Hot Trademark, Copyright and Advertising Issues in the Entertainment and Sports Industries

October 11, 2019 | 1:30 pm – 3:00 pm

Program Description

Leaders of the Intellectual Property and Advertising Law bars will examine and discuss the latest cases and hottest issues in the entertainment and sports industries including topics such as the USPTO’s recent proposal to require all foreign pro se applicants to have a U.S. attorney to file a U.S. application (including an overall discussion regarding filing strategy), the USPTO’s pilot programs to clear away dead and fraudulently obtained marks from the federal trademark registry, the USPTO’s guidelines on registerability of marks in the cannabis space, the In re Brunetti case involving registerability of “derogatory” or “scandalous” trademarks, the Rimini Street, Inc. v. Oracle USA, Inc. case clarifying the definition of “full costs” to a prevailing party in a copyright infringement case, the Fourth Estate Public Benefit Corp. v. Wall-Street.com, LLC case dealing with timeliness of copyright registrations prior to filing a lawsuit, and the EZ Pedo vs Mayclin Dental Studio case involving trade dress.

Lead Facilitator

Timothy C. Matson, Counsel, Fox Rothschild, Minneapolis, MN

Speakers

- Emeka Igbokwe, Corporate Counsel, UFC, Las Vegas, NV
- Michael Adlin, Judge, Trademark Trial and Appeal Board, Nashville, TN
- Stephen Coates, Senior Counsel, CoatesIP.Com, Inc. Seattle, WA

Program Materials

1. United States: Patent and Trademark Office: Recent TTAB and USPTO Developments, By Judge Michael Adlin, Trademark Trial and Appeal Board
2. Minneapolis Panel Slides
3. EZ Pedo, Inc v. Mayclin Dental Studio, Inc by Timothy Matson
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Recent TTAB and USPTO Developments

Judge Michael Adlin, Trademark Trial and Appeal Board
Refused under Trademark Act 2(a):
Registration is barred if the trademark:
“Consists of or comprises immoral, deceptive, or scandalous matter;...”

Mark: fuct
Standard character mark

IC 25: Athletic apparel, namely, shirts, pants, jackets, footwear, hats and caps; *Children’s and infant’s apparel*, namely, jumpers, overall sleepwear, pajamas, rompers and one-piece garments
“Two Terms ago, in *Matal v. Tam*, 582 U.S. ___ (2017), this Court invalidated the Lanham Act’s bar on the registration of ‘disparaging’ trademarks. 15 U.S.C. § 1052(a) ... Today we consider a First Amendment challenge to a neighboring provision of the Act, prohibiting the registration of ‘immoral[] or scandalous’ trademarks. *Ibid.* We hold that this provision infringes the First Amendment for the same reason: It too disfavors certain ideas.”
Brunetti

Setting the stage

The *Tam* Court disagreed over whether Lanham Act bar on disparaging marks is a condition on a government benefit or a simple restriction on speech. But all Justices agreed that: (1) if a registration bar is viewpoint-based, it is unconstitutional; and (2) the disparagement bar was viewpoint based. The problem was the Office registered marks that were positive about a person, but not derogatory.
Brunetti

USPTO and Board decision

• USPTO asks whether a substantial composite of the general public would find the mark, inter alia, “shocking to the sense of truth, decency, or propriety,” “offensive,” or “vulgar.”

• “Brunetti’s website and products contained imagery, near the mark, of ‘extreme nihilism’ and ‘anti-social’ behavior,” and therefore the mark communicated “misogyny, depravity, [and] violence.”

• Board: “Whether one considers [the mark] as a sexual term, or finds that [Brunetti] has used [the mark] in the context of extreme misogyny, nihilism or violence, we have no question but that [the term is] extremely offensive.”
Brunetti

Supreme Court decision

• Ban on “immoral” and “scandalous” marks is viewpoint based.
  • Allows registration when marks accord with, but not when they defy, society’s sense of decency or propriety.
  • USPTO has allowed registration of: SAY NO TO DRUGS—REALITY IS THE BEST TRIP IN LIFE for printed matter; JESUS DIED FOR YOU for clothing; WAR ON TERROR MEMORIAL for memorial services.
  • USPTO has denied registration of: KO KANE for beverages; MADONNA for wine; BABY AL QAEDA for t-shirts.

• Rejects Government’s argument that statutory bar could be limited to “marks that are offensive [or] shocking to a substantial segment of the public because of their mode of expression, independent of any views they may express.”
  • Effectively this would limit USPTO to refusing “vulgar,” “lewd” or “sexually explicit or profane” marks.
  • “The ‘immoral or scandalous’ bar stretches far beyond the Government’s proposed construction.”
Brunetti

Supreme Court concurring and dissenting opinions

• Alito, concurring: “Our decision does not prevent Congress from adopting a more carefully focused statute that precludes the registration of marks containing vulgar terms that play no real part in the expression of ideas.”

• Roberts would construe “scandalous” to bar “only marks that offend because of their mode of expression – marks that are obscene, vulgar, or profane.”

• Breyer would uphold “scandalous” bar, but agrees that “immoral” bar violates First Amendment.

• Sotomayor concerned with “unfortunate results” of decision. Also agrees that “immoral” bar violates First Amendment. But “scandalous” is “ambiguous” and can be read narrowly to cover “only offensive modes of expression.”
Rulemaking – U.S. counsel

U.S. counsel requirement

- New rule requires foreign-domiciled trademark applicants, registrants and parties to be represented by a U.S.-licensed attorney when filing trademark documents with the USPTO

- Rule goals:
  - Ensure effective use of available mechanisms to enforce foreign applicant compliance with statutory and regulatory requirements
  - Increase confidence that registrations that issue to foreign applicants are not subject to invalidation for reasons such as improper signatures and use claims
  - Aid our efforts to improve accuracy of the U.S. Trademark Register
Rulemaking – U.S. counsel

U.S. counsel requirement – impact on U.S.-licensed attorneys

• Must enter bar membership information
  – May be required to confirm status as active member in good standing

• Owner’s domicile address will be required
  – For individuals – permanent legal place of residence
  – For juristic entities – principal place of business (i.e. headquarters)

• Beware of foreign solicitations – persons located internationally offering to pay to use your bar information to circumvent the rule
Cannabis-related trademarks

• New exam guide released May 2, 2019
• Discusses implications of various federal laws on lawfulness of cannabidiol (“CBD”) and cannabis-related goods and services
• 2018 Farm Bill and corresponding amendments to the Controlled Substances Act (“CSA”) remove “hemp” (defined as cannabis containing less than .3% THC) from controlled substance schedules
Cannabis-related trademarks

• Marks for CBD and hemp products may still violate other laws

• Several factors considered in ex officio examination of cannabis goods/services:
  – Date of filing of application – 2018 Farm Bill effective December 20, 2019; no lawful use or bona fide intent to use in lawful commerce prior to such date
  – If goods are cannabis-derived, does cannabis meet definition of “hemp” or of “marijuana”?
  – Are goods for human or pet consumption? Food Drug and Cosmetic Act (FDCA) likely applies
Cannabis-related trademarks

- FDA has approved only one prescription drug product derived from cannabis.
  - EPIDIOLEX® - a purified form of CBD for treatment of seizure disorders
  - FDCA prohibits introduction of a new drug into interstate commerce without approval by FDA
- Neither CBD nor THC may be sold as a “dietary supplement.”
- It is unlawful to sell food or beverages to which CBD has been added.
Efforts to “declutter” register

Proof of use audit program (2012)
The USPTO began a pilot program in 2012 and made it permanent in 2017, giving the USPTO the authority to cancel audited registrations with unsubstantiated use claims or to delete unsupported goods and services.

Excluded unauthorized foreign practitioners (2015)
The commissioner has excluded specific foreign practitioners from appearing before the USPTO.

Proof of actual use in examination (2016)
Examiners have been trained about the issues posed by mocked-up and fake specimens and to use the 37 CFR §2.61(b) request for information authority to request proof of actual use when refusing registration because the specimen does not show use of the mark in commerce.
Efforts to “declutter” register

Improved readability of declaration (2017)
The declaration was reformatted to make it more readable and to make the signer acknowledge the required statements by checking a box next to each one, thereby increasing the likelihood that the signer will read the declaration and appreciate the significance of swearing to use for each and every good or service listed.

Expedited cancellation pilot for non-use or abandonment claims (2018) Implemented TTAB pilot program for cases raising non-use or abandonment claims to identify the types of procedures needed to accelerate disposition of those claims; considering whether to make permanent.

Issued U.S. counsel final rule (July 2, 2019)
The USPTO issued a final rule, effective August 3, 2019, to require all foreign-domiciled trademark applicants and registrants to be represented before the USPTO by a lawyer licensed to practice law in the U.S.
Decluttering initiative: proof-of-use audit program

• Permanent program launched November 1, 2017
• Improves integrity of the federal Trademark Register
  – Allows the USPTO to cancel audited registrations with unsubstantiated use claims or remove unsupported goods and services from others
• Your registration may be audited if you meet both requirements:
  – File a Section 8 or 71 declaration of use
  – Registration includes at least one class with four or more goods or services, or at least two classes with two or more goods or services.
Decluttering initiative: proof-of-use audit program

- If audited, you must submit proof of use for additional goods/services listed in registration
- When filing affidavit of use **delete** goods/services **not in use** – TMEP §1604.09(b)
- [uspto.gov/trademarks-maintaining-trademark-registration/post-registration-audit-program](http://uspto.gov/trademarks-maintaining-trademark-registration/post-registration-audit-program)
Proof-of-use audit program results so far
November 2017 – May 31, 2019

• 4,091 first actions issued by examiners on project
• 2,538 responses received
• 50.4 percent of registrations with response deleted at least some goods or services
• 79 percent of respondents represented by an attorney
• 21 percent of respondents pro se
Specimen issues

• Mocked-up or fake specimens remain a problem
• Created specimens are much more sophisticated
• Applicants are pasting their marks on products or services of others to show use in commerce
• Using Amazon® and other online retailers to create pages for purposes of submission
Mock-ups and digitally altered specimens

• Fake specimens present several issues:
  – Fail to show mark as used in commerce
  – Fraud on the USPTO
  – Subject to discipline by the Office of Enrollment and Discipline (OED)
  – Impact on validity of registration
Specimen protest pilot program
Specimen protest pilot program
Specimen protest pilot program

- Email address for public to report improper specimens
- Email submissions should include either:
  - Objective evidence of third party use of images identical to the specimen of record
  - Registration or serial numbers showing identical specimens bearing different marks
- Additional submission guidelines and information on our website under “Recent postings”
- Specimens mailbox email address: TMSpecimenProtest@uspto.gov
Specimen rule revision

- Revision to Rule 2.56 with new mandatory electronic filing rule
- Updated language codifies current specimen requirements in case law and the TMEP
- Requirements include
  - URL and access or print date for webpage specimens
  - Specimens must show use of the mark placed on the goods, on containers or packaging for the goods, or on labels/tags affixed to the goods
  - Loose hangtags or labels without depiction of affixation will be refused
Special task force

• Developed in response to the significant increase in unauthorized and improper activities in connection with trademark filings

• Objectives relating to addressing various improper behaviors

• Will look to other federal agencies for best practices and feedback on available technical solutions
Expedited Cancellation Interests

- Safeguarding due process, presumptions, and attaching to registrations
- Creating a fast, efficient proceeding, but still allowing for possible settlement talks
- Identifying “in-between” types of cases (e.g., no need if default judgment likely; unsuitable for cases in need of detailed fact-finding) – where’s the middle ground?
Pilot program

- Expedited Cancellation program
- Instead of drafting NPRM on separate “streamlined” proceeding, TTAB commenced a pilot program focusing on use of existing ACR tools in an “expedited” cancellation proceeding.
- See News and Notices section on TTAB webpage, with link to background, how it works, how to participate, program goals, and expected duration.
Pilot program – objectives

• Identify abandonment and non-use cancellation cases most suitable for some sort of “expedited” proceeding

• Discuss with parties application of ACR procedures that could be used most effectively in such proceedings

• Involve board attorney and judge participating in discovery conferences in cases that board identifies as suitable candidates
Pilot program – early results

• Default rates are high in cancellation cases and growing
• 44% in all cancellation cases
• 49% when the case includes abandonment or nonuse claim
• 55% for cases with only nonuse claims
• 60% for cases with only abandonment claims
Pilot program – early results

• More than 135 cases found eligible to date
• Nearly 70 conferences held to date, and orders for conferences have been issued in multiple cases
• Parties in 12 cases agreed to use of some form of ACR; a number of others agreed to consider ACR as the case progressed, or to discuss the possible use of ACR with the assigned interlocutory attorney at a later conference.
• TV Azteca, S.A.B. de C.V. v. Martin, 128 USPQ2d 1786 (TTAB 2018)
Pilot program – early findings

• Many uncontroversial cases result in default or early settlement.

• In many cases involving pleaded or asserted claims of ongoing use, petitioner wants to investigate or question the claimed use via discovery.

• Discovery is almost always desired in cases where the primary issue is excusable nonuse/intent to resume use.
Pilot program – early findings

• Cases involving no or limited discovery are better candidates for inclusion in pilot.

