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precedent of the TTAB

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UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board

Zero Transportation, LLC

v.

Scottsdale Taxi Sedan Service Co.

Opposition No. 91218718
to Application No. 86175541

Paul D. Ticen, McFadden Ticen & Beam PLC and Oliver R. Chernin, McLaughlin & Stern, LLP, for Opposer.

Maria Crimi Speth and Aaron K. Haar, Jaburg & Wilk, P.C., for Applicant.

Before Kuhlke, Mermelstein, and Adlin, Administrative Trademark Judges.

Opinion by Mermelstein, Administrative Trademark Judge:

Applicant Scottsdale Taxi Sedan Service Co. seeks registration of **SCOTTSDALE TAXI** (in standard characters) on the Principal Register for “taxi transport” services.¹ Zero Transportation, LLC, opposes registration on a variety of grounds discussed below. *Amend. Not. of Opp.*, 12 TTABVUE. Applicant denies the salient allegations of the notice of opposition and asserts various defenses. *Answer to Amend. Not. of Opp.*, 14 TTABVUE 4.

We sustain the opposition.

¹ Filed January 27, 2014, alleging first use and use in commerce dates of January 7, 1994. Applicant disclaimed the exclusive right to use **TAXI** apart from the mark as shown, and claims the benefit of Trademark Act § 2(f) as to the entire mark.

I. Description of the Record

The pleadings and, pursuant to Trademark Rule 2.122(b), the file of the opposed application, are of record.

A. Opposer's Submissions

Opposer filed the following evidence during trial:

- Testimony of Eric Weinstein, Opposer's manager and director of operations (as refiled), 21 TTABVUE.
- Opposer's Notice of Reliance, 18 TTABVUE:
 - Discovery deposition of Marek Tabor, Applicant's CEO and President²;
 - Discovery Deposition of Jessica Pena, Arizona Department of Weights and Measures;
 - Applicant's responses to Opposer's interrogatories and requests for admission;
 - Screen shots of Applicant's and Opposer's websites, Applicant's Yelp page, and third-party websites;
 - Documents produced by the Arizona Department of Weights and Measures in response to a subpoena *duces tecum*;
 - Sections of the Arizona Revised Statutes;
 - Various communications between the parties and between their attorneys.
- Opposer's Rebuttal Notice of Reliance, 28 TTABVUE:
 - Third-party websites of businesses using the word "Sun Devil" in their trade name;
 - Websites of non-party taxi companies using the words "Scottsdale Taxi";
 - Online records of the Arizona Corporation Commission regarding Apache Taxi, LLC.

² Mr. Tabor's deposition and that of Ms. Pena were submitted pursuant to the parties' stipulation. See *Stipulation Re Offering Discovery Deposition Transcripts*, 17 TTABVUE 2.

B. Applicant's Submissions

During its trial period, Applicant offered the following evidence:

- Applicant's Notice of Reliance, 22–23, 25 TTABVUE, as amended 27 TTABVUE.³
 - Opposer's disclosure and responses to Applicant's discovery requests (Exh. 1–6);
 - Opposer's corporate records (Exh. 7–8);
 - Applicant's webpage, social media pages, and app (Exh. 9–11, 18–19);
 - Applicant's Yellow Pages advertisements (Exh. 12);
 - Online records of the Arizona Corporation Commission regarding Applicant (Exh. 13);
 - Information regarding criminal matter (Exh. 14);
 - Opposer's website (Exh. 17);
 - Mr. Heywood's Facebook page (Exh. 20);
 - Arizona State University licensing policy; various registrations for the mark **SUN DEVIL** or **SUN DEVILS** (Exh. 21–22);
 - Search results from WHOXY Domain Name Search Engine (Whois data regarding various websites) (Exh. 23);
 - Websites concerning alleged other users of Applicant's mark (Exh. 24–25);
 - Google image search for "car driver" (Exh. 27);
 - Washington Times article (Exh. 28).
- Testimonial declaration of Mr. Tabor, with exhibits. 24 TTABVUE.

³ By stipulation, Exhibits 15 and 16 to Applicant's Notice of Reliance were withdrawn, and Exhibit 14 was limited to the pages attached to the stipulation. *Stipulation to Withdraw Applicant's Exhibits 15 & 16 and Limit Applicant's Exhibit 14*, 26 TTABVUE. We have considered the evidence in accordance with the parties' stipulation.

C. Evidentiary Objections

In an appendix to its opening brief, Opposer lodged a number of objections to Applicant's evidence. 30 TTABVUE 47–55. Applicant responded to Opposer's objections. 32 TTABVUE.

Opposer objects to some exhibits to Applicant's amended notice of reliance on the ground that they were not identified in Applicant's pretrial disclosure. These objections are overruled. "A party need not disclose, prior to its testimony period, any notices of reliance it intends to file during its testimony period." Trademark Rule 2.121(e). What must be disclosed prior to trial is information about witnesses whose testimony the disclosing party intends to introduce, including "a general summary or list of the types of documents and things which may be introduced as exhibits *during the testimony of the witness.*" *Id.* (emphasis added). By contrast, documentary evidence presented by notice of reliance is not subject to pre-trial disclosure.

Opposer also raised a number of objections based on relevance. These will not be separately considered. TTAB proceedings are heard by Administrative Trademark Judges, not lay jurors who might easily be misled, confused, or prejudiced by irrelevant evidence. *Cf. Harris v. Rivera*, 454 U.S. 339, 346 (1981) ("In bench trials, judges routinely hear inadmissible evidence that they are presumed to ignore when making decisions."). Mindful of any objections, we have accorded this evidence whatever probative value (if any) it is due.⁴ *Luxco, Inc. v. Consejo Regulador del Tequila, A.C.*, 121

⁴ By definition, irrelevant evidence either has no tendency to make an asserted fact more or less probable, is of no consequence to the case, or both. *See* FED. R. EVID. 401. While the

USPQ2d 1477, 1479 (TTAB 2017).

Finally, as will be seen, we resolve this case without reaching all of Opposer's grounds for opposition. Accordingly, while we have reviewed the entire record, we need not consider the evidence (and objections to it) unnecessary to our disposition of the case. To the extent necessary, any remaining evidentiary matters are noted in our discussion of the substantive issues.

II. Background

A. Applicant and its Business

Since 1994, Applicant has provided ground transportation services in and around Scottsdale, Arizona, under the designation **SCOTTSDALE TAXI**. *Tabor Dec.* ¶ 3, 24 TTABVUE 3. From 1994 until 2003, Applicant operated vehicles with licensed meters which calculated fares based on a combination of the distance driven and the time of the ride. *App. Not. of Reliance*, Exh. 1 (“*Tabor Depo.*”), 18 TTABVUE 21–22. Beginning in 2003, Applicant has provided transportation in vehicles without meters, charging by the distance driven, or upon request, by a flat rate negotiated prior to travel. *Id.*, 18 TTABVUE 21–24. Although the composition of its fleet has changed over the years, Applicant currently owns one vehicle and provides services through eight independent contractors. *Id.*, 18 TTABVUE 25.

