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Hurdles to Federal Trademark Registration Part 2 - Merely Descriptive & Geographically Descriptive

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Trademarks are also non-registrable under the Lanham Act if the mark, when used in connection with applicant's goods or services, is merely descriptive of them. 15 U.S.C. § 1052(e)(1). In a recent case, *In re Houston Bites, LLC*, Serial No. 87170141, applicant Houston Bites LLC attempted to register "Houston Bites" for services identified as "providing a website featuring non-downloadable photographs regarding restaurants, food and beverages." The examining USPTO attorney refused registration on the ground that the mark was merely descriptive of the service in question: providing a website of photos related to light meals and snacks located in Houston, Texas. Houston was merely descriptive of applicant's location, and a dictionary entry that defined "bites" as light meals or snacks bolstered the notion that the word bites was merely descriptive of what applicant's services provided images of. If all individual components of the mark were descriptive, then the composite mark was also descriptive and not registrable. The TTAB affirmed the refusal, finding that the issue was whether someone who knows what the services were would understand "Houston Bites" as conveying information about them. The Board found that customers would interpret "Houston Bites" as doing this exact thing based on several third-party websites of other city names paired alongside the word "bites" as a service that provided photographs and information on foods and beverages in that particular area (Chicago Bites, Jersey Bites, etc). Therefore, the mark was merely descriptive since it conveyed the subject matter of the service in question.

Equally important, primarily geographically descriptive marks may also be refused registration. The applicant in *In Zero Transportation, LLC v. Scottsdale Taxi Sedan Service Co.*, Opposition No. 91218718 to Application No. 86175541 (June 14, 2018), sought to register "Scottsdale Taxi" for "taxi transport" services in or around the Scottsdale, Arizona area but faced an opposition filed by Zero Transportation. Applicant had provided ground transportation services in and out of Scottsdale, Arizona since 1994, and the opposer began offering transportation services in and around Scottsdale under the name Scottsdale Cab Company. The TTAB considered whether "Scottsdale Taxi" was primarily geographically descriptive and lacked acquired descriptiveness. If the "Scottsdale Taxi" mark no longer created a public association between the mark and a particular place, and consumers associated the services with a particular source, then the mark acquired distinctiveness and could be registered.

The Board found, however, that "Scottsdale Taxi" was highly geographically descriptive of the city and services offered, and there was nothing resulting from the combination of the two words that would detract from the geographic significance of the designation as a whole. The Board acknowledged that although the mark was used for 23 years, applicant offered little to no evidence concerning the nature and extent of the use of the mark and the effect it had on consumer perception. Additionally, because several of applicant's competitors were using "Scottsdale Taxi" in connection with taxi transport services in the Scottsdale area, applicant's use was not substantially exclusive, thus relevant consumers were unlikely to consider it as indicating the source of applicant's taxi transport services. The Board, therefore, affirmed the opposition and refused to register the "Scottsdale taxi" mark.

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