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**IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF ARIZONA**

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VIP Products, LLC,

No. CV-14-2057-PHX-SMM

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Plaintiff,

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vs.

**MEMORANDUM OF DECISION
AND ORDER**

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Jack Daniel's Properties, Inc.,

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Defendant.

14

15

And Related Counterclaim.

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Pending before the Court is Plaintiff VIP Products, LLC's ("VIP") motion for summary judgment. (Doc. 110.) VIP contends that it is entitled to judgment as a matter of law on its Amended Complaint that contains three claims for declaratory relief. (Id.) VIP further contends that it is entitled to judgment as a matter of law on all of the claims that Defendant Jack Daniel's Properties Inc.'s ("JDPI") brought as Counterclaims in its Answer. (Id.) The matter is fully briefed.

23

Also pending is JDPI's motion for partial summary judgment. (Doc. 101.) At issue, JDPI moves for partial summary judgment regarding VIP's second and third claims. (Id.) The matter is fully briefed.

26

Finally, there are pending motions associated with the parties' cross-motions for summary judgment, which are also fully briefed.

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The Court will deny VIP's motion for summary judgment, grant JDPI's motion for

1 partial summary judgment, and resolve all of the pending motions associated with the parties’
2 cross-motions for summary judgment.¹ The Court will set a status hearing for the parties in
3 order to discuss the remaining matters that must be adjudicated at trial.

4 **FACTUAL BACKGROUND**

5 The Court will summarize the basic factual background here. In its discussion of the
6 particular claims, the Court will discuss certain relevant and material facts that arise in
7 conjunction with those particular legal claims at issue.

8 VIP designs, manufactures, markets, and sells chew toys for dogs. VIP sells various
9 brands of dog chew toys, including the “Tuffy’s” line (durable sewn/soft toys), the “Mighty”
10 line (durable toys made of a different material than the Tuffy’s line), and the “Silly
11 Squeakers” line (durable rubber squeaky novelty toys). (Doc. 110 at 2.) In July of 2013, VIP
12 introduced its latest novelty dog toy, the “Bad Spaniels” durable rubber squeaky novelty dog
13 toy. (Doc. 158.) The Bad Spaniels toy is in the shape of a liquor bottle and features a
14 wide-eyed spaniel over the words “Bad Spaniels, the Old No. 2, on your Tennessee Carpet.”
15 (Id.) The design for the Bad Spaniels toy has many similarities to the bottle design for Jack
16 Daniel’s Tennessee Sour Mash Whiskey (“Old No. 7 Brand”). (Doc. 157.) These similarities
17 include the shape of the product, the use of white lettering over a black background, and font
18 styles. Nevertheless, on the back of the Silly Squeakers packaging for the Bad Spaniels toy,
19 it states: “This product is not affiliated with Jack Daniel’s.” (Doc. 158.)

20 JDPI promptly demanded that VIP stop selling the new toy. (Doc. 47.) VIP responded
21 by filing this suit seeking a declaratory judgment. (Doc. 49.) In Claim 1, VIP alleged that its
22 use of the Bad Spaniels’ name and trademark does not infringe or dilute any claimed
23 trademark rights that JDPI may claim in its Jack Daniel’s trademark for its Tennessee sour
24 mash whiskey and/or any other product. (Id. at 9.) In Claim 2, VIP alleged that neither the

26 ¹Both parties have requested oral argument. Based on the parties’ extensive legal
27 memoranda and submitted supporting evidence, the Court will not set oral argument on the
28 parties’ cross-motions as it would not aid the Court’s decisional process. See e.g., Partridge
v. Reich, 141 F.3d 920, 926 (9th Cir. 1998).

1 Jack Daniel’s trade dress nor the Jack Daniel’s bottle design are entitled to trademark
2 protection because they are functional; they contain merely ornamental and decorative
3 features; they are generic; and they are non-distinctive. (Id. at 9-10.) In Claim 3, VIP alleges
4 that Jack Daniel’s bottle design is not entitled to Patent and Trademark Office (“PTO”)
5 registration because it is functional, generic, and non-distinctive. (Id. at 10-11.) The PTO
6 registration states that JDPI’s trademark consists of a three-dimensional configuration of the
7 square shaped bottle container for the goods having an embossed signature design comprised
8 of the words, “Jack Daniel.” (Doc. 49 at 5.) VIP contends that JDPI’s trademark registration
9 should be cancelled. (Id. at 10-11.)

10 In response, JDPI answered VIP’s complaint and filed nine separate counterclaims:
11 (1) Infringement of JDPI’s federally-registered trademarks and trade dress under the Lanham
12 Act, 15 U.S.C. § 1114, 1116-18; (2) Trade dress infringement in violation of federal law, 15
13 U.S.C. § 1114, 1116-18 and 1125; (3) Dilution by tarnishment of the JDPI trademarks under
14 15 U.S.C. § 1125(c); (4) Dilution by tarnishment of the Jack Daniel’s trade dress under 15
15 U.S.C. § 1125(c); (5) Trademark infringement in violation of Arizona law, A.R.S. §§ 44-
16 1451 et seq.; (6) Infringement of the JDPI trademarks and unfair competition at common law;
17 (7) Infringement of the Jack Daniel’s trade dress at common law; (8) Dilution of the JDPI
18 trademarks under A.R.S. § 44-1448.01; and (9) Dilution of the Jack Daniel’s trade dress
19 under A.R.S. § 44-1448.01. (Doc. 12.)

20 JDPI alleged in its Answer that it owns a trade dress consisting of a combination of
21 square bottle with a ribbed neck, a black cap, a black neck wrap closure with white printing
22 bearing the OLD NO. 7 mark, and a black front label with white printing and a filigreed
23 border bearing the JACK DANIEL’S trademark depicted in arched lettering at the top of the
24 label, the OLD NO. 7 trademark contained within a filigreed oval design in the middle
25 portion of the label beneath the JACK DANIEL’S trademark, and the words “Tennessee Sour
26 Mash Whiskey” in the lower portion of the label with the word “Tennessee” depicted in
27 script. (Doc. 12 at 5 ¶ 6; see also Doc. 101 at 9.)

28 VIP has moved for summary judgment contending that JDPI’s infringement and

1 dilution claims be denied because the defenses of nominative and First Amendment fair use
2 shield it from liability. (Doc. 110.) VIP further argues that even if those defenses do not
3 apply, VIP is still entitled to summary judgment on all claims because JDPI cannot prove its
4 dilution claims under the Trademark Dilution Revision Act (“TDRA”); as to JDPI’s
5 infringement claims, that Jack Daniel’s Tennessee Whiskey (“JDTW”) trademarks and bottle
6 dress are functional and non-distinctive. (Id. at 3, 15-28.)

7 JDPI moves for partial summary judgment on VIP’s Amended Complaint. (Doc. 101.)
8 As to Claim 1, JDPI leaves for trial the issue of whether VIP’s alleged parody infringes or
9 dilutes the Jack Daniel’s trademarks and trade dress. (Id. at 7.) As to Claims 2 and 3, JDPI
10 acknowledges that it bears the burden of proof regarding the protectability of its Jack
11 Daniel’s trade dress. (Id.) JDPI disputes that the Jack Daniel’s trade dress and the trademark
12 shown in United States Trademark Registration No. 4,106,178 (See Doc. 12 at 7) are
13 functional, contain merely ornamental and decorative features that do not function as
14 trademarks, are generic, and are non-distinctive. (Doc. 101 at 6.)

15 STANDARD OF REVIEW

16 *Summary Judgment*

17 “A party may move for summary judgment, identifying each claim or defense—or the
18 part of each claim or defense—on which summary judgment is sought.” Fed. R. Civ. P. 56(a)
19 A court must grant summary judgment if the pleadings and supporting documents, viewed
20 in the light most favorable to the nonmoving party, show “that there is no genuine issue as
21 to any material fact and the movant is entitled to judgment as a matter of law.” Id.; see
22 Celotex Corp. v. Catrett, 477 U.S. 317, 322-23 (1986); Jesinger v. Nevada Fed. Credit Union,
23 24 F.3d 1127, 1130 (9th Cir. 1994). Substantive law determines which facts are material.
24 See Anderson v. Liberty Lobby, 477 U.S. 242, 248 (1986); see also Jesinger, 24 F.3d at
25 1130. “Only disputes over facts that might affect the outcome of the suit under the governing
26 law will properly preclude the entry of summary judgment.” Anderson, 477 U.S. at 248. The
27 dispute must also be genuine, that is, the evidence must be “such that a reasonable jury could
28 return a verdict for the nonmoving party.” Id.; see Jesinger, 24 F.3d at 1130.

1 A principal purpose of summary judgment is “to isolate and dispose of factually
2 unsupported claims.” Celotex, 477 U.S. at 323-24. Summary judgment is appropriate against
3 a party who “fails to make a showing sufficient to establish the existence of an element
4 essential to that party’s case, and on which that party will bear the burden of proof at trial.”
5 Id. at 322; see also Citadel Holding Corp. v. Roven, 26 F.3d 960, 964 (9th Cir. 1994). The
6 moving party need not disprove matters on which the opponent has the burden of proof at
7 trial. See Celotex, 477 U.S. at 323. The party opposing summary judgment may not rest upon
8 the mere allegations or denials of the party’s pleadings, but must set forth “specific facts
9 showing that there is a genuine issue for trial.” See Matsushita Elec. Indus. Co. v. Zenith
10 Radio, 475 U.S. 574, 586-87 (1986) (quoting Fed. R. Civ. P. 56(e) (1963) (amended 2010));
11 Brinson v. Linda Rose Joint Venture, 53 F.3d 1044, 1049 (9th Cir. 1995). The non-movant’s
12 bare assertions, standing alone, are insufficient to create a material issue of fact and defeat
13 a motion for summary judgment. Anderson, 477 U.S. at 247–48.