Mr. Tabor testified that over the years, Applicant made various efforts to promote its business, advertising in the Yellow Pages, distributing business cards and flyers,

submission of irrelevant evidence is a waste of the Board's time and that of the parties, extensive objections to irrelevant evidence are rarely worthwhile unless made in response to an attempt to try unpleaded issues.

and more recently, advertising through electronic media. *Tabor Dec.* ¶¶ 4–8, 24 TTABVUE 3–4. Applicant made of record pages from a number of editions of the Phoenix metropolitan area Yellow Pages published between 1995 and 2015. *Id.* Exh. A, 24 TTABVUE 12; *Def. Not. of Reliance*, Exh. 12, 22 TTABVUE 141–56. From 1995–2000, Applicant ran ads in the Yellow pages; after 2000, Applicant’s business and telephone number were merely listed alphabetically, along with those of other similar businesses.

According to Mr. Tabor, “between approximately 2000 and 2008, Scottsdale Taxi only marketed by handing out business cards and flyers because the company was already well known and business was robust.” *Tabor Dec.* ¶ 5, 24 TTABVUE 3. But in response to the faltering economy, Applicant began to promote its business through electronic media, developing a website in 2008 and another in 2012. Applicant purchased certain Google AdWords, and “in or around 2013,” created social media pages on Facebook, Twitter, Yelp!, YouTube, and Google+. *Id.* ¶¶ 5–8, 24 TTABVUE 3–4; *see App. Not. of Reliance* Exh. 10, 22 TTABVUE 133–37. Applicant also advertises through Yext, a service which places advertisements on websites. *Tabor Dep.* 18 TTABVUE 40–41. In recent years, Applicant estimates its total annual advertising expenditures at \$3,000 per year. *Tabor Dep.* 18 TTABVUE 43.

Applicant made of record the following screenshot of its current website and pre-view of its Google ad:



At Scottsdale Taxi, we pride ourselves on providing the most professional and reliable sedan transportation in all of Arizona. A family owned business, Scottsdale Taxi has been serving the greater East Valley for over 20 years. Located in the heart of Scottsdale, our main goal is to offer our clientele a quick, reliable and personal transportation service. We specialize in airport transportation and local sedan services for all occasions. Our areas of operation include Scottsdale, North Scottsdale, Paradise Valley, Cave Creek, Carefree and Fountain Hills.

App. Not. of Reliance, Exh. 9, 22 TTABVUE 125.



Tabor Dec. Exh. B, 24 TTABVUE 15.

B. Opposer and its Business

Opposer's manager/director of operations Eric Weinstein testified that in May 2014, he began offering transportation services in and around Scottsdale, Arizona under the name Scottsdale Cab Company, operating as a sole proprietorship, and

since May 2014, operating as Zero Transportation, LLC. *Weinstein Test.*, 20 TTABVUE 9–10. Opposer owns no vehicles; it takes calls for transportation and dispatches independent contractors to provide transportation services. *Id.*, 20 TTABVUE 10–11. Opposer uses “Scottsdale taxi” on its website, scottsdalecabcompany.com, *see Opp. Not. of Reliance*, 18 TTABVUE 116, and in other advertising, including Google AdWords. *Weinstein Test.*, 20 TTABVUE 11–12. Mr. Weinstein testified that Opposer uses “Scottsdale taxi” “[a]s a descriptive term,” “[b]ecause we provide taxi service in Scottsdale.” *Id.*, 20 TTABVUE 13. Mr. Weinstein testified that it is “commonplace” for those offering similar services in the Scottsdale area to use “Scottsdale taxi” or similar terms. *Id.*, 20 TTABVUE 17.

When Applicant learned that Opposer was using “Scottsdale taxi” in connection with Opposer’s transportation services, Applicant complained to Opposer and filed the subject application to register **SCOTTSDALE TAXI** as a trademark. Shortly after filing, Applicant sent a form letter addressed to Opposer claiming — incorrectly — that Applicant owned a trademark registration for **SCOTTSDALE TAXI**, and using the federal registration symbol (®) when referring to the alleged registration.⁵

Letter to Eric Haywood Weinstein (Feb. 4, 2014), *Opp. Not. of Reliance*, 18 TTABVUE

⁵ If Opposer was deceived by Applicant’s misrepresentation and use of the registration symbol, it was not for long. Applicant filled in its application serial number on the form letter in a space designated for the “U.S. Registration #.” *Letter*, 18 TTABVUE 113. Mr. Weinstein testified that he looked up the application and found a pending application. *Weinstein Test.*, 20 TTABVUE 16. There is no testimony or other evidence that Opposer relied to its detriment on Applicant’s misrepresentation that the mark was registered or on Applicant’s use of the registration symbol, or that Opposer was otherwise damaged by either. In particular, it does not appear that Opposer acceded to any of the demands in Applicant’s letter. According to Applicant, its use of the federal registration symbol in the letter was an “honest mistake.” *Tabor Dec.* ¶ 17, 24 TTABVUE 6; *see Tabor Depo.* 18 TTABVUE 27.

110. The letter noted Opposer's use on its website of "marks and designs containing instances and variations of Scottsdale Taxi Sedan Service CO's [*sic*] federally registered trademark **SCOTTSDALE TAXI** ®," and that such use "constitute[s] possible trademark infringement and dilution" and "willful infringement," and "tarnishes the good reputation of **SCOTTSDALE TAXI**." *Id.*, 18 TTABVUE 110–11. The letter demanded that Opposer confirm that it has "disabled or terminated all display of **Scottsdale Taxi** at any website [it] own[s] or control[s]" or is associated with, and confirm the destruction of "all goods and any tangible promotional materials that contain **Scottsdale Taxi**"; "agree never in the future to offer for sale or otherwise commercially promote any product or service under **Scottsdale Taxi**"; and "agree to, if requested by Scottsdale Taxi Sedan Service CO [*sic*] stipulate to any subsequent written agreement and/or injunction barring your usage of **SCOTTSDALE TAXI**." The letter advised that if Opposer complied, Applicant was willing to waive its potential claims, including infringement, dilution, and unfair competition, but if not, "**SCOTTSDALE TAXI** would . . . be entitled to recover from you a judgment for all of your profits and ill-gotten gains in connection with any infringing sale or activity, in addition to all reasonable attorney's fees and costs in pursuing the instant matter." *Id.*, 18 TTABVUE 111.

C. Application to Register SCOTTSDALE TAXI

Upon initial examination of the subject application, the Examining Attorney refused registration on the ground that the mark is primarily geographically descriptive, pursuant to Trademark Act § 2(e)(2). *App. No. 86175541, Ofc. Action* (May 3,

2014). The Examining Attorney suggested that Applicant consider seeking registration based on acquired distinctiveness under Trademark Act § 2(f), and also required a disclaimer of the term **TAXI** on the ground that it is generic for the identified services. *Id.* In response, Applicant provided the required disclaimer and amended the application to seek registration under Trademark Act § 2(f), based on Applicant's declaration of its "substantially exclusive and continuous use in commerce that the U.S. Congress may lawfully regulate for at least the five years immediately before the date of this statement." *Response to Ofc. Action* (May 10, 2014). No other evidence of acquired distinctiveness was submitted. The Examining Attorney accepted the disclaimer and the amendment claiming acquired distinctiveness and approved the application for publication.