• Some parties are comfortable agreeing to cross-motions for summary judgment type of ACR, but are retaining the right to take some discovery.
Pilot program – future uses?

• Identify (1) possible changes to Trademark Rules to support a separate new expedited cancellation proceeding, (2) possible expansion of early intervention pilot into cases involving other issues, and (3) possible adaptation of current ACR procedures.
TTAB trial tips

Pleadings—not just for breakfast

• Think about what you have to prove at trial before it starts (ideally before trial)

• Plead claims and defenses—if unpled, and not tried by implied consent (rare), we can’t consider
  • Might require amendment
  • Amendment must be prompt

• Find cases analogous to yours, then use TTABVUE to see what parties did at trial

• Attach pleaded registrations

• If defendant, consider Section 18 defense--we “may otherwise restrict or rectify with respect to the register the registration of a registered mark.” Defense must be pleaded, and include proposed restriction and some argument re why the restriction alleviates loc (i.e. different trade channels, classes of consumers, sophistication).
TTAB trial tips

Trials—not just for dinner

• Think of trial as a meal
  • You can’t expect to just sit down at dinnertime and for food to materialize out of nowhere
  • You have to prepare meal in advance

• From the moment you file, be thinking about what you have to prove at trial, and how you’ll do it
  • Read the Rules, TBMP is a good source
  • What evidence are you going to cite in your brief?
  • What is it admissible for and probative of?
  • Judicial notice is limited and pretty much never proves a case; attorney argument not sufficient

• In Glengarry Glen Ross it was “always be closing,” at the Board (and court) it’s “always be trying” (the case)
TTAB trial tips

Summary Judgment can be more than lunch or a snack

- Denial can frame issues for trial

- Can stipulate that sj evidence be considered part of the trial record, or, better yet, consider submitting summary judgment briefs and evidence as Accelerated Case Resolution (ACR) case, with or without supplementation
TTAB trial tips

ACR

• Imagine efficiencies, and agree to them

• We’ll approve it
TTAB trial tips

Litigation is adversarial, litigating should not be

- If problems with opposing counsel, call interlocutory attorney

- They’re quite good at resolving issues on the phone and can quickly get cases back on track
TTAB trial tips

Do’s and Don’ts

• Internet printouts are great, but
  • Do not establish truth of matters asserted (need testimony for that)
  • Only what they show on their face (sometimes important nevertheless, like public exposure to mark and perception)

• Third party use/registration
  • Mere lists don’t work
  • We need to see marks and goods and services (only similar marks for similar g/s relevant to show weakness)
  • Pending applications prove nothing
  • Registrations do not prove use but can be used like dictionary
TTAB trial tips

Do’s and Don’ts

• Objections to evidence
  • Procedural objections waived if errors could have been cured if objection made more promptly
  • Make substantive objections in brief, but
    • Our cases are like bench trials—no juries
    • We know the Rules
    • If not outcome determinative, think long and hard aboutobjecting

• Our typical approach
  • “We simply accord the evidence whatever probative value it deserves, if any at all ... Ultimately, the Board is capable of weighing the relevance and strength or weakness of the objected-to testimony and evidence in this specific case, including any inherent limitations, and this precludes the need to strike the testimony and evidence.”
  • “We also remind the parties that our proceedings are tried before judges not likely to be easily confused or prejudiced. Objections to trial testimony on bases more relevant to jury trials are particularly unnecessary in this forum.”
TTAB trial tips

Do’s and Don’ts

• Be judicious in designating materials confidential
  • Your advertisements aren’t
  • Your website isn’t
  • Annual reports aren’t
  • Anything publicly available or not kept secret shouldn’t be designated that way

• If relying on common law rights
  • Need testimony or evidence about priority
  • Need testimony or other evidence about goods and services
TTAB trial tips

Do’s and Don’ts

• If trying to prove fame/strength, we need
  • Sales and advertising figures
  • Market share
  • Public exposure
    • Circulation figures
    • TV ratings
    • On web, hit/subscriber numbers
    • Social medial followers, likes, etc.
    • Mere long term use not impressive by itself
TTAB trial tips

Do’s and don’ts

“THE AUTHORITY IS LEGION”

• If relying on application or registration, cases dictate that the goods and services are the identification
Questions?
TTAB Contact Information
(800) 786-9199
(571) 272-8500

Thank you,

Michael B. Adlin
Administrative Trademark Judge
Trademark Trial and Appeal Board
United States Patent and Trademark Office
List of Subjects in 33 CFR Part 100
Marine safety, Navigation (water), Reporting and recordkeeping requirements, Waterways.

For the reasons discussed in the preamble, the Coast Guard proposes to amend 33 CFR part 100 as follows:

PART 100—SAFETY OF LIFE ON NAVIGABLE WATERS

1. The authority citation for part 100 continues to read as follows:

Authority: 33 U.S.C. 1233; 33 CFR 1.05–1.

2. Add § 100.501T05–1102 to read as follows:

§ 100.501T05–1102 Special Local Regulation; Chesapeake Bay, between Sandy Point and Kent Island, MD.

(a) Regulated area. The following location is a regulated area: All navigable waters of the Chesapeake Bay, adjacent to the shoreline at Sandy Point State Park and between and adjacent to the spans of the William P. Lane Jr. Memorial Bridges, from shoreline to shoreline, bounded to the north by a line drawn from the western shoreline at latitude 39°01′05.23″ N, longitude 076°23′47.93″ W; thence eastward to latitude 39°01′02.08″ N, longitude 076°22′40.24″ W; thence southeastward to eastern shoreline at latitude 38°59′13.70″ N, longitude 076°19′58.40″ W; and bounded to the south by a line drawn parallel and 500 yards south of the south bridge span that originates from the western shoreline at latitude 39°00′17.08″ N, longitude 076°24′28.36″ W; thence eastward to latitude 38°59′38.36″ N, longitude 076°23′59.67″ W; thence eastward to latitude 38°59′26.93″ N, longitude 076°23′25.53″ W; thence eastward to the eastern shoreline at latitude 38°58′40.32″ N, longitude 076°20′10.45″ W, located between Sandy Point and Kent Island, MD. All coordinates reference North American Datum 83 (NAD 1983).

(b) Definitions. As used in this section:

Captain of the Port (COTP) Maryland-National Capital Region means the Commander, U.S. Coast Guard Sector Maryland-National Capital Region or any Coast Guard commissioned, warrant or petty officer who has been authorized by the COTP to act on the COTP’s behalf.

Coast Guard Patrol Commander (PATCOM) means a commissioned, warrant, or petty officer of the U.S. Coast Guard who has been designated by the Commander, Coast Guard Sector Maryland-National Capital Region.

Official Patrol means a vessel assigned or approved by the Commander, Coast Guard Sector Maryland-National Capital Region with a commissioned, warrant, or petty officer on board and displaying a Coast Guard ensign.

Participant means a person or vessel registered with the event sponsor as participating in the Bay Bridge Paddle event or otherwise designated by the event sponsor as having a function tied to the event.

Spectator means a person or vessel not registered with the event sponsor as a participant or assigned as an official patrol.

(c) Special local regulations: (1) The COTP Maryland-National Capital Region or PATCOM may forbid and control the movement of all vessels and persons, including event participants, in the regulated area. When hailed or signaled by an official patrol, a vessel or person in the regulated area must immediately comply with the directions given by the patrol. Failure to do so may result in the Coast Guard expelling the person or vessel from the area, issuing a citation for failure to comply, or both. The COTP Maryland-National Capital Region or PATCOM may terminate the event, or a participant’s operations at any time the COTP Maryland-National Capital Region or PATCOM believes it necessary to do so for the protection of life or property.

(2) Except for participants and vessels already at berth, a person or vessel within the regulated area at the start of enforcement of this section must immediately depart the regulated area. (3) A spectator must contact the PATCOM to request permission to either enter or pass through the regulated area. The PATCOM, and official patrol vessels enforcing this regulated area, can be contacted on marine band radio VHF–FM channel 16 (156.8 MHz) and channel 22A (157.1 MHz). If permission is granted, the spectator may enter the regulated area or pass directly through the regulated area as instructed by PATCOM. A vessel within the regulated area must operate at a safe speed that minimizes wake. A spectator vessel must not loiter within the navigable channel while within the regulated area.

(4) A person or vessel that desires to transit, moor, or anchor within the regulated area must first obtain authorization from the COTP Maryland-National Capital Region or PATCOM. A person or vessel seeking such permission can contact the COTP Maryland-National Capital Region at telephone numbers 410–576–2893 or on Marine Band Radio, VHF–FM channel 16 (156.8 MHz) or the PATCOM on Marine Band Radio, VHF–FM channel 16 (156.8 MHz).

(5) The Coast Guard will publish a notice in the Fifth Coast Guard District Local Notice to Mariners and issue a marine information broadcast on VHF–FM marine band radio announcing specific event date and times.

(d) Enforcement period. This section will be enforced from 7 a.m. to 1 p.m. on June 1, 2019, and, if necessary due to inclement weather, from 7 a.m. to 1 p.m. on June 2, 2019.


Joseph B. Loring,
Captain, U.S. Coast Guard, Captain of the Port Maryland-National Capital Region.

DEPARTMENT OF COMMERCE

Patent and Trademark Office

37 CFR Parts 2 and 11

[Docket No. PTO–T–2018–0021]

RIN 0910–04–P

Requirement of U.S. Licensed Attorney for Foreign Trademark Applicants and Registrants


ACTION: Notice of proposed rulemaking.

SUMMARY: The United States Patent and Trademark Office (USPTO or Office) proposes to amend the Rules of Practice in Trademark Cases and the rules regarding Representation of Others Before the United States Patent and Trademark Office to require applicants, registrants, or parties to a proceeding whose domicile or principal place of business is not located within the United States (U.S.) or its territories (hereafter foreign applicants, registrants, or parties) to be represented by an attorney who is an active member in good standing of the bar of a court of a state in the U.S. (including the District of Columbia and any Commonwealth or territory of the U.S.). A requirement that such foreign applicants, registrants, or parties be represented by a qualified U.S. attorney will instill greater confidence in the public that U.S. registrations that issue to foreign applicants are not subject to invalidation for reasons such as improper signatures and use claims and enable the USPTO to more effectively use available mechanisms to enforce foreign applicant compliance with statutory and regulatory requirements in trademark matters.
DATES: Comments must be received by March 18, 2019 to ensure consideration.

ADDRESSES: The USPTO prefers that comments be submitted via electronic mail message to TMFENotices@uspto.gov. Written comments also may be submitted by mail to the Commissioner for Trademarks, P.O. Box 1451, Alexandria, VA 22313–1451, attention Catherine Cain; by hand delivery to the Trademark Assistance Center, Concourse Level, James Madison Building-East Wing, 600 Dulany Street, Alexandria, VA 22314, attention Catherine Cain; or by electronic mail message via the Federal eRulemaking Portal at https://www.regulations.gov. See the Federal eRulemaking Portal website for additional instructions on providing comments via the Federal eRulemaking Portal. All comments submitted directly to the USPTO or provided on the Federal eRulemaking Portal should include the docket number (PTO–T–2018–0021).

Although comments may be submitted by postal mail, the Office prefers to receive comments by electronic mail message over the internet because the Office may easily share such comments with the public. Electronic comments are preferred to be submitted in plain text, but also may be submitted in portable document format or DOC file format. Comments not submitted electronically should be submitted on paper in a format that facilitates convenient digital scanning into portable document format.

The comments will be available for public inspection on the USPTO’s website at https://www.uspto.gov, on the Federal eRulemaking Portal, and at the Office of the Commissioner for Trademarks, Madison East, Tenth Floor, 600 Dulany Street, Alexandria, VA 22314. Because comments will be made available for public inspection, information that is not desired to be made public, such as an address or phone number, should not be included.

FOR FURTHER INFORMATION CONTACT: Catherine Cain, Office of the Deputy Commissioner for Trademark Examination Policy, TMPolicy@uspto.gov, (571) 272–8946.

SUPPLEMENTARY INFORMATION: The USPTO proposes to revise the rules in parts 2 and 11 of title 37 of the Code of Federal Regulations to require foreign applicants, registrants, or parties to a proceeding to be represented by an attorney, as defined in § 11.1, 37 CFR 11.1, that is, an attorney who is an active member in good standing of the bar of any court of a state or territory (including the District of Columbia and any Commonwealth or territory) and who is qualified under § 11.14(a), 37 CFR 11.14(a), to represent others before the Office in trademark matters. A requirement that such foreign applicants, registrants, or parties be represented by a qualified U.S. attorney will (1) instill greater confidence in the public that U.S. registrations that issue to foreign applicants are not subject to invalidation for reasons such as improper signatures and use claims and (2) enable the USPTO to more effectively use available mechanisms to enforce foreign applicant compliance with statutory and regulatory requirements in trademark matters.

I. Integrity of the U.S. Trademark Register

The trademark register must accurately reflect marks that are actually in use in commerce in the U.S. for the goods/services identified in the registrations. By registering trademarks, the USPTO has a significant role in protecting consumers, as well as providing important benefits to U.S. commerce by allowing businesses to strengthen and safeguard their brands and related investments.

