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UNITED STATES DISTRICT COURT
CENTRAL DISTRICT OF CALIFORNIA

GIBSON BRANDS INC.,)	Case No. CV 14-00609 (SSx)
)	
Plaintiff,)	ORDER DENYING CERTIFICATION
)	FOR INTERLOCUTORY APPEAL
v.)	
)	[Dkt. 258]
JOHN HORNBY SKEWES & CO., LTD.,)	
ET AL ,)	
)	

Presently before the court is Plaintiff Gibson Brands, Inc.’s Motion to Certify Order for Interlocutory Appeal. Having reviewed the parties’ submissions, the court DENIES the Motion and adopts the following Order.

I. BACKGROUND

On September 29, 2016, this Court issued an Order granting in part and denying in part cross-motions for summary judgment filed by Plaintiff Gibson Brands, Inc., (“Gibson”) and Defendant John Hornby Skewes & Co. Ltd. (“JHS”). (Dkt. 249 (“SJ

1 Order”).¹ The factual background of the case is set forth in the SJ Order, as well as
2 numerous previous orders of this Court. (*See* SJ Order; *see also* Dkts. 16, 29, 57, 67, 72, 88,
3 106, 141.) In the SJ Order, the court granted JHS summary judgment on Count II of
4 Gibson’s complaint for trademark counterfeiting. (SJ Order 12-16.) Gibson seeks to certify
5 the court’s determination as to counterfeiting for interlocutory appeal.² Specifically,
6 Gibson seeks certification of the following question: “Whether a counterfeiting claim
7 based on the Lanham Act requires the entire goods or rather only the trademark(s) to be
8 identical or substantially indistinguishable.”

9 **II. LEGAL STANDARD**

10 28 U.S.C. § 1292(b) permits a district court to certify an issue for interlocutory
11 appeal if the following three elements are met: (1) there is a controlling question of law;
12 (2) there are substantial grounds for differences of opinion; and (3) an immediate appeal
13 may materially advance the ultimate termination of the litigation. *In re Cement Antitrust*
14 *Litig.*, 673 F.2d 1020, 1026 (9th Cir. 1982). Interlocutory appeals should be granted “only
15 in extraordinary cases,” and not “merely to provide review of difficult rulings in hard
16 cases.” *U.S. Rubber Co. v. Wright*, 359 F.2d 784, 785 (9th Cir. 1966).

17 **III. DISCUSSION**

18 The court begins its analysis with the “controlling question of law” prong.
19 Although Congress has not specifically defined what it meant by “controlling,” the Ninth
20 Circuit has explained that “the legislative history of 1292(b) indicates that this section
21 was to be used only in exceptional situations in which allowing an interlocutory appeal
22 would avoid protracted and expensive litigation.” *In re Cement Antitrust Litigation*, 673
23 F.2d 1020, 1026 (9th Cir. 1982) (citing *United States Rubber Co. v. Wright*, 359 F.2d 784, 785

24
25 ¹ Although Gibson did not seek clarification or reconsideration of the Court’s Summary
26 Judgment Order, the court has nonetheless revised the Order in light of the concerns
27 Gibson has raised in the instant Motion. The Amended Order was issued on December
28 29, 2016. (Dkt. 270.)

² Because of the voluminous filings in this litigation, the court has required the parties to
seek permission before making any additional filings. (*See* Dkt. 248.) In accordance with
that requirement, Gibson filed a request for leave to file a motion for certification of an
interlocutory appeal, which the court subsequently granted. (*See* Dkts. 255, 256.)

1 (9th Cir. 1966) (per curiam)). With this constraint in mind, a “controlling question of law”
2 has been defined as one where “resolution of the issue on appeal could materially affect
3 the outcome of litigation in the district court.” *Id.* By contrast, if “an interlocutory appeal
4 would delay resolution of the litigation, it should not be certified.” *Sullivan v. Kelly Servs.,*
5 *Inc.*, No. C 08-3893 CW, 2010 WL 1445683, at *1 (N.D. Cal. Apr. 7, 2010) (citing *Shurance v.*
6 *Planning Control Int’l, Inc.*, 839 F.2d 1347, 1348 (9th Cir. 1988)).

