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UNITED STATES DISTRICT COURT
 SOUTHERN DISTRICT OF CALIFORNIA

H.I.S.C., INC. and DEPALMA
 ENTERPRISES, INC.,
 Plaintiff,

Case No.: 3:16-cv-00480-BEN-WVG

v.
 FRANMAR INTERNATIONAL
 IMPORTERS, LTD. et al.,
 Defendants.

ORDER:

**(1) GRANTING IN PART AND
 DENYING IN PART
 PLAINTIFFS' PARTIAL
 MOTION FOR SUMMARY
 JUDGMENT;**

FRANMAR INTERNATIONAL
 IMPORTERS, LTD.,
 Counterclaimant,

**(2) DENYING PLAINTIFFS'
 DAUBERT MOTIONS**

[Docket Nos. 99, 102, 103]

v.
 H.I.S.C., INC. and DEPALMA
 ENTERPRISES, INC.,
 Counterclaim Defendants.

Plaintiffs H.I.S.C., Inc. and DePalma Enterprises, Inc. move for partial summary judgment and to exclude from consideration the testimony of two experts under *Daubert*. Docket Nos. 99, 102, 103. For the reasons that follow, Plaintiffs' motion for partial

1 summary judgment is **GRANTED IN PART AND DENIED IN PART**. Plaintiffs'
2 *Daubert* motions are **DENIED as moot**.

3 I. BACKGROUND¹

4 This case is about an intellectual property dispute between Plaintiffs H.I.S.C., Inc.
5 and DePalma Enterprises, Inc. and Defendants Franmar International Importers, Ltd.,
6 Maria Rajanayagam, and Ravi Industries, Ltd. The dispute primarily concerns
7 Defendants' alleged trade dress rights to an outdoor "garden broom."

8 Maria Rajanayagam owns and operates the Canadian company, Franmar, which
9 sells an outdoor garden broom called "The Original Garden Broom" (the "Original
10 Broom"). Sri Lankan company Ravi Industries manufactures the outdoor brooms sold by
11 Franmar. From approximately February 2012 through July 25, 2012, Plaintiffs purchased
12 the Original Broom from Franmar and Rajanayagam. Under the business name,
13 "Ultimate Innovations," Plaintiffs sold the Original Broom to its customers in the United
14 States, including to its customers at garden shows and QVC. However, on or about July
15 25, 2012, Defendants advised that they were terminating all sales of the Original Broom
16 to Plaintiffs. In turn, Plaintiffs sold off the remainder of the brooms purchased from
17 Defendants. Plaintiffs then found an alternative source for the garden broom, branded the
18 broom "The Ultimate Garden Broom," and obtained federal trademark protection for the
19 name.

20 Around August 24, 2015, Defendants' counsel sent a letter to Plaintiffs' customer,
21 QVC, stating that Ravi owned the exclusive patent for the Original Broom and that
22 Franmar was the exclusive distributor of the Original Broom in North America. On
23 September 1, 2015, Defendants' counsel sent a letter to Plaintiffs' counsel demanding
24

25
26 ¹ The following overview of the facts is drawn from the relevant admissible
27 evidence submitted by the parties. The Court's reference to certain pieces of evidence is
28 not an indication that it is the only pertinent evidence relied on or considered. The Court
has reviewed and considered all of the relevant admissible evidence submitted by the
parties.

1 that Plaintiffs “cease and desist any further infringement of Franmar’s exclusive rights to
2 its intellectual property, including, without limitation, The Original Garden Broom . . .
3 and all associated patents, copyrights, trademarks, trade dress, good will and
4 marketing/advertising ideas.” Docket No. 1-8, p. 1. The parties exchanged additional
5 letters expressing their disagreement about the alleged violations of Franmar’s
6 intellectual property. Ultimately, Plaintiffs filed the present lawsuit against Defendants
7 Franmar International Importers, Ltd., Maria Rajanayagam, and Ravi Industries, Ltd.,
8 asserting numerous claims for declaratory judgment related to patent, copyright,
9 trademark, and trade dress rights for the outdoor broom, among other claims. Defendant-
10 Counterclaimant Franmar then counterclaimed for trade dress infringement and unfair
11 competition. On April 4, 2018, the Court entered default judgment against Ravi.²
12 Docket Nos. 52, 75, and 76.