Upon publication, Opposer filed a notice of opposition. In its amended pleading, Opposer alleges that Applicant's mark is geographically descriptive and has not or cannot acquire distinctiveness. *Amend. Not. of Opp.*, ¶¶ 15–22, 12 TTABVUE 8–9. Opposer also alleges several grounds for opposition based on the fact that Applicant provides its "taxi transport" services without using meters to calculate fares. It is Opposer's contention that meters are required under Arizona law for the provision of taxi services. Accordingly, Opposer contends that the designation **SCOTTSDALE TAXI** is deceptive or deceptively misdescriptive because Applicant does not provide taxi services under Arizona law (*i.e.*, transportation in a metered vehicle), *id.*, ¶¶ 4–7, 12 TTABVUE 7, and alternatively that Applicant's provision of "taxi transport" services without a meter constitutes unlawful use of the mark under Arizona law, *id.*,

¶¶ 7–12, 12 TTABVUE 7–8. Finally, Opposer contends that registration should be refused due to Applicant’s use of the federal registration symbol in its letter demanding that Opposer stop using “Scottsdale taxi” on its website. *Id.*, ¶¶ 26–28, 12 TTABVUE 10. Applicant denied the salient allegations of the amended notice of opposition, raised the defenses of laches, estoppel, and unclean hands, and asserted that, “[t]o the extent that the mark is determined to be descriptive, [it] has acquired secondary meaning. . . .”⁶ *Answer to Amend. Not. of Opp.*, 14 TTABVUE 4. Because it is sufficient to reach a disposition, we consider only whether **SCOTTSDALE TAXI** is primarily geographically descriptive and without acquired distinctiveness. *Multisorb Tech., Inc. v. Pactiv Corp.*, 109 USPQ2d 1170, 1171 (TTAB 2013) (“the Board’s determination of registrability does not require, in every instance, decision on every pleaded claim”).

III. Discussion

A. Standing

An opposition may be filed by “[a]ny person who believes that he would be damaged by the registration of a mark.” Trademark Act § 13. This standing requirement is satisfied when the Opposer demonstrates “both a real interest in the proceeding as well as a reasonable basis for its belief of damage.” *Empresa Cubana Del Tabaco v. Gen. Cigar Co.*, 753 F.3d 1270, 111 USPQ2d 1058, 1062 (Fed. Cir. 2014) (cleaned up).

⁶ Applicant also alleged as “affirmative defenses” Opposer’s lack of standing, which is not an affirmative defense, *Blackhorse v. Pro Football Inc.*, 98 USPQ2d 1633, 1637 (TTAB 2011) (burden is on plaintiff to plead and prove standing); and that its use of **SCOTTSDALE TAXI** “predates any use of any similar mark by Opposer in commerce,” which is not a defense to any of Opposer’s claims.

In this case the undisputed evidence establishes that Opposer is a competitor of Applicant, and that Opposer uses — and asserts a right to use — the phrase “Scottsdale taxi” in connection with providing and advertising its own transportation services in and around the city of Scottsdale, Arizona. *See Alcatraz Media Inc. v. Chesapeake Marine Tours Inc.*, 107 USPQ2d 1750, 1760–61 (TTAB 2013). Because registration to Applicant would provide it a *prima facie* right to the exclusive use of **SCOTTSDALE TAXI** for taxi transport services, Trademark Act § 7(b), Opposer has demonstrated a real interest in this proceeding and a reasonable basis for its belief in damage should a registration issue to Applicant.

In addition, Applicant sent a letter to Opposer demanding that Opposer stop using “Scottsdale taxi” in its business. Applicant’s letter is further evidence of Opposer’s real interest in this proceeding and a basis for Opposer’s reasonable belief of damage. *See Miller v. Miller*, 105 USPQ2d 1615, 1619 (TTAB 2013). Accordingly, Opposer has established its standing.

B. Geographic Descriptiveness and Acquired Distinctiveness

1. Applicable Law

Registration on the Principal Register is properly refused when the applied-for mark is primarily geographically descriptive of the identified services. Trademark Act § 2(e)(2). Nevertheless, such a mark may be registered if it “has become distinctive of the applicant’s [services] in commerce.” Trademark Act § 2(f). “Where, as here, an applicant seeks a registration based on acquired distinctiveness under Section 2(f), the *statute* accepts a lack of distinctiveness as an established fact.” *Yamaha Int’l Corp. v. Hoshino Gakki Co.*, 840 F.2d 1571, 6 USPQ2d 1001, 1005 (Fed. Cir. 1988).

“This means that opposer is not required to advance evidence of descriptiveness and may concentrate its case on the question of acquired distinctiveness.”⁷ *Duramax Marine LLC v. R.W. Fernstrum & Co.*, 80 USPQ2d 1780, 1794 (TTAB 2006).

A descriptive or otherwise non-distinctive designation acquires distinctiveness when “in the minds of the public, the primary significance of [the] . . . term is to identify the source of the product rather than the product.” *Inwood Labs., Inc. v. Ives Labs., Inc.*, 456 U.S. 844, 214 USPQ 1, 4 n.11 (1982). And as relevant in this case, when a primarily geographically descriptive term has acquired distinctiveness, it “no longer cause[s] the public to associate the goods with a particular place but to associate the goods with a particular source.” *Burke-Parsons-Bowlby Corp. v. Appalachian Log Homes, Inc.*, 871 F.2d 590, 10 USPQ2d 1443, 1446 (6th Cir. 1989), quoted in *Leelanau Wine Cellars Ltd. v. Black & Red Inc.*, 502 F.3d 504, 84 USPQ2d 1225, 1228 (6th Cir. 2007).

Whether a mark has acquired distinctiveness is determined based on consideration of all of the evidence bearing on the public perception of the mark. “To determine

⁷ When registration of a mark in an application claiming the benefit of Trademark Act § 2(f) is — as here — opposed on the ground that the evidence of record is insufficient to show that the mark has acquired distinctiveness, the opposer bears the initial burden to make out a *prima facie* case of insufficiency, upon which the burden shifts to the applicant to demonstrate registrability. Whether this initial burden has been satisfied may be raised on motion, but once the case has been fully tried, the question resolves simply to whether the evidence as a whole demonstrates that the mark has acquired distinctiveness. *Yamaha Int’l*, 6 USPQ2d at 1005–06 (“Since we are reviewing the entire proceeding in the PTO in which both sides presented all their evidence, filed briefs, and made closing arguments, the only relevant issue before this court on appeal, as it should have been before the board, is which party should prevail on the entire record.”).

whether a mark has acquired secondary meaning, courts consider: advertising expenditures and sales success; length and exclusivity of use; unsolicited media coverage; copying of the mark by the defendant; and consumer studies.” *Coach Servs. Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1729 (Fed. Cir. 2012) (citing *In re Steelbuilding.com*, 415 F.3d 1293, 75 USPQ2d 1420, 1424 (Fed. Cir. 2005)); *In re Ennco Display Sys. Inc.*, 56 USPQ2d 1279, 1284 (TTAB 2000) (Board may consider both direct evidence of consumer perception and “[c]ircumstantial evidence . . . from which consumer association might be inferred”).

