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UNITED STATES DISTRICT COURT  
CENTRAL DISTRICT OF CALIFORNIA

MERCADO LATINO, INC. dba	)	Case No. CV 13-01027 DDP (RNBx)
CONTINENTAL CANDLE COMPANY,	)	
	)	
Plaintiff,	)	<b>ORDER GRANTING DEFENDANT'S MOTION</b>
	)	<b>TO DISMISS</b>
v.	)	
	)	
INDIO PRODUCTS, INC., a	)	
California corporation,	)	
	)	Dkt. No. 20]
Defendant.	)	
	)	

Presently before the court is Defendant Indio Products, Inc. ("Indio")'s Motion to Dismiss. Having considered the submissions of the parties and heard oral argument, the court grants the motion and adopts the following order.

**I. Background**

Indio and Plaintiff Mercado Latino, Inc. ("Mercado") both sell devotional prayer candles bearing images of saints and other religious figures. (First Amended Complaint ("FAC") ¶¶ 21, 28, 35.) Mercado's "Sanctuary Series" candles depict a religious icon within a "bullet" shape in the style of a stained glass window, surrounded by a patterned border of colorful, geometric shapes.

1 (FAC ¶ 21, Ex. E; Motion to Dismiss, Ex. 2.) Mercado obtained  
2 copyrights on "the original and distinctive artwork shown on  
3 Sanctuary Series candles." (FAC ¶¶ 12-14.) Mercado also  
4 trademarked the name "Sanctuary Series" and a design consisting of  
5 three circles within a window. (FAC ¶¶ 18-19.) Mercado allegedly  
6 owns trade dress "comprised of candles with distinctive  
7 appearance," and featuring "the unique combination of the following  
8 design elements: a depiction of a saint or religious icon, with a  
9 border that appears to be a 'bullet' shape in the style of a  
10 stained glass window and the name of the saint or the religious  
11 icon underneath the depiction." (FAC ¶ 21.)

12 In its First Amended Complaint, Mercado alleges that Defendant  
13 Indio copied Mercado's copyrights and passed off inferior Indio  
14 candles as Mercado products. (FAC ¶¶ 29-31.) The FAC further  
15 alleges that Indio infringed upon Mercado's Sanctuary Series trade  
16 dress and trademarks. Mercado also alleges causes of action for  
17 federal unfair competition under 15 U.S.C. § 1125(a) and  
18 intentional interference with prospective economic advantage.  
19 Indio now moves to dismiss all five claims.

20 **II. Legal Standard**

21 **II. Legal Standard**

22 A complaint will survive a motion to dismiss when it contains  
23 "sufficient factual matter, accepted as true, to state a claim to  
24 relief that is plausible on its face." Ashcroft v. Iqbal, 556 U.S.  
25 662, 678 (2009) (quoting Bell Atl. Corp. v. Twombly, 550 U.S. 544,  
26 570 (2007)). When considering a Rule 12(b)(6) motion, a court must  
27 "accept as true all allegations of material fact and must construe  
28 those facts in the light most favorable to the plaintiff." Resnick

1 v. Hayes, 213 F.3d 443, 447 (9th Cir. 2000). Although a complaint  
2 need not include "detailed factual allegations," it must offer  
3 "more than an unadorned, the-defendant-unlawfully-harmed-me  
4 accusation." Iqbal, 556 U.S. at 678. Conclusory allegations or  
5 allegations that are no more than a statement of a legal conclusion  
6 "are not entitled to the assumption of truth." Id. at 679. In  
7 other words, a pleading that merely offers "labels and  
8 conclusions," a "formulaic recitation of the elements," or "naked  
9 assertions" will not be sufficient to state a claim upon which  
10 relief can be granted. Id. at 678 (citations and internal  
11 quotation marks omitted).

12 "When there are well-pleaded factual allegations, a court should  
13 assume their veracity and then determine whether they plausibly  
14 give rise to an entitlement of relief." Id. at 679. Plaintiffs  
15 must allege "plausible grounds to infer" that their claims rise  
16 "above the speculative level." Twombly, 550 U.S. at 555.  
17 "Determining whether a complaint states a plausible claim for  
18 relief" is a "context-specific task that requires the reviewing  
19 court to draw on its judicial experience and common sense." Iqbal,  
20 556 U.S. at 679.