The public relies on the register to determine whether a chosen mark is available for use or registration. When a person’s search of the register discloses a potentially confusingly similar mark, that person may incur a variety of resulting costs and burdens, such as those associated with investigating the actual use of the disclosed mark to assess any conflict, initiating proceedings to cancel the registration or oppose the application of the disclosed mark, engaging in civil litigation to resolve a dispute over the mark, or choosing a different mark and changing business plans regarding its mark. In addition, such persons may incur costs and burdens unnecessarily if the disclosed registered mark is not actually in use in U.S. commerce, or is not in use in commerce in connection with all the goods/services identified in the registration. An accurate and reliable trademark register helps avoid such needless costs and burdens.

A valid claim of use made as to a registered mark likewise benefits the registrant. Fraudulent or inaccurate claims of use jeopardize the validity of any resulting registration and may render it vulnerable to cancellation. Furthermore, trademark documents submitted in support of registration require statutorily prescribed averments and must be signed in accordance with § 2.193(e)(1), 37 CFR 2.193(e)(1). If signed by a person determined to be an unauthorized signatory, a resulting registration may be invalid.

Therefore, the USPTO anticipates that implementation of the proposed rule would have the benefit of generally reducing costs to applicants, registrants, and other parties and providing greater value to consumers who rely on registered marks.

As discussed below, in the past few years, the USPTO has seen many instances of unauthorized practice of law (UPL) where foreign parties who are not authorized to represent trademark applicants are improperly representing foreign applicants before the USPTO. As a result, increasing numbers of foreign applicants are likely receiving inaccurate or no information about the legal requirements for trademark registration in the U.S., such as the standards for use of a mark in commerce, who can properly aver to matters and sign for the mark owner, or even who the true owner of a mark is under U.S. law. This practice raises legitimate concerns that affected applications and any resulting registrations are potentially invalid, and thus negatively impacts the integrity of the trademark register.

II. Enforce Compliance With U.S. Statutory and Regulatory Requirements

The proposed requirement for representation by a qualified U.S. attorney is also necessary to enforce compliance by all foreign applicants, registrants, and parties with U.S. statutory and regulatory requirements in trademark matters. It will not only aid the USPTO in its efforts to improve and preserve the integrity of the U.S. trademark register, but will also ensure that foreign applicants, registrants, and parties are assisted only by authorized practitioners who are subject to the USPTO’s disciplinary rules.

The requirement for representation by a qualified U.S. attorney is being proposed in response to the increasing problem of foreign trademark applicants who purportedly are pro se (i.e., one who does not retain a lawyer and appears for himself or herself) and who are filing inaccurate and possibly fraudulent submissions that violate the Trademark Act (Act) and/or the USPTO’s rules. For example, such foreign applicants file applications claiming use of a mark in commerce, but frequently support the use claim with mocked-up or digitally altered specimens that indicate the mark may not actually be in use. Many appear to be doing so on the advice, or with the assistance, of foreign individuals and entities who are not authorized to represent trademark applicants before the USPTO. This practice undermines the accuracy and integrity of the U.S.
trademark register and its utility as a means for the public to reliably determine whether a chosen mark is available for use or registration, and places a significant burden on the trademark examining operation.

Current Mechanisms and Sanctions are Inadequate

(1) Show-Cause Authority: Under 35 U.S.C. 3(b)(2)(A), the Commissioner for Trademarks (Commissioner) possesses the authority to manage and direct all aspects of the activities of the USPTO that affect the administration of trademark operations. The Commissioner may use that authority to investigate and issue an order requiring an applicant to show cause why the applicant’s representative, or the applicant itself, should not be sanctioned under § 11.18(c), 37 CFR 11.18(c), for presenting a paper to the USPTO in violation of § 11.18(b), 37 CFR 11.18(b). However, given the location of foreign applicants and those acting on their behalf, as well as potential language barriers, the show-cause authority has rarely been successful in resolving the underlying issues. Although all those who sign documents in trademark matters before the USPTO do so subject to criminal penalties for knowing and willful false statements made to a government agency under 18 U.S.C. 1001, the criminal perjury prosecution option under 18 U.S.C. 1001 is similarly difficult to enforce against those who are not subject, or are not easily subject, to U.S. jurisdiction. Further, proof to support such sanctions under § 11.18 is often difficult to obtain. For these primary reasons, when a foreign applicant fails to comply with statutory and regulatory requirements in ex parte examination, it has been challenging and, in some cases, impossible for the Commissioner to use her show-cause authority to impose the sanctions available under § 11.18(c).

(2) USPTO Disciplinary Authority Under 35 U.S.C. 32: Requiring foreign applicants, registrants, and parties to retain U.S. counsel in all trademark matters before the USPTO will likely reduce the instances of UPL and misconduct. In addition, when UPL and/or misconduct does occur, requiring foreign applicants, registrants, and parties to retain U.S. counsel will enable the Office of Enrollment and Discipline (OED) to more effectively pursue those who are engaged in the UPL and/or misconduct. OED’s disciplinary jurisdiction extends to a “Practitioner,” as that term is defined in § 11.1, 37 CFR 11.1, or a non-practitioner who offers legal services to people seeking to register trademarks with the USPTO. For practitioners, OED may investigate and institute formal disciplinary proceedings, which can result in discipline of the practitioner, including: (1) Exclusion from practice before the Office; (2) suspension from practice before the Office; (3) reprimand or censure; or (4) probation.

When formal discipline is issued against a U.S. practitioner, OED may also notify other federal agencies and the U.S. state bar(s) where the practitioner is licensed and/or authorized to practice law as appropriate. A number of states have criminal statutes penalizing UPL. Depending on the state, the state bar, consumer-protection arm of the state’s attorney office, and/or state consumer-protection agency may investigate UPL and take action to protect the public. Additionally, consumer-protection organizations and law-enforcement agencies can investigate possible civil or criminal fraud at the federal and state level. OED’s ability to refer a discipline matter to a state bar for further action or to a federal or state consumer-protection agency, or law-enforcement agency, thus effectively deters disciplined practitioners from violating the terms of their disciplinary orders.

Moreover, the threat of a claim of UPL has not been equally effective with foreign applicants and the unqualified foreign individuals, attorneys, or firms advising them. Although the USPTO investigates possible UPL by such foreign parties, because these parties are not practitioners authorized to practice before the USPTO, the absence of any realistic threat of disciplinary action has impeded the USPTO’s efforts to deter foreign parties from engaging in UPL or violating a USPTO exclusion order. In addition, while the USPTO can send a letter to a foreign government regarding the USPTO’s exclusion order, foreign government officials have great discretion regarding whether to pursue further sanctions against their own citizens. Further, since foreign parties are representing foreign applicants, there may be few U.S. stakeholders directly affected by the unauthorized practice of law by the foreign party. There is little incentive for a state or federal law-enforcement or consumer-protection agency to take action against a foreign party engaged in UPL to protect U.S. interests, or to pursue further action with consumer-protection agencies in other countries where the foreign national does business.

Moreover, the threat of criminal perjury prosecution in U.S. courtrooms does not have the same deterrent effect for foreign nationals as it does for U.S. nationals and domiciles. As a practical matter, even if U.S. law enforcement is able to devote resources toward prosecution of a foreign national for a violation of 18 U.S.C. 1001, exorting jurisdiction over such a party is not always possible. Furthermore, many foreign unauthorized parties acting on behalf of foreign applicants and registrants who have been excluded by a Commissioner’s order typically continue to engage in UPL before the USPTO, often increasing the scale of their efforts and employing tactics intended to circumvent the USPTO’s rules.

Under the proposed rule, submissions would be made by practitioners subject to the disciplinary jurisdiction of OED, making it less likely that they would be signed by an unauthorized party or contain statements that are inaccurate, particularly as to any averment of use of the mark in U.S. commerce or intention to use the mark. Further, because it would result in a more accurate and reliable trademark register, fewer U.S. applicants, registrants, and parties would incur the costs associated with investigating the actual use of a mark to assess any conflict, initiating proceedings to cancel a registration or oppose an application, engaging in civil litigation to resolve a dispute over a mark, or changing business plans to avoid use of a chosen mark.

Surge in Foreign Filings

Contributing to concerns regarding UPL, in recent years the USPTO has experienced a significant surge in foreign filings, with the number of applications from foreign applicants increasing as a percentage of total filings, as shown in the following table. The numbers in parentheses indicate the number of applications represented by each percentage:

<table>
<thead>
<tr>
<th>Filings from foreign or U.S. applicants as a percentage of total filings</th>
<th>FY15</th>
<th>FY16</th>
<th>FY17</th>
</tr>
</thead>
<tbody>
<tr>
<td>Foreign</td>
<td>19% (70,853)</td>
<td>22% (87,706)</td>
<td>26% (115,402)</td>
</tr>
<tr>
<td>U.S</td>
<td>81% (301,098)</td>
<td>78% (306,281)</td>
<td>74% (320,885)</td>
</tr>
</tbody>
</table>

*Data as of 12/10/2018.
The USPTO predicts that the number of foreign filings will continue to rise based on a variety of economic factors, including the strength of the U.S. economy. This growth is coupled with a significant growth in the number of filings by foreign pro se applicants in FY15 through FY17, especially as compared with filings by U.S. pro se applicants. The information shown below reflects the representation status at the time the USPTO electronic record was searched to obtain the data. Representation status may change over the course of prosecution. However, system limitations only permit the USPTO to retrieve representation status at the time a search is done.

<table>
<thead>
<tr>
<th>Filings from foreign or U.S. applicants—Representation Status</th>
<th>FY15</th>
<th>FY16</th>
<th>FY17</th>
</tr>
</thead>
<tbody>
<tr>
<td>U.S.—Pro Se</td>
<td>25.3% (76,140)</td>
<td>27.2% (83,161)</td>
<td>28.5% (91,593)</td>
</tr>
<tr>
<td>U.S.—Represented</td>
<td>74.7% (224,958)</td>
<td>72.8% (223,120)</td>
<td>71.5% (229,292)</td>
</tr>
<tr>
<td>Foreign—Pro Se</td>
<td>25.4% (17,967)</td>
<td>35.9% (31,475)</td>
<td>44.0% (50,742)</td>
</tr>
<tr>
<td>Foreign—Represented</td>
<td>74.6% (52,886)</td>
<td>64.1% (56,231)</td>
<td>56.0% (64,660)</td>
</tr>
</tbody>
</table>

*Data as of 12/10/2018.

Currently, the USPTO is in the process of addressing numerous instances of UPL by foreign parties who engage in tactics designed to circumvent USPTO rules. When the USPTO has identified UPL by foreign parties in an application, the USPTO has sent information to the applicant’s address of record. In the event that it is apparent that its appointed representative has been “excluded” from practice before the USPTO and cannot represent the applicant in the matter. In addition, the USPTO has published the order excluding foreign unauthorized individuals and entities on its website and suggested that applicants review all application submissions previously submitted on their behalf. However, in many applications, the address information for the applicant is not legitimate (i.e., the address is for the unauthorized individual or entity representing the applicant) or is incomplete or inaccurate, and the USPTO cannot be sure that the affected applicants receive this information. This fact raises concerns that the applications are potentially invalid because they were signed by an unauthorized party or contain statements that are inaccurate, particularly as to any averment of use of the mark in U.S. commerce or intent to use the mark, which forms the underlying statutory basis for federal registration.

Efforts to educate foreign applicants about UPL or to impose effective sanctions against the foreign unauthorized individuals or entities have proved ineffective. The problem of foreign applicants who violate U.S. legal and regulatory requirements in trademark matters and do so largely on the advice of foreign unauthorized individuals or entities grows each month. Within the last few years, the scale of the problem has become massive, with the estimated number of total tainted applications now in the tens of thousands. It also is becoming increasingly difficult for the USPTO, with its limited resources, to identify and prove misconduct and UPL, particularly as tactics and technology to mask the misconduct evolve.

III. Proposed Rule Changes

1. Requirement for Representation

Under this proposed rule, § 2.11 would be amended to require applicants, registrants, or parties to a proceeding whose domicile or principal place of business is not located within the U.S. or its territories to be represented by an attorney who is an active member in good standing of the bar of the highest court of any of the 50 states of the U.S., the District of Columbia, and any Commonwealth or territory of the U.S. To ensure clarity regarding who is subject to the requirement, § 2.2 would be amended to define “domicile” and “principal place of business.” The proposed requirement is similar to the requirement that currently exists in many other countries, such as Brazil, Chile, the People’s Republic of China, Israel, Japan, Jordan, Republic of Korea, Morocco, and South Africa, as well as the European Union’s Intellectual Property Office. The majority of countries with a similar requirement condition the requirement on domicile. The USPTO intends to follow this practice. Moreover, requiring a qualified attorney to represent applicants, registrants, and parties whose domicile or principal place of business is not located within the U.S. or its territories is an effective tool for combating the growing problem of foreign individuals, entities, and applicants failing to comply with U.S. law.