14 *General Trademark Principles*

15 “A trademark is a limited property right in a particular word, phrase or symbol.” New
16 Kids on the Block v. News Am. Publ’n, Inc., 971 F.2d 302, 306 (9th Cir. 1992). “Throughout
17 the development of trademark law, the purpose of trademarks remained constant and limited:
18 Identification of the manufacturer or sponsor of a good or the provider of a service.[] And
19 the wrong protected against was traditionally equally limited: Preventing producers from
20 free-riding on their rivals’ marks.” Id. at 305. “[T]he holder of a trademark will be denied
21 protection if it is (or becomes) generic, i.e., if it does not relate exclusively to the trademark
22 owner’s product.” Id. at 306.

23 To state an infringement claim, whether it be a trademark claim or a trade dress claim,
24 a plaintiff must meet three basic elements: (1) distinctiveness, (2) nonfunctionality, and (3)
25 likelihood of confusion. Kendall-Jackson Winery, Ltd. v. E. & J. Gallo Winery, 150 F.3d
26 1042, 1047 (9th Cir. 1998).

27 *General Trade Dress Principles*

28 “Trade dress refers generally to the total image, design, and overall appearance of

1 a product.” Two Pesos, Inc. v. Taco Cabana, Inc., 505 U.S. 763, 765 n.1 (1992). It may
2 include the packaging, the “dress” of a product or the design of a bottle. See Fiji Water Co.
3 v. Fiji Mineral Water U.S., LLC, 741 F. Supp. 2d 1165, 1172-74 (C.D. Cal. 2010). A
4 product’s trade dress or packaging is protectable under trademark law so long as the trade
5 dress is nonfunctional and distinctive. See Wal-Mart Stores, Inc. v. Samara Bros., 529 U.S.
6 205, 210 (2000); Kendall-Jackson, 150 F.3d at 1047. “[T]he proper inquiry is not whether
7 individual features of a product are functional or nondistinctive but whether the whole
8 collection of features taken together are functional or nondistinctive.” Kendall-Jackson, 150
9 F.3d at 1050.

10 The trade dress of a product is “distinctive and capable of being protected if it either
11 (1) is inherently distinctive or (2) has acquired distinctiveness through secondary meaning.”
12 Two Pesos, Inc. v. Taco Cabana, Inc., 505 U.S. 763, 769 (1992). Broadly speaking, trade
13 dress is inherently distinctive if it is so “unique, unusual, or unexpected in this market that
14 one can assume without proof that it will automatically be perceived by consumers as an
15 indicator of origin[.]” Fiji Water, 741 F. Supp. 2d at 1176 (citing Seabrook Foods, Inc. v.
16 Bar-Well Foods Ltd., 568 F.2d 1342, 1344 (C.C.P.A. 1977)). Trade dress may also acquire
17 distinctiveness through secondary meaning, that is, when the trade dress ““has come through
18 use to be uniquely associated with a specific source.”” Two Pesos, 505 U.S. at 766 n.4
19 (quoting Restatement (Third) of Unfair Competition § 13 (1995)).

20 The trade dress of a product is functional if the trade dress is essential to the use or
21 purpose of the product or affects the cost or quality of the product. See Disc Golf Ass’n v.
22 Champion Discs, Inc., 158 F.3d 1002, 1006 (9th Cir. 1998). The Ninth Circuit utilizes four
23 factors to consider whether a product feature is functional: (1) whether the design yields a
24 utilitarian advantage; (2) whether alternative designs are available; (3) whether advertising
25 touts the utilitarian advantages of the design; and (4) whether the particular design results
26 from a comparatively simple or inexpensive method of manufacture. See Disc Golf, 158 F.3d
27 at 1006. No one factor is dispositive; all are to be weighed collectively. See International
28 Jensen, Inc. v. Metrosound U.S., Inc., 4 F.3d 819, 823 (9th Cir. 1993).

1 dog toy, VIP argues that it had to utilize several key components of the JDTW Marks and
2 Bottle Dress; (2) VIP used only so much of the JDTW Marks and Bottle Dress that were
3 reasonably necessary to identify the bottle. VIP otherwise states that it did not specifically
4 use any of JDPI's registered marks; and (3) VIP did nothing to suggest that JDPI had
5 sponsored or endorsed the VIP Product. (See Doc. 110 at 4.)

6 JDPI contends that the nominative fair use defense does not apply because this
7 defense only applies where a defendant uses the plaintiff's identical mark or trade dress.
8 (Doc. 142 at 10-11.) Here, VIP did not identically use JDPI's trademarks or trade dress. (Id.)
9 According to JDPI, the nominative fair use doctrine applies only "where a defendant has used
10 the plaintiff's mark to describe the plaintiff's product, even if the defendant's ultimate goal
11 is to describe his own product," citing Cairns v. Franklin Mint Co., 292 F.3d 1139, 1151 (9th
12 Cir. 2002) (finding that it was necessary for the defendant to use the name and likeness of
13 Princess Diana to refer to its "Diana-related" merchandise). (Doc. 142 at 10-11.)

14 The Court does not find that VIP is entitled to be shielded from liability based on its
15 nominative fair use defense. VIP's Bad Spaniels toy closely imitates the Jack Daniel's Trade
16 Dress and marks, but it did not use any of JDPI's registered marks, including the Jack
17 Daniel's name; the number 7; the embossed Jack Daniel's signature on the bottle; the same
18 filigree design on the label; the three-sided body label, or the identical combination of
19 elements constituting the trade dress. Under the New Kids test, when a defendant uses a
20 trademark nominally, the trademark will be identical to the plaintiff's mark, at least in terms
21 of the words in question. 971 F.2d at 308. As further stated in Playboy Enter., Inc. v. Welles,
22 279 F.3d 796, 801 (9th Cir. 2001), it is the defendant's very use of the plaintiff's identical
23 trademark that makes the nominative fair use analysis necessary rather than application of
24 AMF Inc. v. Sleekcraft Boats, 599 F.2d 341 (9th Cir. 1979) which utilizes eight factors to
25 focus on the similarity of the trademarks used by the plaintiff and the defendant in order to
26 determine liability for likelihood of confusion in the marketplace. Because it is undisputed
27 that VIP did not use JDPI's identical marks or trade dress in its Bad Spaniels toy, the
28 nominative fair use doctrine does not apply as matter of law.

1 *First Amendment Fair Use*

2 Next, VIP argues that JDPI's infringement and dilution claims must fail because VIP's
3 Bad Spaniels' parody use of the JDTW Marks and Bottle Dress is protected speech under the
4 First Amendment. (Doc. 110 at 6.) VIP states that its dog toy parody qualifies as an
5 expressive work under the First Amendment. (*Id.*) VIP argues that in order to qualify as
6 "expressive use," first a defendant must have used the mark "beyond its source-identifying
7 function" (*Id.* at 6 (citing Mattel Inc. v. MCA Records, Inc., 296 F.3d 894, 900 (9th Cir.
8 2002)), and second, its parody form of expression must not be part of a commercial
9 transaction. (*Id.* at 6-7, (citing Nissan Motor Co. v. Nissan Comput. Corp., 378 F.3d 1002,
10 1017 (9th Cir. 2004)).)

11 JDPI contends that VIP's dog toy is not entitled to protection under the First
12 Amendment. (Doc. 142 at 13.) In MCA Records, 296 F.3d at 902, JDPI states that the Ninth
13 Circuit adopted the Rogers v. Grimaldi, 875 F.2d 994 (2d Cir. 1989), standard for
14 determining the balancing of interests between trademark law and the First Amendment.
15 According to JDPI, the Rogers standard applies to artistic or expressive works and requires
16 courts to construe trademark law only where the public interest in avoiding consumer
17 confusion outweighs the public interest in free expression. Rogers, 875 F.2d at 999. Because
18 the VIP dog toy is not an artistic or expressive work, JDPI contends that the Rogers
19 balancing test is not applicable. (Doc. 142 at 14-15.) Rather, JDPI contends that the VIP dog
20 toy falls into those cases construing parody products—cases which have uniformly applied the
21 standard trademark likelihood of confusion analysis. (*Id.*)

22 The Court finds that VIP's dog toy is not entitled to protection under the First
23 Amendment because it is not an expressive work. See Brown v. Elec. Arts, Inc., 724 F.3d
24 1235 (9th Cir. 2013) (stating that the Rogers test is reserved for expressive works). In
25 Rogers, the court dealt with the intersection of trademark law and the title of a motion
26 picture. 875 F.2d at 997. The Rogers court went on to find that movies, plays, books, and
27 songs are works of "artistic expression" and thus subject to the balancing between trademark
28 law and the protections of the First Amendment. *Id.*; see also E.S.S. Entm't 2000 Inc. v. Rock

1 Star Videos, Inc., 547 F.3d 1095, 1099 (9th Cir. 2008) (stating that the Rogers balancing test
2 only applies to artistic works). Although Rogers dealt with a motion picture; the Ninth
3 Circuit has also applied the Rogers balancing test to a song (MCA Records), photographs
4 (Mattel Inc. v. Walking Mountain Prods., 353 F.3d 792 (9th Cir. 2003), and video games
5 (E.S.S. and Brown).

