

UNITED STATES DISTRICT COURT  
SOUTHERN DISTRICT OF NEW YORK

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CAROLYN JANET ARNOLD, :  
 : MEMORANDUM DECISION  
 : AND ORDER  
 Plaintiff, :  
 : 06 Civ. 1747 (GBD)  
 -against- :  
 :  
 ABC, INC. and THE WALT DISNEY :  
 COMPANY, :  
 :  
 Defendants. :  
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GEORGE B. DANIELS, District Judge:

Plaintiff Carolyn Janet Arnold sued defendants American Broadcasting Company, Inc. (“ABC”) and The Walt Disney Company (“Disney”) (collectively “Defendants”) for trademark infringement under sections 32(1) and 43(a) of the Lanham Act, 15 U.S.C. §§ 1114(a) & 1125(a), trademark dilution in violation of New York General Business Law § 368-d,<sup>1</sup> and unfair competition. Plaintiff alleges that Defendants are “using Plaintiff’s trademark to advertise, promote and distribute ‘Boston Legal.’” Compl. ¶ 10. Defendants moved to dismiss pursuant to Fed. R. Civ. P 12(b). The motion to dismiss is granted.

Plaintiff owns a registered trademark, Reg. No. 2821328, for the phrase “WHAT’S YOUR PROBLEM?” for use in connection with a “reality based tv show providing real solutions to real problems.” Compl. ¶ 13; Declaration of Eric J. Lobenfeld, sworn to May 23, 2006 (“Lobenfeld Decl.”) Ex. B. Plaintiff is also the creator of a reality-based television show called “WHAT’S YOUR PROBLEM?” Compl. ¶ 15. “WHAT’S YOUR PROBLEM?” is a “comical show in which a host interviews real people and solves their problems.” Compl. ¶ 19. The show

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<sup>1</sup>Plaintiff asserts her dilution claim under New York General Business Law § 369-d, but that section was repealed in 1996 and replaced by New York General Business Law § 360-l. N.Y. Gen. Bus. Law § 360-l (2006).

airs every other Wednesday at 8:00 p.m., on public access channel 67, on Time Warner Cable of New York. Compl. ¶ 20.

Defendant ABC airs a well-known television show, “Boston Legal,” about the fictional Boston law firm of Crane, Poole & Schmidt. Defendants’ Memorandum of Law in Support of their Motion to Dismiss (“Def. Mem. of Law”) at 1. As part of its efforts to promote “Boston Legal,” ABC uses the phrase “WHAT’S YOUR PROBLEM?” in advertisements throughout the United States. Compl. ¶ 32. Specifically, “WHAT’S YOUR PROBLEM?” appears in advertisements on buses, phone booths, and billboards throughout New York City and Los Angeles, California. *Id.* at ¶ 33; Lobenfeld Decl. Ex. E. The phrase also appears on the “Boston Legal” website, which is set-up as a mock website for the firm of Crane, Poole & Schmidt. Compl. ¶ 35; Lobenfeld Decl. Ex. C. On the advertisements and the website, the phrase “WHAT’S YOUR PROBLEM?” appears directly above the phone number “1-877-SUE-2-WIN.” Lobenfeld Decl. Ex. C and Ex. E.<sup>2</sup>

In October 2005, plaintiff sent Defendants a cease and desist letter requesting that Defendants “immediately cease using Plaintiff’s trademark ‘WHAT’S YOUR PROBLEM?’.”

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<sup>2</sup>Plaintiff argues that the Court cannot, in deciding this motion, consider either the copy of the “Boston Legal” advertisement, or the printout of the “Boston Legal” website, without converting this motion into one for summary judgment. *See* Fed. R. Civ. P. 12(b). The Court may, however, consider a document if the plaintiff “relies heavily upon its terms and effect,” rendering “the document ‘integral’ to the complaint.” *Chambers v. Time Warner, Inc.*, 282 F.3d 147, 153 (2d Cir. 2002) (citation omitted). Furthermore, “[w]here [a] plaintiff has actual notice of all the information in the movant’s papers and has relied upon these documents in framing the complaint the necessity of translating a Rule 12(b)(6) motion into one under Rule 56 is largely dissipated.” *Cortec Industries, Inc. v. Sum Holding L.P.*, 949 F.2d 42, 48 (2d Cir. 1991). Here, plaintiff not only relies *heavily* on the content of the advertisements and the website, she relies *entirely* on this material in crafting her allegations. Also, because plaintiff relied on this material, she obviously has actual notice of what they represent, thereby diminishing the need to convert Defendants’ motion into one for summary judgment.

