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UNITED STATES DISTRICT COURT
NORTHERN DISTRICT OF CALIFORNIA

INN S.F. ENTERPRISE, INC.,

Plaintiff,

v.

NINTH STREET LODGING, LLC,

Defendant.

Case No. [3:16-cv-00599-JD](#)

**ORDER RE MOTIONS FOR
SUMMARY JUDGMENT**

Re: Dkt. Nos. 46, 47

Plaintiff Inn S.F. Enterprise, Inc. (“Inn SF”) and defendant Ninth Street Lodging, LLC (“Ninth Street”) provide lodging services in San Francisco. Inn SF operates a bed-and-breakfast that has called itself “The Inn San Francisco” since 1985. Dkt. No. 1 at 3. “The Inn San Francisco” is not a registered federal trademark. Since 2013, Ninth Street has operated a motel under the name “San Francisco Inn.” Dkt. No. 25 at 2, 4. Inn SF alleges that it has a valid trademark in “The Inn San Francisco” and that Ninth Street’s use of “San Francisco Inn” infringes its mark. Inn SF is suing for unfair competition under the Lanham Act, trademark infringement and unfair competition under California law, and common law unjust enrichment. Dkt. No. 1 at 1-2.

Ninth Street has answered the complaint with a number of affirmative defenses and counterclaims. Dkt. No. 25. Ninth Street now moves for summary judgment on all of Inn SF’s claims, arguing that “The Inn San Francisco” is not a valid trademark because it is either generic or descriptive and lacks secondary meaning. Dkt. No. 46. Inn SF opposes the motion and moves for summary judgment on a number of Ninth Street’s affirmative defenses and counterclaims. Dkt. No. 47.

1 does not argue otherwise. *See* Dkt. No. 52 at 10 (framing the threshold issue as whether Inn SF’s
 2 mark is descriptive); *see also Entrepreneur Media, Inc. v. Smith*, 279 F.3d 1135, 1142 (9th Cir.
 3 2002) (suggestive mark requires consumer to use imagination or multistage reasoning to
 4 understand the mark’s significance). Consequently, “The Inn San Francisco” must be either
 5 generic or descriptive.

6 A term is generic if it is a common word or phrase that describes “a class of goods rather
 7 than an individual product.” *Japan Telecom, Inc. v. Japan Telecom Am., Inc.*, 287 F.3d 866, 872
 8 (9th Cir. 2002) (internal quotation omitted). A generic term can never be a valid mark. In
 9 contrast, a term is descriptive if it defines “qualities or characteristics of a product in a
 10 straightforward way that requires no exercise of the imagination to be understood.” *Entrepreneur*
 11 *Media*, 279 F.3d at 1141-42 (internal quotation omitted). A descriptive mark may be protected if
 12 it has acquired “secondary meaning in the minds of consumers, i.e., it has become distinctive of
 13 the trademark applicant’s goods in commerce.” *Filipino Yellow Pages*, 198 F.3d at 1147 (internal
 14 quotation omitted). The proponent of a weak descriptive term -- a term “perilously close to the
 15 generic line” -- must make out “a strong showing of strong secondary meaning” to establish
 16 validity. *Id.* at 1151 (internal quotation omitted).

17 **DISCUSSION**

18 The record shows that “The Inn San Francisco” is best understood as a generic term. Our
 19 circuit uses a “who-are-you/what-are-you” test to distinguish between generic and descriptive
 20 marks. *Yellow Cab*, 419 F.3d at 929. Terms that answer the “what are you?” question are
 21 typically generic, and terms that answer the “who are you?” question may be descriptive. *Id.* In
 22 *Advertise.com, Inc. v. AOL Advertising, Inc.*, 616 F.3d 974, 978 (9th Cir. 2010), for example, the
 23 court applied the “who-are-you/what-are-you” test and found that “Advertising.com” is very likely
 24 generic because “any online advertising company, including AOL’s competitors,” could respond
 25 to “what are you?” with “an advertising.com” or “an advertising dot-com.” Conversely, an AOL
 26 competitor asked to refer someone to “an advertising dot-com” could reasonably offer its own
 27 services. *Id.*

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1 Like “Advertising.com,” the term “The Inn San Francisco” is an answer to “what are you?”
2 rather than “who are you?” Any lodging services provider in San Francisco could answer “what
3 are you?” with “an inn in San Francisco.” Conversely, an Inn SF competitor asked to refer
4 someone to “an inn in San Francisco” could reasonably offer its own services. That is good
5 evidence of the genericness of the claimed mark, which modifies a clearly generic term by
6 prepending “the” and deleting “in.”

7 To be sure, adding or deleting a preposition from a generic term may in some cases result
8 in a non-generic term. But the undisputed evidence here shows that the exact term “Inn San
9 Francisco” is used by many other lodging providers in San Francisco. *See* Dkt. No. 46-6 (listing
10 “Seaside Inn San Francisco,” “Presidio Inn San Francisco,” as well as multiple “Holiday Inn San
11 Francisco” locations, “Days Inn San Francisco” locations, and “Hampton Inn San Francisco”
12 locations, among others). This usage of “Inn San Francisco” indicates that “Inn San Francisco” is
13 not an unusual way to title or refer to an inn located in San Francisco. The term is widely used in
14 a generic fashion by other lodging providers, who distinguish their own services by prefacing the
15 term with a more specific descriptor (e.g., *Seaside Inn San Francisco*, *Presidio Inn San Francisco*).

