

UNITED STATES DISTRICT COURT
SOUTHERN DISTRICT OF NEW YORK

J.T. COLBY & COMPANY, INC. d/b/a/)
 BRICKTOWER PRESS, J. BOYLSTON &)
 COMPANY, PUBLISHERS LLC and)
 IPICTUREBOOKS LLC,)
)
 Plaintiffs,)
)
 -against-)
)
 APPLE INC.,)
)
 Defendant.)

Case No. 11 Civ. 4060 (DLC)

**MEMORANDUM OF LAW IN SUPPORT OF PLAINTIFFS' MOTION TO EXCLUDE
THE TESTIMONY, INCLUDING AFFIDAVITS, DECLARATIONS, AND REPORTS,
OF DEFENDANT'S EXPERT WITNESS GREGORY S. CARPENTER**

ALLEGAERT BERGER & VOGEL LLP
111 Broadway, 20th Floor
New York, NY 10006
(212) 571-0550

TABLE OF CONTENTS

	<u>Page</u>
PRELIMINARY STATEMENT	1
ARGUMENT	3
I. THE COURT SHOULD PRECLUDE CARPENTER FROM SERVING AS AN EXPERT BECAUSE HE IS NOT QUALIFIED	4
A. Carpenter Is Not An Expert In Book Publishing Or Book Marketing.....	4
B. Carpenter Is Not An Expert In Trademark Law	9
CONCLUSION.....	12

TABLE OF AUTHORITIES

Page

Cases

Alfa Corp. v. OAO Alfa Bank,
475 F. Supp. 2d 357 (S.D.N.Y. 2007).....8

Baker v. Urban Outfitters, Inc.,
254 F. Supp. 2d 346 (S.D.N.Y. 2003).....4

Daubert v. Merrell Dow Pharmaceuticals, Inc.,
509 U.S. 579 (1993).....3, 10

Gen. Elec. Co. v. Joiner,
522 U.S. 136 (1997).....3

Kumho Tire Co., Ltd. v. Carmichael,
526 U.S. 137 (1999).....3, 4

Nimely v. City of New York,
414 F.3d 381 (2d Cir. 2005).....4, 10

Perfect Fit Industries, Inc. v. Acme Quilting Co., Inc.,
618 F.2d 950 (2d Cir. 1980).....10

Price v. Fox Entm't Group,
499 F. Supp. 2d 382 (S.D.N.Y. 2007).....11

Ralston v. Smith & Nephew Richards, Inc.,
275 F.3d 965 (10th Cir. 2001)11

Stagl v. Delta Air Lines, Inc.,
117 F.3d 76 (2d Cir. 1997).....4, 8

United States v. Tin Yat Chin,
371 F.3d 31 (2d Cir. 2004).....4, 8

Statutes

Fed. R. Evid. 4013

Fed. R. Evid. 4023

Fed. R. Evid. 4033, 10

Fed. R. Evid. 7023, 4, 7, 8, 10

Miscellaneous

J. Thomas McCarthy,
McCarthy on Trademarks and Unfair Competition § 18:210

Plaintiffs J.T. Colby & Company, Inc. d/b/a Bricktower Press, J. Boylston & Company, Publishers LLC and iPicturebooks, LLC (collectively, “Colby”) submit this memorandum of law in support of their motion to exclude the testimony of Gregory S. Carpenter (“Carpenter”), including any affidavits, declarations, or reports proffered by Defendant Apple Inc. (“Apple”) for all purposes, including trial.

PRELIMINARY STATEMENT

In his first report (the “Report” or “Carpenter Rep.”),¹ Carpenter seeks to offer an expert opinion on “the strength of IBOOKS and IPICTUREBOOKS imprints and, from a marketing perspective, the likelihood of confusion of those alleged marks with Apple’s IBOOKS mark.” (Carpenter Rep. ¶ 7.) In addition, in a second report (“Rebuttal” or “Carpenter Rbt.,” and collectively with the Report, “Reports”), Carpenter seeks to offer an opinion rebutting the expert report of Robert T. Scherer—a former PTO examiner and trademark lawyer—by commenting on the transfer of goodwill in Family System’s iBook mark to Apple and whether Colby’s ibooks and ipicturebooks marks have acquired secondary meaning as trademarks. (Carpenter Rbt. ¶ 14.)² But Carpenter is not qualified to opine on *any* of these topics, and apparently made no effort to educate himself on either book publishing or trademark law before submitting his Reports. As a result, his Reports amount to nothing more than irrelevant musings.