6 In this case, the Court finds that the standard trademark likelihood of confusion
7 analysis, not Rogers, is appropriate. See Sleekcraft Boats, 599 F.2d at 348-49 (establishing
8 the eight factors applicable to likelihood of confusion analysis). Under likelihood of
9 confusion principles, confusion exists where there is a likelihood that an appreciable number
10 of ordinary prudent purchasers will be misled or confused as to the source of goods, or where
11 consumers are likely to believe that the trademark's owner sponsored, endorsed, or otherwise
12 approved of the defendant's use of the trademark. Id. Based on the facts here, the First
13 Amendment affords no protection to VIP because it is trademark law that regulates
14 misleading commercial speech where another's trademark is used for source identification
15 in a way likely to cause consumer confusion. See Tommy Hilfiger Licensing, Inc. v. Nature
16 Labs, LLC, 221 F. Supp. 2d 410, 415 (S.D.N.Y. 2002) (refusing First Amendment protection
17 to "Timmy Holedigger" an alleged parody "dog perfume" in favor of the owner of the
18 Tommy Hilfiger trademarks for clothing). Here, as was similarly the case in Tommy Hilfiger,
19 VIP is using an adaptation of the Jack Daniel's trademark and trade dress for the dual
20 purpose of making an alleged expressive comment as well as the commercial selling of a
21 non-competing product. See Tommy Hilfiger, 221 F. Supp. 2d at 415. The Court agrees with
22 the analysis in Tommy Hilfiger that because the adaptation of the Jack Daniel's trademark
23 and trade dress mark are being used, at least in part, to promote a somewhat non-expressive,
24 commercial product, the First Amendment does not extend to such use. See id. at 415-16.

25 In conclusion, the Bad Spaniels dog toy is not an expressive work for purposes of the
26 application of the Rogers test because VIP makes trademark use of its adaptations of JDPI's
27 trademarks and the Jack Daniel's trade dress to sell a commercial product, its novelty dog
28 toy. The novelty dog toy is not an expressive work like those to which the Rogers test has

1 been applied in the Ninth Circuit. In this case, where the adaptation of the Jack Daniel's
2 trademark and trade dress were engaged for the dual purpose of making an alleged expressive
3 comment as well as the commercial selling of a non-competing product, the First
4 Amendment does not establish protection.

5 **II. VIP's Motion for Summary Judgment Re:**
6 **JDPI's Counterclaims for Trade Dress Infringement**

7 In JDPI's Answer to VIP's Complaint for Declaratory Judgment, JDPI asserted nine
8 counterclaims against VIP. (Doc. 12.) In five of those claims, JDPI asserted either trademark
9 or trade dress infringement. (Id.) In the other four claims, JDPI asserted trademark and trade
10 dress dilution. (Id.) In VIP's motion for summary judgment, it alleged entitlement to
11 summary judgment on each of JDPI's counterclaims. (Doc. 110.) As a threshold matter, VIP
12 contended that it is entitled to summary judgment on all of JDPI's counterclaims because the
13 nominative fair use defense and the First Amendment fair use defense shield it from liability.
14 (Id. at 3.)

15 The Court has found that neither nominative fair use nor First Amendment fair use
16 provides a defense for VIP. Consequently, the Court turns to the merits of VIP's arguments
17 that it is entitled to summary judgment.

18 *Infringement Claims*

19 To state an infringement claim, whether it be a trademark claim or a trade dress claim,
20 a plaintiff must meet three basic elements: (1) distinctiveness, (2) nonfunctionality, and (3)
21 likelihood of confusion. See Kendall-Jackson, 150 F.3d at 1047. VIP alleges that the bottle
22 dress of the Jack Daniel's Tennessee whiskey bottle and the "Jack Daniel" embossed
23 signature bottle design lacks distinctiveness and is functional. (Doc. 110 at 15-28.)

24 *Lack of Distinctiveness*

25 *Generic*

26 VIP first argues that JDPI has not proven that the JDTW bottle dress is a source
27 identifier for Jack Daniel's whiskey. Rather, VIP argues that the JDTW bottle dress is only
28 a generic identifier of Kentucky Bourbon/Tennessee Whiskey, not Jack Daniel's whiskey in

1 particular. (Doc. 110 at 18.) In order for JDPI to prove that its JDTW bottle dress is not
2 generic, VIP argues that JDPI must show more than a subordinate meaning that applies to
3 its trade dress. (Id.) It must show that the primary significance of the term in the minds of the
4 consuming public is not the product but the producer. (Id.)

5 JDPI contends that VIP's expert, Martin Wolinsky, has already conceded that the
6 JDTW bottle dress is not generic, but a source identifier for Jack Daniel's whiskey. (See Doc.
7 104-5 at 23, Deposition of Martin Wolinsky ("Q: Do you consider the Jack Daniel's
8 packaging to be generic? . . . A: I do not consider the Jack Daniel's package to be generic."))

9 The Court finds that the JDTW bottle dress is a source identifier for Jack Daniel's
10 whiskey. The JDTW bottle dress is a combination bottle and label elements. It includes the
11 Jack Daniel's and Old No. 7 word trademarks. (See Doc. 12 at 5, ¶6.) Under
12 Kendall-Jackson, the inquiry is not whether individual features of the trade dress are
13 nondistinctive, but whether the whole collection of features taken together are nondistinctive.
14 See 150 F.3d at 1050. No reasonable trier of fact could find that the JDTW Bottle Dress, as
15 a "whole collection of features taken together," id., including the Jack Daniel's and Old No.
16 7 trademarks, merely serves as an identifier for any Kentucky Bourbon/Tennessee Whiskey.
17 The Court finds that the JDTW Bottle Dress is a source identifier for Jack Daniel's whiskey;
18 it is not generic as a matter of law.

19 *Inherent Distinctiveness*

20 Next, VIP argues that JDPI's infringement counterclaims fail because it cannot prove
21 that the JDTW bottle dress is inherently distinctive. (Doc. 110 at 18, 21-23.) JDPI
22 acknowledges that its JDTW bottle dress is not inherently distinctive. (Doc. 142 at 30.)

23 *Acquired Distinctiveness-Secondary Meaning*

24 Next, VIP argues that JDPI's infringement counterclaims fail because it cannot prove
25 that the JDTW Bottle Dress has acquired distinctiveness through secondary meaning. (Doc.
26 110 at 23-28.) In support, VIP contends that JDPI has not established any direct evidence
27 of acquired distinctiveness through secondary meaning. (Id. at 24.) Further, VIP contends
28 that JDPI's circumstantial evidence is also lacking. (Id. at 25-28.) VIP argues that although

1 JDPI relies on extensive sales and advertising, extensive consumer recognition, billions of
2 dollars in revenue, and allegedly being one of the most iconic consumer products in
3 American history, JDPI has failed to substantiate these vague claims with actual, probative
4 evidence. (Id.) Accordingly, VIP contends that the JDTW bottle dress has not acquired
5 distinctiveness through secondary meaning. (Id.)

6 In support of acquired distinctiveness through secondary meaning, JDPI contends that
7 it has both direct and circumstantial evidence in support. Regarding direct evidence, JDPI
8 contends that VIP intentionally copied aspects of the JDTW bottle dress. (Doc. 142 at 31-32.)
9 JDPI also contends that Dr. Gerald Ford’s likelihood of confusion survey is directly
10 probative of secondary meaning. (Id. at 32-33.) In further support, JDPI contends that its
11 circumstantial evidence is probative of secondary meaning. (Id. at 33-37.) JDPI cites the
12 success of its advertising, it being the best-selling US whiskey for almost 20 years, and
13 significant media exposure of its overall product packaging. (Id.)

14 *Secondary Meaning-Direct Evidence*

15 “[A] mark has acquired distinctiveness, . . . if it has developed secondary meaning,
16 which occurs when ‘in the minds of the public the primary significance of a [mark] is to
17 identify the source of the product rather than the product itself.’ Wal-Mart, 529 U.S. at 211.
18 “It is well established that trade dress can be protected under federal law. The design or
19 packaging of a product may acquire a distinctiveness which serves to identify the product
20 with its manufacturer or source; and a design or package which acquires this secondary
21 meaning, assuming other requisites are met, is a trade dress which may not be used in a
22 manner likely to cause confusion as to the origin, sponsorship, or approval of the goods.”
23 TrafFix Devices, 532 U.S. at 28.

24 The Court finds that JDPI has established direct evidence of secondary meaning. VIP
25 admits that it intentionally copied the JDTW bottle dress, and that it did so precisely to
26 enable consumers to instantly recognize Jack Daniel’s whiskey as the “target” of the Bad
27 Spaniels alleged parody. (See Doc. 110 at 2 (VIP stating that it designed the Bad Spaniels
28 dog toy to be a comical parody of a Jack Daniel’s whiskey bottle).) VIP’s copying of the

1 identifiable parts of the JDTW bottle dress was indisputably an attempt to capitalize and free
2 ride upon the success of Jack Daniel’s existing secondary meaning. In this case, intentional
3 copying by VIP supports an inference of secondary meaning. See Vision Sports v. Melville
4 Corp., 888 F.2d 609, 615 (9th Cir. 1989) (stating that proof of copying strongly supports an
5 inference of secondary meaning); Lisa Frank, Inc. v. Impact Int’l, Inc., 799 F. Supp. 980, 989
6 (D. Ariz. 1992) (same). Thus, JDPI has established direct evidence of secondary meaning.

7 Next, the Court also finds that JDPI has established circumstantial evidence of
8 acquired distinctiveness through secondary meaning. Between 1997 and 2015, sales of Jack
9 Daniel’s whiskey in the United States exceeded 75 million cases, and advertising
10 expenditures were in the hundreds of millions of dollars. (Doc. 105 at 1-6.) The sales,
11 advertising, and public exposure of JDTW is greater than the facts that established secondary
12 meaning in Fiji Water. Between 1997, when FIJI water was first sold, and 2010, Fiji sold
13 nearly 65 million cases worldwide and expended more than \$65 million in advertising. 741
14 F. Supp. 2d at 1177. JDTW has been sold and advertised in the Jack Daniel’s Trade Dress
15 for more than 30 years longer than FIJI water. (See Doc. 106 at 1-6, Docs. 106-1 through
16 106-4.) Between 1997 and April 30, 2015, JDPI states that total unit sales of JDTW in the
17 United States in various sizes exceeded 75 million units, resulting in revenues exceeding ten
18 billion dollars. (Doc. 105 at 1-6.) JDPI further states that the vast majority of these sales were
19 in packaging bearing the Jack Daniel’s Trade Dress. (Id.)

