IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF COLORADO

Civil Action No. 16-cv-02002-WJM

OPEN STUDIOS, INC, a Colorado, Nonprofit Corporation

Plaintiff,

v.

BOULDER METALSMITHING ASSOCIATION, a Colorado, Nonprofit Corporation
Defendant.

DEFENDANT'S MOTION TO DISMISS PLAINTIFF'S COMPLAINT

Defendant, Boulder Metalsmithing Association (BOMA)moves this Court to dismiss Plaintiff's complaint pursuant to Fed. R. Civ. P. 12 (b)(6).

LOCAL RULE 7.1 CERTIFICATION

BOMA's counsel, Kirstin Jahn talked with Howard Bernstein, counsel for Plaintiff on August 26, 2016 and discussed dismissing the complaint based on the generic use of "open studio" for BOMA's art studio space that is open for public use. Mr. Bernstein advised Ms. Jahn Plaintiff would oppose this motion.

INTRODUCTION

The terms OPEN STUDIOS and OPEN STUDIO are generic terms. The term "Open Studio" commonly denotes when an art studio space is open for artists to create their work. The term OPEN STUDIOS (with an added "S") commonly refers to an annual event in various cities across the country where artists open their art studios to display and sell their artwork. Plaintiff has alleged BOMA's use of the term OPEN

STUDIO in advertising the particular dates and times its studio is open to metalsmithing artists infringes its OPEN STUDIOS mark as used in connection with the annual art walk. A plethora of museums and artist studios prominently display their "OPEN STUDIO" dates and times are so that artists (which may include the general public) may know when it is open for use. Examples of include the Denver Art Museum, The Getty Museum, the Whitney Museum of Art, National Portrait Museum, Museum of Modern Art, the Guggenheim Museum among many other smaller entities such as Classical Art Academy, TinkerMill Pottery Studio, Inspiration Academy, Whimsey, Denver Scholl of Metal Arts, Clear Creek Academy, Fancy Tiger Crafts, Certified Ink, Stone Leaf Pottery and Juilliard School of Music.

Moreover, a showing of just a few of the cities and towns across the United States which use OPEN STUDIOS to denote its annual art walk tour and are the following: San Francisco Open Studios, Open Studios Art Tour (Santa Cruz), Bushwick Open Studios Open Studio (Hartford), Silicon Valley Open Studios, Artists' Open Studios of Northeast CT, Cambridge Open Studios, Massachusetts Open Studios and Boston Open Studios.

Plainly, there is no issue of fact in this case which needs to be discovered to determined. Plaintiff does not allege nor can it ever have exclusive rights to use the term OPEN STUDIO in connection with either advertising a particular date and time when an artist studio is open for use (as in BOMA's case) or in connection with the yearly date when artist's open their studios for public viewing. It does not matter whether Plaintiff used the term OPEN STUDIOS for its annual artist tour for the past 25 years because no one can gain exclusive rights in a generic term.

Despite providing tremendous evidence of the generic use of OPEN STUDIO and OPEN STUDIOS to Plaintiff, Plaintiff moved forward with this litigation. BOMA moves this Court pursuant to 12(b)(6) because Plaintiff has no exclusive rights in the term OPEN STUDIOS and has no claim upon which relief can be granted against BOMA's use of the term OPEN STUDIOS to denote the dates and times when its art studio is open for artist's to create their art work. BOMA requests this motion be treated as a motion for summary judgment. *J. Martinez Practice Standards II(D)(3)*.

FACTS

The term OPEN STUDIO is commonly used around the country to denote the dates and times and place a particular art studio is open to artist's (or the public) to create various types of art. *Declaration of Kirstin M. Jahn dated August 30, 2016 (Jahn Decl.) at ¶2, Exhibit A*. The term OPEN STUDIOS (plural, with an "s") has been used extensively by various parties (entities, towns and cities) around the United States to denote that party's annual art walk whereby the public can travel to various artist studios to view the artist's work. *Id. at ¶3, Exhibit B*. See, also Wikipedia definition of OPEN STUDIO. *Id. at ¶4, Exhibit C*. BOMA uses the term OPEN STUDIO to denote the date and time its metalsmithing art studio is open to various artists. *See, Exhibit 2 attached to the Complaint*.