The applicant would be required to obtain U.S. counsel to prosecute the application. When the USPTO receives an application filed by a foreign domiciliary, with a filing basis under section 1 and/or section 4 of the Act, 15 U.S.C. 1051, 1126, that does not comply with the requirements of proposed § 2.11(a), the applicant would be informed in an Office action that appointment of a qualified U.S. attorney is required. The applicant would have the usual period of six months to respond to an Office action including the requirement, and failure to comply would result in abandonment of the application. See 37 CFR 2.63, 2.65(a).

For those applicants the USPTO identifies as being subject to the rule, the USPTO is considering whether to: (1) Defer full examination of the application until the applicant complies with the requirement to appoint U.S. counsel, thereby allowing the appointed attorney to have the opportunity to review the application for compliance with U.S. law during the period to respond to the Office action raising the requirement; or (2) expend additional resources to conduct a complete examination and issue an Office action that includes the requirement along with other applicable refusals and requirements. The USPTO welcomes comments on the two approaches under consideration.

Although applications based on section 66(a) of the Act (Madrid applications), 15 U.S.C. 1141f, would be subject to the requirement to appoint a qualified U.S. attorney, the USPTO is assessing its procedures for a small set of applications (2.9% of all Madrid applications in fiscal year 2017) that are submitted with all formalities and statutory requirements already satisfied, and therefore are in a condition ready for publication upon first action. Madrid applications are initially filed with the International Bureau (IB) of the World Intellectual Property Organization and subsequently transmitted to the USPTO. There is currently no provision for designating a U.S. or any other local attorney in an application submitted to the IB, and the USPTO does not expect that the IB will update its capabilities prior to the anticipated implementation of this proposed rule. Therefore, the USPTO may consider waiving the requirement to appoint a qualified U.S. practitioner prior to publication in this limited situation, until such time as the Madrid system is updated to allow for the designation of a U.S. attorney.
Conforming amendments would also be made to the following sections, which set out the requirements noted: § 2.17(e), for recognition for representation; § 2.22, for filing a TEAS Plus application; and 2.32(a)(4), for a complete application.

(2) Reciprocal recognition. Under this proposed rule, § 11.14 would be amended to clarify that only registered and active foreign attorneys or agents who are in good standing before the trademark office of the country in which the attorney or agent resides and practices may be recognized for the limited purpose of representing parties located in such country, provided the trademark office of such country and the USPTO have reached an official understanding to allow substantially reciprocal privileges. The proposed rule would also require that in any trademark matter where an authorized foreign attorney or agent is representing an applicant, registrar, or party to a proceeding, a qualified U.S. attorney must also be appointed pursuant to § 2.17(b)(c) as the representative with whom the Office will communicate and conduct business.

Currently, only Canadian attorneys and agents are reciprocally recognized under § 11.14(c). The proposed rule removes the authorization for reciprocally recognized Canadian patent agents to practice before the USPTO in trademark matters, but continues to allow reciprocal recognition of Canadian trademark attorneys and agents in trademark matters. Those Canadian patent agents already recognized who are in good standing in Canada and (2) in connection with an application or post-registration maintenance filing pending before the Office on the effective date of the proposed rule, for which the recognized patent agent is the representative. Recognized Canadian trademark attorneys and agents would continue to be authorized to represent Canadian parties in U.S. trademark matters.

IV. Cost To Retain U.S. Counsel

The following tables estimate the costs for complying with the proposed rule, using FY17 filing numbers for pro se applicants and registrants with a domicile or principal place of business outside the U.S. or its territories and for Madrid applicants and registrants. The professional rates shown below are the median charges for legal services in connection with filing and prosecuting an application, or filing a post-registration maintenance document, as reported in the 2017 Report on the Economic Survey, published by the American Intellectual Property Law Association.

As noted above, applicants subject to the proposed rule would be required to retain U.S. counsel to prosecute an application and to handle post-registration maintenance requirements and proceedings before the Trademark Trial and Appeal Board. The tables below reflect two sets of aggregate costs—those for applicants who filed pro se in FY17 and would have retained counsel prior to filing and those who would have retained counsel after filing. As discussed above, the information shown below reflects the representation status at the time the USPTO electronic record was searched to obtain the data. Representation status may change over the course of prosecution. The USPTO does not collect information on statistics on applicants who file pro se but subsequently retain counsel during the prosecution of their application. The USPTO recognizes that there may have been a higher number of pro se applicants at filing than is reflected below, but that those applicants had retained counsel prior to the date the search report was generated. Therefore, it is possible that a higher number of pro se applicants may incur the cost of having counsel prepare and file an application, those applicants would have already incurred the additional cost for prosecution of the application.

The following table sets out the estimated costs, based on filing basis, if pro se applicants in FY17 with a domicile or principal place of business outside the U.S. or its territories retained counsel prior to filing their applications. A filing basis is the statutory basis for filing an application for registration of a mark in the U.S. An applicant must specify and meet the requirements of one or more bases in a trademark or service mark application. 37 CFR 2.32(a)(5). There are five filing bases: (1) A use of a mark in commerce under section 1(a) of the Act; (2) A bona fide intention to use a mark in commerce under section 1(b) of the Act; (3) A claim of priority, based on an earlier-filed foreign application under section 44(d) of the Act; (4) Ownership of a registration of the mark in the applicant’s country of origin under section 44(e) of the Act; and (5) Extension of protection of an international registration to the United States, under section 66(a) of the Act. 15 U.S.C. 1051(a)–(b), 1126(d)–(e), 1141f(a).

The number of applicants shown within each filing-basis category in the tables below reflects the basis status at the time the USPTO electronic record was searched to obtain the representation status.

Although the USPTO believes that applicants who would be subject to the proposed requirement should retain U.S. counsel prior to filing an application, the USPTO recognizes that not all would do so. Therefore, the USPTO expects that the total estimated costs reflected in the table below would be reduced by the number of applicants within each filing-basis category who chose to file an application without retaining U.S. counsel.

### FY17 Pro Se Applications by Basis (Excluding Madrid)—Cost if Counsel Retained Before Filing *

<table>
<thead>
<tr>
<th>Activity performed by counsel</th>
<th>Median charge</th>
<th>1(a)/35,506</th>
<th>1(b)/4,010</th>
<th>1(a)/1(b)/69</th>
<th>44/1,142</th>
<th>44/1(b)/137</th>
<th>Total cost</th>
</tr>
</thead>
<tbody>
<tr>
<td>Filing foreign origin registration application received ready for filing.</td>
<td>$600</td>
<td>N/A</td>
<td>N/A</td>
<td>N/A</td>
<td>N/A</td>
<td>$603,000</td>
<td>N/A</td>
</tr>
<tr>
<td>Preparing and filing application</td>
<td>775</td>
<td>$27,517,150</td>
<td>$3,107,750</td>
<td>$53,475</td>
<td>N/A</td>
<td>$106,175</td>
<td>30,784,550</td>
</tr>
<tr>
<td>Prosecution, including amendments and interviews but not appeals.</td>
<td>1,000</td>
<td>35,506,150</td>
<td>4,010,000</td>
<td>69,000</td>
<td>1,140,000</td>
<td>Included in 44 applications.</td>
<td>40,727,000</td>
</tr>
<tr>
<td>Statement of use †</td>
<td>400</td>
<td>N/A</td>
<td>1,604,000</td>
<td>27,600</td>
<td>N/A</td>
<td>$54,800</td>
<td>1,686,400</td>
</tr>
<tr>
<td>Total</td>
<td>63,023,150</td>
<td>8,721,750</td>
<td>150,075</td>
<td>1,745,000</td>
<td>$160,975</td>
<td>73,800,950</td>
<td></td>
</tr>
</tbody>
</table>

* Data as of 12/10/2018. In addition to the number of applications shown for each filing basis, an additional 62 applications did not indicate a basis on the date of filing and currently have no filing basis, either because the application has abandoned or because the applicant has not yet responded to the requirement to indicate a basis.
† If an application is filed under section 1(b) of the Act, the applicant must file a statement of use prior to registration.
‡ The numbers underneath the filing basis indicate the number of applications filed for that basis.
§ The cost shown is for 1,005 section 44 applications, which is the total number of section 44 applications minus the subset that also includes a section 1(b) filing basis.
Alternatively, the table below sets out the estimated costs, based on filing basis, if pro se applicants in FY17 with a domicile or principal place of business outside the U.S. or its territories retained counsel after filing their applications. As in the situation described above, the USPTO anticipates that a certain number of these applicants would retain U.S. counsel prior to filing an application. Therefore, the USPTO expects that the total estimated costs reflected in the table below would be increased by the number of applicants within each filing-basis category who chose to do so.

**FY17 PRO SE APPLICATIONS BY BASIS (EXCLUDING MADRID)—COST IF COUNSEL RETAINED AFTER FILING**

<table>
<thead>
<tr>
<th>Activity performed by counsel</th>
<th>Median charge</th>
<th>1(a) 35,506 ‡</th>
<th>1(b) 4,010</th>
<th>1(a)/1(b) 69</th>
<th>44 1,142</th>
<th>44/1(b) § 137</th>
<th>Total cost</th>
</tr>
</thead>
<tbody>
<tr>
<td>Filing foreign origin registration application received ready for filing</td>
<td>$600</td>
<td>N/A</td>
<td>N/A</td>
<td>N/A</td>
<td>N/A</td>
<td>N/A</td>
<td>N/A</td>
</tr>
<tr>
<td>Preparing and filing application</td>
<td>775</td>
<td>N/A</td>
<td>N/A</td>
<td>N/A</td>
<td>N/A</td>
<td>N/A</td>
<td>N/A</td>
</tr>
<tr>
<td>Prosecution, including amendments and interviews but not appeals</td>
<td>1,000</td>
<td>$35,506,000</td>
<td>$4,010,000</td>
<td>$69,000</td>
<td>$1,142,000</td>
<td>Included in prior column.</td>
<td>$40,727,000</td>
</tr>
<tr>
<td>Statement of use †</td>
<td>400</td>
<td>N/A</td>
<td>1,604,000</td>
<td>27,600</td>
<td>N/A</td>
<td>N/A</td>
<td>$54,800</td>
</tr>
<tr>
<td>Total</td>
<td>35,506,000</td>
<td>5,614,000</td>
<td>96,600</td>
<td>1,142,000</td>
<td>$54,800</td>
<td>1,686,400</td>
<td>42,413,400</td>
</tr>
</tbody>
</table>

* Data as of 12/10/2018. In addition to the number of applications shown for each filing basis, an additional 62 applications did not indicate a basis on the date of filing and currently have no filing basis, either because the application has abandoned or because the applicant has not yet responded to the requirement to indicate a basis.

† If an application is filed under section 1(b) of the Act, the applicant must file a statement of use prior to registration.

‡ The numbers underneath the filing basis indicate the number of applications filed for that basis.

§ This column represents the subset of section 44 applications that also includes a section 1(b) filing basis.

As discussed above, Madrid applications are initially filed with the IB and subsequently transmitted to the USPTO. In FY17, the USPTO received 24,418 Madrid applications in which the applicant had an address outside the U.S. or its territories, and thus would be subject to the proposed requirement.

There is currently no provision for designating a U.S. attorney in an application submitted to the IB. Therefore, the USPTO presumes that none of the Madrid applicants subject to the requirement retained U.S. counsel prior to filing. However, USPTO records indicate that at some point after filing, 14,602 of those FY17 Madrid applicants were represented by counsel. Therefore, only the remaining 9,816 Madrid applicants would be subject to the requirement to retain U.S. counsel to prosecute their applications, as shown in the following table:

**FY17 MADRID APPLICATIONS—COST IF COUNSEL RETAINED AFTER FILING**

<table>
<thead>
<tr>
<th>Activity performed by counsel</th>
<th>FY17</th>
<th>Median charge</th>
<th>Total charge</th>
</tr>
</thead>
<tbody>
<tr>
<td>Prosecution, including amendments and interviews but not appeals</td>
<td>9,816</td>
<td>$1,000</td>
<td>$9,816,000</td>
</tr>
<tr>
<td>Total</td>
<td></td>
<td></td>
<td>$9,816,000</td>
</tr>
</tbody>
</table>

* Data as of 12/10/2018.

The following table sets out the estimated costs to FY17 pro se registrants who would be subject to proposed § 2.11(a) when filing a post-registration maintenance document.

**FY17 PRO SE POST-REGISTRATION FILINGS—COST IF COUNSEL RETAINED BEFORE FILING**

<table>
<thead>
<tr>
<th>Activity performed by counsel</th>
<th>FY17</th>
<th>Median charge</th>
<th>Total charge</th>
</tr>
</thead>
<tbody>
<tr>
<td>Section 8 and 15 †</td>
<td>976</td>
<td>$500</td>
<td>$488,000</td>
</tr>
<tr>
<td>Renewal ‡</td>
<td>405</td>
<td>500</td>
<td>202,500</td>
</tr>
<tr>
<td>Section 71 §</td>
<td>522</td>
<td>500</td>
<td>261,000</td>
</tr>
<tr>
<td>Madrid Renewal ∨</td>
<td>134</td>
<td>500</td>
<td>67,000</td>
</tr>
<tr>
<td>Total</td>
<td></td>
<td></td>
<td>1,018,500</td>
</tr>
</tbody>
</table>

* Data as of 12/10/2018.