### 21 **III. Discussion**

#### 22 A. Copyright Infringement

23 To state a claim for copyright infringement, a Plaintiff must  
24 allege "(1) ownership of a valid copyright, and (2) copying of  
25 constituent elements of the work that are original." Feist Pubs.,  
26 Inc. v. Rural Tel. Serv. Co., Inc., 499 U.S. 340, 361 (1991). To  
27 satisfy the copying prong, a copyright plaintiff must also allege  
28 that the works are substantially similar in their protected

1 elements. Wild v. NBC Universal, Inc., 788 F.Supp.2d 1083, 1098  
2 (C.D. Cal. 2011). Courts in this circuit regularly apply these  
3 requirements at the pleading stage. See, e.g., Wild, 788 F.Supp.2d  
4 at 1098; Zella v. E.W. Scripps Co., 529 F.Supp.2d. 1124, 1130-31  
5 (C.D. Cal. 2007); Lafarqa v. Lowrider Arte Magazine, No. SACV 11-  
6 1501 DOC, 2012 WL 3667441 at \*3 (C.D. Cal. Aug. 24, 2012); Minden  
7 Pictures, Inc. v. Pearson Education, Inc., No. C 11-05385 WHA, 2012  
8 WL 1595081 at \*2 (N.D. Cal. May 4, 2012); Fractional Villas, Inc.  
9 v. Tahoe Clubhouse, No. 08cv1396-IEG, 2009 WL 160932 at \*2 (S.D.  
10 Cal. Jan. 22, 2009).<sup>1</sup>

11 Courts employ a two-part analysis, comprised of an "intrinsic"  
12 and "extrinsic" test, to determine whether two works are  
13 substantially similar. Cavalier v. Random House, Inc., 297 F.3d  
14 815, 822 (9th Cir. 2002). Here, Indio argues that the FAC fails to  
15 allege sufficient facts to satisfy the extrinsic test. (Mot. at  
16 10.) The extrinsic test is an objective comparison of specific,  
17 protectable expressive elements. Id. at 822-23. General ideas and  
18 scenes a faire that flow necessarily from ideas are not  
19 protectable, and therefore play no role in an extrinsic analysis.  
20 Id.

21 Mercado argues that the protectable elements of the Sanctuary  
22 series candles are "the artwork of border with appearance of  
23 cathedral window-shaped stained glass." (Opp. at 6-7, FAC Ex. B.)  
24 Mercado's opposition makes no attempt, however, to dispute Indio's  
25 contention that Indio candles are not substantially similar to  
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27 <sup>1</sup> The bulk of Plaintiff's opposition is devoted to the  
28 assertion that the validity of its claims cannot be analyzed prior  
to summary judgment. (Opp. at 2, 4, 5-6, 8-9, 12-15.)

1 Mercado's Sanctuary Series candles. That alone would be reason  
2 enough to grant Indio's motion to dismiss. Even putting aside  
3 Mercado's implicit concession, however, it does not appear that the  
4 two lines of candles are substantially similar.

5 As an initial matter, the elements identified by Mercado are  
6 not all protectable. The court must filter out the unprotected  
7 elements before applying the extrinsic test. Mattel, Inc. v. MGA  
8 Entertainment, Inc., 616 F.3d 904, 913 (9th Cir. 2010.) Mercado  
9 seeks protection for artwork with the "appearance of cathedral  
10 window-shaped stained glass." An idea alone, such as the idea of  
11 depicting a stained-glass cathedral window, is not copyrightable.  
12 Feist, 499 U.S. at 344-45; Satava v. Lowry, 323 F.3d 805, 810 (9th  
13 Cir. 2003) ("[N]o copyright protection may be afforded to the idea  
14 of producing a glass-in-glass jellyfish sculpture.").

15 To the extent that Mercado argues that the shape of the  
16 artwork is a protectable element of expression, the court  
17 disagrees. (See Opp. at 7 ("The copyright cause of action is based  
18 on the additional artwork of the border with the stained glass  
19 cathedral window shape." (emphasis added).) Standard features  
20 (i.e., scenes a faire) and unoriginal components are not  
21 protectable. Mattel, 616 F.3d at 913-14; Cavalier, 297 F.3d at  
22 822-23; Dream Games of Arizona, Inc. v. PV Onsite, 561 F.3d 983,  
23 988 (9th Cir. 2009) ("[E]lements of expression that necessarily  
24 follow from an idea, or expressions that are as a practical matter,  
25 indispensable or at least standard in the treatment of an idea are  
26 [also] not protected." (internal quotation and alteration  
27 omitted.)). The placement of a border around an (admittedly  
28 unprotected) image of a religious figure is hardly an original or

1 unique expression. Nor is the use of a "bullet," arched, or  
2 conical shape in a depiction of a religious icon in any way novel  
3 or groundbreaking. As evinced by Plaintiff's own use of the term  
4 "cathedral window shape," the bullet-type design is a widespread  
5 and longstanding staple of devotional iconography, to which Mercado  
6 can lay no copyright claim.

7 Thus, the only protectable element of expression to which to  
8 apply the extrinsic test is Mercado's border artwork design itself.  
9 The extent of copyright protection afforded to an idea or element  
10 depends on the possible range of expression of that idea or  
11 element. Mattel, 616 F.3d at 913-14. Where the range is narrow,  
12 copyright protection is "thinner," and a work must be "virtually  
13 identical" to infringe. Id. Where the range of possible  
14 expression is broad, substantial similarity is sufficient to  
15 establish infringement. Id. Here, the court disagrees with  
16 Indio's assertion that there is but a narrow range of potential  
17 expression for border artwork. Because there are "gazillions of  
18 ways" to design a border, Indio's work need only be substantially  
19 similar to Mercado's design. Id.