20 Furthermore, VIP admits that through JDPI’s advertising it has created significant
21 customer recognition of Jack Daniel’s whiskey. (See Doc. 104-2 at 34, Deposition of Stephen
22 Sacra, Chief Executive Officer of VIP, “Q: Do you agree that the Jack Daniel’s trademark
23 is very well known in the United States? . . . A: I think that Jack Daniel’s is more
24 recognizable than other brands. But they’ve spent a lot of money to make that recognition.”)
25 Mr. Sacra further acknowledged that “the success of the Bad Spaniels toy “comes from the
26 fact that people are familiar with Jack Daniel’s . . . and have seen it before, and will get the
27 parody.” (Id.) Based on all of the above, the Court finds that JDPI’s circumstantial evidence
28 also demonstrates acquired distinctiveness through secondary meaning.

1 Thus, JDPI has established acquired distinctiveness through secondary meaning both
2 with direct and circumstantial evidence. Therefore, VIP's motion for summary judgment
3 regarding JDTW bottle dress's lack of distinctiveness will be denied.

4 *Nonfunctionality*

5 To state an infringement claim, whether it be a trademark claim or a trade dress claim,
6 JDPI must establish the element of nonfunctionality. VIP argues that the JDTW bottle is
7 functional; JDPI contends otherwise.

8 *Utilitarian Functionality*

9 "The functionality doctrine prevents trademark law, which seeks to promote
10 competition by protecting a firm's reputation, from instead inhibiting legitimate competition
11 by allowing a producer to control a useful product feature." Qualitex Co. v. Jacobson Prod.
12 Co., 514 U.S. 159, 164 (1995). The Ninth Circuit asks four questions to test utilitarian
13 functionality: (1) whether the trade dress yields a utilitarian advantage; (2) whether
14 alternative designs are available; (3) whether advertising touts the utilitarian advantages of
15 the design; and (4) whether the particular design results from a comparatively simple or
16 inexpensive method of manufacture. See Disc Golf, 158 F.3d at 1006. No one factor is
17 dispositive; all are to be weighed collectively, that is, whether the whole collection of
18 elements are functional. See International Jensen, 4 F.3d at 822-23. Given the functionality
19 doctrine's underlying purpose, the Ninth Circuit applies it with somewhat less force in
20 product packaging cases, as opposed to cases involving product configuration. See Clicks
21 Billiards Inc. v. Sixshooters Inc., 251 F.3d 1252, 1261 (9th Cir. 2001) (stating that a wide
22 range of available packaging and design options allows a producer to appropriate a
23 distinctive identity without unduly hindering his competitor's ability to compete).

24 In support of JDTW bottle dress's utilitarian functionality, VIP makes two arguments:
25 (1) that its features are "essential to the use or purpose of the article [or] affects [its] cost or
26 quality" citing Inwood Labs. v. Ives Labs., Inc., 456 U.S. 844, 850, n.10 (1982); and (2)
27 based on VIP's expert John Howard's report, VIP argues that the Jack Daniel's
28 embossed-signature bottle design is one of the several utilitarian features used in the JDTW

1 bottle dress. (Doc. 116 at 85-95.) VIP contends that because JDPI has not offered
2 controverting testimony, other than the opinions of interested parties (i.e., JDPI employees),
3 this design feature is clearly functional under Disc Golf. (Doc. 110 at 16.)

4 JDPI responds that the JDTW bottle dress reflects aesthetic design choices and
5 embodies branding features that focus on the historical identification of the product, and that
6 such are wholly unrelated to utility. (Doc. 142 at 25 (citing Doc. 101 at 20-22 in support of
7 lack of utilitarian functionality).) JDPI states that it only seeks to protect the square “shape
8 of the bottle, together with aesthetic elements” of the JDTW bottle dress, nothing more.
9 (Doc. 101 at 20.) JDPI contends that its advertising does not tout any utilitarian advantage
10 of the JDTW bottle design, rather, its advertising focuses on the quality and history of
11 JDTW. (Id.) Finally, JDPI contends that its JDTW bottle dress is not a comparatively simple
12 or inexpensive method of manufacture, given its manufacture of a square bottle and the use
13 of an embossed signature on all four sides of the bottle. (Id. at 27-28.)

14 Based on VIP’s arguments regarding utilitarian functionality of the JDTW bottle
15 dress, the Court finds that VIP is not entitled to summary judgment. The Court notes that
16 based on the four factors set forth in Disc Golf, VIP chose not to address how each factor
17 supports its contention that the JDTW bottle dress is functional. See International Jensen, 4
18 F.3d at 822-23 (stating that the four factor review considers whether the whole collection of
19 product packaging are functional).

20 Initially, the Court finds that JDPI’s advertising does not tout any utilitarian advantage
21 of the JDTW bottle design, rather, its advertising has focused on the quality and history of
22 JDTW. (Doc. 105 at 4, 105-2 at 1-116.) VIP’s expert, John Howard, acknowledged that
23 advertising for Jack Daniel’s whiskey did not tout any utilitarian advantages of the Jack
24 Daniel’s bottle design. (Doc. 104-4 at 64-65.)

25 Next, the Court must look at product packaging as a whole, with a particular focus on
26 whether JDPI’s particular integration of the various elements on the packaging leaves
27 competitors with commercially-feasible alternatives. See Clicks Billiards, 251 F.3d at 1261
28 (explaining that utilitarian functionality in packaging-type cases evaluates whether the

1 “particular integration of elements leaves a multitude of alternatives to [competitors in the]
2 industry that would not prove confusingly similar”). As shown in Doc. 104-7 at 22, 24, and
3 admitted by VIP (See Doc. 104-7 at 5, 22, 24, and 30-31), there are many, many alternative
4 trade dresses available for use by the competition for whiskey. VIP acknowledged that some
5 companies use elements of the Jack Daniel’s trade dress, including a square bottle, and
6 graphic features such as filigree and arched lettering, but none combine all of these elements
7 together with the other elements of the Jack Daniel’s trade dress. (See Doc. 104-3 at 17-18.)
8 “Since competitors routinely use alternative designs in packaging their [whiskey], protecting
9 the particular combination of elements in the [Jack Daniel’s] packaging will not hinder
10 competition in the [spirits] industry.” Fiji Water, 741 F. Supp. 2d at 1174.

11 Based on the foregoing, VIP has not demonstrated that it is entitled to summary
12 judgment that the JDTW Bottle Dress has utilitarian functionality.

13 *Aesthetic Functionality*

14 “[P]urely aesthetic product features may be protected as a trademark where they are
15 source identifying and are not functional.” Au-Tomotive Gold, 457 F.3d at 1064. Under the
16 aesthetic functionality test, trade dress may be functional if “protection of the [trade dress]
17 as a trademark would impose a significant non-reputation-related competitive disadvantage.”
18 Id. at 1072. In practice, aesthetic functionality thus has been limited to product features that
19 serve an aesthetic purpose wholly independent of any source-identifying function. Id. (stating
20 that there was no evidence that consumers buy Auto Gold’s products solely because of their
21 intrinsic aesthetic appeal; instead the alleged aesthetic function is indistinguishable from and
22 tied to the mark’s source-identifying nature—Audi and VW Logos).

23 VIP argues that in order to evaluate aesthetic functionality, the Court should utilize
24 the comparable-alternatives test or the effective-competition test. (Doc. 110 at 17-18.)
25 Regarding the comparable-alternatives test, VIP argues that the focus is on the existence of
26 feasible alternative designs, meaning how difficult it would be for JDTW’s competitors to
27 compete in the market if they were precluded from using the JDTW’s design, and were
28 instead required to transition to a new design, citing competitive use of square bottles. (Id.

1 at 17.) Next, regarding the effective-competition test, VIP argues that the focus is on whether
2 a particular design feature is a pre-requisite for market participation. If, for whatever reason,
3 the cost of protection renders JDTW's competitors unable to compete in the relevant market,
4 then the feature is not protectable, citing the square bottle, black-and-white label, number
5 designation, arched text, and filigree design. (Id. at 18.)

6 JDPI cites to Au-Tomotive Gold as the proper Ninth Circuit standard and its holding
7 that aesthetic functionality inquires into whether protection of the feature as a trademark
8 would impose a significant non-reputation-related competitive disadvantage. 457 F.3d at
9 1072. In response to VIP, JDPI contends that its competitor's trade dress demonstrates that
10 multiple comparable alternatives exist and are in use, and that the use of the combination of
11 features in the JDTW bottle dress for decades has had, and will have, no impact on the ability
12 of competitors to use individual features, singly or in part-combination. (Doc. 142 at 27.)
13 JDPI further contends that "[s]ince competitors routinely use alternative designs in packaging
14 their [whiskey], protecting the particular combination of elements in the [Jack Daniel's]
15 packaging will not hinder competition in the [spirits] industry" (Id. at 28 (quoting Fiji Water,
16 741 F. Supp. 2d at 1174).)

17 The Court agrees with JDPI; based on the submitted evidence, the Court first finds
18 that VIP is not entitled to summary judgment based on the argument that consumers buy Jack
19 Daniel's Tennessee Whiskey because of its intrinsic aesthetic appeal. See Au-Tomotive
20 Gold, 457 F.3d at 1073. Rather, as the court stated in Fiji Water, "[c]onsumers do not buy
21 [whiskey] based on how its packaging looks, but rather on how the [whiskey] tastes or how
22 much it costs." Fiji Water, 741 F. Supp. 2d at 1174.