When registration is sought under Trademark Act § 2(f), the applicant bears the burden to demonstrate acquired distinctiveness by a preponderance of the evidence. *Yamaha Int’l*, 6 USPQ2d at 1007–08; *In re Hollywood Brands, Inc.*, 214 F.2d 139, 102 USPQ 294, 295 (CCPA 1954) (“[T]here is no doubt that Congress intended that the burden of proof [under Section 2(f)] should rest upon the applicant”). “[L]ogically that standard becomes more difficult to meet as the mark’s descriptiveness increases.” *Yamaha Int’l*, 6 USPQ2d at 1008; *Target Brands Inc. v. Hughes*, 85 USPQ2d 1676, 1683 (TTAB 2007) (finding evidence insufficient to show acquired distinctiveness in highly descriptive mark); see *Steelbuilding.com*, 75 USPQ2d at 1424 (“the applicant’s burden of showing acquired distinctiveness increases with the level of descriptiveness”); *Roux Labs., Inc. v. Clairol Inc.*, 427 F.2d 823, 166 USPQ 34, 39 (CCPA 1970) (“The amount and character of the evidence, if any, required to establish that a given word or phrase is a trademark or ‘has become distinctive’ of the goods necessarily depends on the facts of each case and particularly on the nature of the alleged mark.”).

Finally, the record includes evidence spanning many years. “Registrability of a mark must be determined on the basis of facts as they exist at the time when the issue of registrability is under consideration.” *McCormick & Co. v. Summers*, 354 F.2d 668, 148 USPQ 272, 276 (CCPA 1966); *Kaiser Aluminum & Chem. Corp. v. Am. Meter Co.*, 153 USPQ 419, 420 n.2 (TTAB 1967). In an opposition, the parties have the opportunity to establish factual matters during trial, which in this case ran from October 2016 to May 2017. Thus, we have considered the parties’ evidence of facts and events as they transpired over the years, including as of the time of trial, to determine the issue of registrability.

2. Primarily Geographically Descriptive

Applicant’s claim of acquired distinctiveness is a concession that its mark is primarily geographically descriptive. *Yamaha Int’l*, 6 USPQ2d at 1005 (“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.”). Although geographic descriptiveness is established, the *degree* of descriptiveness is relevant to our consideration of the evidence of acquired distinctiveness, and therefore a brief geographic descriptiveness analysis is warranted before considering acquired distinctiveness.

A refusal to register on the ground that the applied-for mark is primarily geographically descriptive is appropriate if:

- (1) the mark sought to be registered is the name of a place known generally to the public[;] . . . (2) the public would make a goods/place association, i.e., believe that the goods for which the mark is sought to be registered originate in that place[;] . . . [and] (3) the source of the

goods is the geographic region named in the mark.

In re Newbridge Cutlery Co., 776 F.3d 854, 113 USPQ2d 1445, 1448–49 (Fed. Cir. 2015) (cleaned up).

Applicant seeks to register the designation **SCOTTSDALE TAXI** for “taxi transport” services. The Examining Attorney asserted that **SCOTTSDALE** is the name of a geographic location — Scottsdale, Arizona — and that **TAXI** is a generic name for Applicant’s services. *Ofc. Action* (May 3, 2014). In support of the refusal to register, the Examining Attorney submitted an article on “Scottsdale, Arizona,” *id.* from Wikipedia, and a definition of “Scottsdale” as “[a] city of south-central Arizona, a suburb of Phoenix. It is a noted resort area and retirement community. Population 215,000.” *Id.*

We take judicial notice⁸ of the following gazetteer entry for Scottsdale, Arizona:

Scottsdale, city (1990 population 130,069; 2000 population 202,705), Maricopa county, central Arizona, a suburb 8 mi/12.9 km ENE of downtown Phoenix; 33° 41' N 111° 52' W. The city extends 20 mi/32 km N–S. It is a resort and retirement center in the rapidly expanding Phoenix area. Electronic equipment is an important manufacture that is being extensively produced and developed in the state. Other manufacturing includes chemicals, plastic products, pharmaceuticals, furniture, transportation equipment. Agriculture is supported in the surrounding area by canals (Hayden–Rhodes Aqueduct crosses city) of the Salt River project. Scottsdale is one of the fastest-growing U.S. cities, marked by a population increase of nearly 47% between 1980 and 1990. The Taliesin West Home and School, School of Architecture founded by Frank Lloyd Wright, is to the N

⁸ *In re Spirits of New Merced LLC*, 85 USPQ2d 1614, 1617 n.3 (TTAB 2007) (Board may take judicial notice of reference works in online or printed format); *In re Consolidated Specialty Rests. Inc.*, 71 USPQ2d 1921, 1927 (TTAB 2004) (taking judicial notice of article in Columbia Gazetteer).

of the city; training camp of San Francisco Giants baseball team; Scottsdale Municipal Airport in N part of city. Adjoins Gila River Indian Reservation to E, including Scottsdale Community College on reservation. Phoenix Military Reserve to SW, Fort McDowell Mountain Park to NE; Fort McDowell Indian Reservation to E; Tonto National Forest to E and NE; Papago Park to SW, including Phoenix Zoo. Settled in 1895 by Winfield Scott, incorporated 1951.

COLUMBIA GAZETTEER OF THE WORLD ONLINE, “Scottsdale,” <http://www.columbiagazetteer.org/main/ViewPlace/129376> (accessed March 18, 2018).

It is therefore readily apparent that **SCOTTSDALE** “is the name of a place known generally to the public.” *See Newbridge Cutlery*, 113 USPQ2d at 1448–49. There is no evidence that the term has any other meaning and so it would be readily understood to be a reference to Scottsdale, Arizona, a location which is neither obscure nor remote — particularly for the parties’ actual and potential consumers, who live and work in (or are seeking transportation around) Scottsdale, Arizona and its vicinity.⁹ And to state the obvious, Applicant’s customers would readily make a goods/place association, that is, they would believe that Applicant’s services are performed in and around Scottsdale, Arizona, both because the customers and Applicant are there, and because the services are provided there. *See, e.g., In re Chalk’s Int’l Airlines Inc.*, 21 USPQ2d 1637, 1638 (TTAB 1991) (presuming a services/place association because applicant’s services are performed in the place named in the mark).