Carpenter’s own testimony demonstrates why he is not qualified to present any of his “expert” opinions in this case. *First*, as Carpenter admitted, a marketing expert must account for the fact that “particular [marketing] strategies that are effective vary from context to context.”

¹ See Declaration of Claudia T. Bogdanos in Support of Plaintiffs’ Motion to Exclude the Testimony of Defendant’s Expert Witness Gregory S. Carpenter, dated December 21, 2012 (“Bogdanos Decl.”), Ex. A.

² Bogdanos Decl., Ex. B.

(Deposition of Gregory S. Carpenter, dated November 21, 2012 (“Carpenter Tr.”), 7:23-8:6.)³

Carpenter further explained:

What works in automobiles is different than what might work for some brands, in coffee, for example. So you need to understand those differences, the meaningful dimensions of those differences to make recommendations about what works and what wouldn’t work. . . .

(*Id.* 8:6-12.) Carpenter’s own words demonstrate that his report and testimony should be excluded. Carpenter has no experience in, and fundamentally *misunderstands*, marketing practices in the book-publishing industry—though the publishing industry is the particular “context” in which Colby markets and sells its products. He has never worked in the publishing industry (*id.* 9:8-18), he has never been a consultant for a publishing company (*id.*), and he did not review any books, articles, or reports relating to the publishing industry in preparing his Report in this case (Carpenter Rep., App’x B). Probably because of his total lack of knowledge about marketing in the relevant context, Carpenter’s Report contains *no* discussion or analysis of the book-publishing industry—analysis which he admitted is necessary in order for him to provide a relevant expert opinion here. (Carpenter Tr. 9:2-7.) Thus, for the reasons he himself espoused, Carpenter fails to qualify as an expert in this case because he has no expertise in the book-publishing industry, and he has submitted no evidence showing that he understands the “the meaningful dimensions” of the differences between publishing and other industries sufficient to “make recommendations about what works and what wouldn’t work.” (*Id.* 8:6-12.) For this reason, his Report and testimony should be excluded.

Second, Carpenter is supremely unqualified to opine on any matters of trademark law because: (1) he is not a lawyer, (2) he has never published any articles on trademark law, (3) he has never conducted a likelihood of confusion survey, and (4) he does not appear to have read

³ Bogdanos Decl., Ex. C.

any articles on trademark assignments in preparing either of his Reports. (Carpenter Tr. 98:14-17, 98:22-99:4; Carpenter Rep., App’x B; Carpenter Rbt. ¶ 7.) Yet the entirety of his Rebuttal, and segments of his Report, are fundamentally premised on his lay, untutored legal opinions—for example, whether confusion is likely under trademark law or whether a trademark has been validly assigned.

At base, Carpenter is not qualified as an expert and his opinions are unreliable, irrelevant, and should not form part of the record evidence in this case. *See* Fed. R. Evid. 401, 402, 403, 702 (respectively, “Rule 401,” “Rule 402,” “Rule 403” and “Rule 702”).

ARGUMENT

The Supreme Court has exhorted trial courts to scrutinize expert testimony and to exclude unreliable expert evidence. *Kumho Tire Co., Ltd. v. Carmichael*, 526 U.S. 137, 147-49 (1999); *Gen. Elec. Co. v. Joiner*, 522 U.S. 136, 142 (1997). Under *Daubert v. Merrell Dow Pharmaceuticals, Inc.*, 509 U.S. 579 (1993), district courts must act as “gatekeepers” with respect to expert testimony in order to ensure that speculative or unreliable expert testimony does not reach the finder of fact. The guidelines from *Daubert* are equally applicable to all expert testimony, including that based on scientific, technical, or other specialized knowledge. *See Kumho Tire*, 526 U.S. at 147-49.

