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WIPO DECISION ON GENERICNESS DOES NOT SUPPORT MOTION TO DISMISS TRADEMARK CLAIMS

[Robert Novak dba Pets Warehouse v. Overture Services, Inc. et al., 2004 U.S. Dist. LEXIS 5277 (E.D.N.Y. March 25, 2004)]

Robert Novak filed a complaint against defendants alleging various trademark infringement theories along with a claim for breach of the terms and conditions associated for using discussion groups on the internet. A variety of motions were filed to dismiss the case, including a motion for summary judgment for all claims relating to the breach of terms and conditions, lack of personal jurisdiction, and to dismiss the trademark claims as a matter of law.

In analyzing the motion to dismiss the trademark claims, the court noted that the question is "whether it is clear as a matter of law at this stage of the litigation that the term 'PETS WAREHOUSE' is generic."¹ To support this position one of the defendants, Biochemies, introduced an administrative panel decision which had been rendered by the World Intellectual Property Organization (WIPO). WIPO is an international authority that administers selected intellectual property rights. The panel decision issued by WIPO concluded that "pet warehouse" was "too generic to merit trademark protection."² While the court had acknowledged that "generic marks merely 'describe the article or substance represented,'"³ it also noted that distinguishing between distinctive and generic marks requires a difficult analysis. The analysis requires a determination of many factors,

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including: "(1) generic use of the term by competitors which plaintiff has not challenged or generic use by the plaintiff himself; (2) dictionary definitions, which may be relevant while not dispositive; (3) generic usage in trade journals or newspapers; (4) testimony of persons in the trade; and (5) consumer surveys."⁴

The court gave three reasons for refusing to rely on the WIPO decision to decide the case dispositively on the motion. First, although the decision from WIPO appeared to rely on US trademark law, it was not issued by either a state or federal court and therefore was not precedent. Second, it was not clear whether the decision was bound by US trademark law. Third, the "decisions were not made as a matter of law."⁵ The court finally noted that in view of the fact that plaintiff had received a registration for the mark, there was some evidence that the mark was descriptive rather than generic.

¹ 2004 U.S. Dist. LEXIS 5277 at 30.

² Id.

³ Id. At 29 citing Bernard v. Commerce Drug Co., Inc. 774 F. Sup 103, 106 (E.D.N.Y. 1991).

⁴ Id. At 29.

⁵ Id. At 31.