petitioner's mark is primarily geographically descriptive or geographically deceptively misdescriptive under Section 2(e) of the Act. *See Multisorb Tech., Inc. v. Pactiv Corp.*, 109 USPQ2d 1170 (TTAB 2013).