Under Rule 702, a witness may testify in the form of an opinion regarding technical or other specialized knowledge when such knowledge will “help the trier of fact to understand the evidence or determine a fact in issue,” if the witness is “qualified as an expert by knowledge, skill, experience, training, or education,” and if: (1) the testimony is based on sufficient facts or data; (2) the testimony is the product of reliable principles and methods; and (3) the expert has reliably applied the principles and methods to the facts of the case. Rule 702. These determinations are case-specific, and a court acting as a gatekeeper must determine whether the

proposed expert has “sufficient specialized knowledge to assist the jurors in deciding the particular issues in the case.” *Kumho Tire Co.*, 529 U.S. 137, 156 (internal quotation marks omitted).

As part of this “gatekeeping” role, courts must weed out proposed expert witnesses who are not qualified as an expert, including proposed experts whose skill, education, or experience lies in an area different from or more general than the subject matter of the proffered testimony. *See* Rule 702; *United States v. Tin Yat Chin*, 371 F.3d 31, 40 (2d Cir. 2004); *Stagl v. Delta Air Lines, Inc.*, 117 F.3d 76, 81 (2d Cir. 1997). In so doing, courts recognize that merely “because a witness qualifies as an expert with respect to certain matters or areas of knowledge, it by no means follows that he or she is qualified to express expert opinions as to other fields.” *Nimely v. City of New York*, 414 F.3d 381, 399 n. 13 (2d Cir. 2005). And the proponent of expert evidence bears the burden of showing its admissibility by a preponderance of the evidence. *Baker v. Urban Outfitters, Inc.*, 254 F. Supp. 2d 346, 353 (S.D.N.Y. 2003).

Under these standards, Carpenter’s testimony, including both Reports, must be excluded. While Carpenter may be a self-proclaimed expert in marketing, he is also admittedly without any expertise in or knowledge of the book-publishing industry, nor is he a trademark lawyer or an expert in likelihood of confusion surveys. Therefore, this Court should exclude all of Carpenter’s submissions and preclude him from testifying in this matter.

I. THE COURT SHOULD PRECLUDE CARPENTER FROM SERVING AS AN EXPERT BECAUSE HE IS NOT QUALIFIED

A. Carpenter Is Not An Expert In Book Publishing Or Book Marketing

While Carpenter may be a professor of marketing strategy, he is *not* an expert in book publishing, nor does he have even a basic understanding of the book-publishing industry, where marketing strategies and steps differ fundamentally from those in other fields—thus, he is not

qualified to opine on the adequacy of Colby's marketing strategy, the strength of Colby's imprints, or any likelihood of confusion arising therefrom. As Carpenter recognizes, marketing strategies are context-driven, and in order to provide an opinion with respect to activities in the book-publishing industry, one must be "aware of the context and understand some of the tickers." (Carpenter Tr. 7:5-6, 8:4-12.)

Nothing in Carpenter's Reports, however, suggests either that Carpenter has any background that would give him the necessary understanding of the "meaningful dimensions" of book publishing (Carpenter Tr. 8:6-12), or that he has done any work in conjunction with his Reports to learn about the industry. In his Report, for example, Carpenter lists previous clients for whom he provided "consulting and executive education on marketing strategy and branding issues," such as Coca-Cola, Dow Chemical, and Harley Davidson.⁴ (Carpenter Rep. ¶ 4.) His list is entirely devoid of entities even tangentially associated with book publishing.⁵ Just as marketing expertise in cars does not translate to marketing expertise in coffee, Carpenter offers no basis for his opinion that his experience in the marketing of soft drinks and cruise lines has any relevance to marketing in book publishing. Without such a foundation, he cannot profess to

⁴ He also lists Carnival Corporation, Cunard Lines, Government of Mexico, and General Electric, as well as indicating that he served as a member of the advisory boards of Terlato Wine Group and Hamilton Consulting. (Carpenter Rep. ¶ 4.)

⁵ During his deposition, Carpenter also claimed to have provided "executive seminars for people in magazine publishing and media and related businesses and many businesses that have characteristics associated with book publishing." (Carpenter Tr. 9:14-18.) Not only did Carpenter fail to mention these alleged seminars or any of the supposedly relevant companies in his Report (*id.* 9:19-10:10), he also failed to connect any of his analysis to this alleged experience, and did not even assert that his analysis was based on it. Moreover, Carpenter did not provide the names of any of these companies or any other specific substantive information when asked about these alleged seminars at his deposition, even though his Report did include the names of various companies, unrelated to the publishing industry, to which Carpenter had provided "consulting in executive education." (*Id.* 10:12-12:11.)