23 As to JDTW's packaging, "[s]ince competitors routinely use alternative designs in
24 packaging their [whiskey], protecting the particular combination of elements in the [Jack
25 Daniel's] packaging will not hinder competition in the [spirits] industry" Id. Rather, the
26 combination of the trademarks and the aesthetic elements merely source-identify JDTW
27 bottle dress as JDTW.

28 ///

1 *Lack of Confusion*

2 The Court has found that VIP is not entitled to summary judgment regarding the first
3 two elements of JDPI's counterclaim regarding trade dress infringement, rejecting VIP's
4 contention that the JDTW bottle dress is functional and non-distinctive. VIP's motion for
5 summary judgment fails to argue lack of confusion. (Doc. 110.) In its reply in support of
6 summary judgment, VIP reiterated that it need not undertake an analysis of the Sleekcraft
7 likelihood of confusion factors in its motion for summary judgment because VIP is not
8 required to rebut confusion in order to receive protection under the fair use defenses. (Doc.
9 163 at 7.)² However, in this case, the Court has rejected VIP's nominative and First
10 Amendment fair use defenses.

11 Under Sleekcraft, the Court analyzes eight factors to determine likelihood of
12 confusion: (1) strength of the mark; (2) proximity of the goods; (3) similarity of the marks;
13 (4) evidence of actual confusion; (5) marketing channels used; (6) type of goods and the
14 degree of care likely to be exercised by the purchaser; (7) VIP's intent in selecting the mark;
15 and (8) likelihood of expansion of the product lines. See 599 F.2d at 348-49.

16 The material facts are construed in favor of the non-moving party, JDPI. JDPI
17 contends that there are material facts in its favor from which a reasonable trier of fact could
18 find for JDPI on its infringement claims under Sleekcraft. JDPI argues that it established
19 VIP's intentional copying of various aspects of its trade dress, the close similarity between
20 the Bad Spaniels' trademark and trade dress to the Jack Daniel's trademarks and trade dress,
21 and the longstanding and extensive sales, advertising, and public exposure of Jack Daniel's
22 whiskey.

23 In general, likelihood of confusion is often a fact-intensive inquiry, and therefore
24 _____

25 ²Although VIP argues the Sleekcraft factors in its Reply (Doc. 163 at 8-10), the Court
26 will not consider arguments raised for the first time in a Reply. "It is well established that
27 issues cannot be raised for the first time in a reply brief." Gadda v. State Bar of Cal., 511
28 F.3d 933, 937 n.2 (9th Cir. 2007). The Court need not belabor the point that VIP could have
raised alternative arguments regarding Sleekcraft in its motion for summary judgment; it
chose not to raise such arguments.

1 courts are reluctant to decide this issue at the summary judgment stage. See Au-Tomotive
2 Gold, 457 F.3d at 1075. The Court finds that VIP is not entitled to summary judgment on the
3 likelihood of confusion element regarding JDPI’s counterclaims for trade dress infringement.

4 **III. VIP’s Motion for Summary Judgment Re:**
5 **JDPI’s Counterclaim for Trade Dress Dilution**

6 On October 6, 2006, the Trademark Dilution Revision Act of 2006 (the “TDRA”),
7 was signed into law. See Pub.L. 109–312, 120 Stat. 1730 (Oct. 6, 2006). The TDRA defines
8 dilution as follows:

9 Subject to the principles of equity, the owner of a famous mark that is
10 distinctive, inherently or through acquired distinctiveness, shall be entitled to
11 an injunction against another person who, at any time after the owner’s mark
12 has become famous, commences use of a mark or trade name in commerce that
13 is likely to cause dilution by blurring or dilution by tarnishment of the famous
14 mark, regardless of the presence or absence of actual or likely confusion, of
15 competition, or of actual economic injury.

16 15 U.S.C. § 1125(c)(1).

17 In JDPI’s Answer to VIP’s Complaint, it raised four counterclaims related to dilution:
18 dilution by tarnishment of JDPI’s trademarks under federal law; dilution by tarnishment of
19 Jack Daniel’s trade dress under federal law; and trademark and trade dress dilution under
20 Arizona law. (Doc. 12 at 3-21.)

21 VIP claims that it is entitled to summary judgment on Jack Daniel’s trade dress
22 dilution claim under federal law because: (1) the alleged Jack Daniel’s trade dress is not
23 “famous” under the TDRA; (2) the VIP Product is not similar enough to the Jack Daniel’s
24 trade dress to dilute; (3) the VIP Product is not likely to cause dilution by tarnishment; and
25 (4) even if JDPI were able to meet its burden under the TDRA, VIP is not liable for dilution
26 by tarnishment because VIP’s Product is exempted by TDRA’s fair-use provision. (Doc. 110
27 at 9.)

28 JDPI initially notes that VIP only challenges one of its dilution counterclaims, its Jack
Daniel’s trade dress dilution by tarnishment claim under federal law. (Doc. 142 at 19; see
Doc. 12 at 16-17 and at 5 ¶ 6) (picturing Jack Daniel’s trade dress).) JDPI responds that
VIP’s challenge to this claim is without merit. (Doc. 142 at 9.)

1 *Federal Trade Dress Dilution-Tarnishment*

2 The TDRA provides for injunctive relief for dilution by tarnishment claims under 15
3 U.S.C. § 1125(c)(1). The TDRA further defines dilution by tarnishment, as follows: “For
4 purposes of [15 U.S.C. § 1125(c)(1)], ‘dilution by tarnishment’ is association arising from
5 the similarity between a mark or trade name and a famous mark that harms the reputation of
6 the famous mark.” 15 U.S.C. § (c)(2)(C).

7 *VIP’s Fair Use Defense*

8 Under the TDRA, VIP claims its parody product, which satirizes JDPI’s product, is
9 not actionable under an anti-dilution statute because of its fair use defense. (Doc. 110 at 15.)

10 JDPI claims that VIP’s argument is without merit under the TDRA. (Doc. 142 at 24.)
11 Under the TDRA, § 1125(c)(3)(A) provides an exclusion for liability for “[a]ny fair use . .
12 . other than as a designation of source for the person’s own goods or services, including use
13 in connection with . . . (ii) parodying” Thus, according to JDPI, “[u]nder the statute’s
14 plain language, parodying a famous mark is protected by the fair use defense only if the
15 parody is not ‘a designation of source for the person’s own goods or services.’” (Doc. 142
16 at 24-25 (quoting Louis Vuitton Malletier S.A. v. Haute Diggity Dog LLC, 507 F.3d 252,
17 266 (4th Cir. 2007)).) JDPI contends that the fair use exclusion was not available to the
18 defendant in Louis Vuitton because the defendant used its parody dog toy, Chewy Vuitton,
19 as a trademark to designate the source. (Id. at 25 (citing Louis Vuitton, 507 F.3d at 267).) In
20 the same manner, JDPI states that the fair use defense is not applicable here because VIP uses
21 its Bad Spaniels trademark and trade dress as source identifiers of its dog toy.

22 The Court finds that the language of the statute and its application in Louis Vuitton
23 is directly applicable here and compel the result that the fair use defense is not available to
24 VIP and its alleged parody product. See Louis Vuitton, 507 F.3d at 267. Under the facts here,
25 VIP did use its Bad Spaniels trademark and trade dress as source identifiers of its dog toy,
26 which takes its alleged parody product outside the fair use defense under the TDRA.

27 *Fame of Jack Daniel’s Trade Dress*

28 On the merits, VIP challenges Jack Daniel’s trade dress dilution by tarnishment claim

1 under the FDRA. VIP alleges that Jack Daniel’s trade dress, separate and apart from the
2 possible fame of the JDTW trademarks, is not famous, that is, not being widely recognized
3 by the general consuming public as a designation of the source of the goods of the
4 trademark’s owner. (Doc. 110 at 9-10.) According to VIP, Jack Daniel’s trade dress is not
5 famous enough to support its dilution claim because Jack Daniel’s trade dress is not a source
6 identifier. (Id. at 10 (citing the competition’s use of many of the same design elements in
7 their trade dresses, especially the use of square bottles).)

8 VIP further alleges that Jack Daniel’s trade dress is not famous due to lack of actual
9 recognition. According to VIP, the only direct evidence JDPI presented to show national
10 fame is the Ford Survey, but Dr. Gerald Ford admitted that his survey did not test for fame.
11 (Id. at 11.) Further, VIP argues that even if the Ford Survey had tested for fame, it would not
12 be probative because the survey respondents were not representative of the general
13 consuming public in the United States. (Id.)

14 With regard to the factors listed at 15 U.S.C. § 1125(c)(2)(A)(i)-(iv), VIP alleges that
15 JDPI’s advertising and promotional evidence is not probative because it is not specific to
16 Jack Daniel’s trade dress. (Id. at 12.) Regarding sales, VIP alleges that without evidence of
17 actual consumer recognition, the evidentiary value of Jack Daniel’s Tennessee whiskey’s
18 sales is non-existent. Regarding federal registration, VIP alleges that JDPI must prove that
19 its unregistered trade dress is famous, independent of its registered trade marks. (Id.)

20 JDPI responds that in analyzing trade dress for all purposes, the focus is “not on the
21 individual elements, [like square bottles,] but rather the overall visual impression that the
22 combination and arrangement of those elements create.” Clicks Billiards, 251 F.3d at 1259.
23 JDPI argues that Jack Daniel’s trade dress as a whole is widely recognized by the general
24 consuming public as a designation of the source of the goods of the trademark’s owner, that
25 is, that it is a source identifier for Jack Daniel’s Tennessee whiskey.

