

***YELLOW CAB CO. OF SACRAMENTO V.
YELLOW CAB OF ELK GROVE, INC.***
419 F.3d 925 (9th Cir. 2005)

The Ninth Circuit held that a plaintiff alleging infringement of an unregistered mark has the burden of proving that the mark is not generic and therefore protectable.

Yellow Cab Company of Sacramento (“Sacramento Cab”) filed an action against Yellow Cab of Elk Grove (“Elk Grove Cab”) alleging trademark infringement under the Lanham Act. Sacramento Cab had been in operation in the Sacramento area, including the suburb of Elk Grove, since 1922. At the time of the suit, it operated approximately ninety cabs and had a number of exclusive business accounts. In 2001, Elk Grove Cab, a one-cab taxi operation, began operations in Elk Grove. “Yellow Cab of Sacramento” was not a federally registered mark. The district court granted Elk Grove Cab’s motion for summary judgment, holding that the plaintiff has the burden to prove that a nonregistered mark is not generic. Further, the court held in the alternative that “yellow cab” is a generic term, and that even if it were a descriptive term, Sacramento Cab failed to demonstrate secondary meaning.

Sacramento Cab appealed, and the Ninth Circuit reversed on the grounds that the district court erred in determining that there were no genuine issues of material fact concerning genericness and secondary meaning. However, the Ninth Circuit agreed with the district court that the plaintiff bears the burden of proof establishing that the mark was not generic. The Ninth Circuit noted that when a plaintiff pursues a trademark action regarding a federally registered mark, the mark is presumed valid and the burden of proving that the mark is generic rests on the defendant. However, if the mark has not been federally registered and the defendant argues that the mark is generic, the burden shifts to the plaintiff to show the mark is valid and *not* generic. Here, the mark was not federally registered, but since Sacramento Cab came forward with evidence raising a genuine issue of material fact as to whether “yellow cab” was generic or had acquired secondary meaning, summary judgment was not appropriate.