13 Plaintiffs move for summary judgment on Counts I, II, III, IV, and V of their
14 Complaint and on Defendant-Counterclaimant Franmar International Importers, Ltd.’s
15 Counterclaims I, II, III, and IV. In their opposition to Plaintiffs’ motion, Defendants
16 concede they “do not assert rights to the ‘664 patent, any copyright, or trademark in the
17 name the ‘Original Garden Broom’” and thus, do not oppose Plaintiffs’ motion for
18 summary judgment on Counts I-IV. Docket No. 105, p. 5. Thus, summary judgment is
19 **GRANTED** in favor of Plaintiffs on Counts I, II, III, and IV of their Complaint.

20 Accordingly, the Court turns to the remaining claims at issue in the present motion:

- 21 (1) **Plaintiffs’ Count V** for Declaratory Judgment that Defendants’ trade
22 dress is unenforceable and that Plaintiffs have not infringed and are not
23 infringing upon Defendants’ trade dress;
- 24 (2) **Franmar’s Counterclaim I** for Unfair Competition: Trade Dress
25 Infringement under 15 U.S.C. § 1125(a);
- 26 (3) **Franmar’s Counterclaim II** for Unfair Competition under 15 U.S.C. §
27 1125(a);

28 ² Accordingly, for simplicity, the Court uses “Defendants” throughout to refer only
to Defendants Franmar and Rajanayagam.

- 1 (4) **Franmar's Counterclaim III** for Common Law Unfair Competition;
2 and
3 (5) **Franmar's Counterclaim IV** for Unfair Competition under California
4 Business and Professions Code §§ 17200, *et seq.*³

5 II. LEGAL STANDARD

6 Summary judgment on a claim is appropriate "if the movant shows that there is no
7 genuine dispute as to any material fact and the movant is entitled to judgment as a matter
8 of law." Fed. R. Civ. P. 56(a). To prevail on summary judgment, the moving party must
9 show the absence of a genuine issue of material fact with respect to an essential element
10 of the non-moving party's claim. *See Celotex Corp. v. Catrett*, 477 U.S. 317, 323 (1986).
11 Once the movant has made that showing, the burden then shifts to the party opposing
12 summary judgment to identify "specific facts showing there is a genuine issue for trial."
13 *Id.* The party opposing summary judgment must then present affirmative evidence from
14 which a jury could return a verdict in that party's favor. *Anderson v. Liberty Lobby*, 477
15 U.S. 242, 257 (1986).

16 III. DISCUSSION

17 At its core, the present motion for summary judgment concerns the alleged trade
18 dress of Defendants' Original Garden Broom (the "Original Broom"). "Trade dress
19 involves the total image of a product and may include features such as size, shape, color,
20 color combinations, texture, or graphics." *Vision Sports, Inc. v. Melville Corp.*, 888 F.2d
21 609, 613 (9th Cir. 1989). The parties agree on the components of the alleged trade dress
22 at issue here: the Original Broom's ornate weaving, wide-fan appearance, coconut shell
23 atop the broom bristles, and smooth handle. *See* Defendants' Opposition, p. 7 and
24 Plaintiffs' Reply, p. 5.

25
26 ³ The Court does not address, and Plaintiffs did not move for summary judgment
27 on their two state law claims: Count VI for Unfair Competition in violation of California
28 Business and Professions Code §§ 17200, *et seq.* and Count VII for Tortious Interference
with Prospective Economic Advantage.

1 To succeed on a trade dress infringement claim, the alleged claimant must show:
2 (1) the trade dress is non-functional; (2) the trade dress serves a source-identifying role,
3 either because it is “inherently distinctive” or has acquired “secondary meaning”; and (3)
4 there is a substantial likelihood of consumer confusion between the claimant’s and
5 infringer’s products. *Disc Golf Ass’n, Inc. v. Champion Discs, Inc.*, 158 F.3d 1002, 1005
6 (9th Cir. 1998). Where the trade dress at issue concerns the product’s design, however, a
7 showing of secondary meaning is required. *Wal-Mart Stores, Inc. v. Samara Bros., Inc.*,
8 529 U.S. 205 (2000). Plaintiffs challenge only the second element, requiring proof of
9 either inherent distinctiveness or secondary meaning.

10 **A. Product Design or Product Packaging**

11 As a threshold matter, the parties dispute whether Defendants must show
12 secondary meaning or may instead, show inherent distinctiveness. The answer to that
13 question turns on whether Defendants’ trade dress is product design or more akin to
14 product packaging. Plaintiffs contend the Original Broom’s trade dress constitutes
15 product design and thus, requires a showing of secondary meaning. Meanwhile,
16 Defendants argue their trade dress is akin to product packaging, which requires a showing
17 of inherent distinctiveness, not secondary meaning.