The applied-for mark also includes the term **TAXI**. Although “Scottsdale Taxi” is

⁹ This case is unlike *Newbridge Cutlery*, for instance, where the geographic location referred to in the mark (Newbridge, Ireland) was physically remote from any of the relevant United States consumers.

not alleged to be the name of a geographic location, the inclusion of descriptive or generic matter will not obviate a refusal under Trademark Act § 2(e)(2) if the mark as a whole retains its primarily geographic significance. *See, e.g., In re JT Tobacco-nists*, 59 USPQ2d 1080, 1082 (TTAB 2001) (**MINNESOTA CIGAR COMPANY** primarily geographically descriptive of cigars); *In re Carolina Apparel*, 48 USPQ2d 1542, 1543 (TTAB 1998) (**CAROLINA APPAREL** primarily geographically descriptive of retail clothing store services). It is obvious that **TAXI** is generic for “taxi transport” services.¹⁰ And finally, there is nothing resulting from the combination of **SCOTTSDALE** and **TAXI** which alters the significance of either word or detracts from the geographic significance of the designation as a whole. Considered in its entirety, **SCOTTSDALE TAXI** is thus primarily geographically descriptive under Trademark Act § 2(e)(2). Geographic descriptiveness in this case is not a close call.

We conclude that **SCOTTSDALE TAXI** is highly geographically descriptive, and that Applicant bears a commensurately high burden to prove that it has acquired distinctiveness.

3. Evidence of Acquired Distinctiveness

Before the Examining Attorney, Applicant relied solely on its declaration that

¹⁰ Applicant included in its brief a definition of “taxi” as “an automobile that carries passengers for a fare usually determined by the distance traveled.” *App. Br.*, 31 TTABVUE 26 (citing Merriam–Webster’s online dictionary). Additionally, Applicant’s disclaimer is essentially an admission that **TAXI** is generic. While geographically descriptive marks may be registered if they have acquired distinctiveness, generic components of such marks remain unregistrable and subject to a disclaimer requirement. Trademark Act § 6(a); *see In re Creative Goldsmiths of Wash., Inc.*, 229 USPQ 766, 768 (TTAB 1986). Applicant’s disclaimer in response to the Examining Attorney’s contention that the term is generic for “taxi transport” services is an admission that **TAXI** is unregistrable under § 2(f) because it is generic.

“[t]he mark has become distinctive of the goods/services through the applicant’s substantially exclusive and continuous use in commerce that the U.S. Congress may lawfully regulate for at least the five years immediately before the date of this statement.” *Response to Ofc. Action* (May 10, 2014). Although the Examining Attorney withdrew the refusal to register and approved the application for publication based on Applicant’s declaration, Opposer is not bound by that *ex parte* determination, and by the same token, Applicant is not restricted to its declaration, the only evidence of acquired distinctiveness presented to the Examining Attorney. We accordingly consider the evidence bearing on acquired distinctiveness.

a. Length and Nature of Applicant’s Use

We first consider the length and nature of Applicant’s use of **SCOTTSDALE TAXI** in connection with its taxi transport services. Longevity of use is relevant because the longer a descriptive term has been used in the manner of a trademark, the more likely it is that the relevant public has been exposed to the use and has come to view the term as an indication of source. That said, length of use is but one factor to be considered; even long use is no guarantee that a mark, especially a highly descriptive mark, has acquired distinctiveness. *See, e.g., In re Andes Candies Inc.*, 178 USPQ 156 (CCPA 1973) (**CREME DE MENTHE** not registrable for “laminated chocolate mint candy squares” despite more than twenty years’ use); *In re Packaging Specialists, Inc.*, 221 USPQ 917, 920 (TTAB 1984) (evidence insufficient to establish acquired distinctiveness despite continuous and substantially exclusive use for sixteen years).

The evidence establishes that Applicant has used the designation **SCOTTSDALE TAXI** since 1994, or for approximately twenty-three years by the close of testimony.

Tabor Dec. ¶ 3, 24 TTABVUE 3. Although this is a considerable period of time, we find its significance much diminished in this case by both the evidence and lack of evidence concerning the nature and extent of Applicant’s use during that time.

From 1995 to 1999, the record indicates that Applicant ran advertisements in the Scottsdale area Yellow Pages. *App. Not. of Reliance*, 22 TTABVUE 141–47. Although there were some changes over the years, this example from 1996 is typical:



22 TTABVUE 143. At the top of the advertisement are the words **SCOTTSDALE TAXI**, the image of an antique limousine, and a telephone number. The ad then continues with the words “ALSO SERVING,” and the names of several communities in the general vicinity of Scottsdale, Arizona.¹¹ Although this advertisement and others

¹¹ We take judicial notice of the proximity of North Scottsdale, Paradise Valley, Fountain Hills, Carefree, and Cave Creek to Scottsdale. *In re Morinaga Nyugyo Kabushiki Kaisha*, 120 USPQ2d 1738, 1744 n.4 (TTAB 2016) (taking judicial notice of the locations of Puyallup, Washington and Mount Rainier); *Pinocchio’s Pizza Inc. v. Sandra Inc.*, 11 USPQ2d 1227, 1229 n.6 (TTAB 1989) (taking judicial notice of the location of Catonsville, Maryland).

like it demonstrate use of **SCOTTSDALE TAXI** in connection with Applicant's business, it does so in a way that emphasizes the geographic descriptiveness of the phrase, rather than any distinctiveness it may have as a trademark. Specifically, the phrase "also serving" after **SCOTTSDALE TAXI** and before the other listed locales conveys to the prospective purchaser that **SCOTTSDALE** is merely one of the geographic locations in which Applicant provides **TAXI** services, rather than a distinctive indicator of Applicant's services.

And there's another problem with the Yellow Pages advertisements. "Registrability of a mark must be determined on the basis of facts as they exist at the time when the issue of registrability is under consideration." *McCormick*, 148 USPQ at 276. But Applicant's Yellow Pages ads only ran between 1995 and 1999. Telephone directories are ephemeral in nature, typically being discarded and replaced every year or so. Absent evidence that (for instance) the advertising campaign was particularly memorable, or particularly effective in building Applicant's business in its earlier years, we cannot imagine how an ad that last ran (among thousands of others) seventeen or eighteen years earlier in a telephone directory that was likely discarded long ago could have any substantial effect on current consumer perception. The record does not suggest how many current purchasers of taxi transport services were exposed to these advertisements even when they were in circulation, much less whether the current perception of those purchasers is influenced by them. Nor is it credible to suppose that one currently seeking taxi transport services would possess, let alone refer to, a

seventeen-year-old telephone directory. As a result, we are unable to give this evidence significant weight in considering current consumer perception.

Beginning in 2000, Applicant's presence in the Yellow Pages was reduced to an alphabetical listing of Applicant's telephone number along with those of similar businesses, such as this example from 2000:



22 TTABVUE 149. The listing of "Scottsdale Taxi Scottsdale" conveys only that the listed business conducts taxi service in or around Scottsdale. *See also* 22 TTABVUE 150–56 (similar listings for years 2000 to 2015). Again, we think it unlikely that the alphabetical listings from earlier years have any effect on current consumer perception of **SCOTTSDALE TAXI** as a trademark, but unlike the ads discussed above, the evidence shows that these listings continued until 2015. That said, because of their nature, we find they are entitled to very little weight in demonstrating acquired distinctiveness.

