

case, e.g. Document 26 ¶¶ 60–62, 64, but Plaintiff has totally failed to explain how these explanations are “necessary to explain technical terms or complex matters” already in the record.

[22] Plaintiff is reminded that application of this exception requires, as a threshold matter, a showing that the existing record is so inadequate as to frustrate judicial review. *Bair v. California State Dept. of Transp.*, 867 F.Supp.2d 1058, 1067 (N.D.Cal.2012) (citing *Animal Defense Council v. Hodel*, 840 F.2d 1432, 1437 (9th Cir.1988)). Plaintiff has not even attempted to explain why the existing record is inadequate to permit judicial review of NIJ’s actions, let alone how the Documents offered would cure any inadequacy. Plaintiff has failed to meet its burden to furnish these explanations.

Plaintiff’s request to supplement the record with all 22 disputed Documents under the “necessary to explain technical terms or complex matters” is DENIED.

III. CONCLUSION

For the reasons set forth above, Plaintiff’s motion to supplement the RAR is DENIED with the exceptions that the RAR shall be supplemented with:

- Document 8, pursuant to the consent of Defendant;
- Document 10, a differently redacted version of a document already in the record; and
- Document 21 under the relevant factors exception.

In addition, the Court will permit Plaintiff to file a very narrow motion for discovery to uncover whether NIJ considered additional data from the Army or DOD. Any such motion for discovery, which shall not exceed five pages in length, shall be filed on or before March 1, 2013, with any response, subject to the same page limit, due on or before March 8, 2013. The motion will be decided on the papers with-

out oral argument. The Parties are admonished to attempt to stipulate as to the nature of any discovery and/or to supplementation of the RAR with appropriate documents. Any such stipulation must be filed on or before March 1, 2013 in lieu of a motion for discovery.

Once any such discovery is completed or the matter is resolved by stipulation, the Parties are instructed to attempt to stipulate to a schedule for resolution of this case on the merits pursuant to the supplemented RAR. Normally, APA cases are resolved on cross-motions for summary judgment, frequently with the defendant filing an opening brief, the plaintiff filing a single brief encompassing its opposition and cross-motion, followed by a reply from the defendant, and concluding with a reply from the plaintiff. If the Parties believe it would be more efficient for Defendant to withdraw its pending motion and re-brief the merits issues according to such a coordinated schedule, they are encouraged to do so. If the Parties cannot agree to a schedule, they shall contact the magistrate judge to set up a scheduling conference. IT IS SO ORDERED.



BRIGHTON COLLECTIBLES,
INC., Plaintiff,

v.

RK TEXAS LEATHER MFG.; K & L
Imports, Inc.; et al., Defendants;

and related cross claims.

Case No. 10–CV–419–GPC (WVG).

United States District Court,
S.D. California.

Feb. 12, 2013.

Background: Manufacturer of fashion accessories and handbags filed suit



against competitor alleging trade dress infringement in violation of Lanham Act. Defendant moved to exclude expert witness testimony, and both sides moved for summary judgment.

Holdings: The District Court, Gonzalo P. Curiel, J., held that:

- (1) genuine issue of material fact as to whether plaintiff's heart-shaped design was functional, so as to play a source-identifying role, precluded summary judgment on claim of trade dress infringement;
- (2) genuine issue of material fact as to whether design was generic or, instead, distinctive precluded summary judgment on claim of trade dress infringement;
- (3) genuine issue of material fact as to whether plaintiff's design had acquired secondary meaning precluded summary judgment on claim of trade dress infringement;
- (4) proffered testimony of accounting expert witness was not based on reliable methodology;
- (5) survey conducted to determine likelihood of confusion as to source of allegedly infringing handbags contained flaws which rendered it inadmissible for purposes of determining actual damages; but
- (6) flaws in Internet survey conducted to determine whether plaintiff's reputation was harmed went to its weight, rather than admissibility; and
- (7) genuine issue of material fact as to damage to plaintiff's reputation precluded summary judgment on issue of lost profits.

Motions for summary judgment denied and motion to exclude granted in part and denied in part.

1. Trademarks ⇌1062

The Lanham Act protects not just word marks and symbol marks but also "trade dress" which is a category that originally included only the packaging, or dressing, of a product, but has been expanded to encompass the design of a product. Lanham Act, § 43(a), 15 U.S.C.A. § 1125(a).

See publication Words and Phrases for other judicial constructions and definitions.

2. Trademarks ⇌1436

To prove trade dress infringement, in violation of Lanham Act, plaintiff must prove: (1) that its claimed trade dress is nonfunctional; (2) that its claimed trade dress serves as a source-identifying role either because it is inherently distinctive or has acquired secondary meaning; and (3) that defendant's product creates a likelihood of consumer confusion. Lanham Act, § 43(a), 15 U.S.C.A. § 1125(a).