18 As support, Defendants rely primarily on *Two Pesos, Inc. v. Taco Cabana, Inc.*,
19 505 U.S. 763 (1992). That case, however, is inapposite. In *Two Pesos*, the Supreme
20 Court found certain restaurant décor to be inherently distinctive and thus, protectable,
21 without a showing of secondary meaning. Yet, in its later case, *Wal-Mart Stores, Inc. v.*
22 *Samara Bros., Inc.*, 529 U.S. 205 (2000), the Supreme Court clarified its *Two Pesos*
23 holding by analogizing the restaurant décor to “product packaging” for the restaurant’s
24 food, rather than product design. *Id.* at 215. The Supreme Court acknowledged that
25 distinguishing *Two Pesos* in such a way would “force courts to draw difficult lines
26 between product-design and product-packaging” cases, but decided “that the frequency
27 and the difficulty of having to distinguish between product design and product packaging
28 w[ould] be much less than the frequency and the difficulty of having to decide when a

1 product design is inherently distinctive.” *Id.* The Supreme Court then directed, “To the
2 extent there are close cases . . . courts should err on the side of caution and classify
3 ambiguous trade dress as product design, thereby requiring secondary meaning.” *Id.*

4 To be sure, *Wal-Mart* did not offer a bright-line test for distinguishing between
5 product packaging and design, but it did provide several illustrative examples. For
6 instance, the Supreme Court reasoned that “even the most unusual of product designs—
7 such as a cocktail shaker shaped like a penguin—is intended not to identify the source,
8 but to render the product itself more useful and more appealing.” *Id.* at 213. The trade
9 dress at issue in *Wal-Mart* also offers guidance. There, the Supreme Court found “a line
10 of spring/summer one-piece seersucker outfits decorated with appliques of hearts,
11 flowers, fruits, and the like” amounted to product design, not packaging. *See also, e.g.,*
12 *In re Slokevage*, 441 F.3d 957, 961-62 (Fed. Cir. 2006) (interpreting *Wal-Mart* and
13 holding that, where the alleged trade dress is incorporated into the product itself, it
14 amounts to product design).

15 The facts before this Court do not present a “close case[.]” between product design
16 and product packaging, and even if they did, the Court heeds *Wal-Mart*’s guidance to err
17 on the side of classifying trade dress as product design. *See id.* Contrary to Defendants’
18 contentions, the trade dress at issue here is not akin to a fancy bottle containing a bath
19 product, *see In re Creative Beauty Innovations, Inc.*, 56 U.S.P.Q.2d (BNA) 1203, 2000
20 WL 1160455 at *5 (TTAB 2000); a restaurant with distinctive décor, *see Two Pesos*, 505
21 U.S. 763; or even, a glass Coca-Cola bottle that arguably “constitute[s] packaging for
22 those consumers who drink the Coke and then discard the bottle, but may constitute the
23 product itself for those consumers who are bottle collectors,” *see Wal-Mart*, 529 U.S.
24 205. Instead, Defendants’ alleged trade dress – the ornate weaving, the wide-fan
25 appearance, the coconut shell top, and the smooth handle – are part of the broom *product*,
26 itself, not some form of disposable packaging. *Cf. e.g., Globefill Inc. v. Elements Spirits,*
27 *Inc.*, 2013 WL 12109779, at *2 (C.D. Cal. Oct. 15, 2013) (“Plaintiff’s skull-shaped bottle
28 is packaging, and the trade dress is not product design.”); *Yankee Candle Co. v.*

1 *Bridgewater Candle Co., LLC*, 259 F.3d 25, 41 (1st Cir. 2001) (“Detachable labels are a
2 classic case of product packaging, and therefore may be inherently distinctive.”);
3 *Moroccanoil, Inc. v. Marc Anthony Cosmetics, Inc.*, 57 F.Supp.3d 1203, 1222 (C.D. Cal.
4 2014) (“Moroccanoil’s trade dress is inherently distinctive because, like a Tide bottle and
5 colors, its function is identification.”).

6 Put another way, the components of the Original Broom’s alleged trade dress make
7 the broom product what it is and are “intended not to identify the source, but to render the
8 product itself more useful and more appealing.” *Wal-Mart*, 529 U.S. at 213. Thus,
9 Defendants’ trade dress features are more analogous to those *Wal-Mart* classified as
10 product design.⁴ Accordingly, this is a product design case, which can be proven only
11 through a showing of secondary meaning.⁵ *See Wal-Mart*, 529 U.S. at 216 (“In an action
12 for infringement of unregistered trade dress under § 43(a) of the Lanham Act, a product’s
13 design is distinctive, and therefore protectable, only upon a showing of secondary
14 meaning.”).