The Yellow Pages advertisements and listings are the only examples of Applicant's

pre-2008 promotional efforts. Although Mr. Tabor testified that from 2000–2008, Applicant promoted its business by handing out flyers and business cards,¹² *Tabor Dec.*, ¶ 5, 24 TTABVUE 3, there are no examples of those materials in the record, so the manner in which Applicant used **SCOTTSDALE TAXI** in the flyers or business cards cannot be determined. Although we take Mr. Tabor’s testimony at face value, without further information, we are unable to conclude that Applicant’s flyers or business cards had any significant effect on the public perception of the applied-for mark — then or now.

In 2008, Applicant began to make more robust efforts to promote its business under the **SCOTTSDALE TAXI** mark. Applicant established a website in 2008 and another in 2012, and “in or around 2013,” Applicant created social media pages on various platforms, *Tabor Dec.* ¶¶ 5–8, 24 TTABVUE 3–4; *see App. Not. of Reliance Exh. 10*, 22 TTABVUE 133–37, and began placing ads on third party websites through Yext, *Tabor Dep.* 18 TTABVUE 40–41. While it is clear that these recent

¹² According to Mr. Tabor’s testimony, no other marketing was necessary from 2000–2008 “because the company was already well known and business was robust,” *Tabor Test.* ¶ 5, 24 TTABVUE 3. Similarly, Mr. Tabor testified that “Scottsdale Taxi is well known in the area and consumers identify the company with the name **SCOTTSDALE TAXI**,” *id.* ¶ 3, and that “Scottsdale Taxi . . . was, and remains, a dominant presence in the taxi industry in Scottsdale, Arizona,” *id.* ¶ 4. Applicant cites these statements as facts in its brief. *App. Br.*, 31 TTABVUE 27.

Although Opposer’s characterization of these statements as “self-serving,” *Opp. Br.* 30 TTABVUE 27; *Reply Br.* 33 TTABVUE 6–8, is unhelpful, *see Sanders v. Melvin*, 873 F.3d 957, 960 (7th Cir. 2017) (“[e]verything a litigant says in support of a claim is self-serving”), we agree that Mr. Tabor’s statements about Applicant’s renown and market position and consumers’ recognition of **SCOTTSDALE TAXI** as a trademark are wholly conclusory, with no factual support in Mr. Tabor’s testimony or elsewhere in the record. These issues go the heart of the question of acquired distinctiveness, and it was incumbent on Applicant to prove them by the introduction of factual evidence, not the statement of bald conclusions or unsupported opinion.

activities are potentially significant, Mr. Tabor testified that he did not track the traffic on Applicant's websites or social media pages, *Tabor Dep.* 18 TTABVUE 42–43, so it remains unclear how many potential customers are exposed to these promotional efforts.

b. Advertising Expenditures

Mr. Tabor estimated Applicant's current total advertising expenses at \$3,000 per year, *Tabor Dep.* 18 TTABVUE 43, a relatively modest sum for a company which apparently serves much of the Scottsdale metropolitan area. The context of Mr. Tabor's testimony makes clear that he was referring to recent expenditures for online advertising. While these expenditures indicate that Applicant has recently made some promotional efforts which may be assumed to have reached prospective purchasers, the small amounts involved do not permit the inference that the effect on consumer perception has been particularly strong.

c. Exclusivity of Use

While an applicant's use of its asserted mark need not be absolutely exclusive to demonstrate acquired distinctiveness, significant use of a term by others makes it less likely that consumers will consider it to be a trademark, which identifies a single source for the relevant goods or services. *In re Boston Beer Co.*, 198 F.3d 1370, 53 USPQ2d 1056, 1058 (Fed. Cir. 1999) ("The examples of use of the phrase by others in its descriptive form support the board's conclusion that the mark had not acquired distinctiveness."); *Levi Strauss & Co. v. Genesco, Inc.*, 742 F.2d 1401, 222 USPQ 939, 940–41 (Fed. Cir. 1984).

According to Mr. Weinstein's testimony, Opposer and others use "Scottsdale taxi"

in connection with taxi or related services. He identified the web pages of a number of Scottsdale area companies advertising transportation services using “Scottsdale taxi” and similar terms. Applicant proffered evidence suggesting that some of the websites identified in Mr. Weinstein’s testimony are affiliated with Opposer or Mr. Weinstein. *App. Br.*, 31 TTABVUE 7 n.1 (citing *App. Not. of Reliance*, Exh. 23, 22 TTABVUE 256–65 (Whois search)), but Opposer objected to the evidence as hearsay. *Opp. Br. (Appx.)*, 30 TTABVUE 47–48. Web pages, like other printed publications, may be relied upon for what they show on their face. But absent an exception to the hearsay rule or testimony vouching for the accuracy of the information appearing on it, a web page cannot be used to prove the truth of any matter asserted therein. *E.g.*, *7-Eleven Inc. v. Wechsler*, 83 USPQ2d 1715, 1717 n.2 (TTAB 2007). Opposer’s objection is sustained.¹³

But regardless of who controls the disputed websites, Opposer’s evidence shows use of “Scottsdale taxi” in advertising taxi transport services on several websites that are not alleged to be connected with Opposer or Mr. Weinstein. For instance:

- The “Scottsdale Cab Guy offers efficient reliable Scottsdale taxi service to meet the transportation needs of residents, visitors, and our corporate clients.” *Id.* Exh. 7, 31 TTABVUE 8;

¹³ Even if Applicant’s Whois evidence were admissible, we think it makes little difference whether several of the websites submitted by Opposer are owned, controlled, or otherwise affiliated with Opposer or Mr. Weinstein. The websites submitted by Opposer are relevant because they show that Applicant’s use of **SCOTTSDALE TAXI** for taxi services is not substantially exclusive, and there seems to be no dispute that the proffered websites show the use of that term by someone other than Applicant. We are aware of no rule excluding from our consideration for that purpose websites owned, controlled by, or otherwise affiliated with Opposer or its principal.

- Clean Air Cab advertises its services under the heading “SCOTTSDALE TAXI SERVICE.” *Id.* Exh. 8, 20 TTABVUE 34; and
- Valley Transportation touts its “Valley Cab Scottsdale Taxi Cab service in Scottsdale Arizona.” *Id.*, Exh. 10, 20 TTABVUE 38.

Thus, the designation “Scottsdale taxi” appears to be in use by Opposer and at least three other companies offering taxi transport services in or around Scottsdale, Arizona — in addition to use of the mark by Opposer and on several websites allegedly affiliated with Opposer or Mr. Weinstein.