“understand [the] differences” (or even be aware that differences may or may not exist). (Carpenter Tr. 8:6-12.)

Carpenter’s *only* claimed experience in the book-publishing industry has been through his involvement as an editor of or contributor to academic books (unrelated to the publishing industry) and/or journals (unrelated to the publishing industry) and as a reviewer of such books and journals. (*Id.* 44:23-45:4.) And his only experience in marketing books has been “in thinking about marketing [his] own books that [he has] edited.” (*Id.* 45:5-9.) These experiences of course cannot qualify Carpenter as a marketing expert in the book-publishing industry—if such general experience sufficed, every published academic, from a musicologist to a botanist, would be qualified to provide expert testimony on marketing in the book-publishing industry. Further, in preparing his report and testimony, Carpenter utterly failed to mitigate his lack of experience and knowledge by educating himself about the book publishing industry: his list of materials reviewed in conjunction with the preparation of his Report, although full of articles relating to Apple, does not contain a single publication relating to book-publishing. (Carpenter Rep., App’x B.) In short, Carpenter lacks the very qualifications he concedes he needs.

Not only does Carpenter lack experience in and knowledge of the publishing industry, he fundamentally misunderstands its most crucial aspects. For example, he does not mention a *single imprint* in his Report, instead comparing Colby’s ibooks/iBooks imprint to massive publishing houses. (Carpenter Rep. ¶ 21; Carpenter Tr. 28:5-30:5.) Carpenter has further claimed that an imprint is a publishing label used “to denote the publisher of the book,” (Carpenter Tr. 21:25-22:8.), and admits that he does not understand “the distinction . . . between the imprint and the publisher.” (*Id.* 24:12-26:16.) But imprints *are* distinct from publishers—imprints denote teams of editors and marketers *within* a publishing house, and are a crucial part

of multi-level branding in the book industry. (See Expert Report of Mike Shatzkin (“Shatzkin Rep.”), at 4.)⁶ This distinction is critical in this case, where Colby’s mark denotes a small niche imprint, not a large, general publishing house.

Given Carpenter’s lack of basic understanding of the publishing industry, it is no surprise that he is also unfamiliar with “niche imprints” like Colby’s (Carpenter Tr. 33:11-34:16), and is unable to grasp that niche imprints rely on a different type of consumer recognition than do general publishing houses. (See *id.* 17:11-20 (agreeing that “[a]ll marketing principles are applicable to all industries”); Shatzkin Rep. 4-5.) Indeed, Colby’s expert witness Mike Shatzkin, a marketer with over 50 years of experience in the book industry, has explained that imprints, rather than large publishing houses, offer a “consistency of . . . content experience” that “buil[ds] brand awareness.” (*Id.* at 5.) “[P]articularly compared to a big general publisher, [an imprint’s] specialization in a genre” that is characterized by repeat purchasers “suggests the potential for a core audience that would recognize it as a publishing specialist.” (*Id.*) If Carpenter does not understand what niche imprints are nor how they build awareness, he cannot possibly help the jury understand whether Colby has built awareness for its niche imprint. See Rule 702.

Further, because Carpenter’s Report was prepared without an understanding of the book publishing industry, it is utterly devoid of analysis of that industry. It consists of an assortment of general marketing principles illustrated through brand examples—Lays, Starbucks, Godiva, Costco, Wal-Mart, Nordstrom, Honda, Harley-Davidson, OREO cookies—that have no connection at all to publishing brands of any sort. Carpenter does not acknowledge (let alone explain) the differences between marketing these consumption brands (*i.e.*, potato chips) and publishing imprints. (Carpenter Rep. ¶¶ 12, 13, 16, 17, 83.) Nor does he make any attempt to

⁶ Bogdanos Decl., Ex. D.

analyze or explain the book-publishing industry before attempting to apply his general marketing “principles” to it—the Report does not mention any marketing strategies employed by book publishers to develop consumer recognition of certain imprints, or any discussion at all of marketing strategy specific to the book-publishing world.⁷ Yet Carpenter himself admitted that, in order for him to provide an opinion on marketing in a particular industry, he must first analyze that industry. (Carpenter Tr. 9:3-7.)