† Under section 8 of the Act, 15 U.S.C. 1058, an affidavit or declaration of continued use is required during the sixth year after the date of registration for registrations issued under section 1 or section 44 of the Act. Section 15 of the Act, 15 U.S.C. 1065, provides a procedure by which the owner of the registration can become “incontestable,” if the owner of the registration files an affidavit or declaration stating, among other criteria, that the mark has been in continuous use in commerce for a period of five years after the date of registration.

‡ Under section 9 of the Act, 15 U.S.C. 1059, requires that registrations resulting from applications based on section 1 or section 44 be renewed at the end of each successive 10-year period following the date of registration.

§ Under section 71 of the Act, 15 U.S.C. 1141k, an affidavit or declaration of use is required during the sixth year after the date of registration for registered extensions of protection of international registrations to the U.S.

∨ The term of an international registration is ten years, and it may be renewed for ten years upon payment of the renewal fee. Articles 6(1) and 7(1) of the Common Regulations Under the Madrid Agreement Concerning the International Registration of Marks and the Protocol Relating to That Agreement.
For applicants, registrants, and parties not subject to the proposed requirement, the USPTO anticipates that implementation of the proposed rule would result in a more accurate and reliable trademark register, which would have the benefit of generally reducing costs to applicants, registrants, and parties and providing greater value to consumers who rely on registered marks. Under the proposed rule, submissions would be made by practitioners subject to the disciplinary jurisdiction of OED, making it less likely that they would be signed by an unauthorized party or contain statements that are inaccurate, particularly as to any averment of use of the mark in U.S. commerce or intention to use the mark. Because it would result in a more accurate and reliable trademark register, fewer U.S. applicants, registrants, and parties would incur the costs associated with investigating the actual use of a mark to assess any conflict, initiating proceedings to cancel a registration or oppose an application, engaging in civil litigation to resolve a dispute over a mark, or changing business plans to avoid use of a chosen mark.

Discussion of Proposed Regulatory Changes

The USPTO proposes to amend § 2.2 to add § 2.22(o), defining “domicile” and § 2.22(p), defining “principal place of business.”

The USPTO proposes to amend § 2.11 to change the title to “Requirement for representation,” to delete the first sentence, to include the remaining sentence in new § 2.11(a) and to add § 2.11(b)–(e), which set out the requirements regarding representation of applicants, registrants, or parties to a proceeding whose domicile or principal place of business is not located within the U.S. or its territories.

The USPTO proposes to amend § 2.17(e) to change the word “Canadian” in the title to “Foreign,” to state that recognition of foreign attorneys and agents is governed by § 11.14(c) of this chapter, and to delete current § 2.17(e)(1) and (2).

The USPTO proposes to amend § 2.22 to add § 2.22(a)(21), which would require representation by a U.S. attorney for applicants, registrants, or parties to a proceeding whose domicile or principal place of business is not located within the U.S. or its territories.

The USPTO proposes to amend § 2.32(a)(4) to indicate that when the applicant is, or must be, represented by a practitioner, the practitioner’s name, postal address, email address, and bar information are required.

The USPTO proposes to redesignate current § 11.14(c) as § 11.14(c)(1) and to clarify the requirements for reciprocal recognition in revised paragraph (c)(1). The USPTO also proposes to add § 11.14(c)(2) to require that in any trademark matter where an authorized foreign attorney or agent is representing an applicant, registrant, or party to a proceeding, a qualified U.S. attorney must also be appointed pursuant to § 2.17(b), (c) as the representative with whom the Office will communicate and conduct business and to amend § 11.14(e) to add the prefatory phrase “Except as specified in § 2.11(a) of this chapter” and the wording “or on behalf of” to the second sentence and to delete the third sentence. The USPTO also proposes to delete the wording “if such firm, partnership, corporation, or association is a party to a trademark proceeding pending before the Office” from § 11.14(e)(3).

Rulemaking Requirements

A. Administrative Procedure Act: The changes in this rulemaking involve rules of agency practice and procedure, and/or interpretive rules. See Perez v. Mortg. Bankers Ass’n, 135 S. Ct. 1199, 1204 (2015) (Interpretive rules “advise the public of the agency’s construction of the statutes and rules which it administers.” (citation and internal quotation marks omitted)); Nat’l Org. of Veterans’ Advocates v. Sec’y of Veterans Affairs, 260 F.3d 1365, 1375 (Fed. Cir. 2001) (Rule that clarifies interpretation of a statute is interpretive.); Bachow Commc’ns Inc. v. FCC, 237 F.3d 683, 690 (D.C. Cir. 2001) (Rules governing an application process are procedural under the Administrative Procedure Act.); Inova Alexandria Hosp. v. Shalala, 244 F.3d 342, 350 (4th Cir. 2001) (Rules for handling appeals were procedural where they did not change the substantive standard for reviewing claims.).

Accordingly, prior notice and opportunity for public comment for the changes in this rulemaking are not required pursuant to 5 U.S.C. 553(b) or (c), or any other law. See Perez, 135 S. Ct. at 1206 (Notice-and-comment procedures are required neither when an agency “issue[s] an initial interpretive rule” nor “when it amends or repeals that interpretive rule.”); Cooper Techs. Co. v. Dudas, 536 F.3d 1330, 1336–37 (Fed. Cir. 2008) (stating that 5 U.S.C. 553, and thus 35 U.S.C. 2(b)(2)(B), does not require notice and comment rulemaking for “interpretative rules, general statements of policy, or rules of agency organization, procedure, or practice” (quoting 5 U.S.C. 553(b)(A))). However, the Office has chosen to seek public comment before implementing the rule to benefit from the public’s input.

B. Initial Regulatory Flexibility Analysis: Under the Regulatory Flexibility Act (5 U.S.C. 601 et seq.), whenever an agency is required by 5 U.S.C. 553 (or any other law) to publish a notice of proposed rulemaking (NPRM), the agency must prepare and make available for public comment an Initial Regulatory Flexibility Analysis (IRFA), unless the agency certifies under 5 U.S.C. 605(b) that the proposed rule, if implemented, will not have a significant economic impact on a substantial number of small entities. 5 U.S.C. 603, 605. The USPTO publishes this IRFA to examine the impact on small entities of the Office’s proposed requirement that foreign applicants, registrants, or parties to a proceeding be represented by a qualified U.S. attorney in trademark matters and to seek the public’s views.

Items 1–5 below discuss the five items specified in 5 U.S.C. 603(b)(1)–(5) to be addressed in an IRFA. Item 5 below discusses alternatives to this proposal that the Office considered.

1. Description of the reasons that action by the USPTO is being considered:

The USPTO proposes to require applicants, registrants, or parties to a proceeding whose domicile or principal place of business is not located within the U.S. or its territories to be represented by an attorney who is an active member in good standing of the bar of the highest court of a state in the U.S. and who is qualified to represent others before the Office in trademark matters.

The requirement for representation by a qualified U.S. attorney is being proposed in response to the increasing problem of foreign trademark applicants who purportedly are pro se and who are filing what appear to be inaccurate and even fraudulent submissions that violate the Act and/or the USPTO’s rules. In the past few years, the USPTO has seen many instances of UPL where foreign parties who are not authorized to represent trademark applicants are improperly representing foreign applicants before the USPTO. As a result, increasing numbers of foreign applicants are likely receiving inaccurate or no information about the legal requirements for trademark registration in the U.S., such as the standards for use of a mark in commerce, who can properly aver to matters and sign for the mark owner, or even who the true owner of a mark is under U.S. law. This practice raises legitimate concerns that affected
applications and any resulting registrations are potentially invalid, particularly as to averments of use of the mark in U.S. commerce or intention to use the mark, and thus negatively impacts the integrity of the national trademark register.

The proposed requirement is also necessary to enforce compliance by all foreign applicants, registrants, and parties with U.S. statutory and regulatory requirements in trademark matters. Thus, it will not only aid the USPTO in its efforts to improve and preserve the integrity of the U.S. trademark register, but will also ensure that foreign applicants, registrants, and parties are assisted only by authorized practitioners who are subject to the USPTO's disciplinary rules.

2. Succinct statement of the objectives of, and legal basis for, the proposed rule:

The policy objectives of the proposed rule are to: (1) Instill greater confidence in the public that U.S. registrations that issue to foreign applicants are not subject to invalidation for reasons such as improper signatures and use claims and (2) enable the USPTO to more effectively use available mechanisms to enforce foreign applicant compliance with statutory and regulatory requirements in trademark matters.

Further, the USPTO anticipates that implementation of the proposed rule would result in a more accurate and reliable trademark register, which would have the benefit of generally reducing costs to applicants, registrants, and parties. Under the proposed rule, submissions would be made by practitioners subject to the disciplinary jurisdiction of OED, making it less likely that they would be signed by an unauthorized party or contain statements that are inaccurate, particularly as to any averment of use of the mark in U.S. commerce or intention to use the mark. Therefore, fewer U.S. applicants, registrants, and parties should incur the costs associated with investigating the actual use of a mark to assess any conflict, initiating proceedings to cancel a registration or oppose an application, engaging in civil litigation to resolve a dispute over a mark, or changing business plans to avoid use of a chosen mark.

3. Description of and, where feasible, estimate of the number of affected small entities:

The USPTO does not collect or maintain statistics in trademark cases on small- versus large-entity applicants, and this information would be required in order to determine the number of small entities that would be affected by the proposed rule. The proposed rule would apply to any entity filing with USPTO whose domicile or principal place of business is not located within the U.S. or its territories. The USPTO believes that although such entities would incur the costs associated with retaining counsel to prosecute applications and handle maintenance filings for registrations, the overall impact of the proposed rule on such entities would be positive, because it would (1) instill greater confidence in the public that U.S. registrations that issue to foreign applicants are not subject to invalidation for reasons such as improper signatures and use claims and (2) enable the USPTO to more effectively use available mechanisms to enforce foreign applicant compliance with statutory and regulatory requirements in trademark matters.

The USPTO considered three alternatives before recommending that foreign applicants, registrants, or parties be represented by a qualified U.S. attorney. The USPTO chose the alternative proposed herein because it will enable the Office to achieve its goals effectively and efficiently. Those goals are to (1) instill greater confidence in the public that U.S. registrations that issue to foreign applicants are not subject to invalidation for reasons such as improper signatures and use claims and (2) enable the USPTO to more effectively use available mechanisms to enforce foreign applicant compliance with statutory and regulatory requirements in trademark matters.

Due to the difficulty in quantifying the intangible benefits associated with the preferred alternative, the Office provides below a discussion of the qualitative benefits to trademark applicants and registrants. One of the primary benefits of the preferred alternative is ensuring the accuracy of the trademark register. The accuracy of the trademark register as a reflection of marks that are actually in use in commerce in the U.S. for the goods/services identified in the registrations listed therein serves a critical purpose for the public and for all registrants. By registering trademarks, the USPTO has a significant role in protecting consumers, as well as providing important benefits to American businesses, by allowing them to strengthen and safeguard their brands and related investments. Such benefits would be especially valuable for small entities for the following reasons. The public relies on the register to determine whether a chosen mark is available for use or registration. When a person’s search of the register discloses a potentially confusingly similar mark, that person may incur a variety of resulting costs and burdens, such as those associated with investigating the actual use of the disclosed mark to assess any conflict, initiating proceedings to cancel the registration or oppose the application of the disclosed mark, engaging in civil litigation to resolve a dispute over the mark, or changing business plans to avoid use of the party’s chosen mark. In addition, such persons may incur costs and burdens unnecessarily if a registered mark is not actually in use in commerce in the U.S., or is not in use in commerce in connection with all the goods/services identified in the registration. An accurate and reliable trademark register helps avoid such needless costs and burdens. A valid claim of use made as to a registered mark likewise benefits the registrant. Fraudulent or inaccurate claims of use jeopardize the validity of any resulting registration and may subject it to attack and render it vulnerable to cancellation.

The chosen alternative also addresses the increasing problem of foreign trademark applicants who purportedly are present and who are filing what appear to be inaccurate and possibly even fraudulent submissions that violate
the Act and/or the USPTO’s rules.

Requiring foreign applicants, registrants, and parties to retain U.S. counsel in all trademark matters before the USPTO will likely reduce the instances of UPL and misconduct and, when misconduct does occur, it will enable OED to more effectively pursue those who are engaged in the UPL and/or misconduct. The threat of a claim of UPL has not been effective with foreign applicants and the unqualified foreign individuals, attorneys, or firms advising them.

The USPTO has estimated the costs for complying with the proposed rule using FY17 filing numbers for pro se applicants and registrants with a domicile or principal place of business outside the U.S. or its territories, and for Madrid applicants and registrants. As discussed in the preamble, the cost estimates reflect the representation status at the time the USPTO electronic record was searched to obtain the data.