ARGUMENT

THE COMPLAINT SHOULD BE DISMISSED BECAUSE PLAINTIFF DOES NOT (AND CANNOT) HAVE EXCLUSIVE RIGHTS TO THE TERM "OPEN STUDIOS"

A. Motion to Dismiss Standard.

The Federal Rules of Civil Procedure provide that a defendant may move to dismiss a claim for "failure to state a claim upon which relief can be granted." Fed. R. Civ. P. 12(b)(6). In determining a motion to dismiss, the court assumes all of plaintiff's factual allegations are true and construes them in the light most favorable to the plaintiff. *Ridge at Red Hawk, LLC v. Schneider,* 493 F.3d 1174, 1177 (10th Cir. 2007). "While a complaint attacked by a Rule 12(b)(6) motion to dismiss does not need detailed factual allegations, . . . a plaintiff's obligation to provide the 'grounds' of his 'entitlement to relief' requires more than labels and conclusions, and a formulaic recitation of the elements of a cause of action will not do . . . ." *Bell Atl. Corp. v. Twombly*, 550 U.S. 544, 555 (2007). Plaintiff must state enough facts to state a claim to relief that is plausible on its face. *Id*. at 570. If plaintiffs "have not nudged their claims across the line from conceivable to plausible, their complaint must be dismissed." *Id*. "Thus, the mere metaphysical possibility that some plaintiff could prove some set of facts in support of the pleaded claims is insufficient; the complaint must give the court reason to believe that this plaintiff has a reasonable likelihood of mustering factual support for these claims." *Bison Designs, LLC v. Lejon of Cal., Inc.*, 2016 U.S. Dist. LEXIS 32326, *24-25 (D. Colo. Feb. 1, 2016).

In evaluating a Rule 12(b)(6) motion to dismiss, courts may consider not only the complaint itself, but also attached exhibits, documents incorporated into the complaint by reference and documents which are central to the plaintiff's claim and the parties do not dispute the authenticity of the documents. *Cleary Bldg. Corp v. David A. Dame, Inc.*, 674 F. Supp. 2d 1257, 1268-1269 (D. Colo. 2009). Thus, the Court may review

BOMA's Exhibits as well as Exhibit 2 to the Complaint to determine whether Plaintiff's Complaint should be dismissed because they are central to Plaintiff's claim.

B. Plaintiff's Federal Claims for Trademark Infringement, False Designation of Origin and Unfair Competition Under 15 U.S.C. § 1125(a) Must Be Dismissed

Plaintiff alleges that BOMA has infringed Plaintiff's OPEN STUDIOS mark, that BOMA is engaged in false designation of origin and unfair competition all in violation of 15 U.S.C. § 1125(a). *Complaint at ¶¶ 42-49 and 56-61.*

15 U.S.C. § 1125(a) provides, *inter alia*:

> 1) Any person who, on or in connection with any goods or services, or any container for goods, uses in commerce any word, term, name, symbol, or device, or any combination thereof, or any false designation of origin, false or misleading description of fact, or false or misleading representation of fact, which --
>
> (A) is likely to cause confusion, or to cause mistake, or to deceive as to the affiliation, connection, or association of such person with another person, or as to the origin, sponsorship, or approval of his or her goods, services, or commercial activities by another person, or
>
> (B) in commercial advertising or promotion, misrepresents the nature, characteristics, qualities, or geographic origin of his or her or another person's goods, services, or commercial activities, shall be liable in a civil action by any person who believes that he or she is or is likely to be damaged by such act.