Although “Opposer presents no evidence that Scottsdale Taxi’s use was nonexclusive until recently,” *App. Br.*, 31 TTABVUE 28, there appears to be no question that in addition to Opposer, several of Applicant’s competitors currently use the term **SCOTTSDALE TAXI** in connection with “taxi transport” services provided in and around Scottsdale, Arizona. We conclude that Applicant’s use of the applied-for mark is not substantially exclusive, and that relevant consumers are unlikely to consider it as indicating the source of Applicant’s taxi transport services.

d. Other Evidence Bearing on Acquired Distinctiveness

As Opposer points out, *Opp. Br.*, 30 TTABVUE 28, Applicant submitted no direct evidence of consumer perception, such as consumer testimony or a survey showing recognition of **SCOTTSDALE TAXI** as an indication of the source of Applicant’s “taxi transport” services. While we agree with Opposer that a well-conducted survey can be highly persuasive on the question of acquired distinctiveness, our precedent is clear that a survey is not required to establish acquired distinctiveness. *Yamaha*, 6 USPQ2d at 1010 (citing *Roux Labs.*, 166 USPQ 35). Likewise, Applicant submitted no evidence indicating the success of its business under the **SCOTTSDALE TAXI**

designation, such as evidence of its sales volume, revenue, or market share. Although robust business under the putative mark is often considered as indirect evidence of acquired distinctiveness, such evidence is also not required. To the contrary, we must consider evidence of any type reflecting on the public perception of the putative mark as an indication of source. *See Coach Servs.*, 101 USPQ2d at 1729. Nonetheless, while we do not construe Applicant's "failure" to submit any particular type of evidence as an indication that **SCOTTSDALE TAXI** has *not* acquired distinctiveness, it remains Applicant's burden to demonstrate that the applied-for mark has acquired distinctiveness by whatever evidence it has made of record.

e. "Confusion" Caused by Opposer

Finally, Applicant contends that Opposer's use of "Scottsdale taxi" has caused confusion among Applicant's customers. *App. Br.*, 31 TTABVUE 6. While the avoidance of consumer confusion is of considerable importance under the Trademark Act, we cannot agree that the confusion alleged here either demonstrates acquired distinctiveness or otherwise requires a decision in Applicant's favor. First, the question before us focuses not on Opposer's use of "Scottsdale taxi," but on whether that term can be registered by Applicant in view of the evidence that it is primarily geographically descriptive and significantly so.¹⁴ Second, because Applicant's putative trademark is highly geographically descriptive, Applicant's competitors may and have a

¹⁴ Applicant does not assert (and has therefore forfeited) the argument that Opposer's use or "copying" of **SCOTTSDALE TAXI** is itself evidence that the term has acquired distinctiveness, but even if it had, the facts do not support such a claim. While intentional copying by a junior user is sometimes considered evidence (albeit not conclusive evidence) of acquired distinctiveness, the doctrine seems most often applied when the putative trademark consists of

need to use it in describing and advertising their own services. As the Supreme Court noted in an analogous situation, “[i]f any confusion results, that is a risk [Applicant] accepted when it decided to identify its product with a mark that uses a well-known descriptive phrase.” *KP Permanent Make-Up Inc. v. Lasting Impression I Inc.*, 543 U.S. 111, 72 USPQ2d 1833, 1838 (2004) (quoting *Cosmetically Sealed Indus., Inc. v. Chesebrough-Pond’s USA Co.*, 125 F.3d 28, 43 USPQ2d 1956, 1958 (2d Cir. 1997)); see *Alzheimer’s Disease & Related Disorders Ass’n, Inc. v. Alzheimer’s Found. of Am., Inc.*, — F. Supp. 3d —, 2018 WL 2122829 *25 (SDNY 2018) (“In light of the descriptive nature of the marks, confusion between the unchallenged ‘Alzheimer’s Foundation of America’ mark and ‘Alzheimer’s Association’ supports the notion that it is the weakness of the marks and consumers’ inattention, not AFA’s specific disputed practices, that yields confusion.”). We conclude that the alleged confusion in this case has no bearing on the registrability of the applied-for mark.

trade dress or a configuration of the goods. Even so, intentional copying is only relevant when done with the intention of passing off the junior user’s goods or services as those of the senior user, *Blau Plumbing, Inc. v. S.O.S. Fix-It, Inc.*, 781 F.2d 604, 611, 228 USPQ 519, 522 (7th Cir. 1986), rather than to exploit some “intrinsic consumer-desirability” of the alleged mark. *Cicena, Ltd. v. Columbia Telecomms. Grp.*, 900 F.2d 1546, 14 USPQ2d 1401, 1406 (Fed. Cir. 1990). In this case, the mark in question is a highly geographically descriptive, standard-character word mark, not trade dress of arguable distinctiveness, and on this record, it is far from clear that Opposer uses **SCOTTSDALE TAXI** with the intent to pass off its own services as Applicant’s, rather than because it is an apt description of Opposer’s own services. “[A] defendant may deliberately copy a descriptive mark because it accurately and succinctly describes the properties of the defendant’s goods or services.” *Cont’l Lab. Prod., Inc. v. Medax Int’l, Inc.*, 114 F. Supp. 2d 992, 56 USPQ2d 1548, 1562 (S.D. Cal. 2000) (citing *Blau Plumbing*, 228 USPQ at 522; *Philip Morris, Inc. v. R.J. Reynolds Tobacco Co.*, 188 USPQ 289, 293–94 (SDNY 1975)). “It must . . . not be forgotten that there is absolutely nothing legally or morally reprehensible about exact copying of things in the public domain.” J.T. McCarthy, MCCARTHY ON TRADEMARKS & UNFAIR COMPETITION, § 15:38 (5th ed. Mar. 2018 Update).

IV. Equitable Defenses

Applicant pleaded the defenses of laches, estoppel, and unclean hands. *Answer to Amend. Not. of Opp.*, 14 TTABVUE 4, ¶¶ 2–3. The first two need not be discussed at length as they were not argued in Applicant’s brief so they are waived. *Cerveceria India Inc. v. Cerveceria Centroamericana, S.A.*, 10 USPQ2d 1064, 1066, n.3 (TTAB 1989) (affirmative defenses not argued in brief), *aff’d*, 892 F.2d 1021, 13 USPQ2d 1307 (Fed. Cir. 1989); *Alcatraz Media*, 107 USPQ2d at 1753 n.6.