Applicants under section 1 or section 44 of the Act who are subject to the proposed requirement would be required to retain U.S. counsel to meet the requirements for a complete application under proposed § 2.32(a)(4). If such applicants did not retain counsel prior to filing an application, the USPTO estimates that the cost for representation would be $42,413,400. The estimated cost if such applicants had retained counsel prior to filing their applications would be $73,800,950. Madrid applications, which are based on section 66(a) of the Act, are initially filed with the IB and subsequently transmitted to the USPTO. In FY17, the USPTO received 24,418 Madrid applications in which the applicant had an address outside the U.S. or its territories, and thus would be subject to the proposed requirement. There is currently no provision for designating a U.S. attorney in an application submitted to the IB. Therefore, the USPTO presumes that none of the Madrid applicants subject to the requirement would have retained U.S. counsel prior to filing. However, USPTO records indicate that at some point after filing, 14,602 of those FY17 Madrid applicants were represented by counsel. Therefore, only the remaining 9,816 Madrid applicants would be subject to the requirement to retain U.S. counsel to prosecute their applications. Therefore, the USPTO estimates the cost to all FY17 Madrid applicants to retain counsel after filing their applications as $9,816,000. The estimated costs to FY17 pro se registrants who registered under section 1, section 44, or section 66(a) and who would be subject to the requirement to retain U.S. counsel when filing a post-registration maintenance document is $1,018,500.

The costs to comply with the requirement proposed herein would be borne by foreign applicants, registrants, and parties. The proposed requirement would not impact individuals or large or small entities with a domicile or principal place of business within the U.S. Moreover, the proposed requirement would provide qualitative value to all applicants and registrants, as well as to consumers, because it would result in a more accurate and reliable trademark register. Under the proposed rule, submissions would be made by practitioners subject to the disciplinary jurisdiction of OED, making it less likely that they would be signed by an unauthorized party or contain statements that are inaccurate, particularly as to any aversion of use of the mark in U.S. commerce or intention to use the mark. Because it would result in a more accurate and reliable trademark register, fewer applicants, registrants, and parties would incur the costs associated with investigating the actual use of a mark to assess any conflict, initiating proceedings to cancel a registration or oppose an application, engaging in civil litigation to resolve a dispute over a mark, or changing business plans to avoid use of a chosen mark.

The second alternative considered would be to take no action at this time. This alternative was rejected because the Office has determined that the requirement is needed to accomplish the stated objectives of instilling greater confidence in the public that U.S. registrants, and parties would incur the costs associated with invalidation for reasons such as improper signatures and use claims and enabling the USPTO to more effectively use available mechanisms to enforce foreign applicant compliance with statutory and regulatory requirements in trademark matters.

A third alternative considered was to propose a revision to § 2.22 that would require foreign applicants to retain U.S. counsel in order to obtain a filing date for an application under section 1 and/or section 44 of the Act. This alternative was rejected due to international considerations. Thus, when the USPTO receives an application filed by a foreign domiciliary, with a filing basis under section 1 and/or section 44 of the Act that does not comply with the requirements of proposed § 2.22(a), the USPTO must inform the applicant that appointment of a qualified U.S. attorney is required. Although this places an additional burden on the USPTO, it will not be the impact of the proposed rule on small entities. Although such entities may choose to incur the cost of retaining counsel to prepare and file an application, they would not be required to do so.

6. Identification, to the extent practicable, of all relevant Federal rules which may duplicate, overlap, or conflict with the proposed rule:

The proposed rule would not duplicate, overlap, or conflict with any other Federal rules.

C. Executive Order 12866 (Regulatory Planning and Review): This rulemaking has been determined to be significant for purposes of Executive Order 12866 (Sept. 30, 1993).

D. Executive Order 13563 (Improving Regulation and Regulatory Review): The Office has complied with Executive Order 13563 (Jan. 18, 2011).

Specifically, the Office has, to the extent feasible and applicable: (1) Made a reasoned determination that the benefits justify the costs of the rule; (2) tailored the rule to impose the least burden on society consistent with obtaining the regulatory objectives; (3) selected a regulatory approach that maximizes net benefits; (4) specified performance objectives; (5) identified and assessed available alternatives; (6) involved the public in an open exchange of information and perspectives among experts in relevant disciplines, affected stakeholders in the private sector and the public as a whole, and provided online access to the rulemaking docket; (7) attempted to promote coordination, simplification, and harmonization across government agencies and identified goals designed to promote innovation; (8) considered approaches that reduce burdens and maintain flexibility and freedom of choice for the public; and (9) ensured the objectivity of scientific and technological information and processes.

E. Executive Order 13771 (Reducing Regulation and Controlling Regulatory Costs): This proposed rule is not subject to the requirements of E.O. 13771 because it is expected to result in no more than de minimis costs to citizens and residents of the United States.

F. Executive Order 13132 (Federalism): This rulemaking does not contain policies with federalism implications sufficient to warrant preparation of a Federalism Assessment under Executive Order 13132 (Aug. 4, 1999).

G. Executive Order 13175 (Tribal Consultation): This rulemaking will not: (1) Have substantial direct effects on one or more Indian tribes; (2) impose substantial direct compliance costs on Indian tribal governments; or (3) preempt tribal law. Therefore, a tribal summary impact statement is not
required under Executive Order 13175 (Nov. 6, 2000).

H. Executive Order 13211 (Energy Effects): This rulemaking is not a significant energy action under Executive Order 13211 because this rulemaking is not likely to have a significant adverse effect on the supply, distribution, or use of energy. Therefore, a Statement of Energy Effects is not required under Executive Order 13211 (May 18, 2001).

I. Executive Order 12988 (Civil Justice Reform): This rulemaking meets applicable standards to minimize litigation, eliminate ambiguity, and reduce burden as set forth in sections 3(a) and 3(b)(2) of Executive Order 12988 (Feb. 5, 1996).

J. Executive Order 13045 (Protection of Children): This rulemaking does not concern an environmental risk to health or safety that may disproportionately affect children under Executive Order 13045 (Apr. 21, 1997).

K. Executive Order 12630 (Taking of Private Property): This rulemaking will not affect a taking of private property or otherwise have taking implications under Executive Order 12630 (Mar. 15, 1988).

L. Congressional Review Act: Under the Congressional Review Act provisions of the Small Business Regulatory Enforcement Fairness Act of 1996 (5 U.S.C. 801 et seq.), prior to issuing any final rule, the USPTO will submit a report containing the final rule and other required information to the United States Senate, the United States House of Representatives, and the Comptroller General of the Government Accountability Office. The changes in this notice are not expected to result in an annual effect on the economy of 100 million dollars or more, a major increase in costs or prices, or significant adverse effects on competition, employment, investment, productivity, innovation, or the ability of United States-based enterprises to compete with foreign-based enterprises in domestic and export markets. Therefore, this notice is not expected to result in a major rule as defined in 5 U.S.C. 804(2).

M. Unfunded Mandates Reform Act of 1995: The changes set forth in this notice do not involve a Federal intergovernmental mandate that will result in the expenditure by State, local, and tribal governments, in the aggregate, of 100 million dollars (as adjusted) or more in any one year, or a Federal private sector mandate that will result in the expenditure by the private sector of 100 million dollars (as adjusted) or more in any one year, and will not significantly or uniquely affect small governments. Therefore, no actions are necessary under the provisions of the Unfunded Mandates Reform Act of 1995. See 2 U.S.C. 1501 et seq.

N. National Environmental Policy Act: This rulemaking will not have any effect on the quality of the environment and is thus categorically excluded from review under the National Environmental Policy Act of 1969. See 42 U.S.C. 4321 et seq.

O. National Technology Transfer and Advancement Act: The requirements of section 12(d) of the National Technology Transfer and Advancement Act of 1995 (15 U.S.C. 3501 et seq.). The collection of information involved in this rule has been reviewed and previously approved by OMB under control numbers 0651–0009, 0651–0050, 0651–0051, 0651–0054, 0651–0055, 0651–0056, and 0651–0061. We estimate that 41,000 applications will have an additional burden of 5 minutes due to this rulemaking, adding in 3,000 burden hours across all trademark collections.

Notwithstanding any other provision of law, no person is required to respond to nor shall a person be subject to a penalty for failure to comply with a collection of information subject to the requirements of the Paperwork Reduction Act unless that collection of information displays a currently valid OMB control number.

List of Subjects
37 CFR Part 2
Administrative practice and procedure, Trademarks.

37 CFR Part 11
Administrative practice and procedure, Lawyers, Trademarks.

For the reasons stated in the preamble and under the authority contained in 15 U.S.C. 1123 and 35 U.S.C. 2, as amended, the Office proposes to amend parts 2 and 11 of title 37 as follows:

PART 2—RULES OF PRACTICE IN TRADEMARK CASES

1. The authority citation for 37 CFR part 2 continues to read as follows:


2. Amend § 2.2 by adding paragraphs (o) and (p) to read as follows:

§ 2.2 Definitions.
* * * * * 

(o) The term domicile as used in this part means the permanent legal place of residence of a natural person.

(p) The term principal place of business as used in this part means the location of a juristic entity’s headquarters where the entity’s senior executives or officers ordinarily direct and control the entity’s activities and is usually the center from where other locations are controlled.

3. Revise § 2.11 to read as follows:

§ 2.11 Requirement for representation.

(a) An applicant, registrant, or party to a proceeding whose domicile or principal place of business is not located within the United States or its territories must be represented by an attorney, as defined in § 11.1 of this chapter, who is qualified to practice under § 11.14 of this chapter. The Office cannot aid in the selection of an attorney.

(b) The Office may require an applicant, registrant, or party to a proceeding to furnish such information or declarations as may be reasonably necessary to the proper determination of whether the applicant, registrant, or party is subject to the requirement in paragraph (a) of this section.

(c) An applicant, registrant, or party to a proceeding may be required to state whether assistance within the scope of § 11.5(b)(2) of this chapter was received in a trademark matter before the Office and, if so, to disclose the name(s) of the person(s) providing such assistance and whether any compensation was given or charged.

(d) Failure to respond to requirements issued pursuant to paragraphs (a) through (c) of this section is governed by § 2.65.

(e) Providing false, fictitious, or fraudulent information in connection with the requirements of paragraphs (a) through (c) of this section shall be deemed submitting a paper for an improper purpose, in violation of § 11.18(b) of this chapter, and subject to the sanctions and actions provided in § 11.18(c).

4. Amend § 2.17 by revising paragraph (e) to read as follows:

§ 2.17 Recognition for representation.
* * * * * 

(e) Foreign attorneys and agents.

Recognition to practice before the Office in trademark matters is governed by § 11.14(c) of this chapter.

* * * * *
§ 2.22 Requirements for a TEAS Plus application.
(a) * * *
(21) An applicant whose domicile or principal place of business is not located within the United States or its territories must designate an attorney as the applicant’s representative, pursuant to § 2.11(a).
* * * * *
§ 2.32 Requirements for a complete trademark or service mark application.
(a) * * *
(4) The address of the applicant. When the applicant is, or must be, represented by a practitioner, as defined in § 11.1 of this chapter, who is qualified to practice under § 11.14 of this chapter, the practitioner’s name, postal address, email address, and bar information;
* * * * *
PART 11—REPRESENTATION OF OTHERS BEFORE THE UNITED STATES PATENT AND TRADEMARK OFFICE
§ 7. The authority citation for 37 CFR part 11 continues to read as follows:
§ 8. Amend § 11.14 by revising paragraphs (c) and (e) to read as follows:
§ 11.14 Individuals who may practice before the Office in trademark and other non-patent matters.
* * * * *
(c) Foreigners. (1) Any foreign attorney or agent not a resident of the United States who shall file a written application for reciprocal recognition under paragraph (f) of this section and prove to the satisfaction of the OED Director that he or she is a registered and active member in good standing before the trademark office of the country in which he or she resides and practices and possesses good moral character and reputation, may be recognized for the limited purpose of representing parties located in such country before the Office in the presentation and prosecution of trademark matters, provided: The trademark office of such country and the USPTO have reached an official understanding to allow substantially reciprocal privileges to those permitted to practice in trademark matters before the Office. Recognition under this paragraph (c) shall continue only during the period that the conditions specified in this paragraph (c) obtain.
(2) In any trademark matter where a foreign attorney or agent authorized under paragraph (c)(1) of this section is representing an applicant, registrant, or party to a proceeding, an attorney, as defined in § 11.1 and qualified to practice under paragraph (a) of this section, must also be appointed pursuant to § 2.17(b) and (c) of this chapter as the representative with whom the Office will communicate and conduct business.
* * * * *
(e) Appearance. No individual other than those specified in paragraphs (a), (b), and (c) of this section will be permitted to practice before the Office in trademark matters on behalf of a client. Except as specified in § 2.11(a) of this chapter, an individual may appear in a trademark or other non-patent matter in his or her own behalf or on behalf of:
(1) A firm of which he or she is a member;
(2) A partnership of which he or she is a partner; or
(3) A corporation or association of which he or she is an officer and which he or she is authorized to represent.
* * * * *
Dated: February 6, 2019.
Andrei Iancu,
Under Secretary of Commerce for Intellectual Property and Director of the United States Patent and Trademark Office.
[FR Doc. 2019–02154 Filed 2–14–19; 8:45 am]
BILLING CODE 3510–16–P