15 U.S.C. § 1125(a).

Courts addressing claims of both trademark infringement and unfair competition, address the claims together because they have virtually identical elements. *Cleary*, 674 F. Supp. 2d at 1268-1269, citing *Utah Lighthouse Ministry v. Foundation for Apologetic Info & Res.*, 527 F.3d 1045, 1050 (10th Cir. 2008). Although Plaintiff does not have a registered trademark, an unregistered mark is entitled to Lanham Act protection if it

would qualify for registration. *Courtenay Communs. Corp. v. Hall*, 334 F.3d 210, 214 (2d Cir. N.Y. 2003); *Lahoti v. VeriCheck, Inc.*, 586 F.3d 1190, 1196 (9th Cir. 2009) . To claim trademark infringement, a plaintiff must have a "valid, protectable trademark." *Brookfield Commc'ns, Inc. v. W. Coast Entm't Corp.*, 174 F.3d 1036, 1046 (9th Cir. 1999). To be valid and protectable, a mark must be "distinctive." Marks are generally classified in one of five categories of increasing distinctiveness: (1) generic, (2) descriptive, (3) suggestive, (4) arbitrary, or (5) fanciful. *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 768 (1992); *Donchez v. Coors Brewing Co.*, 392 F.3d 1211, 1216 (10th Cir. Colo. 2004). Suggestive, arbitrary, and fanciful marks are considered "inherently distinctive" and are automatically entitled to federal trademark protection because "their intrinsic nature serves to identify a particular source of a product." *Two Pesos*, 505 U.S. at 768.

The five categories have been described as follows:

> "A mark is generic if it is a common description of products [or services] and refers to the genus of which the particular product [or service] is a species. A mark is descriptive if it describes the product's [or service's] features, qualities, or ingredients in ordinary language or describes the use to which the product [or service] is put. A mark is suggestive if it merely suggests the features of the product [or service], requiring the purchaser to use imagination, thought, and perception to reach a conclusion as to the nature of the goods [or services]. An arbitrary mark applies a common word in an unfamiliar way. A fanciful mark is not a real word at all, but is invented for its use as a mark."

Donchez v. Coors Brewing Co., 392 F.3d 1211, 1216 (10th Cir. Colo. 2004). *Id*.

"These categories reflect both the eligibility for protection and the degree of protection accorded" a particular mark. *Donchez v. Coors Brewing Co.*, 392 F.3d 1211, 1216-1217 (10th Cir. Colo. 2004). A term is generic if it is the common name for the

product or service and is inelligible for trademark protection because "'the public has an inherent right to call a product or service by its generic name.'" *Id*. at 1215 citing, *U.S. Search, LLC v. U.S. Search.Com.Inc.*, 300 F.3d 517, 523 (4th Cir. 2002); *Two Pesos*, 505 U.S. at 768.

Plaintiff's federal claims for infringement, unfair competition and false designation of origin must be dismissed against BOMA because OPEN STUDIO is the common name for advertising when a particular art studio is open for artists to create art and OPEN STUDIOS is the common name for a particular city's art walk to various artist studios. As such, the term OPEN STUDIO and OPEN STUDIOS are generic and inelligible for protection because the public has a right to use those terms in connection with posting dates and times when an art studio is open to the public or a city's annual art walk. *See, Exhibits A, B and C*.

C. Plaintiff's State Law Claims Must Also Be Dismissed

Although it is unclear whether Plaintiff's unfair competition claim is based in common law or federal law (Complaint ¶¶56-61), in either event, it, along with Plaintiff's state law deceptive trade practices claim (Complaint¶¶50-55), require the same elements as those necessary for a claim for infringement or unfair competition because the allegations are based upon Plaintiff's ownership of a valid and protectable mark. *Cleary*, 674 F. Supp. at 1270.

Since Plaintiff cannot claim ownership of a protectable mark - OPEN STUDIO-- Plaintiff's state law claims must also be dismissed.

CONCLUSION

In sum, Plaintiff's Complaint must be dismissed as a matter of law because Plaintiff does not have exclusive right in the term OPEN STUDIOS for an annual art walk or OPEN STUDIO to denote the dates and times an art studio is open for use by the public or an artist.

Dated: August 30, 2016

Respectfully submitted,

JAHN & ASSOCIATES, LLC

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Boulder Metalsmithing Association

CERTIFICATE OF SERVICE

I certify that on August 30, 2016, I electronically filed the foregoing document with the Clerk of Court using the CM/ECF system which sent notification of such filing to Plaintiff's counsel at the following email address:

Howard Bernstein
howard@bernsteinattorney.com

Dated: August 30, 2016

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