

**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 REPLY TO OPPOSITION TO ITS
MOTION TO DISMISS**

Defendant, Boulder Metalsmithing Association (BOMA) in reply to Plaintiff’s response to its Motion to Dismiss states:

ADDITIONAL EVIDENCE THE TERM OPEN STUDIO IS GENERIC

The term “open studio” is used extensively throughout the United States by various art venues in connection with advertising when a particular art venue is open to artists or the public to learn, practice, create, or study an art. *Declaration of Kirstin M. Jahn dated October 12, 2016 (Jahn Decl. II) at ¶¶2-4, Exhibits D (Boulder/Denver use), E (Museum use), F (Western States use- including Colorado), G (Eastern States use), H (Southern States use).*

Further, the word “open” is defined as: “5: not restricted to a particular group or category of participants”, “10a: characterized by ready accessibility and usually generous attitude”, “13: being in operation... ready for business, patronage , or use”; the

simple definition of the word “studio” is “the building or room where an artist works: a place where people go to learn, practice, or study an art...” *Id.*, *Exhibit I*, *Merriam Webster Dictionary definition of the words “open” and “studio.”*

Lastly, BOMA’s tradename filing in May, 2016 was withdrawn in August, 2016. *Id.*, *Exhibit J*.

LEGAL AUTHORITY SUPPORTING DISMISSAL

Plainly, there is no genuine issue as to any material fact that many different entities have used and continue to use the term “open studio” throughout the United States including, Colorado, Denver and Boulder. Nor is there a genuine issue of material fact as to the definition of “open” and “studio.” As such, a determination that “open studio” is a generic term when used in connection with posting or advertising when an art studio is open to the public or its artist community is ripe for determination by this Court. In addition, there are no genuine issues of material fact preventing this Court from making a determination that BOMA’s use of the common phrase “open studio” does not infringe any alleged trademark rights of Plaintiff.

POINT I

“OPEN STUDIO” IS GENERIC FOR ADVERTISING WHEN AN ART STUDIO IS OPEN TO THE PUBLIC

The question of genericness is a question of fact which can be resolved on summary judgment when the evidence is so one-sided that there can be no doubt about how the question should be answered. *Door Systems, Inc. v. Pro-Line Door Systems, Inc.*, 83 F.3d 169, 171 (7th Cir. 1996); *McKillip Indus. v. Integrated Label Corp.*, 477 F. Supp. 2d 928, 930 (N.D. Ill. 2006); *The Golf Warehouse, LLC v. Golfer’s*

Warehouse, Inc., 142 F.Supp 2nd 1307, 1312 (D. Kan. 2001)(holding in favor of alleged infringer stating a generic mark is not entitled to protection, nor can use of a generic phrase be deceptive); *BellSouth Corp. v. White Directory Publr., Inc.*, 42 F. Supp. 2d 598, 607 (M.D.N.C. 1999). Even this Court evidenced its frustration when a trademark infringement action continued through trial and post trial motions when it could have be dismissed as a matter of law early on in a case had the appropriate motion been filed. *Tony's Taps, LLC v. PS Enters.*, 2012 U.S. Dist. LEXIS 43293, *27, *35, 2012 WL 1059956 (D. Colo. Mar. 29, 2012). In *Tony's Taps*, one of the reasons this Court denied permanent injunctive relief to a plaintiff after receipt of a jury verdict in plaintiff's favor was because plaintiff's mark - Pagosa Brewing Company - was "entirely descriptive" and defendant had the right to use the common generic elements of its mark - Pagosa Pub Works BrewPub. *Id.* at 32-34.

Thus, the time is ripe to determine the generic nature of the term "open studio" before the endless expense of litigation begins and further time and resources of this Court are wasted.

A term is generic if it is the common name for the product or service offered and is inelligible for trademark protection because "the public has an inherent right to call a product or service by its generic commonly used and known name." *Donchez v. Coors Brewing Co.*, 392 F.3d 1211, 1215 (10th Cir. 2004). "Generic terms must remain in the public domain, free for all to use, in order to prevent one user from wielding trademark rights unfairly to its competitive advantage." *BellSouth Corp. v. White Directory Publr., Inc.*, 42 F. Supp. 2d 598, 606 (M.D.N.C. 1999). A generic name of a

product or service can never achieve trademark protection because "generic" and "trademark" are mutually exclusive." See, 2 J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition ("McCarthy")* § 12:1 at 12-4 (4th ed. 1998). As such, generic terms can never acquire secondary meaning and become protectable trademarks. *Knights Armament Co. v. Optical Systems Technology, Inc.*, 654 F.3d 1179, 1188 (11th Cir. 2011). "No one can take out of the language a word, even a slang term, that has generic meaning as to a category of products or service and appropriate it for its own trademark use. *Harley-Davidson, Inc. v. Grottanelli*, 164 F.3d 806, 811-812 (2nd Cir. 1999) ("HOG" is generic nickname for a large motorcycle and cannot be appropriated as a mark.)

The test for deciding whether a word is generic is one of buyer understanding. *The Golf Warehouse, LLC. v. Golfer's Warehouse, Inc.*, 142 F.Supp 2nd 1307, 1312 (D. Kan. 2001) . "Any competent source, including dictionaries, newspapers, consumer surveys, advertisements, and other publications, may provide evidence of the public's understanding of the term at issue." *Id.*; *In re Northland Aluminum Products, Inc.*, 777 F.2d 1556, 1559 (*Fed. Cir.*1985).