26 Regarding lack of direct evidence of fame, JDPI contends that all relevant factors
27 should be considered including indirect evidence of fame such as advertising or sales.
28 According to JDPI, evidence of actual recognition of fame, such as a survey, is not required.

1 JDPI contends that based upon VIP's deliberate copying, the undisputed success of sales,
2 advertising, and public exposure of Jack Daniel's Tennessee Whiskey, which is packaged in
3 the Jack Daniel's trade dress, provide sufficient indirect evidence from which a reasonable
4 trier of fact could find the fame of the Jack Daniel's trade dress.

5 The Court determines that a reasonable trier of fact could find that Jack Daniel's trade
6 dress as a whole serves as a source identifier for Jack Daniel's Tennessee Whiskey. See
7 Clicks Billiards, 251 F.3d at 1259 (stating the Clicks Billiards could claim as its mark the
8 particular combination and arrangement of design elements that distinguish it from others
9 using the same concept); see also Wal-Mart, 529 U.S. at 215 (stating that overall product
10 packaging is the typical form of trade dress and it normally is taken by the customer to
11 indicate origin).

12 Next, based on consideration of the statutory factors, see 15 U.S.C. §
13 1125(c)(2)(A)(i)-(iv), it is undisputed that the sales, advertising, and public exposure of Jack
14 Daniel's whiskey packaged in the Jack Daniel's trade dress provide substantial indirect
15 evidence of fame. Between 1997 and 2015, sales of Jack Daniel's whiskey packaged in the
16 Jack Daniel's trade dress exceeded 75 million cases in the United States, yielding revenues
17 in excess of \$10 billion dollars and advertising expenditures in the hundreds of millions of
18 dollars (Doc. 101 at 15); cf. Mattel Inc. v. MGA Ent. Inc., 782 F. Supp. 2d 911, 942 (C.D.
19 Cal. 2011) (finding that MGA had presented no evidence, direct or indirect, of the fame of
20 its trade dress); Vallavista Corp. v. Amazon.com, Inc., 657 F. Supp. 2d 1132, 1138-39 (N.D.
21 Cal. 2008) (finding that the limited evidence of use, coupled with very modest sales and
22 advertising expenditures, was insufficient to prove fame); Clearly Food & Bev. Co. v. Top
23 Shelf Bevs., Inc., No. CV 13-1763, 2015 WL 1926503, *17 (W.D. Wash. Apr. 28, 2015)
24 (finding that the product bearing the allegedly famous mark had been out of production for
25 six years, only negligible sales were still occurring, and the defendant's survey showed very
26 low recognition of the mark). Thus, as a whole, the Court determines that a reasonable trier
27 of fact could find that Jack Daniel's trade dress is famous. (See Doc. 12 at 5 (picturing Jack
28 Daniel's trade dress at ¶ 6).)

1 *VIP's Motion to Exclude Testimony of JDPI's Expert, Dr. Itamar Simonson*

2 Prior to the Court's resolution of the remaining elements of JDPI's dilution by
3 tarnishment claim, VIP moves to exclude the report and the testimony of JDPI's dilution
4 expert, Dr. Itamar Simonson. (Doc. 92.) According to VIP, JDPI's expert purports to opine
5 on the issue of whether, and how, consumers associate VIP's product with JDPI's product
6 and whether that association dilutes JDPI's trade dress by harming its reputation. (Id.) VIP
7 contends that Dr. Simonson's reported opinion is lacking in both methodology and
8 conceptual support that would permit admissibility as a scientific expert opinion. (Id. at 2.)
9 In further support of exclusion, VIP argues that Dr. Simonson does not qualify as an
10 "experienced-based" expert because an experience-based expert is someone with relevant
11 real world experience, not someone who fails to follow scientific methodology. (Id. at 3.)
12 Based on Daubert v. Merrell Dow Pharmaceuticals, Inc., 509 U.S. 579 (1993) and Fed. R.
13 Evid. 702, VIP contends that the Court should exercise its gatekeeping function and deny
14 admissibility to both Dr. Simonson's report and his testimony at trial. (Id.)

15 JDPI contends that the opinions and testimony of its dilution expert, Dr. Itamar
16 Simonson, should be admitted. (Doc. 96.) According to JDPI, Dr. Simonson has been
17 retained as an expert witness to testify regarding the implication(s) of the association between
18 the Bad Spaniels toy and Jack Daniel's whiskey on JDPI's trade dress and trademarks and
19 the meaning of the mark/brand to consumers. (Id. at 6.)

20 In summary of Dr. Simonson's expert report (Doc. 96 at 3 (citing Doc. 92-1)), JDPI
21 states that Dr. Simonson will assist the finder of fact by discussing the following at trial:

22 1) The basics of consumer behavior and "how marks such as famous trade dress are
23 represented in memory." (Doc. 92-1 at 4, 7-9);

24 2) The basics of the "associative network memory model" which are accepted by
25 experts in the consumer behavior field. (Id. at 4-5);

26 3) The application of the "associative network memory model" to the instant case. (Id.
27 at 10-12); and

28 4) The conclusion that VIP's Bad Spaniels toy causes negative implication for JDPI's

1 trade dress and marks and thus is likely to tarnish them. (Id. at 10–14.)

2 JDPI contends that Dr. Simonson’s report and testimony are admissible and will assist
3 the trier of fact because Dr. Simonson is eminently qualified to provide his expert opinions
4 and because his opinions are relevant and reliable based upon his specialized knowledge.
5 (Doc. 96 at 2.) JDPI argues that its dilution expert is not required to quantify findings through
6 prescribed “scientific” methodology, rather, his conclusions may be based on his specialized
7 knowledge and principles that are accepted within his relevant area of expertise. (Id. at 2-3
8 (citing Hangarter v. Provident Life & Acc. Ins. Co., 373 F.3d 998, 1017 (9th Cir. 2004)
9 (stating that the Daubert factors (peer review, publication, error rate, etc.) are not applicable
10 to expert testimony whose reliability depends heavily on the knowledge and experience of
11 the expert, rather than the methodology or theory behind it).)

12 In opposition to Dr. Simonson’s exclusion, JDPI further cites Visa Int’l Serv. Ass’n
13 v. JSL Corp., No. CV 01-294, 2006 WL 3248394, at *3-4 (D. Nev. Nov. 7, 2006), in which
14 the Nevada District Court admitted Dr. Itamar Simonson as a dilution expert and allowed his
15 expert testimony based on his presentation of “specialized knowledge evidence” rather than
16 scientific evidence.³

17 The Court will deny VIP’s motion to exclude Dr. Simonson and allow the
18 admissibility of Dr. Simonson’s report and his expert testimony to assist the trier of fact.
19 Rule 702 is to be applied with a liberal thrust favoring admission. See Messick v. Novartis
20 Pharm. Corp., 747 F.3d 1193, 1196 (9th Cir. 2014).

21 Under Daubert, the Court is required to maintain a gatekeeping role regarding all
22 forms of expert testimony, not just scientific testimony. See White v. Ford Motor Co., 312
23 F.3d 998, 1007 (9th Cir. 2002). With regard to non-scientific testimony, the Court is required
24 to make some kind of reliability determination to fulfill its gatekeeping function. See
25 Hangarter, 373 F.3d at 1018. Under United States v. Hankey, 203 F.3d 1160, 1169 (9th Cir.

26
27
28 ³The Visa court found it uncontested that no scientific method exists for determining
whether actual dilution of a trademark occurred. Id. at *3.

1 2000), the court admitted expert testimony on gang behavior based on the expert's extensive
2 personal knowledge of street gangs. In exercising its gatekeeping function regarding expert
3 specialized knowledge cases, the Hankey court set forth six factors to evaluate in determining
4 admissibility: (1) whether the opinion is based on scientific, technical, or other specialized
5 knowledge; (2) whether the opinion would assist the trier of fact in understanding the
6 evidence or determining a fact in issue; (3) whether the expert has the appropriate
7 qualifications to render the opinion; (4) whether the testimony is relevant and reliable; (5)
8 whether the methodology or technique used fits the conclusions; and (6) whether the
9 opinion's probative value is substantially outweighed by the risk of unfair prejudice,
10 confusion of issues, or undue consumption of time.

11 Dr. Simonson is an recognized expert in consumer behavior. In Visa, the court
12 concluded that Dr. Simonson's opinion as an expert would not be excluded based on the
13 following:

14 Dr. Simonson, himself, is the Sebastian S. Kresge Professor of Marketing at
15 the Stanford University Graduate School of Business and a recognized expert
16 on consumer behavior. He has won multiple awards for his scholarship and
17 research in the fields of marketing and consumer behavior. He relied on
18 surveys conducted by Visa in 2000, his own validation survey, studies of
19 on-line payments from 2000 to 2001, and his own personal expertise to reach
20 the conclusions in his opinion. The court considers these sources and Dr.
21 Simonson's methodology to satisfy the requirements of reliability and proper
22 methodology for this type of evidence. In addition, the court considers Dr.
23 Simonson's qualifications sufficient to render him an expert in the subject at
24 hand. Finally, the court does not see any prejudice arising out of the use of Dr.
25 Simonson's opinion and therefore finds that the probative value of Dr.
26 Simonson's opinion is not substantially outweighed by the potential for
27 prejudice, confusion of the issues or undue consumption of time.

28 Visa, 2006 WL 3248394, at *3-4.

The Court finds that Dr. Simonson's opinions regarding consumer behavior are not
technical and therefore his report and testimony can be found reliable based on his
knowledge and experience alone. The Court does not agree that post-Daubert expert opinion
requires the performance of surveys, focus groups, studies or other real world tests or that
Daubert would preclude an expert from applying his expertise to the facts of the case.
Experience, training and education may provide a sufficient foundation for an expert's

1 testimony. See Hangarter, 373 F.3d at 1018.