3. Trademarks ⇌1064

Under the traditional or utilitarian test associated with trade dress, a product's feature is "functional," as required to prove trade dress infringement in violation of Lanham Act, if it is essential to the use or purpose of the article or if it affects the cost or quality of the article. Lanham Act, § 43(a)(3), 15 U.S.C.A. § 1125(a)(3).

See publication Words and Phrases for other judicial constructions and definitions.

4. Trademarks ⇌1064

Under the competition theory of functionality, a feature is "functional," as required to prove trade dress infringement in violation of Lanham Act, if exclusive use of the feature would put competitors at a significant non-reputation-related disadvantage. Lanham Act, § 43(a)(3), 15 U.S.C.A. § 1125(a)(3).

5. Trademarks ⇨1064

A plaintiff can prove a feature is not “functional,” for purposes of trade dress infringement in violation of Lanham Act, by showing that it is merely an ornamental, incidental, or arbitrary aspect of the product. Lanham Act, § 43(a)(3), 15 U.S.C.A. § 1125(a)(3).

6. Trademarks ⇨1064

In context of determining whether a product’s feature is functional, for purposes of trade dress infringement under Lanham Act, if a feature contributes to the consumer appeal and saleability of the product, court first applies the utilitarian test for functionality before turning to the competition test. Lanham Act, § 43(a)(3), 15 U.S.C.A. § 1125(a)(3).

7. Federal Civil Procedure ⇨2493

Genuine issue of material fact as to whether heart-shaped design used on accessories and handbags was functional, so as to play a source-identifying role, or whether it was merely aesthetically pleasing, precluded summary judgment in trade dress infringement suit under Lanham Act between competitors in the women’s accessories business. Lanham Act, § 43(a)(3), 15 U.S.C.A. § 1125(a)(3).

8. Trademarks ⇨1063

To be protectable under Lanham Act, a trade dress must be capable of distinguishing plaintiff’s work from the goods of others. Lanham Act, § 43(a), 15 U.S.C.A. § 1125(a).

9. Trademarks ⇨1611

Plaintiff has burden of proving that its trade dress serves a source-identifying role, in order to succeed on trade dress infringement claim under Lanham Act. Lanham Act, § 43(a), 15 U.S.C.A. § 1125(a).

10. Trademarks ⇨1034

The Lanham Act does not protect generic terms. Lanham Act, § 43(a), 15 U.S.C.A. § 1125(a).

11. Trademarks ⇨1063

In Lanham Act trade dress cases, the distinctiveness inquiry is whether the definition of a product design is overbroad or too generalized. Lanham Act, § 43(a), 15 U.S.C.A. § 1125(a).

12. Federal Civil Procedure ⇨2493

Genuine issue of material fact as to whether heart-shaped design used on accessories and handbags was generic, or whether it was distinctive enough that customers associated the overall look with plaintiff’s product, precluded summary judgment in trade dress infringement suit under Lanham Act between competitors in the women’s accessories business. Lanham Act, § 43(a), 15 U.S.C.A. § 1125(a).

13. Trademarks ⇨1063

In context of trade dress infringement under Lanham Act, “secondary meaning” is a term of art for identification of source. Lanham Act, § 43(a), 15 U.S.C.A. § 1125(a).

See publication Words and Phrases for other judicial constructions and definitions.

14. Trademarks ⇨1063

A trade dress acquires secondary meaning, for purposes of protection under Lanham Act, when, in the minds of the public, the primary significance of the trade dress is to identify the source of the product rather than the product itself. Lanham Act, § 43(a), 15 U.S.C.A. § 1125(a).

15. Trademarks ⇨1063, 1631

Secondary meaning, for purposes of trade dress infringement under Lanham Act, can be established in many ways, including, but not limited to: (1) direct consumer testimony; (2) survey evidence; (3) exclusivity, manner and length of use;

(4) amount and manner of advertising; (5) amount of sales and number of customers; (6) established place in the market; and (7) proof of intentional copying by defendant. Lanham Act, § 43(a), 15 U.S.C.A. § 1125(a).

16. Federal Civil Procedure ⇨2493

Genuine issue of material fact as to whether heart-shaped design used on accessories and handbags had acquired secondary meaning precluded summary judgment in trade dress infringement suit under Lanham Act between competitors in the women's accessories business. Lanham Act, § 43(a), 15 U.S.C.A. § 1125(a).

17. Evidence ⇨508, 555.2

Trial judge must act as gatekeeper for expert testimony by carefully applying federal rule of evidence to ensure that specialized and technical evidence is not only relevant, but reliable. Fed.Rules Evid. Rule 702, 28 U.S.C.App.(2006 Ed.)

18. Evidence ⇨545

Proponent of expert testimony evidence bears burden of proving its admissibility under federal rule. Fed.Rules Evid. Rule 702, 28 U.S.C.App.(2006 Ed.)