On the other hand, Applicant argues at some length, *App. Br.*, 31 TTABVUE 7–13, that Opposer and its principal are unscrupulous in their business dealings, operating a variety of “fictitious companies,” *App. Br.*, 31 TTABVUE 7; that “Mr. Weinstein’s taxi scheme is just his latest plot to make easy money through deception,” *id.*, 31 TTABVUE 9; and that Opposer’s arguments to the Board are deceptive.¹⁵ *Id.*, 31 TTABVUE 9–10. “To the extent Opposer has grounds for relief,” Applicant urges, Opposer has “unclean hands, which should preclude any such relief.” *Id.*, 31 TTABVUE

¹⁵ Applicant cites Opposer’s concern that if Applicant is successful in registering its mark, Applicant “might preclude [Opposer], and others, from making descriptive use of the terms ‘Scottsdale’ and ‘taxi.’” *App. Br.*, 31 TTABVUE 9 (footnote omitted). According to Applicant, Opposer “aims to deceive” the Board with this argument because under the doctrine of fair use, Applicant “could *not* preclude Opposer from descriptive use of the term ‘Scottsdale taxi.’” *Id.*, 31 TTABVUE 9–10. Applicant’s argument misses the point. The availability of fair use as a *defense* to a claim of infringement cannot justify the *registration* of a primarily geographically descriptive term on the Principal Register. Absent acquired distinctiveness, such terms are unregistrable, in part so they cannot be used to threaten competitors with infringement suits in the first place. *Cf. In re Abcor Dev. Corp.*, 588 F.2d 811, 200 USPQ 215, 217 (CCPA 1978) (One “major reason[] for not protecting [descriptive] marks [is] . . . to maintain freedom of the public to use the language involved, thus avoiding the possibility of harassing infringement suits by the registrant against others who use the mark when advertising or describing their own products.”). We do not find Opposer’s argument deceptive or — in light of Applicant’s cease and desist letter — unreasonable.

13. In response, Opposer argues that Applicant's unclean hands defense is "simply irrelevant and improper to proceedings based on descriptiveness," *Reply Br.*, 33 TTABVUE 11, and that it is based on inadmissible evidence. *Id.*, 33 TTABVUE 12. Not surprisingly, Opposer disagrees with Applicant's characterization of its behavior. *Id.* 33 TTABVUE 13–14.

Unclean hands is an equitable defense generally available in Board proceedings. *See* Trademark Rule 2.106(b)(2) (oppositions), 2.114(b)(2) (cancellations). When applicable, the defense denies relief to one who has acted inequitably with respect to the matter before the tribunal. *E.g.*, *Hornblower & Weeks Inc. v. Hornblower & Weeks Inc.*, 60 USPQ2d 1733, 1738 (TTAB 2001). *But see* *Warnaco Inc. v. Adventure Knits, Inc.*, 210 USPQ 307, 313 (TTAB 1981) ("misconduct in the abstract, unrelated to the claim in which it is asserted as a defense, does not constitute unclean hands"). But in applying equitable defenses such as unclean hands, the tribunal must take into account "the public interest as well as the private interests of the litigants." *Precision Instrument Mfg. Co. v. Auto. Maint. Mach. Co.*, 324 U.S. 806, 65 USPQ 133, 138 (1945). When a dispute primarily involves the individual rights of the parties, equitable defenses will bar relief in appropriate cases. But the Board and its primary reviewing courts have refused to apply unclean hands and other equitable defenses in cases where their application might implicate the interests of others, including consumers and competitors. For example, in *Loglan Inst. Inc. v. Logical Language Group Inc.*, 962 F.2d 1038, 22 USPQ2d 1531 (Fed. Cir. 1992), the Federal Circuit affirmed the Board's holding that defenses of laches, estoppel, and acquiescence are

insufficient to bar a claim that a mark is generic. “The Board did not err in declining to apply the defenses, as the public interest in a cancellation proceeding to rid the register of a generic mark transcends them.” *Id.* at 1534. Likewise, laches will not bar a claim under Trademark Act § 2(d) where consumer “confusion or mistake . . . is not only likely but inevitable.” *Ultra-White Co. v. Johnson Chem. Indus., Inc.*, 465 F.2d 891, 175 USPQ 166, 167 (CCPA 1972). “In such a situation, . . . the public interest . . . is the dominant consideration.” *Id.* Similarly, equitable defenses are not available against claims of fraud or abandonment, *Treadwell’s Drifters Inc. v. Marshak*, 18 USPQ2d 1318, 1320 (TTAB 1990) (citing *TBC Corp. v. Grand Prix Ltd.*, 12 USPQ2d 1311, 1313 (TTAB 1989)), or claims that a mark is merely descriptive, deceptively misdescriptive, deceptive, or functional, *Saint-Gobain Abrasives, Inc. v. Unova Indus. Automation Sys., Inc.*, 66 USPQ2d 1355 (TTAB 2003) (functional); *Southwire Co. v. Kaiser Aluminum & Chem. Corp.*, 196 USPQ 566, 576 (TTAB 1977) (descriptive); *W.D. Byron & Sons, Inc. v. Stein Bros. Mfg. Co.*, 146 USPQ 313 (TTAB 1965), *aff’d*, 377 F.2d 1001, 153 USPQ 749 (CCPA 1967) (misdescriptive or deceptive).

More to the point, in *Ohio State Univ. v. Ohio Univ.*, 51 USPQ2d 1289 (TTAB 1999), Ohio University’s applied-for and registered marks were challenged on the ground that they were primarily geographically descriptive. Upon motion, the Board struck a defense of equitable estoppel because, “as with merely descriptive marks, the public interest is not served by allowing primarily geographically descriptive marks to become or remain registered based on the action or inaction of any single person or concern.” *Id.* at 1294. So too in this case. Even if Applicant’s allegations

about Opposer's actions and motives are true — a question we need not reach — it would not change the fact that the designation **SCOTTSDALE TAXI** is primarily geographically descriptive, and quite clearly so. In the absence of a showing that the designation has acquired distinctiveness, it should remain available for use by others providing taxi transportation services in and around Scottsdale, Arizona to describe and market their services. Registration of **SCOTTSDALE TAXI** on the Principal Register is inconsistent with that right, regardless of what Applicant characterizes as Opposer's misbehavior. Because the interest in preventing the registration of Applicant's mark is broader than the dispute between the individual parties, we find Applicant's invocation of the equitable doctrine of unclean hands insufficient to bar Opposer's claim in this case.

V. Conclusion

We find **SCOTTSDALE TAXI** to be highly geographically descriptive as used in connection with "taxi transport" services in and around Scottsdale. As a result, Applicant bears a heavy burden to demonstrate that the designation has acquired distinctiveness. Upon consideration of the record and the parties' arguments, we conclude that Applicant has not met that burden.

Although we accept Mr. Tabor's testimony that Applicant has used **SCOTTSDALE TAXI** in its business since 1994, the evidence of Applicant's promotion of its services under the applied-for mark prior to 2008 is weak. While Applicant's post-2008 online use of **SCOTTSDALE TAXI** in connection with its business is clearly more significant, it covers only the most recent few years and more importantly, Applicant provided no evidence of how many consumers have accessed its

website or viewed its ads. Moreover, Applicant's recent modest advertising expenditures do not suggest strong promotion of **SCOTTSDALE TAXI** as a designation of source. Finally, Applicant's lack of substantially exclusive use of the applied-for mark is inconsistent with a finding that the term has acquired distinctiveness.

We find the evidence — considered as a whole — insufficient to meet Applicant's burden to demonstrate that **SCOTTSDALE TAXI** has acquired distinctiveness as a trademark for "taxi transport" services.

Decision: The opposition to registration of Application Serial No. 86175541 is sustained on the ground that the applied-for mark is primarily geographically descriptive pursuant to Trademark Act § 2(e)(2), and has not acquired distinctiveness. Registration to Applicant is refused.