2 On the basis of the foregoing, the Court will deny VIP’s motion to exclude the report
3 and the testimony of JDPI’s dilution expert, Dr. Itamar Simonson.

4 *Similarity Requirement*

5 Next, VIP alleges that JDPI cannot show that the VIP Product is sufficiently similar
6 to the Jack Daniel’s trade dress. (Doc. 110 at 13.) According to VIP, similarity must be
7 considered in light of how consumers will encounter the respective products in the
8 marketplace, as opposed to a mere side-by-side comparison of the trade dress. (Id.) In
9 support, VIP cites lack of similarity due to: (1) the VIP Product uses the name “Bad
10 Spaniels” in place of the “Jack Daniel’s” name; (2) the VIP Product uses “The Old No. 2”
11 in place of JDPI’s “Old No. 7” slogan; (3) VIP has added its SILLY SQUEAKERS® brand
12 name to prominent locations on the VIP Product hangtag; and (4) VIP has added different
13 design elements and omitted several key components to the VIP trade dress, citing Apple,
14 Inc. v. Samsung Elecs. Co., 920 F. Supp. 2d 1116, 1128–29 (N.D. Cal. 2013) (holding that
15 the parties’ trade dresses were not sufficiently similar because the phones varied in
16 appearance, and defendant’s trade dress was missing key features of plaintiff’s trade
17 dress—this weighed heavier than expert testimony claiming that defendant’s phone was
18 likely to dilute; the jury’s findings on non-dilution was not against the clear weight of the
19 evidence). (Id.) Finally, VIP alleges a lack of similarity because VIP sells its Product in a
20 completely different market than Jack Daniel’s whiskey. (Id.)

21 JDPI responds that prior to the TDRA, a party had to prove that the famous mark and
22 the accused mark were identical or nearly identical when bringing allegations of dilution,
23 (Doc. 142 at 22, (citing Welles, 279 F.3d at 806).) Quoting Levi Strauss & Co. v.
24 Abercrombie & Fitch Trading Co., 633 F.3d 1158, 1159 (9th Cir. 2011), “the ‘identical or
25 nearly identical’ standard did not survive Congress’s enactment of the TDRA.” Now a party
26 only must show “similarity” between the famous mark and the accused mark. (Id.)

27 According to JDPI, similarity or lack of similarity is a highly fact-specific inquiry
28 rarely found as a matter of law. (Id. (citing Nordstrom, 2013 WL 1196948, at *14 (denying

1 Nordstrom a preliminary injunction as a matter of law due to improbability of success on its
2 dilution by tarnishment claim)); Apple, Inc., 920 F. Supp. 2d at 1131 (denial of post-trial
3 motion for judgment as a matter of law seeking to overturn jury finding of no dilution).
4 Thus, JDPI contends that under the TDRA it is for the fact-finder, not for the Court as a
5 matter of law, to determine the fact-specific issue of similarity. (Id. at 23.)

6 Regarding the differences that VIP alleges between its Bad Spaniels toy and the Jack
7 Daniel’s trade dress, JDPI contends that rather than focusing on the discrete differences
8 between the products, the focus is on how a consumer would see their trade dresses as a
9 whole. (Id. at 22-23.) As a whole, JDPI argues that a reasonable trier of fact could find that
10 the VIP product and Jack Daniel’s trade dress meet the requisite similarity, an “association
11 arising from the similarity between a mark or trade name and a famous mark. . . .” (Id. at 23
12 (quoting 15 U.S.C. § 1125(c)(2)(C)).)

13 Initially, the Court notes that under the TDRA, a party only must show “similarity,”
14 not substantial similarity or nearly identical, between the famous mark and the accused mark.
15 Levi Strauss, 633 F.3d at 1159, 1172. However, the Ninth Circuit has not issued its guidance
16 by providing a model jury instruction for the “similarity” standard in dilution by tarnishment
17 claims.

18 At this stage, the Court will not rule as a matter of law that the products are not similar
19 based upon the statutory dilution standards. Based on the factors stated by the parties, a
20 reasonable trier of fact could find that the VIP product and Jack Daniel’s trade dress meet the
21 requisite similarity standard for dilution, an “association arising from the similarity between
22 a mark or trade name and a famous mark. . . .” (Id. at 23 (quoting 15 U.S.C. §
23 1125(c)(2)(C)).)

24 *Reputational Harm*

25 VIP alleges that dilution by tarnishment “generally arises when the plaintiff’s
26 trademark is linked to products of shoddy quality, or is portrayed in an unwholesome or
27 unsavory context likely to evoke unflattering thoughts about the owner’s product.” (Doc. 110
28 at 14 (quoting Nordstrom, 2013 WL 1196948, at *11).) In evaluating likelihood of harm, VIP

1 contends that “[c]onsiderations such as complaints, reduction in sales, loss of customers, and
2 negative press are all relevant to the overall determination.” (*Id.* (quoting *Nordstrom*, 2013
3 WL 1196948, at *13; see also *Starbucks Corp. v. Wolfe’s Borough Coffee, Inc.*, 588 F.3d
4 97, 110 (2d Cir. 2009) (stating that plaintiff failed to show likelihood of dilution by
5 tarnishment because it did not show how “coffee named either ‘Mister Charbucks’ or
6 ‘Charbucks Blend’ would affect the positive impressions about the coffee sold by Starbucks).

7 In support, VIP alleges that its expert, Dr. Bruce Silverman, arranged several focus
8 groups to test consumer reactions to the VIP Product and that his study revealed that none
9 of the test subjects reacted negatively to the VIP product. (Doc. 110 at 14.) VIP further
10 contends that JDPI cannot rebut Dr. Silverman’s study because it has not disclosed any
11 evidence of actual consumer reactions to the VIP Product. (*Id.* at 14-15.)

12 In response, JDPI contends that its dilution expert, Dr. Itamar Simonson, his expert
13 report and testimony details how the VIP product tarnished JDPI’s product. (Doc. 142 at 24.)
14 JDPI further contends that such expert evidence of alleged tarnishment is sufficient to
15 preclude summary judgment. (*Id.* (citing *Gucci Am., Inc. v. Guess?, Inc.*, 843 F. Supp. 2d
16 412, 439 (S.D.N.Y. 2012)).) According to JDPI, the credibility of the parties’ respective
17 positions is for the trier of fact to assess at trial. After drawing all reasonable factual
18 inferences in favor of JDPI, JDPI contends that summary judgment cannot be granted against
19 it on this issue. *Matsushita*, 475 U.S. at 587.

20 The Court finds that summary judgment on this issue is precluded. Both parties will
21 present expert opinions and testimony on the issue of whether the VIP product tarnished the
22 JDPI product. VIP will have its expert, Bruce Silverman, and JDPI will have its expert,
23 Itamar Simonson, present their evidence. It will be up to the trier of fact to assess and resolve
24 the facts on this issue.

25 **IV. JDPI’s Motion for Partial Summary Judgment**

26 As to Claim 1 of VIP’s Amended Complaint, JDPI leaves for trial the ultimate finding
27 of whether VIP’s alleged parody infringes or dilutes the Jack Daniel’s trademarks and trade
28 dress. (Doc. 101 at 7.) Jack Daniel’s trade dress and the trademark is shown in part by PTO

1 Trademark Registration No. 4,106,178. (See Doc. 12 at 7 ¶ 11.) JDPI moves for summary
2 judgment on VIP’s second and third claim. (Doc. 101 at 6.) As to VIP’s second claim, JDPI
3 contests VIP’s complaint that Jack Daniel’s trade dress and the trademarks are not entitled
4 to protection because they are functional and non-distinctive. (Id.) As to VIP’s third claim,
5 based on the same arguments as in Claim 2, JDPI contests VIP’s cancellation argument for
6 JDPI’s PTO Trademark Registration No. 4,106,178. (Id.)

7 JDPI alleges that its protectable trade dress consists of a combination of a square
8 bottle with a ribbed neck, a black cap, a black neck wrap closure with white printing bearing
9 the OLD NO. 7 mark and a black front label with white printing and a filigreed border
10 bearing the JACK DANIEL’S mark depicted in arched lettering at the top of the label, the
11 OLD NO. 7 mark contained within a filigreed oval design in the middle portion of the label
12 beneath the JACK DANIEL’S mark and the words “Tennessee Sour Mash Whiskey” in the
13 lower portion of the label with the word “Tennessee” depicted in script. (Doc. 101 at 9.) JDPI
14 states that the Jack Daniel’s Trade Dress is covered, in part, by a PTO registration (No.
15 4,106,178) for the three-dimensional configuration of a square shape bottle container with
16 embossed “Jack Daniel” signature for distilled spirits. (Doc. 12 at 7 ¶ 11.)

17 *Distinctiveness and Functionality*

18 In VIP’s motion for summary judgment, the Court set forth the parties’ arguments as
19 to whether the Jack Daniel’s trade dress and bottle design are distinctive and whether they
20 are non-functional. (*Supra* at 11-18.) The Court then resolved the issues finding that Jack
21 Daniel’s trade dress and bottle design have acquired distinctiveness through secondary
22 meaning, and that Jack Daniel’s trade dress and bottle design are non-functional both from
23 a utilitarian analysis and an aesthetic analysis. (*Supra* at 11-18.) As to lack of confusion in
24 the marketplace, VIP did not argue this element as part of its summary judgment motion and
25 thus its resolution is left for the trier-of-fact at trial.

26 In JDPI’s motion for partial summary judgment on these same issues, the non-movant
27 VIP may avoid summary judgment if the pleadings and supporting documents, viewed in the
28 light most favorable to VIP, the nonmoving party, show that there is a genuine issue as to any

1 material fact such that JDPI would not be entitled to judgment as a matter of law.