Compl. ¶ 39. Plaintiff did not receive a response. *Id.* at ¶ 40. Plaintiff subsequently initiated this lawsuit alleging that Defendants have unlawfully used her trademark in violation of sections 32(1) and 43(a) of the Lanham Act, 15 U.S.C. §§ 1114(a)<sup>3</sup> & 1125(a),<sup>4</sup> and New York General Business Law § 360-*l*. Plaintiff also asserts a claim for common law unfair competition. In particular, Plaintiff alleges that Defendants’ utilization of “WHAT’S YOUR PROBLEM?,” as outlined above “constitute[s] willful and intentional infringement of Plaintiff’s registered trademark and common law trademark rights.” *Id.* at ¶ 37. Defendants now move to dismiss the complaint on the grounds that their use of “WHAT’S YOUR PROBLEM?” is “fair use,” thus precluding plaintiff’s federal trademark and common law unfair competition claims, and that plaintiff has not stated a claim for dilution under New York General Business Law § 360-*l*.

In deciding a motion to dismiss for failure to state a claim, the Court must “accept as true the complaint’s factual allegations and draw all inferences in the plaintiff’s favor.” Cleveland v. Caplaw Enterprises, 448 F.3d 518, 521 (2d Cir. 2006) (citation and alterations omitted).

Dismissal is only appropriate if “it appears beyond doubt that the plaintiff can prove no set of

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<sup>3</sup>Section 32(1)(a) of the Lanham Act prohibits the “use in commerce . . . of a registered mark in connection with the sale, offering for sale, distribution, or advertising of any goods or services on or in connection with which such use is likely to cause confusion, or to cause mistake, or to deceive.” 15 U.S.C. § 1114(1)(a).

<sup>4</sup>Plaintiff’s claim under this section is more appropriately one of false designation of origin. See 15 U.S.C. § 1125(a)(1)(a) (stating that it is unlawful to “use[] in commerce any word, term, name, symbol, or device, or any combination thereof, or any false designation of origin, . . . which . . . is likely to cause confusion, or to cause mistake, or to deceive as to the affiliation, connection, or association of . . . the origin, sponsorship, or approval of his or her goods, services, or commercial activities by another person”); see also Compl ¶ 58 (alleging that “Defendants’ activities are likely to lead to and result in consumer confusion, mistake or deception and are likely to cause consumers and the public to believe that Plaintiff is connected or affiliated with Defendants’ activities and events”).

facts in support of [her] claim which would entitle [her] to relief.” Field Day, LLC v. County of Suffolk, 463 F.3d 167, 192 (2d Cir. 2006) (citation omitted).

#### **A. Federal Trademark Claims**

To state a claim for trademark infringement under sections 32(1)(a) and 43(a) of the Lanham Act, plaintiff must allege facts which establish that her mark merits protection and that Defendants’ use of her mark is likely to cause consumer confusion as to the mark’s source.

Louis Vuitton Malletier v. Dooney & Bourke, Inc., 454 F.3d 108, 115 (2d Cir. 2006).

Defendants maintain, however, that their use of the phrase “WHAT’S YOUR PROBLEM?” constitutes “fair use” under 15 U.S.C. § 1115(b). It is a defense to a trademark-infringement claim if “the use of the name, term, or device charged to be an infringement is a use, otherwise than as a mark, of a term or device which is descriptive of and used fairly and in good faith only to describe the goods or services of such party . . . .” 15 U.S.C. § 1115(b)(4).<sup>5</sup> To be “fair use,” Defendants must have used “WHAT’S YOUR PROBLEM?” “(1) other than as a mark, (2) in a descriptive sense, and (3) in good faith.” EMI Catalogue P’ship v. Hill, Holliday, Connors, Cosmopulos, Inc., 228 F.3d 56, 64 (2d Cir. 2000).

The universe of words or phrases that can be used “to describe the goods” is not “narrowly confined to words that describe a characteristic of the goods, such as size or quality.” Cosmetically Sealed Industries, Inc. v. Chesebrough-Pond’s USA Co., 125 F.3d 28, 30 (2d Cir.

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<sup>5</sup>By the statute’s terms, “fair use” is a defense to claims under 15 U.S.C. § 1114, but courts have extended it to claims under 15 U.S.C. § 1125 as well. See, e.g., New York Mercantile Exchange, Inc. v. IntercontinentalExchange, Inc., 389 F.Supp.2d 527, 545 (S.D.N.Y. 2005) (“Both sections 32(1) and 43(a) are subject to a defense of ‘fair use.’”); Car-Freshner Corp. v. S.C. Johnson & Son, Inc., 70 F.3d 267, 268 (2d Cir. 1995) (applying the “fair use” defense to claims under sections 32(1) and 43(a)).