ENVIRONMENTAL PROTECTION AGENCY
40 CFR Part 52
Air Plan Approval; Florida; 2008 8-Hour Ozone Interstate Transport
AGENCY: Environmental Protection Agency (EPA).
ACTION: Proposed rule.
SUMMARY: The Environmental Protection Agency (EPA) is proposing to approve Florida’s October 3, 2017, State Implementation Plan (SIP) submission pertaining to the “good neighbor” provision of the Clean Air Act (CAA or Act) for the 2008 8-hour ozone National Ambient Air Quality Standards (NAAQS). The good neighbor provision requires each state’s implementation plan to address the interstate transport of air pollution in amounts that contribute significantly to nonattainment, or interfere with maintenance of a NAAQS in any other state. In this action, EPA is proposing to determine that Florida’s SIP contains adequate provisions to prohibit emissions within the state from contributing significantly to nonattainment or interfering with maintenance of the 2008 8-hour ozone NAAQS in any other state.
DATES: Comments must be received on or before March 18, 2019.
ADDRESSES: Submit your comments, identified by Docket ID No. EPA–R04–OAR–2018–0542 at https://www.regulations.gov. Follow the online instructions for submitting comments. Once submitted, comments cannot be edited or removed from regulations.gov. EPA may publish any comment received to its public docket. Do not submit electronically any information you consider to be Confidential Business Information (CBI) or other information whose disclosure is restricted by statute. Multimedia submissions (audio, video, etc.) must be accompanied by a written comment. The written comment is considered the official comment and should include discussion of all points you wish to make. EPA will generally not consider comments or comment contents located outside of the primary submission (i.e., on the web, cloud, or other file sharing system). For additional submission methods, the full EPA public comment policy, information about CBI or multimedia submissions, and general guidance on making effective comments, please visit https://www2.epa.gov/dockets/commenting-epa-dockets.
FOR FURTHER INFORMATION CONTACT: Nacosta C. Ward, Air Regulatory Management Section, Air Planning and Implementation Branch, Air, Pesticides and Toxics Management Division, U.S. Environmental Protection Agency, Region 4, 61 Forsyth Street SW, Atlanta, Georgia 30303–8960. Ms. Ward can also be reached via telephone at (404) 562–9140 and via electronic mail at ward.nacosta@epa.gov.
SUPPLEMENTARY INFORMATION:
I. Background
On March 12, 2008, EPA promulgated an ozone NAAQS that revised the levels of the primary and secondary 8-hour ozone standards from 0.08 parts per
I. Introduction

Use of a mark in commerce must be lawful under federal law to be the basis for federal registration under the U.S. Trademark Act. See generally Trademark Manual of Examining Procedure (TMEP) §907. The United States Patent and Trademark Office (USPTO) refuses to register marks for goods and/or services that show a clear violation of federal law, regardless of the legality of the activities under state law. A determination of whether commerce involving cannabis and cannabis-related goods and services is lawful requires consultation of several different federal laws, including the Controlled Substances Act, 21 U.S.C. §§801 et seq., the Federal Food Drug and Cosmetic Act, 21 U.S.C. §§301 et seq., and the Agriculture Improvement Act of 2018, Pub. L. 115-334 (the 2018 Farm Bill), which amends the Agricultural Marketing Act of 1946 (AMA). The USPTO issues this examination guide to clarify the procedure for examining marks for cannabis and cannabis-derived goods and for services involving cannabis and cannabis production following the 2018 Farm Bill.

II. Examination of marks for cannabis and cannabis-derived goods such as cannabidiol

Under the Controlled Substances Act (CSA), the drug class “Marihuana” (commonly referred to as “marijuana”) is defined as “all parts of the plant Cannabis sativa L., whether growing or not; the seeds thereof; the resin extracted from any part of such plant; and every compound, manufacture, salt, derivative, mixture, or preparation of such plant, its seeds or resin” (subject to certain exceptions). 21 U.S.C. §802(16). Cannabidiol (CBD) is a chemical constituent of the cannabis plant that is encompassed within the CSA’s definition of marijuana. See Clarification of the New Drug Code (7350) for Marijuana Extract, https://www.deadiversion.usdoj.gov/schedules/marijuana/m_extract_7350.html, last accessed April 23, 2019; see also, 21 C.F.R. §1308.11(d)(58). The CSA prohibits, among other things, manufacturing, distributing, dispensing, or possessing certain controlled substances, including marijuana. 21 U.S.C. §§812, 841(a)(1), 844(a). Therefore, the USPTO refuses registration when an application identifies goods encompassing CBD or other extracts of marijuana because such goods are unlawful under federal law and do not support valid use of the applied-for mark in commerce.

The 2018 Farm Bill, which was signed into law on December 20, 2018, amends the AMA and changes certain federal authorities relating to the production and marketing of “hemp,” defined as “the plant Cannabis sativa L. and any part of that plant, including the seeds thereof and all derivatives, extracts, cannabinoids, isomers, acids, salts, and salts of isomers, whether growing or not, with a delta-9 tetrahydrocannabinol [THC] concentration of not more than 0.3 percent on a dry weight basis.” Section 297A. These changes include removing “hemp” from the CSA’s definition of marijuana, which means that cannabis plants and derivatives such as CBD that contain no more than 0.3% THC on a dry-weight basis are no longer controlled substances under the CSA.

For applications filed on or after December 20, 2018 that identify goods encompassing cannabis or CBD, the 2018 Farm Bill potentially removes the CSA as a ground for refusal of registration, but only if the goods are derived from "hemp." Cannabis and CBD derived from
marijuana (i.e., Cannabis sativa L. with more than 0.3% THC on a dry-weight basis) still violate federal law, and applications encompassing such goods will be refused registration regardless of the filing date. If an applicant’s goods are derived from “hemp” as defined in the 2018 Farm Bill, the identification of goods must specify that they contain less than 0.3% THC. Thus, the scope of the resulting registration will be limited to goods compliant with federal law.

For applications filed before December 20, 2018 that identify goods encompassing CBD or other cannabis products, registration will be refused due to the unlawful use or lack of bona fide intent to use in lawful commerce under the CSA. Such applications did not have a valid basis to support registration at the time of filing because the goods violated federal law. However, because of the enactment of the 2018 Farm Bill, the goods are now potentially lawful if they are derived from “hemp” (i.e., contain less than 0.3% THC). Therefore, the examining attorney will provide such applicants the option of amending the filing date and filing basis of the application to overcome the CSA as a ground of refusal.

Specifically, the examining attorney will advise the applicant that it may request to amend the filing date of the application to December 20, 2018. The applicant must specifically state for the record that such a change to the filing date is being authorized and must establish a valid filing basis under 37 C.F.R. §2.34 by satisfying the relevant requirements. See 37 C.F.R. §§2.34 et seq., TMEP §§806 et seq. If the application was originally based on use of the mark in commerce under Section 1(a) of the Trademark Act, 15 U.S.C. §1051(a), the applicant will be required to amend the basis to intent to use the mark in commerce under Section 1(b), 15 U.S.C. §1051(b). Because of the new legal definition of “hemp” under the 2018 Farm Bill, the applicant will also be required to amend the identification of goods to specify that the CBD or cannabis products contain less than 0.3% THC. If the applicant elects to amend the application, the examining attorney will conduct a new search of the USPTO records for conflicting marks based on the later application filing date. TMEP §§206.01, 1102.03. The examining attorney will also advise the applicant that, in lieu of amending the application, it may elect to abandon the subject application and file a new application. Alternatively, the applicant may respond to the stated refusal by submitting evidence and arguments against the refusal.

Applicants should be aware that even if the identified goods are legal under the CSA, not all goods for CBD or hemp-derived products are lawful following the 2018 Farm Bill. Such goods may also raise lawful-use issues under the Federal Food Drug and Cosmetic Act (FDCA). The use in foods or dietary supplements of a drug or substance undergoing clinical investigations without approval of the U.S. Food and Drug Administration (FDA) violates the FDCA. 21 U.S.C. §331(ll); see also 21 U.S.C. §321(ff) (indicating that a dietary supplement is deemed to be a food within the meaning of the FDCA). The 2018 Farm Bill explicitly preserved FDA’s authority to regulate products containing cannabis or cannabis-derived compounds under the FDCA. CBD is an active ingredient in FDA-approved drugs and is a substance undergoing clinical investigations. See FDA Regulation of Cannabis and Cannabis-Derived Products: Questions and Answers, available at https://www.fda.gov/newsevents/publichealthfocus/ucm421168.htm#whatare, last accessed April 23, 2019. Therefore, registration of marks for foods, beverages, dietary supplements, or pet treats containing CBD will still be refused as unlawful under the FDCA, even if derived from hemp, as such goods may not be introduced lawfully into interstate commerce. 21 U.S.C. §331(ll); see also statement of former FDA Commissioner Scott Gottlieb, M.D., on signing of the Agriculture Improvement Act and the agency’s regulation of products containing cannabis and cannabis-derived compounds. https://www.fda.gov/NewsEvents/Newsroom/PressAnnouncements/ucm628988.htm
III. Examination of marks for services involving cannabis and cannabis production

When applications recite services involving cannabis-related activities, they will be examined for compliance with the CSA and the 2018 Farm Bill. As discussed above, the CSA prohibits, among other things, manufacturing, distributing, dispensing, or possessing cannabis that meets the definition of marijuana. Therefore, the USPTO will continue to refuse registration when the identified services in an application involve cannabis that meets the definition of marijuana and encompass activities prohibited under the CSA because such services still violate federal law, regardless of the application filing date. If the identified services involve cannabis that is “hemp” (i.e., contains less than 0.3% THC), the applications will also be examined for compliance with the requirements of the 2018 Farm Bill. Applicants refused registration under the CSA will have the same options outlined in section II above of overcoming the refusal by requesting amendment of the filing date and basis of their application, and amending the identification of services to specify that the involved cannabis contains less than 0.3% THC on a dry-weight basis. In lieu of amending the application, an applicant may elect to abandon the subject application and file a new application. Alternatively, the applicant may respond to the stated refusal by submitting evidence and arguments against the refusal.

For applications that recite services involving the cultivation or production of cannabis that is “hemp” within the meaning of the 2018 Farm Bill, the examining attorney will also issue inquiries concerning the applicant’s authorization to produce hemp. Applicants will be required to provide additional statements for the record to confirm that their activities meet the requirements of the 2018 Farm Bill with respect to the production of hemp. The 2018 Farm Bill requires hemp to be produced under license or authorization by a state, territory, or tribal government in accordance with a plan approved by the U.S. Department of Agriculture (USDA) for the commercial production of hemp. To date, the USDA has not promulgated regulations, created its own hemp-production plan, or approved any state or tribal hemp-production plans. However, the 2018 Farm Bill directs that states, tribes, and institutions of higher education may continue operating under authorities of the 2014 Farm Bill until 12 months after the USDA establishes the plan and regulations required under the 2018 Farm Bill.
Examination Guide 3-19

Examination of Specimens for Use in Commerce: Digitally Created or Altered and Mockup Specimens

July 2019

I. INTRODUCTION

The ongoing issue of applicants submitting specimens that are digitally created/altered, or are mockups, has resulted in the need for the USPTO to focus more attention on whether submitted specimens are real and show the mark as actually used in commerce as required by the Trademark Act. Identifying and refusing suspicious specimens, and requiring additional information about the mark and the applicant’s claimed use of the mark, is important to maintaining the accuracy and integrity of the federal Trademark Register. This Examination Guide supplements existing guidance on examination of specimens to provide additional guidance regarding specimens that appear not to be in use in commerce because they are digitally created/altered or otherwise mocked up.

II. DEFINING DIGITALLY CREATED OR ALTERED AND MOCKUP SPECIMENS

A digitally created/altered or mockup specimen consists of an image created for the purpose of showing how the mark might be used in connection with the goods or services. Such specimens do not evidence actual use of the mark on goods sold or transported in commerce, or in the case of services, displayed in connection with services actually rendered in commerce, all in the ordinary course of trade, as required by 15 U.S.C. §1127.

- A digitally created specimen comprises a digital drawing of the goods or packaging on which the mark appears.

- A digitally altered specimen includes a digital alteration of an existing image of goods or packaging for goods, a display associated with goods, or an advertisement or
website that purports to show the mark used on the goods or in the sale, performance, or rendering of services.

- A mockup specimen comprises a digital or non-digital rendering of what a mark would look like on a product, display, or website; these may be created solely for submission with the application.

### III. IDENTIFYING DIGITALLY CREATED/ALTERED AND MOCKUP SPECIMENS

Digitally created/altered and mockup specimens range from those that are clearly manipulated to those that are more difficult to identify. The following characteristics may indicate a digitally created/altered or mockup specimen.