7 The question of law Gibson seeks to certify is whether a court should evaluate a
8 trademark counterfeiting claim—such as the one brought here on the basis of trademarks
9 as to a guitar’s body shape and headstock—by considering the product as a whole or
10 only the specific trademarks at issue. In Gibson’s view, the SJ Order erroneously focused
11 on whether the products as a whole were identical or substantially indistinguishable
12 instead of limiting the inquiry to only the specific body shape and headstock trademarks.
13 Before addressing the interlocutory appeal factors, the court notes that this reading of the
14 SJ Order misunderstands the basis of the court’s conclusion as to the counterfeiting claim.
15 Although Gibson has not moved for clarification or reconsideration of the SJ Order, the
16 court has nonetheless issued an Amended Order to clarify the decision and address
17 Gibson’s concerns. The court briefly discusses the implication of that clarification here.

18 As stated in the original SJ Order, a counterfeiting claim under the Lanham Act
19 turns on whether there is use of “a spurious mark which is identical with, or
20 substantially indistinguishable from, a registered mark.” 15 U.S.C. § 1116(d)(1)(A). As
21 Gibson notes in the instant motion, both the text of the Lanham Act and Ninth Circuit
22 case law focus on the likeness of the trademark at issue and not the product as a whole.
23 *See Louis Vuitton Malletier, S.A. v. Akanoc Solutions, Inc.*, 658 F.3d 936, 946 (9th Cir. 2011)
24 (“Section 1116(d) requires that the mark in question be (1) a non-genuine mark identical
25 to the registered, genuine mark of another, where (2) the genuine mark was registered for
26 use on the same goods to which the infringer applied the mark.”) The operative question
27 in this case is when is one mark identical to or substantially indistinguishable from
28 another mark. Put in more general terms, the challenge is not determining the test for

1 what constitutes *counterfeiting* but rather what constitutes a *counterfeit*. The case law on
2 this particular point is understandably limited because most counterfeiting cases address
3 obviously identical marks placed on identical goods, *see Adams v. Grand Slam Club/Ovis*,
4 No. 12-CV-2938-WJM-BNB, 2013 WL 1444335, at *6 (D. Colo. Apr. 9, 2013), or so-called
5 “stitch-for-stitch copies,” *see Gucci Am., Inc. v. Guess?, Inc.*, 868 F.Supp. 2d 207 (S.D.N.Y.
6 2012). Here, however, the products are not such stitch-for-stitch copies. Instead, Gibson
7 has asserted trademarks for particular guitar body shapes and headstock shapes, which it
8 contends JHS has counterfeited by producing guitars that utilize identical or
9 substantially indistinguishable body shapes and headstocks. JHS responds that that body
10 shapes and headstocks are not identical or substantially indistinguishable, nor could they
11 be as a matter of law because the allegedly infringing body shapes and headstocks are
12 marked with alternative source indicators: the JHS “Vintage” mark in stylized font on the
13 front of the guitar and the JHS trademark “Vintage A John Hornby Skewes Product” on
14 the back.