1997). Instead, a word or phrase need only be used in a “descriptive sense.” Id. Thus, words or phrases that do not necessarily describe anything about an alleged infringer’s goods might still be used in a “descriptive sense” for purposes of the “fair use” defense. See, e.g., B & L Sales Associates v. H. Daroff & Sons, Inc., 421 F.2d 352, 354 (2d Cir. 1970) (holding that the phrase “Come on Strong” was used in a descriptive sense when it appeared in a men’s clothes advertisement because it “describ[ed] a presumably desirable effect” of the clothing); Cosmetically Sealed, 125 F.3d at 30 (finding that the phrase “Seal it with a Kiss” was used in a descriptive sense when it appeared in a lipstick advertisement because it “describe[d] an action that the sellers hope[d] consumers [would] take, using their product.”).

Here, the phrase “WHAT’S YOUR PROBLEM?” ostensibly does not describe a characteristic of Defendants’ show. But in the context of how it is used in the advertisements and on the website—with “WHAT’S YOUR PROBLEM?” appearing immediately above the phone number “1-877-SUE-2-WIN”—the phrase is generically descriptive to the potential viewing public that Defendants’ product is a show about fictional lawyers in a fictional law firm offering legal services. If any confusion with plaintiff’s television show might result, “that is the risk plaintiff accepted when [she] decided to identify [her show] 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) (citations omitted). Plaintiff does not allege any use of any other element of, or any other similarity to, her trademark other than the use of the three words “WHAT’S YOUR PROBLEM?”

In addition, Defendants are not using the phrase “WHAT’S YOUR PROBLEM?” as a mark to identify or distinguish the show “Boston Legal,” or indicate the show’s source. See 15

U.S.C. § 1127 (defining trademark). On both the advertisements and the website, the identity of show, and the fact that the show's source is ABC and not plaintiff, is clearly evidenced by the prominent display of the show's title, ABC's own famous and recognizable trademark, and large photos of the show's three stars.<sup>6</sup> See, e.g., Cosmetically Sealed, 125 F.3d at 30 (stating that the non-trademark use of plaintiff's mark was "evidenced by the fact that the source of the defendants' product [wa]s clearly identified by the prominent display of the defendants' own trademarks.").

Finally, Plaintiff does not sufficiently allege that Defendants used her mark in bad faith. Cf. EMI Catalogue P'ship., 228 F.3d at 66 ("Fair use analysis . . . requires a finding that the defendants used the protected mark in good faith."). Plaintiff alleges that Defendants acted in bad faith because several ABC employees were familiar with her "WHAT'S YOUR PROBLEM?" reality television show. Compl. ¶ 22.<sup>7</sup> But even taking plaintiff's allegations as

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<sup>6</sup>For example, on the advertisements, although "WHAT'S YOUR PROBLEM?" appears prominently and in large font, the title of the show—"Boston Legal"—appears just below it and also in large, capital letters. Lobenfeld Decl. Ex. E. Moreover, immediately to the right, are large pictures of the show's three stars. Id. Finally, ABC's own well-know trademark appears in the bottom-right corner of the ad. Id. On the website—which is made to look like an actual law firm's website—photos of the three stars with a link to each's "attorney bio" appear prominently at the top. Lobenfeld Decl. Ex. C. And unlike on the advertisements, "WHAT'S YOUR PROBLEM?" appears only in a small box on the left-middle of the page. Finally, the ABC trademark appears at the bottom of the page, and, to get to the website, one must either first go to ABC's main website, or type the website's full address, which contains both "ABC" and "Boston Legal." Id. Thus, it is obvious to anyone visiting the "Boston Legal" website that the show's source is ABC.

<sup>7</sup>For example, plaintiff alleges that an ABC employee who worked in the Monday Night Football Graphics Department created the graphics for plaintiff's "WHAT'S YOUR PROBLEM?" show in July 2003. Compl. ¶ 23. Plaintiff also alleges that another ABC employee performed services in connection with plaintiff's "WHAT'S YOUR PROBLEM?" television show." Id. at ¶ 26. Finally, plaintiff alleges that an ABC employee was taped for an episode of her show and that several ABC employees have viewed her show at a restaurant

true, as this Court must, they are insufficient to create an inference of bad faith. None of these employees are alleged to have had any association with “Boston Legal,” and, even if they did, “[p]rior knowledge of a senior user’s mark does not, without more, create an inference of bad faith.” Playtex Products, Inc. v. Georgia-Pacific Corp., 390 F.3d 158, 166 (2d Cir. 2004) (citation omitted); see also Savin Corp. v. Savin Group, 391 F.3d 439, 461 (2d Cir. 2004) (“Nor is prior knowledge of a senior user’s trade mark inconsistent with good faith.”) (citation and alteration omitted).