15 **B. Secondary Meaning**

16 Plaintiffs challenge whether Defendants’ Original Broom’s trade dress has
17 acquired secondary meaning. A trade dress develops secondary meaning “when, in the
18 minds of the public, the primary significance of [the trade dress] is to identify the source
19 of the product rather than the product itself.” *Wal-Mart Stores, Inc. v. Samara Bros.*, 529
20 U.S. 205, 211 (2000). To show secondary meaning, the trade dress claimant must show
21 “a mental recognition in buyers’ and potential buyers’ minds that products connected
22
23

24 ⁴ Indeed, Defendants sell the Original Broom packaged in a green wrap-around
25 label, a feature not at issue as part of their trade dress dispute but which appears to be
26 more like “packaging” than the underlying broom product, itself. *See* Docket No. 14, pp.
27 19-20, 37 (image), 39 (referring to label as packaging).

28 ⁵ Because the Court finds the Original Broom’s alleged trade dress is product
design requiring secondary meaning, the Court need not reach the parties’ alternative
arguments as to inherent distinctiveness.

1 with the [trade dress] are associated with the same source.” *Japan Telecom v. Japan*
2 *Telecom Am.*, 287 F.3d 866, 873 (9th Cir. 2002). Whether secondary meaning exists is a
3 question of fact. *Id.* at 1355.

4 A trade dress claimant may establish secondary meaning through direct and
5 circumstantial evidence. See 2 J. Thomas McCarthy, *McCarthy on Trademarks and*
6 *Unfair Competition* § 15:30 (4th ed. 2000). Direct evidence, such as consumer surveys
7 and direct consumer testimony, often provides the strongest evidence of secondary
8 meaning. *Levi Strauss & Co. v. Blue Bell, Inc.*, 778 F.2d 1352, 1358 (9th Cir. 1985);
9 *Vision Sports, Inc. v. Melville Corp.*, 888 F.2d 609, 615 (9th Cir. 1989).

10 Plaintiffs argue the Original Broom’s trade dress lacks secondary meaning by
11 relying exclusively on Dr. Jacqueline Chorn’s expert report, which interprets the results
12 of a consumer survey she conducted. Because the expert report is not admissible,
13 however, the Court cannot consider the report in evaluating the present motion. See Fed.
14 R. Civ. P. 56(c)(4) (“An affidavit or declaration used to support or oppose a motion must
15 be made on personal knowledge, set out facts that would be admissible in evidence, and
16 show that the affiant or declarant is competent to testify on the matters stated.”).

17 The expert report fails to comply with Federal Rule of Civil Procedure 56(c)(4) in
18 several material respects: it does not contain Dr. Chorn’s signature under penalty of
19 perjury, and it does not contain her attestation that she is competent to testify to the
20 report’s conclusions and opinions. Nor is the report accompanied by any separate sworn
21 declaration by Dr. Chorn. Instead, Plaintiffs attach to the report only Plaintiffs’ counsel’s
22 expert witness disclosure. Expert disclosures signed under penalty of perjury by a party’s
23 attorney, however, do not satisfy the “functional concerns” of Federal Rule of Civil
24 Procedure 56(c)(4) – that Dr. Chorn is competent to testify to the conclusions and
25 opinions in the report. Cf. *Am. Federation of Musicians of United States and Canada v.*
26 *Paramount Pictures Corp.*, 2017 WL 4290742 (9th Cir. Sep. 10, 2018) (finding an
27 unsworn expert report accompanied by the expert’s sworn declaration satisfied the
28 functional concerns behind Rule 56(c)(4)).

1 Moreover, the Court has reviewed other courts' decisions on similar facts and
2 remains unconvinced that the unsworn expert report at hand qualifies for an exception or
3 some form of lesser admissibility standard. Of those courts that accepted unsworn expert
4 reports, the expert reports at issue otherwise still met the requirements under Rule 56(c).
5 For example, in *Single Chip Systems Corp. v. Intermec IP Corp.*, 2006 WL 4660129
6 (S.D. Cal. Nov. 6, 2006), the Court admitted unsworn expert reports where the reports
7 stated in their introductions "that the contents were made on personal knowledge, that the
8 facts would be admissible in evidence, and that the affiants [we]re competent to testify to
9 the information contained herein." *Id.* at *6. Dr. Chorn's report does not so state. *See*
10 Exhibit K.