Even if we take all of Plaintiff's allegations as true: e.g, it used the term OPEN STUDIOS for 25 years in connection with it annual arts tour for the visual arts (Complaint at ¶¶5-7, 9-14), the overwhelming third party use of the term throughout the United States, Colorado and Boulder in connection with advertising when an art studio is open to create, learn, study or practice an art demonstrates the term is generic. See, Exhibits A, B, D-H. Further evidence the term is generic is shown through the dictionary

definition of the word “open” which means not restricted to a particular group or open for business and the word “studio” which means a building or room where an artist works or a place where people go to learn, practice or study art. *Exhibit I*. When the two words “open studio” are put together they continue to be known by their common meanings which is to denote when an art studio is open to work, learn, practice or study art. *Tonys Taps*, 2012 U.S. Dist. LEXIS 43293 at *35 (dissection of a composite mark and putting it together “only to discover the whole is no greater than the sum of its parts.”)

Here the evidence of third party use and common dictionary definitions of the word “open” and “studio” overwhelmingly demonstrates the term “open studio” is generic and not eligible for trademark protection as a matter of law. Plainly, Plaintiff cannot take the common descriptive phrase “open studio” out of the public domain and claim it as its own and prevent others from using it.

POINT II

EVEN IF PLAINTIFF DEMONSTRATED IT OWNED A VALID PROTECTABLE MARK, BOMA’S USE OF THE TERM “OPEN STUDIO” IS NON-INFRINGEMENT

Even if Plaintiff could demonstrate it owned a valid protectable mark, BOMA’s use of the “open studio” as a common descriptive term for its services is not infringing Plaintiff’s alleged mark as a matter of law.

While the issue of likelihood of confusion is generally a question of fact, this does not preclude the determination of non-infringement as a matter of law in a trademark infringement case. *Murray v. Cable Nat’l Broadcasting Co.*, 86 F.3d 858,

860-61 (9th Cir.1996) (“the district court is not precluded from determining likelihood of confusion as a matter of law, either through dismissal or summary judgment”); *Universal Money Ctrs. v. AT&T*, 22 F.3d 1527, 1530 n. 2 (10th Cir.1994) cert. denied, 513 U.S. 1052 (1994) (affirming summary judgment for defendant); *Utah Lighthouse Ministry v. Found. for Apologetic Info. & Research, (FAIR)*, 527 F.3d 1045, 1057 (10th Cir. 2008) (affirming summary judgment for defendant alleged infringer); *King of the Mountain Sports, Inc. v. Chrysler Corp.*, 185 F.3d 1084, 1089 (10th Cir. 1999)(affirming summary judgment in favor of alleged infringer defendant); *Kazmaier v. Wooten*, 761 F.2d 46, 48-49 (1st Cir.1985) (affirming summary judgment on trade name infringement claim); *Door Systems, Inc. v. Pro-Line Door Systems, Inc.*, 83 F.3d 169, 171 (7th Cir.1996) (affirming summary judgment of no infringement of the mark "door systems"); *Warner Bros. v. American Broadcasting, Cos.*, 720 F.2d 231, 246 (2d Cir. 1983) (granting summary judgment in favor of alleged infringer).

“The Lanham Act does not operate to preclude persons from using generic terms, like ‘brewery/brewpub,’ even when those terms are found in marks that are otherwise rendered distinctive by virtue of having secondary meaning.” *Tony’s Taps*, 2012 U.S. Dist. LEXIS 43293, *33-34, 2012 WL 1059956 (D. Colo. Mar. 29, 2012). A certain degree of customer confusion is tolerated when “an originally descriptive term was selected to be used as a mark, not to mention the undesirability of allowing anyone to obtain a complete monopoly on use of a descriptive term simply by grabbing it first.” *Id.*, citing *KP Permanent Make-Up, Inc. v. Lasting Impression I, Inc.*, 543 U.S. 111, 122 (2004).

Even if Plaintiff were to show it acquired secondary meaning as to the term “open studio” or “open studios” its mark would enjoy very little protection, “particularly against a mark that is making only descriptive or generic use of the same terms” because some degree of customer confusion is anticipated when a descriptive mark is used by others to fairly describe their own product or service. *Tony's Taps*, 2012 U.S. Dist. LEXIS 43293, *34-35, 2012 WL 1059956 (D. Colo. Mar. 29, 2012). “If any confusion results, that is the risk the plaintiff 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, 122 (2004), citing *Cosmetically Sealed Industries, Inc. v. Chesebrough-Pond's USA Co.*, 125 F.3d 28, 30 (2nd Cir. 1997).

Thus, even if Plaintiff were to show it had somehow acquired secondary meaning in the term “open studio” it still cannot stop others, including BOMA, from using this descriptive phrase to describe their services.¹ For, it is the price Plaintiff pays for choosing to covet a common descriptive phrase as its mark.

In sum, Plaintiff’s Complaint must be dismissed as a matter of law as to its Lanham Act claims as well as its deceptive trade practices claim because BOMA has the right to use “open studio” to describe when its studio is open to provide services relating to creating, learning, practicing, or studying art.

CONCLUSION

¹It is of no consequence that BOMA filed for tradename (*not trademark*) protection of the term “open studio” because everyone is able to use this term in its common descriptive sense to describe their respective services. Moreover, BOMA has withdrawn its “open studio” tradename in the State of Colorado. *See, Ex. J.*

Plaintiff's complaint must be dismissed as a matter of law because "open studio" is generic, and/or alternatively, BOMA is entitled to use the term "open studio" to describe when its studio is open to provide services relating to creating, learning, practicing, or studying art.

Dated: August 30, 2016

Respectfully submitted,

JAHN & ASSOCIATES, LLC

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CERTIFICATE OF SERVICE

I certify that on October 12, 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
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Dated: October 12, 2016

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