16 Consequently, Ninth Street has presented evidence of genericness that is substantial and
17 not subject to serious dispute. Inn SF has not offered any relevant evidence in rebuttal.
18 Specifically, Inn SF did not submit any evidence that pertains directly to its own proposed mark,
19 such as evidence of consumer perception. *See, e.g., California Cooler, Inc. v. Loretto Winery,*
20 *Ltd.*, 774 F.2d 1451, 1455 (9th Cir. 1985) (discussing survey evidence of consumer beliefs).
21 Instead, Inn SF only submits examples of other federally registered marks that combine a
22 geographic location with the words “inn” or “hotel.” Dkt. No. 52 at 9. Those examples have
23 nothing to do with whether “The Inn San Francisco” is generic. The burden rests on Inn SF to
24 establish non-genericness, and Ninth Street has offered essentially unopposed evidence that the
25 disputed mark is generic. Summary judgment for Ninth Street would be appropriate on those
26 grounds alone. *See Filipino Yellow Pages*, 198 F.3d at 1151.

27 For the sake of completeness, the Court notes that even if “The Inn San Francisco” were
28 viewed as descriptive, it is at best only weakly descriptive. To survive summary judgment on this

1 score, Inn SF must tender evidence that would permit the Court to reasonably infer that the mark
2 has become distinctive of Inn SF's bed-and-breakfast services in the mind of the consuming
3 public. "Factors considered in determining whether a secondary meaning has been achieved
4 include: (1) whether actual purchasers of the product bearing the claimed trademark associate the
5 trademark with the producer, (2) the degree and manner of advertising under the claimed
6 trademark, (3) the length and manner of use of the claimed trademark, and (4) whether use of the
7 claimed trademark has been exclusive." *Comm. for Idaho's High Desert, Inc. v. Yost*, 92 F.3d
8 814, 822 (9th Cir. 1996) (internal quotation omitted).

9 Inn SF has not carried its burden. It proffers some evidence of advertising expenditures
10 but has not submitted any of the relevant ads. Because no ads have been produced, the Court has
11 no basis for finding that any of the advertising could have fostered consumer association between
12 Inn SF and the claimed mark. Moreover, Inn SF's evidence of expenditures and sales is offered
13 with scant explanation and is difficult to parse. For instance, on advertising expenditures, Inn SF
14 simply directs the Court to a hodge-podge compilation of what appears to be hand-written and
15 printed receipts. Dkt. No. 48-3. The same goes for Inn SF's records of bookings and sales over
16 time. Dkt. No. 48-5.

17 Inn SF says that it has enjoyed unsolicited media coverage at the local, national, and
18 international level, and cites to several publications that have featured the inn. This coverage is
19 unsurprising for a bed-and-breakfast establishment that has been doing business in a popular
20 tourist destination for over thirty years, and is of little value in establishing a trademark. Because
21 Inn SF never discusses how many readers are reached by such publications, the Court cannot infer
22 that a notable portion of the consuming public would ever have been exposed to the relevant
23 coverage; specialty publications such as the 19th edition of *Victorian Glory -- In San Francisco
24 and the Bay Area; Bed & Breakfasts and Country Inns* seem unlikely to have reached a wide
25 national audience. *See* Dkt. No. 52 at 15. According to Inn SF, the most compelling evidence of
26 media coverage is a September 2008 New York Times article. *Id.* An employee declares that the
27 article continues to be a source of bookings for Inn SF. *See* Dkt. No. 47-23 at 45. Even taking
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1 that testimony at face value, the existence of a ten-year-old New York Times article mentioning
2 the inn does not indicate strong secondary meaning for consumers generally.

3 Inn SF also claims that it has used its mark continuously and to the substantial exclusion of
4 others. But it does not produce any evidence of substantial exclusion and fails to rebut contrary
5 evidence offered by Ninth Street. *See* Dkt. No. 46-6 (listing forty-five lodging providers in San
6 Francisco that use “The Inn San Francisco” or some variation thereof in their names). Inn SF says
7 the Court may disregard the use of “Inn San Francisco” by corporate hotel chains, but the use of
8 “Inn San Francisco” by multiple corporate hotel chains suggests that the term is generic. And as
9 Inn SF acknowledges, Seaside Inn San Francisco and Mission Inn in San Francisco are not
10 examples of corporate chains, yet it does not elaborate further and does not describe how long
11 those establishments have operated or advertised under those names. *See* Dkt. No. 52 at 17-18.

12 Finally, Inn SF lays claim to consumer confusion, but with little support in the record. *Id.*
13 at 23. Inn SF refers the Court to a document at Dkt. No. 47-9. This is a 34-page compilation of
14 various hand-written and scanned notes, as well as print-outs of some Yelp reviews, booking
15 records, and emails, all marked up by what appears to be employee commentary. These notes are
16 entirely unexplained and do not support an inference of consumer confusion.

17 **CONCLUSION**

18 Summary judgment is granted to Ninth Street on Inn SF’s federal claims. Inn SF’s
19 complaint also alleges state law trademark and unjust enrichment claims. Since subject matter
20 jurisdiction was based on the federal claims that have been dismissed, the Court declines to
21 consider the remaining state law claims, and they are dismissed without prejudice. 28 U.S.C. §
22 1367(c); *Acri v. Varian Assocs., Inc.*, 114 F.3d 999, 1001 (9th Cir. 1997). Inn SF’s motion for
23 summary judgment is denied in its entirety.

24 **IT IS SO ORDERED.**

25 Dated: January 9, 2018

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JAMES DONATO
United States District Judge