Instead, bad faith requires a showing that Defendants intended “to trade on the good will of the trademark holder by creating confusion as to source or sponsorship.” EMI Catalogue P’ship, 228 F.3d at 66 (citations omitted). Here, aside from plaintiff’s conclusory allegation that “Defendants’ acts are deliberate and intended to confuse customers and the public as to the source of Defendants’s services and to injure Plaintiff and reap the benefit of Plaintiff’s goodwill,” plaintiff alleges no set of facts that, if true, would lead to the conclusion that ABC sought to conflate its show, “Boston Legal,” with plaintiff’s little known, local, cable-access television program. See Star Industries, Inc. v. Bacardi & Co. Ltd., 412 F.3d 373, 389 (2d Cir. 2005) (noting “the implausibility of the notion that a premier international rum manufacturer would seek to conflate its products with those of a regional discount vodka manufacturer” in finding lack of bad faith by defendant).

Accordingly, Defendants’ use of the phrase “WHAT’S YOUR PROBLEM?” in their advertisements and website for the show “Boston Legal” as alleged is fair use under 15 U.S.C. § 1115(b). As such, plaintiff cannot state a claim for trademark infringement.

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across the street from ABC’s offices. Id. ¶¶ 28-30.

## B. State Law Claims

Plaintiff also alleges trademark dilution under New York General Business Law § 360-*l*. The statute only protects “‘extremely strong mark[s]’ that are either ‘distinctive’ or ha[ve] acquired secondary meaning.” Scholastic, Inc. v. Stouffer, 221 F.Supp.2d 425, 437 (S.D.N.Y. 2002) (citations omitted). Thus, to state a claim for dilution under section 360-*l*, a plaintiff must show “(1) that the plaintiff’s mark is truly distinctive or has acquired secondary meaning, and (2) a likelihood of dilution either as a result of ‘blurring’ or ‘tarnishment.’” Information Superhighway, Inc. v. Talk America, Inc., 395 F.Supp.2d 44, 56 (S.D.N.Y. 2005). The claim “rests on the allegation that a defendant is attempting to feed upon the business reputation of an established distinctive trade-mark or name.” Id. (citation and alteration omitted).

Here, although plaintiff alleges that her mark is “unique and distinctive,” a common phrase such as “WHAT’S YOUR PROBLEM?” is not—and cannot—be unique and distinctive unless it has acquired some secondary meaning. See Field Enterprises Ed. Corp. v. Grosset & Dunlap, Inc., 256 F.Supp. 382, 388 (S.D.N.Y. 1966) (“As to the strength of plaintiff’s mark, since ‘How and Why’ is a common English phrase it [could] not be protected in the absence of secondary meaning.”) (citations omitted). Plaintiff does not make any allegation that “WHAT’S YOUR PROBLEM?” has gained some secondary meaning associating the phrase with her show. Cf. TCPIP Holding Co., Inc. v. Haar Communications, Inc., 244 F.3d 88, 94 (2d Cir. 2001) (stating that in “trademark parlance,” a mark acquires a “secondary meaning” when the public “come[s] to associate the mark with the goods and services of the user”). Therefore, plaintiff has failed to state a claim for trademark dilution.


Finally, plaintiff also asserts a claim for common law unfair competition. A claim of

unfair competition under New York Law is analyzed in the same manner as a trademark infringement claim under the Lanham Act. Louis Vuitton Malletier, 454 F.3d at 119 (citation omitted); Information Superhighway, 395 F.Supp.2d at 56 (“The elements necessary to prevail on common law causes of action for trademark infringement and unfair competition mirror Lanham Act claims.”). Thus, because Defendants’ use of the phrase “WHAT’S YOUR PROBLEM?” constitutes fair use, plaintiff’s unfair competition claim is equally precluded as is her trademark infringement claim. See Wonder Labs, Inc. v. Procter & Gamble Co., 728 F.Supp. 1058, 1067 (S.D.N.Y. 1990) (“[T]he defense that the defendant’s use of the mark is purely descriptive and not as a trademark equally precludes recovery for common law unfair competition.”).

Accordingly, Defendants’ motion to dismiss is GRANTED. This case is DISMISSED.

Dated: New York, New York  
January 29, 2007

SO ORDERED:

  
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GEORGE B. DANIELS  
United States District Judge