19. Evidence ⇨555.9

Federal Civil Procedure ⇨2545

Proffered testimony of accounting expert witness was not based on reliable methodology, as required for admissibility on summary judgment on issue of lost profits in trade dress infringement suit brought by manufacturer of women's accessories and handbags against its competitor; figures were based only on the number of defendant's sales, on lower priced product, rather than grounded on plaintiff's sales data, and expert had improperly equated plaintiff's lost profits on a one-to-one scale with defendant's sales. Lanham Act, § 43(a), 15 U.S.C.A. § 1125(a); 17 U.S.C.A. § 504; Fed.Rules Evid.Rule 702, 28 U.S.C.App.(2006 Ed.)

20. Federal Civil Procedure ⇨2545

Survey conducted to determine likelihood of confusion as to source of allegedly infringing handbags contained flaws which rendered it inadmissible for purposes of determining actual damages, on motion for summary judgment in Lanham Act trade dress infringement suit between competing accessories and handbag manufacturers; survey included a line-up of handbags which improperly suggested to participants that one bag was the "correct" answer, skewing whether participants were actually confused by features in the trade dress, and survey failed to use any controls to test accuracy of results. Lanham Act, § 43(a), 15 U.S.C.A. § 1125(a); 17 U.S.C.A. § 504; Fed.Rules Evid.Rule 702, 28 U.S.C.App.(2006 Ed.)

21. Federal Civil Procedure ⇨2545

Flaws contained in survey conducted on Internet participants to determine whether defendant's imitation handbags actually harmed plaintiff's reputation by utilizing features of plaintiff's trade dress, went to weight of the evidence, not to its admissibility, for purposes of establishing actual damages in form of goodwill and lost profits, on motion for summary judgment in Lanham Act trade dress infringement suit between competing accessories and handbag manufacturers. Lanham Act, § 43(a), 15 U.S.C.A. § 1125(a); 17 U.S.C.A. § 504; Fed.Rules Evid.Rule 702, 28 U.S.C.App.(2006 Ed.)

22. Federal Civil Procedure ⇨2493

Genuine issue of material fact as to whether manufacturer's sales of cheap, low quality, imitation handbags which used features of competitor's trade dress had damaged competitor's reputation and goodwill precluded summary judgment on issue of lost profit damages in Lanham Act trade dress infringement suit between competing accessories and handbag manufacturers. Lanham Act, § 43(a), 15 U.S.C.A. § 1125(a); 17 U.S.C.A. § 504.

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ORDER (1) DENYING DEFENDANTS' MOTION FOR SUMMARY JUDGMENT ON TRADE DRESS; (2) GRANTING IN PART DEFENDANTS' MOTION TO EXCLUDE DR. WUNDERLICH'S EXPERT TESTIMONY; AND (3) GRANTING IN PART DEFENDANTS' MOTION TO EXCLUDE DR. FRAZIER'S EXPERT TESTIMONY; AND (4) DENYING DEFENDANTS' MOTION FOR SUMMARY JUDGMENT ON LOST PROFITS

GONZALO P. CUIEL, District Judge.
Plaintiff Brighton Collectibles, Inc. ("Brighton") manufactures and sells wom-

en's fashion accessories, including handbags. Brighton filed this copyright infringement action against Defendants RK Texas Leather Manufacturing, Inc., Richard Ohr, K & L Import, Inc., NHW, Inc., YK Trading, Inc., JC NY, Joy Max Trading Inc., and AIF Corporation ("Defendants"). The Court heard oral argument on December 20, 2012. For the reasons stated below, the Court denies both summary judgment motions, and grants in part and denies in part the motions to exclude two of Brighton's expert witnesses.¹

I. Defendants' Motion for Summary Adjudication of Trade Dress Claim

[1] The Lanham Act, 15 U.S.C. § 1125(a), "gives a producer a cause of action for the use by any person of 'any word, term, name, symbol, or device, or any combination thereof ... which ... is likely to cause confusion ... as to the origin, sponsorship, or approval of his or her goods....'" *Wal-Mart Stores, Inc. v. Samara Bros., Inc.*, 529 U.S. 205, 209, 120 S.Ct. 1339, 146 L.Ed.2d 182 (2000) (children's clothing). The Lanham Act "has been held to embrace not just word marks, such as 'Nike,' and symbol marks, such as Nike's 'swoosh' symbol, but also 'trade dress'—a category that originally including only the packaging, or 'dressing,' of a product, but in recent years has been expanded ... to encompass the design of a product." *Id.*

In its second claim, Brighton alleges that Defendants infringed its distinctive trade dress in the "Brighton" line of fashion accessories. Brighton describes its trade dress as "a sculpted, silver heart,

1. The Court considered all of the arguments presented, even those not discussed in this Order. To the extent that the parties sought

relief that is not expressly granted in this Order, the Court denies the motion.

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