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TRIAL COURT INCORRECTLY DISMISSED COMPLAINT ON THE BASIS THAT THE TRADEMARK WAS GENERIC AND NOT ENTITLED TO PROTECTION.

[Courtenay Communications Corp. v. Patricia Hall, 2003 U.S. App. LEXIS 12749 (2nd Cir. June 24, 2003).

Plaintiff, Courtenay Communications Corp. ("CCC"), uses the mark "iMarketing News" for its product.[1] Defendants have a website that advertises the services of Ms. Hall and 21 Hallmark Capital. On Defendant's website under a section for "what's new" is a description of a Success Story attributed to iMarketing News, using its trademark, along with a description of plaintiff's company as "a $15 million privately held direct marketing media company that was poorly managed, unfocused and unprepared to take advantage of strategic opportunities."[2] It then provided an unauthorized quote by the President/Owner regarding the quality of the services provided.

In considering whether a complaint is sufficient, the court "may not consider matters outside of the pleadings without converting the motion into a motion for summary judgment."[3] In this case, the district court dismissed the complaint based on its conclusion that plaintiff's mark was not entitled to trademark protection because it was generic.[4] "Although CCC has not registered its mark, an unregistered mark is entitled to Lanham Act protection if it would qualify for registration."[5] A trademark only need to "be capable of distinguishing the applicant's goods from those of others" to qualify for registration.[6] Further, to qualify for trademark

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protection, 'the mark must either be (1) 'inherently distinctive' or (2) distinctive by virtue of acquired secondary meaning.[7] The Second Circuit concluded that the trial court had engaged in premature fact-finding on whether the composite mark as a whole was generic.[8] As noted by the court, although the individual components of the iMarketing News mark may be generic and not entitled to protection, the composite mark may nonetheless be entitled to protection.[9] For these reasons, the court concluded that the claim should not have been dismissed because the 'determination of the mark's classification —a question of fact —was premature, and … the court failed to use the correct legal standards to analyze the composite mark.'[10]

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[1] 2003 U.S. App. LEXIS 12749 at *3
[2] *Courtenay* at *4.
[3] *Id.* at *7.
[4] *Id.*
[5] *Id.* at *10 (citing to *Thompson Med. Co., Inc. v. Pfizer, Inc.*, 753 F.2d 208, 215-16 (2nd Cir. 1985).
[6] *Id.* (citing to *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763 (1992).
[7] *Id.* (citing to *Two Pesos* at 769).
[8] *Id.* at *11.
[9] *Id.* at *13.
[10] *Id.* at *18.

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