Carpenter’s Report and testimony merely assumes a one-size-fits-all marketing approach, notwithstanding his own assertion that to properly assess a marketing strategy, one must account for the specific “context” and the “differences” across industries. Because Carpenter offers *zero* indicia that his opinions have any relevance in book publishing, and in fact has demonstrated that he misunderstands the industry, his testimony is inherently unreliable and should be excluded. *See* Rule 702; *Tin Yat Chin*, 371 F.3d at 40 (expert’s area of expertise must be comparable to the subject matter of the testimony); *Stagl*, 117 F.3d at 81 (even relevant testimony must be excluded if the witness’s “expertise is too general or too deficient”); *Alfa Corp. v. OAO Alfa Bank*, 475 F. Supp. 2d 357, 364-66 (S.D.N.Y. 2007) (allowing expert to opine on brand identity in the insurance industry based on his over 30 years of experience as a marketer *in the industry in question*).

⁷ Carpenter does make passing reference, in a *single* paragraph, to “fragmentation of the publishing industry” and the “limited resources of publishers.” (Carpenter Rep. ¶ 21.) However, he offers no expert foundation for this industry-specific knowledge. And while Carpenter claims that there are only “six relatively well-known” publishers, the source upon which he relies merely calls these publishers “conglomerates,” and also identifies **3,400** medium-sized publishers and **86,000** small publishers. (*See id.* ¶ 21 n. 4; “Book Industry Statistics,” *Dan Poynter’s Parapublishing.com*, <http://www.bookstatistics.com/sites/para/resources/statistics.cfm> (last visited Dec. 19, 2012).) In any event, even in this meager paragraph, Carpenter makes no mention of the relevant issue for which he is offered—*i.e.*, the *marketing* of books—highlighting that he has no expertise sufficient for his opinions to be helpful to a finder of fact. *See* Rule 702.

B. Carpenter Is Not An Expert In Trademark Law

As a separate matter, Carpenter professes to opine on: (1) the transfer of goodwill from Family Systems to Apple; (2) secondary meaning achieved by Colby's ibooks imprint; and (3) likelihood of confusion. (Carpenter Rep. ¶ 9; Carpenter Rbt. ¶¶ 14-19.) However, as Carpenter concedes, he is unqualified to opine on any of these matters and should be precluded from doing so.

There is no doubt that Carpenter has no background in trademark law:

- He is not a lawyer. (Carpenter Tr. 98:14-17.)
- He has never published any articles on the subject of trademark law. (*Id.* 98:22-24.)
- He has never conducted a consumer survey designed to show likelihood of confusion. (*Id.* 98:25-99:9.)
- He does not hold any advanced degrees in consumer psychology. (*Id.* 99:5-9.)

Nonetheless, despite his having absolutely zero credentials in this field, Carpenter's Reports are replete with conclusions premised upon trademark law. For example, Section IV.F of Carpenter's Report is entitled "Alleged Confusion" and includes statements such as "these e-mails do not support Plaintiffs' claims that consumers are likely to believe that Apple is the source of Plaintiffs' products," and "the likelihood of confusion is extremely low." (Carpenter Rep. ¶¶ 110, 116.) However, when asked about whether he was familiar with the concept of confusion by affiliation in trademark law, and whether he had applied it in his Report, Carpenter answered that he'd "heard the term before," but he used "the word 'confusion,' . . . not 'confusion by affiliation,'" and was simply describing his view that the writers of certain emails "were not confused." (Carpenter Tr. 103:4-11, 103:21-104:3.) Not only does this highlight that Carpenter is (to put it generously) unclear on the basics of trademark law, but it also

demonstrates that his “opinions” are no different from those of a layperson. The finder of fact in this case is just as able to read emails and arrive at her own conclusions as to the state of mind of the author.

Nor has Carpenter conducted a survey or study to measure likelihood of confusion and on which he could base his conclusions. Because Carpenter’s expressions of opinions such as these are not based on any specialized knowledge or scientific study, and so in no way aid the finder of fact, such testimony must be excluded. Rules 403, 702; *Nimely*, 414 F.3d at 396-97 (“[W]hen an expert opinion is based on data, methodology, or studies that are simply inadequate to support conclusions reached, *Daubert* and Rule 702 mandate the exclusion of that unreliable opinion testimony.”) (internal quotations and citations omitted).