15 Contrary to Gibson’s reading of the SJ Order, the court did not resolve the
16 counterfeiting claim on the grounds that Gibson’s guitar products as a whole were not
17 identical or substantially indistinguishable to JHS’s guitar products. Rather, the court
18 considered the narrower question of whether JHS’s guitar body shapes and headstocks
19 can be considered a counterfeit of Gibson’s trademarks if the allegedly counterfeit JHS
20 guitar body shapes and headstocks are marked with an alternate source indicator. On
21 this point, there is little guidance from the Ninth Circuit other than a case opining that a
22 “counterfeit is something that purports to be something that it is not.” *United Pac. Ins. Co.*
23 *v. Idaho First Nat. Bank*, 378 F.2d 62, 69 (9th Cir. 1967).³ Ultimately, the court resolved the
24 counterfeiting claim by concluding that there is no triable issue that the body shapes and
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27 ³ In the instant Motion, Gibson curiously challenges the relevance of *United Pac*,
28 explaining that it was limited to analyzing the meaning of a “a counterfeit check under
Idaho law and the UCC,” given that it was Gibson which first relied on the case and
directed the court’s attention to it in its summary judgment papers. (*Compare* Mot. Certify
Order for Interlocutory Appeal 4 *with* Pl.’s Opp’n Def.’s Mot. Summ. K. (Dkt. 221) at 13.)

1 headstocks of the JHS guitars are counterfeits of either the Gibson body shape or
2 headstock trademarks given the visual distinctions between the particular body shapes
3 and headstocks and the distinct source identifiers on the JHS body shapes and
4 headstocks. This conclusion was reinforced by the court's understanding that if "[t]he
5 purpose of a trademark is to help consumers identify the source," *Brookfield Commc'ns,*
6 *Inc. v. W. Coast Entm't Corp.*, 174 F.3d 1036, 1051 (9th Cir. 1999), it would be incongruous
7 to conclude that JHS has counterfeited Gibson's body shape and headstock trademarks
8 by selling guitars that are marked as originating from an entirely different source.

9 In light of this clarification, as well as the Amended Order issued on December 29,
10 2016, the court finds that Gibson's Motion does not present a controlling question of law.
11 The question Gibson asks the Ninth Circuit to address would not "materially affect the
12 outcome of this litigation" because it relies on a misreading of the SJ Order. Moreover,
13 while the parties' arguments as to the instant motion suggest that there is a diversity of
14 views as to whether a counterfeiting claim should be evaluated by comparing only the
15 trademarks in question or the products as a whole, an answer to that question would not
16 alter the court's resolution of the counterfeiting claim in this case. If the court is directed
17 to examine the products as a whole, there is no triable counterfeiting claim, but even if
18 the court is limited to examining only the trademarks themselves, the court would still
19 conclude that, due to the alternate source indicators stamped on the trademarks and the
20 visual distinctions between the body shapes and headstocks, there is no triable
21 counterfeiting claim.

22 Gibson has also failed to satisfy the third element of the interlocutory appeal test
23 and demonstrate that certifying an interlocutory appeal would "materially advance the
24 ultimate termination of the litigation" 28 U.S.C. § 1292(b). Gibson's Complaint asserts ten
25 counts against JHS. The court's SJ Order denied summary judgment on eight of those
26 counts and scheduled a trial that is now set for February 28, 2017. (*See* Dkt. 256.) As to the
27 remaining issues, the court granted JHS summary judgment on one count and dismissed
28 the other count because it was based on an outdated statute. (*See* SJ Order 18.) The parties

1 are presumably well into trial preparation and deadlines have been set for motions in
2 limine and a final pretrial conference within the next two months. Gibson proposes
3 delaying this litigation for an extended period to seek review of a single, discrete claim
4 that the court has found lacks merit. Under these circumstances, where a trial verdict
5 would be rendered long before an appeal could run its course, courts have denied
6 motions for interlocutory appeal. *See, e.g., Shurance v. Planning Control Int'l, Inc.*, 839 F.2d
7 1347, 1348 (9th Cir. 1988) (denying interlocutory appeal where “an appeal probably could
8 not be completed before July, 1988, when trial is currently scheduled”).

9 **IV. CONCLUSION**

10 For the reasons stated above, the court DENIES Gibson’s Motion to Certify Order
11 for Interlocutory Appeal.

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13 **IT IS SO ORDERED.**

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16 Dated: December 29, 2016



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18 DEAN D. PREGERSON
19 UNITED STATES DISTRICT JUDGE
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