2 As to VIP's Claim 2 in its Amended Complaint, the Court has reviewed VIP's
3 response to JDPI's motion for partial summary judgment on this claim and finds that VIP has
4 made the same legal arguments as to acquired distinctiveness, utilitarian functionality, and
5 aesthetic functionality that the Court previously considered in VIP's motion for summary
6 judgment. (See Doc. 147 at 7-24.) Therefore, the Court finds that VIP may not avoid
7 summary judgment on the Court's earlier findings that Jack Daniel's trade dress and bottle
8 design have acquired distinctiveness through secondary meaning, and that Jack Daniel's
9 trade dress and bottle design are non-functional both from a utilitarian functional analysis and
10 an aesthetic functional analysis.

11 *Cancellation of Registration*

12 As to VIP's third claim, based on the same arguments that VIP raised in Claim 2, JDPI
13 contests VIP's cancellation argument against JDPI's PTO Trademark Registration No.
14 4,106,178 (the "'178 Registration") (Doc. 101 at 25-35 (discussing the JDPI trademark
15 shown in Doc. 12 at 5 ¶ 11).)

16 JDPI contends that the '178 Registration is prima facie evidence of a trademark's
17 validity, shifting the burden from the registrant to the challenger. See 15 U.S.C. §§ 1057(b);
18 1115(a); see, e.g., Zobmondo Entm't, LLC v. Falls Media, LLC, 602 F.3d 1108, 1114 (9th
19 Cir. 2010) (stating that a "federal registration provides 'prima facie evidence' of the mark's
20 validity and entitles the plaintiff to a 'strong presumption' that the mark is a protectable
21 mark"). According to JDPI, the PTO issued the '178 Registration without requiring JDPI to
22 prove the distinctiveness of the mark which creates a presumption that the mark is inherently
23 distinctive. See Zobmondo, 602 F.3d at 1114. JDPI further contends that the '178
24 Registration creates a presumption that the mark is non-functional. Talking Rain, 349 F.3d
25 at 603. "[T]he presumption of validity is a strong one and the burden on the defendant
26 necessary to overcome that presumption at summary judgment is heavy." Zobmondo, 602
27 F.3d at 1115.

28 In support of distinctiveness, JDPI relies on the testimony of VIP's expert, John

1 Howard, who testified that the shape of the Jack Daniel’s bottle “is part of a marketing
2 program to make the bottle distinctive from competitors,” which has succeeded because the
3 bottle was “very distinctive”; that the bottle has become a “classic design” for whiskey; and
4 that the bottle shape is more eye-catching than the “Jack Daniel” signature and is what does
5 the most to identify the product as coming from Jack Daniel’s. (Doc. 104-4 at 8-9, 15-16,
6 64.) Therefore, because VIP’s own expert admitted that the mark is distinctive, a reasonable
7 trier of fact could only find that the ’178 Registration is distinctive. (Doc. 101 at 26.)

8 In support of a lack of functionality, utilitarian and aesthetic, JDPI presents its
9 previous arguments, and these arguments need not be restated again here. (Id. at 26-35.)

10 VIP contends that it has sufficient evidence to rebut the presumption of validity, citing
11 Talking Rain, 349 F.3d at 603 (stating that once the presumption of validity afforded to a
12 registered trademark has been rebutted, mere registration does not enable a trademark holder
13 to survive summary judgment). (Doc. 147 at 24-25.)

14 In support of a lack of distinctiveness, VIP argues that the bottle design of the ’178
15 Registration amounts to ordinary geometric shaped packaging that is widely used in the
16 market, and therefore it is non-distinctive and protectable only upon proof of secondary
17 meaning. (Id. at 25.)

18 As to distinctiveness, the Court reiterates that the presumption of validity of a
19 trademark registration is a strong one and the burden on the defendant necessary to overcome
20 that presumption at summary judgment is heavy. See Zobmondo, 602 F.3d at 1115. The
21 Court finds that VIP has failed to overcome that presumption. First, and foremost, the ’178
22 Registration includes the embossed signature, “Jack Daniel.” As the Court has already
23 concluded, the Jack Daniel’s name is decidedly famous, and produces a distinctiveness on
24 its own. Moreover, VIP’s own expert, John Howard, also conceded that the ’178 Registration
25 was distinctive. (Doc. 104-4 at 8-9, 15-16, 64.)

26 Next, as to functionality, both utilitarian and aesthetic, both JDPI and VIP have
27 restated a number of the functionality arguments that the Court has already considered and
28 need not be repeated again here. (See Doc. 101 at 26-35 and Doc. 147 at 26-27.)

1 The Court again finds that VIP has failed to rebut the validity of the '178 Registration
2 as it pertains to functionality, both utilitarian and aesthetic. The Court has already found that
3 the bottle design is not functional. (See supra at 15-18.)

4 In conclusion, the Court finds that VIP has failed to rebut the validity of the '178
5 Registration. Therefore, the Court will not invalidate the '178 Registration by directing the
6 Commissioner of Patents and Trademarks to cancel JDPI's federal trademark registration No.
7 4,106,178.

8 *VIP's Motion to Strike*

9 Pursuant to Fed. R. Civ. P. 37, VIP moves to exclude the declaration submitted by
10 JDPI in support of its Opposition to Motion to Exclude Testimony of Defendant's Expert
11 Itamar Simonson (Doc. 96) and certain evidence that JDPI submitted in support of its Motion
12 for Partial Summary Judgment (Doc. 101). VIP lists the evidence as follows. The Declaration
13 of Itamar Simonson in Support of Defendant's Opposition to Plaintiff's Motion to Exclude
14 Testimony of Itamar Simonson ("Simonson Declaration") (Doc. 97-1) and the Declaration
15 of Phillip Epps in Support of JDPI's Motion for Partial Summary Judgment ("Epps
16 Declaration") (Doc. 105). VIP alleges that both contain untimely disclosures, either because
17 they are information not previously disclosed despite interrogatories and requests for
18 production of documents that sought disclosure during the discovery period, or because they
19 were improperly submitted after the discovery cut-off date. (Doc. 133.)

20 In response, JDPI contends that VIP's motion to strike should be denied for the simple
21 reason that it was brought in violation of the local rules. (Doc. 139.) According to JDPI,
22 LRCiv 7.2(m)(2) is clear that a party may not file a separate motion to strike evidence
23 supporting a written motion.

24 The Court finds that VIP's motion to strike does not comply with the Local Rules and
25 will be denied. LRCiv 7.2(m)(2) provides, as follows:

26 Objections to Admission of Evidence on Written Motions. An objection to
27 (and any argument regarding) the admissibility of evidence offered in support
28 of or opposition to a motion must be presented in the objecting party's
response or reply memorandum and not in a separate motion to strike or other
separate filing.

1 LRCiv 7.2(m)(2). The purpose of the Local Rule is to require unitary briefs, including
2 objections to evidence and to the propriety of arguments, within the page limits established
3 by the Court. See Pruet v. Arizona, 600 F. Supp. 2d 1065, 1074 (D. Ariz. 2009). “Litigants
4 may not divide their briefs and multiply their page limits by styling part of the argument as
5 a separate motion to strike.” Id. VIP violated and thus disregarded the purpose of LRCiv
6 7.2(m)(2) by filing a separate motion to strike; its motion to strike will be denied.

7 **CONCLUSION**

8 Accordingly, on the basis of the foregoing,

9 **IT IS HEREBY ORDERED** granting Defendant’s motion for partial summary
10 judgment. (Doc. 101.)

11 **IT IS FURTHER ORDERED** denying Plaintiff’s motion for summary judgment.
12 (Doc. 110.)

13 **IT IS FURTHER ORDERED** denying Plaintiff’s motion to exclude the testimony
14 of Defendant’s expert, Dr. Itamar Simonson. (Doc. 92.)

15 **IT IS FURTHER ORDERED** denying Plaintiff’s motion to exclude Defendant’s
16 supplemental declaration of Dr. Itamar Simonson and evidence offered by Phillip Epps.
17 (Doc. 133.)

18 **IT IS FURTHER ORDERED** denying as moot Plaintiff’s motion for clarification.
19 (Doc. 88.) Prior to trial, at the time the parties file their respective motions in limine, they
20 may argue the disputed admissibility of documentary evidence that each party would present
21 at trial.

22 **IT IS FURTHER ORDERED** denying as moot the parties’ stipulated motion to file
23 documents under seal. (Doc. 152.) In resolving the parties’ dispositive motions, the Court
24 only utilized the redacted portions of the referenced documents; it was not necessary for the
25 Court to review and consider the limited sealed portion of these documents that were lodged
26 under seal. The Clerk of Court shall maintain as lodged under seal Doc. 153 and Doc. 154.
27 At trial, the parties must keep in mind that referencing a confidential fact or a confidential
28 document will in fact reveal it as a matter of course.

1 **IT IS FURTHER ORDERED** denying as moot Defendant's motion to seal. (Doc.
2 162.) The parties did not reference nor did the Court consider any of these documents during
3 resolution of the dispositive motions. The Clerk of Court shall maintain as lodged under seal
4 Doc. 119, Doc. 119-1, and Doc. 127. At trial, the parties must keep in mind that referencing
5 a confidential fact or a confidential document will in fact reveal it as a matter of course.

6 **IT IS FURTHER ORDERED** setting this matter for a status hearing on **Wednesday,**
7 **October 26, 2016, at 2:00 p.m.,** in Courtroom 401, 401 West Washington Street, Phoenix,
8 AZ before Senior Judge Stephen M. McNamee.

9 DATED this 27th day of September, 2016.

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