Similarly, Carpenter’s entire Rebuttal consists of opinions on legal issues for which he has no qualifications—namely assignment of the goodwill associated with Family System’s trademark and development of secondary meaning in Colby’s imprints. *See, e.g.*, 3 J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition* § 18:2 (noting that the Lanham Act’s prohibition on naked trademark assignment derives from the common law); *Perfect Fit Industries, Inc. v. Acme Quilting Co., Inc.*, 618 F.2d 950, 952-53 (2d Cir. 1980) (secondary meaning is a trademark doctrine). It is telling that Apple’s proposed rebuttal expert to the opinions offered by Plaintiffs’ expert Robert T. Scherer—a trademark lawyer and former PTO examiner with over 30 years of experience—is Carpenter, a marketing expert with *zero* trademark or legal experience.⁸ Although Carpenter claims that he approaches these topics from a “marketing perspective,” (Carpenter Tr. 135:13-17), these are, at base, legal issues, and

⁸ This is even more curious given that Apple has submitted expert reports relating to other issues in the case from two acknowledged experts in trademark law, Philip G. Hampton and Siegrun Kane, both of whom tellingly do not offer opinions about the assignment in gross specific to the facts of this case, even though they opined on other matters.

Carpenter’s deposition testimony makes clear that his opinions are, at best, uninformed and meaningless, and at worst, likely to confuse. For example, when asked to explain what marketing has to do with the validity of a trademark assignment, Carpenter answers:

Well, as I understand it, and not being a lawyer, that one of the issues in this trademark assignment is the transfer of what . . . legally what is known as “goodwill.” In the marketing world, we don’t refer to it as “goodwill,” but we have a corresponding term for this entitled “brand equity,” . . . and so I was asked to look and see whether Apple engaged in activities which transferred the brand equity from Family Systems to Apple. . . .

(Carpenter Tr. 135: 21-136:12.)

Carpenter’s answer perfectly demonstrates his lack of qualifications to opine on legal issues. First, he admits that the concept at issue is a legal concept. Then, without any support, he equates this legal concept (with which he has no expertise) to a marketing concept.⁹ Finally, he purports to have explored this marketing concept in order to arrive at a *conclusion as to the legal concept with which he admittedly has no familiarity*.

Because Carpenter’s entire Rebuttal, as well as large sections of his Report, are similarly baseless opinion on trademark-law concepts on which he has no expertise, Carpenter must be precluded from testifying as an expert on any facet of trademark law, including likelihood of confusion, secondary meaning, and validity of assignment. *See, e.g., Price v. Fox Entm’t Group*, 499 F. Supp. 2d 382, 389 (S.D.N.Y. 2007) (excluding expert’s report where expert had opined on principles of copyright law, but had admitted at deposition that he did not understand the meaning of those principles); *see also Ralston v. Smith & Nephew Richards, Inc.*, 275 F.3d

⁹ This is something of a Catch-22. Without knowledge of the legal concept, how could Carpenter know what the marketing corollary would be? And if he was indeed knowledgeable enough about trademark law to understand terms of art such as “goodwill” and transfer this into corresponding marketing-speak, he would not need to opine on these matters from a “marketing perspective” in the first place.

965, 969 (10th Cir. 2001) (concluding proffered expert was not qualified on a particular topic where expert admitted that she lacked expertise on that subject).

CONCLUSION

For the foregoing reasons, the Court should exclude Carpenter's Reports and preclude Carpenter from providing any testimony, including any affidavits, declarations, or reports, for all purposes, including trial.

Dated: New York, New York
December 21, 2012

Respectfully submitted,

ALLEGAERT BERGER & VOGEL LLP

By: s/ Partha P. Chattoraj
Partha P. Chattoraj
David A. Shaiman

111 Broadway, 20th Floor
New York, New York 10006
(212) 571-0550

*Attorneys for Plaintiffs J.T. Colby & Co., Inc. d/b/a
Brick Tower Press, J. Boylston & Co., Publishers,
LLC, and ipicturebooks, LLC*

Of counsel:
Robert L. Raskopf
Claudia T. Bogdanos
QUINN EMANUEL URQUHART & SULLIVAN, LLP
51 Madison Avenue, 22nd Floor
New York, New York 10010
Telephone: (212) 849-7000
Facsimile: (212) 849-7100