11 Further, Plaintiffs do not offer Dr. Chorn's report to show a *dispute* of fact.
12 Rather, as the moving party, they offer the report to show the absence of any dispute of
13 fact and their entitlement to judgment as a matter of law. Because Plaintiffs are the
14 moving party, shouldering the burden on summary judgment, Plaintiffs' evidence is held
15 to a slightly higher standard than that of the non-movant. *See Competitive Technologies,*
16 *Inc. v. Fujitsu Ltd.*, 333 F. Supp. 2d 858 (N.D. Cal. 2004) (noting that the non-movant's
17 expert report submitted in opposition to summary judgment is subject to "less exacting
18 standards" than a moving party's affidavit); *see also Shinabarger v. United Aircraft*
19 *Corp.*, 262 F.Supp. 52, 56 (D. Conn. 1996) ("The existence of such a statement, although
20 not presently in evidentiary form, should alert the summary judgment court to the
21 availability at the trial of the facts contained in the statement."). Accordingly, the Court
22 cannot consider Dr. Chorn's expert report. *See also, Fowle v. C&C Cola, a Div. of ITT-*
23 *Continental Baking Co.*, 858 F.2d 59, 67 (3d Cir. 1989) (excluding expert report where
24 only plaintiff's attorney, not the expert himself, attested to the veracity of the report);
25 *Provident Life & Accident Ins. Co. v. Goel*, 274 F.3d 984, 1000 (5th Cir. 2001)
26 (excluding unsworn expert report).

27 Because Plaintiffs have not offered any admissible evidence showing a lack of
28 secondary meaning, the burden cannot shift to Defendants to identify "specific facts

1 showing there is a genuine issue for trial.” *Celotex Corp. v. Catrett*, 477 U.S. 317, 323
2 (1986). Accordingly, the Court need not turn to Defendants’ evidence.⁶ Plaintiffs’
3 motion for summary judgment on Count V is **DENIED**.

4 **C. Franmar’s Counterclaims**

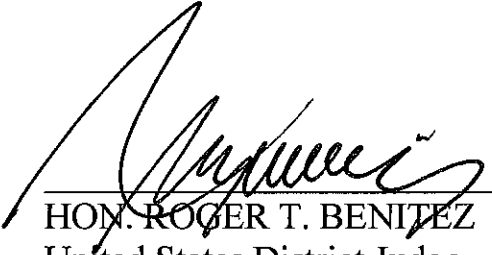
5 Plaintiffs additionally move for summary judgment on Franmar’s Counterclaims I-
6 IV. In support, Plaintiffs argue only that all of Franmar’s counterclaims “rest upon its
7 allegations of trade dress infringement,” for which Plaintiffs contend judgment as a
8 matter of law is warranted. Plaintiffs’ Memorandum in Support, p. 21. Because the
9 Court has denied summary judgment on Defendants’ trade dress rights (Count V),
10 Plaintiffs have not shown as a matter of law that they are entitled to summary judgment
11 on Franmar’s counterclaims. Accordingly, summary judgment is **DENIED** on
12 Counterclaims I, II, III, and IV.

13 **IV. CONCLUSION**

14 For the reasons set forth above, Plaintiffs’ motion for partial summary judgment is
15 **GRANTED IN PART AND DENIED IN PART**. Specifically, summary judgment is
16 **GRANTED** in favor of Plaintiffs on Counts I, II, III, and IV of their Complaint.
17 Summary judgment is **DENIED** as to Plaintiff’s Count V and Defendant-
18 Counterclaimant Franmar International Importers, Ltd.’s Counterclaims I, II, III, and IV.
19 Finally, Plaintiffs’ *Daubert* motions are **DENIED as moot**.

20 **IT IS SO ORDERED.**

21
22 DATED: October 10, 2018

23 
24 _____
25 HON. ROGER T. BENITEZ
26 United States District Judge

27 ⁶ The Court acknowledges that the parties filed numerous evidentiary objections,
28 Docket Nos. 107, 116, 117, 119, 122. Because Plaintiffs have not carried their initial
burden to show they are entitled to judgment as a matter of law, the evidentiary
objections are **OVERRULED as moot**. Likewise, Defendants’ *Daubert* motions,
Docket Nos. 102 and 103, are **DENIED as moot** without prejudice.