20 Indio's border artwork design is not, however, substantially  
21 similar to Mercado's design. Mercado's border design features five  
22 colors in roughly equal proportions, fairly large rectangles and  
23 semicircles in a symmetrical arrangement, and the name of the  
24 particular religious figure within the border itself. Indio's  
25 design is primarily blue, contains a large number of irregular  
26 shapes laid out in a somewhat jumbled and asymmetrical pattern,  
27 contains a distinctive, inset image of a dove or angel at the top  
28 of the border, and does not incorporate any text.

1           Because the protected elements of Mercado's expression are not  
2 similar to Indio's expression, Mercado cannot state a viable  
3 copying claim. Mercado's copyright claim must therefore be  
4 dismissed, with prejudice.

5           B. Trade Dress

6           Mercado's trade dress claim under Section 43(a) of the Lanham  
7 Act, 15 U.S.C. § 1125(a), as currently pled, is premised upon the  
8 same facts as its copyright claim. The FAC describes Mercado's  
9 Sanctuary Series trade dress as "a depiction of a saint or other  
10 religious icon, with a border that appears to be a "bullet" shape  
11 in the style of a stained glass window and the name of the saint or  
12 the religious icon underneath the depiction." (FAC ¶ 21.) As  
13 explained above, these are the same elements for which Mercado  
14 seeks copyright protection. Both the copyright and trade dress  
15 claims allege that Indio attempts to confuse consumers and to pass  
16 its own candles off as Mercado candles. (FAC ¶¶ 31, 36-37.)

17           The Supreme Court has cautioned that the Lanham Act should not  
18 be overextended into areas traditionally covered by copyright law.  
19 Dastar Corp. v. Twentieth Cent. Fox Corp., 539 U.S. 23, 34 (2003).  
20 To the extent that the Copyright Act provides an adequate remedy,  
21 therefore, Lanham Act claims are preempted. Shaw v. Lindheim, 919  
22 F.2d 1353, 1364-65 (9th Cir. 1990); Salt Optics, Inc. v. Jand,  
23 Inc., No. SACV 10-828, 2010 WL 4961702 at \*7 (C.D. Cal. Nov. 19,  
24 2010).

25           Mercado's opposition to Indio's preemption argument is  
26 puzzling. Mercado merely and conclusorily states that "Defendant  
27 has engaged in wrongful conduct under both the Lanham Act and the  
28 Copyright Act." This naked assertion, however, is insufficient to

1 sustain Mercado's Lanham Act claim. Apparently recognizing as  
2 much, Mercado argues that there is an independent basis for its  
3 trade dress claim because "Plaintiff has discovered instances of  
4 Defendant selling Plaintiff's candles bearing Plaintiff's trade  
5 dress inside boxes bearing Defendant's name." (Opp. at 13;  
6 Declaration of R. Joseph Decker ¶ 2.) The FAC, however, makes no  
7 mention of these facts. While the FAC does allege that Indio is  
8 attempting to pass off its candles as Mercado products, the only  
9 basis for that allegation is that "Defendants have placed their  
10 infringing Defendants' Candles in direct competition with Mercado's  
11 Sanctuary Series." (FAC ¶ 37.) Nowhere does the FAC state any  
12 allegations regarding false packaging or repackaging of Mercado  
13 candles. Mercado's trade dress claim is therefore dismissed, with  
14 leave to amend.<sup>2</sup>

15 C. Remaining claims

16 Mercado's opposition suggests that the remaining trademark  
17 claim and state law interference with economic advantage claim are  
18 also premised upon Indio's re-boxing of Mercado candles in Indio  
19 boxes.<sup>3</sup> (Opp. at 14-15; Decker Decl. ¶ 2.) The FAC, however,  
20 includes no such allegations. These claims are dismissed with  
21 leave to amend.

22 **IV. Conclusion**

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24 <sup>2</sup> Mercado's unfair competition claim, which is also based on  
25 Section 43(a) of the Lanham Act, is based upon the same facts as  
26 its trade dress claim, and is therefore also dismissed with leave  
to amend.

27 <sup>3</sup> Plaintiff does not dispute that, to the extent its  
28 intentional interference claim overlaps with its copyright claim,  
the state law claim is preempted. See Wild, 788 F.Supp.2d at 1110-  
1111.



1 For the reasons stated above, Defendant's Motion to Dismiss is  
2 GRANTED. Plaintiff's copyright claim is dismissed with prejudice.  
3 All other claims are dismissed with leave to amend. Any amended  
4 complaint shall be filed within ten days of the date of this order.

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9 IT IS SO ORDERED.

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12 Dated: June 12, 2013

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DEAN D. PREGERSON  
United States District Judge