- The depiction of the product looks like a digital rendering rather than a real product.
- The product, label, or packaging is missing information typically included in the trade.
- The mark appears to float over the product or container.
- Features of the item disappear near or around the mark.
- The image includes pixelization around the mark.
- The mark is not applied to the product in a manner consistent with the material composition of the product.
- The mark appears on goods known to be marketed under a third-party mark.
- The website screenshot showing the mark includes placeholder text indicating that the website was not in use.
- The website screenshot showing the mark is missing important information such as a URL or browser tab, and is displayed in a way that suggests it is not published (e.g., within other software).
- Identical images display different marks or do not display any marks.
- Features of the goods suggest that the goods are used while the tag or label to which the mark is applied appears new.
- The labeling appears to be crudely applied to containers or plain boxes.
- The mark appears superimposed onto signage or other advertising or marketing materials for services.
- A webpage for an online marketplace, submitted as a display associated with the goods, includes indicia indicating that the mark is not in use in U.S. commerce or was not in use on the dates of use indicated in the application (e.g., language, currency, price, first available date, ship-to destination).

This list is not exhaustive; other characteristics not listed above also may indicate a specimen does not show use of the mark in commerce.

### IV. GENERAL EXAMINATION CONSIDERATIONS FOR DIGITALLY CREATED/ALTERED OR MOCKUP SPECIMENS

Examining attorneys must carefully evaluate each specimen for signs indicating that it may have been digitally created/altered or is a mockup. Descriptions of the specimens should be taken into consideration. However, if facts in the record contradict the accuracy of the description of the specimen, these must be considered when determining the acceptability of the specimen.
A. Retouched Images on White Backgrounds

Where the specimen is an image of a product bearing the mark and the image appears to be a retouched image (e.g., on a white background), the examining attorney may conduct research to confirm that a product depicted in the specimen exists. If the examining attorney is able to confirm that the product depicted in the specimen exists and shows use of the mark in commerce, the examining attorney may accept the specimen. In that case, the examining attorney must enter a Note to the File that indicates what resources were checked without including any statements or legal conclusions regarding the use of the mark. The Note to the File may be “checked applicant’s website at [URL of page checked]” or “checked Amazon.com at [URL of page checked].” In instances where the examining attorney confirms that a product exists bearing the mark, but the content of the listing or page where the product is found is suspicious for other reasons that indicate it is very unlikely that products or services offered under the mark have actually been sold or rendered in commerce, the examining attorney may issue requests for information concerning the applicant’s use of the mark. 37 C.F.R. §2.61(b).

B. Digitally Created/Altered or Mockup Specimens

If a specimen appears to be digitally created/ altered or otherwise mocked up, the examining attorney must issue a refusal under Trademark Act Sections 1 and 45 on the grounds that the specimen does not show actual use of the applied-for mark in commerce. 15 U.S.C. §§1051, 1127; TMEP §904.04(a). The refusal must include an explanation of the reasons the specimen appears to be digitally altered or created.

When issuing a refusal because the specimen does not appear to show actual use of the mark in commerce, the examining attorney must also issue a request for information under 37 C.F.R. §2.61(b) requiring the applicant to provide detailed information about the submitted specimen and other information and documents relevant to aiding a determination as to whether the mark is actually in use in commerce.

A §2.61(b) request may require information regarding: (1) the goods or services for which the specimen was submitted; (2) whether the specimen was created for submission with the application and if so, when; (3) the source of the image depicting goods; (4) how the mark is used on goods in the actual sales environment or in the rendering or performing the services, including representative examples showing such use and URLs and publication dates for web pages; (5) when the goods or services were first available for purchase and whether they are still for sale; (6) proof of sales in commerce with or within the United States for the goods in the specimen and dollar amounts of sales; (7) proof of use for additional goods or services identified in the application; or (8) any other information relevant to a determination regarding actual use of the mark in commerce on or in connection with the identified goods/services. However, the request for information must be tailored to the particular facts of an application and generally should not seek information that already exists in the record.

In almost all cases, requests for additional information should be made only when a refusal of registration under Sections 1 and 45 for failure to show use in commerce is being made. Only in very limited circumstances where the examining attorney cannot point to indicia on the specimen itself to support a refusal but there is something suspicious about the contents or display of the specimen that suggests that the mark is not in actual use in commerce, and the examining attorney needs more information for proper examination of the issue, may a request for information be issued without also issuing a refusal.
In some instances, the record may contain both digitally altered/created or mocked up specimens and specimens that may appear not to be digitally altered/created or mocked up. Because the digitally altered/created specimens raise a question as to whether the other specimens were in use in commerce, in these cases the examining attorney must issue a refusal for failure to show use of the mark in commerce along with a request for information.

In all cases, the examining attorney must also include all other relevant specimen-based grounds in the refusal under Sections 1 and 45. For example, applications containing digitally created/ altered or mockup specimens may not show use of the mark with any of the goods/services listed in the application. Likewise, a digitally created website or advertisement also may not show a direct association between the mark and the goods or services. Additionally, if the specimen fails to show the mark functioning as a mark (e.g., the mark is merely informational or is used in an ornamental manner) the examining attorney must also issue a refusal under Sections 1, 2, and 45 or 1, 2, 3, and 45, as appropriate. See TMEP §§904.07(a), (b).

V. EVALUATING RESPONSES

If the applicant satisfactorily responds to all requests for information and the original or substitute specimen does not contradict the response, the specimen must be accepted. However, if the applicant does not provide an acceptable specimen and/or fails to respond or provides incomplete or unsatisfactory responses, the examining attorney must carefully evaluate the responses to determine whether a final refusal under Sections 1 and 45 and/or a final requirement under §2.61(b) is appropriate.

VI. GATHERING EVIDENCE

Generally, extrinsic evidence is not required to support a first-action refusal for a digitally created/ altered or mockup specimen because the specimen itself provides the evidence why it cannot be accepted. Nevertheless, the examining attorney should conduct a search for an image if the examining attorney recognizes the image as appropriated or if there are other signs that the specimen is digitally created/ altered or a mockup. Such evidence should be provided to create a more comprehensive record in a final refusal.

The examining attorney may use free image search and analysis tools available online, such as Google®. When making Google® evidence part of the record, the examining attorney must both (1) provide complete information as to the date the evidence was published or accessed from the Internet and its source (e.g., the complete URL address of the website), and (2) download and attach the evidence to the Office action. TMEP §710.01(b).

Other sources of evidence the examining attorney may consider are Office records such as an X-search record for a registration for the trade dress associated with an appropriated image or a copy of the specimen from the file of the registered mark associated with an appropriated image.
Examination Guide 4-19 (Revised)

Requirement of U.S.-Licensed Attorney for Foreign-Domiciled Trademark Applicants and Registrants

September 2019

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On July 2, 2019, the United States Patent and Trademark Office (USPTO) published a final rule (Requirement of U.S. Licensed Attorney for Foreign Trademark Applicants and Registrants, 84 FR 31498) requiring applicants, registrants, or parties to a trademark proceeding whose domicile is not located within the United States (U.S.) or its territories (hereafter foreign-domiciled applicants, registrants, or parties) to be represented by an attorney who is an active member in good standing of the bar of the highest court of a state in the U.S. (including the District of Columbia or any Commonwealth or territory of the U.S.) (hereafter U.S. attorney or U.S. counsel). In addition, the final rule requires U.S. attorneys to provide their bar information when representing applicants and registrants, whether domiciled inside or outside the U.S. It also removes the ability of foreign patent attorneys or agents to seek reciprocal recognition to practice before the USPTO in trademark matters. The changes became effective August 3, 2019 and supersede the current edition of the Trademark Manual of Examining Procedure (TMEP) to the extent any inconsistency exists.

Since issuing Examination Guide 4-19 on August 2, 2019, the USPTO has received requests for additional clarification regarding implementation of the final rule. Accordingly, the USPTO issues this revised examination guide, which supersedes all prior guidance. The USPTO continues to monitor implementation of this rule and may issue revised and/or additional guidance as needed in the future.

I. REQUIREMENT FOR REPRESENTATION

The Trademark Act has long required that the “application shall include specification of the applicant’s domicile and citizenship.” 15 U.S.C. §1051(a)(2). Under the new U.S. counsel rule, domicile dictates whether an applicant or registrant is required to have an attorney who is an active member in good standing of the bar of the highest court of a U.S. state or territory to represent the applicant or registrant at the USPTO. See 37 C.F.R. §§2.2(o), 2.11(a), 2.189.

Under this rule, the USPTO amended Rule 2.11 to require foreign-domiciled applicants, registrants, or parties to a trademark proceeding to be represented by a U.S. attorney. 37 C.F.R. §2.11(a). Further, the USPTO may require such applicants, registrants, or parties to furnish information or declarations necessary to the proper determination of whether the applicant, registrant, or party is subject to the requirement for a U.S. attorney. 37 C.F.R. §2.11(b).

All applications must include the applicant’s domicile address, and foreign-domiciled applicants must appoint a U.S. attorney to meet the requirements for a complete application. See 37 C.F.R. §§2.11(a), 2.32(a)(2), (a)(4), 2.189. Foreign-domiciled applicants submitting an application using the Trademark Electronic Application System (TEAS) Plus filing option will be required to designate a U.S. attorney in order to complete the submission of the application. 37 C.F.R. §2.22(a)(21).

A. Determining Domicile

The term “domicile” means the “permanent legal place of residence” of a natural person or the “principal place of business” of a juristic entity. 37 C.F.R. §2.2(o). Under this rule, a person’s “permanent legal place of residence” is the place the person resides and intends to be the person’s principal home. The “principal place of business” is the location of a juristic entity’s headquarters where the entity’s senior executives or officers ordinarily direct and control the entity’s activities and is usually the center from where other locations are controlled. 37 C.F.R. §2.2(p). Applicants and registrants must provide and keep current the address of their domicile. 37 C.F.R. §§2.22(a)(1), 2.32(a)(2), 2.189.
The initial determination of whether an applicant's, registrant's, or party's domicile is within or outside the U.S. is based on its street address. In most cases, a post-office box, a “care of” (c/o) address, or other similar variation cannot be a domicile address because it generally does not identify the location of the place the person resides and intends to be the person’s principal home (for a natural person) or the location of a juristic entity’s headquarters where the entity’s senior executives or officers ordinarily direct and control the entity’s activities (for a juristic entity). When necessary, the USPTO will require an applicant or registrant to confirm its domicile address.

The USPTO will implement the following procedures under this rule.

1. **Non-U.S. Domicile**

   If a foreign address (i.e., any street address that is located outside of the United States and its territories) is listed as the domicile in any submission on or after August 3, 2019, and the applicant or registrant is not represented by a U.S. attorney, the examining attorney or post-registration specialist will issue an Office action that requires the applicant or registrant to appoint a U.S. attorney as its representative. The Office action will also include any other applicable refusals and/or requirements.

   If the applicant responds, but does not appoint U.S. counsel, the examining attorney will issue a final action as to the requirement for U.S. counsel and all other unresolved refusals and/or requirements, if the file is otherwise in condition for a final action. If the registrant responds in a post-registration matter, but does not appoint U.S. counsel, the post-registration specialist will issue a second action maintaining the requirement for U.S. counsel and maintaining all prior unresolved refusals and/or requirements.

   If the applicant or registrant responds by appointing U.S. counsel, the examining attorney or post-registration specialist will withdraw the requirement for U.S. counsel. If the applicant or registrant responds by amending to a U.S. street address, but does not appoint U.S. counsel, the USPTO will follow the procedures in Section I.A.2. If the applicant or registrant responds by amending to a U.S. post-office box or “care of” address or other similar variation, the USPTO will follow the procedures in Section I.A.3.

2. **U.S. Domicile**

   If a U.S. address (i.e., any street address that is located within the United States and its territories) is listed as the domicile in any submission, an applicant or registrant need not appoint a U.S. attorney as its representative.

   Under some circumstances, the USPTO will require an applicant or registrant to provide documentation to support its U.S. address. For example, if the address appears incorrect, the examining attorney or post-registration specialist will issue an Office action requiring the applicant or registrant to provide documentation supporting the address as specified below. As another example, if the applicant or registrant is a foreign citizen or entity with a U.S. street address, and is not represented by U.S. counsel, the examining attorney or post-registration specialist will issue an Office action requiring, at the choice of the applicant or registrant, either the addition of U.S. counsel or documentation supporting the address as specified below. In such cases, the Office action will also include all other applicable refusals and/or requirements.
If the applicant or registrant responds by appointing U.S. counsel, the examining attorney or post-registration specialist will withdraw the requirement for documentation supporting the U.S. street address, unless the U.S. street address appears to be incorrect. The requirement will be reissued if the U.S. counsel withdraws or is subsequently revoked.

An applicant or registrant who provides documentation as specified below is not required to appoint U.S. counsel.

If the applicant responds but does not appoint U.S. counsel or provide the information necessary to support its U.S. street address, the examining attorney will issue a final action as to the requirements regarding domicile, U.S. counsel, and all other unresolved refusals and/or requirements, if the application is otherwise in condition for final action. If the registrant responds in a post-registration matter but does not appoint U.S. counsel or provide the information necessary to support its U.S. street address, the post-registration specialist will issue a second action maintaining the requirements regarding domicile, U.S. counsel, and all other unresolved refusals and/or requirements.

Examples of documents that can support a U.S. street address include the following:

(a) For an individual, documentation showing the name and listed address of the individual, such as one of the following:
   (i) a current, valid signed rental, lease, or mortgage agreement;
   (ii) a current, valid homeowner’s, renter’s, or motor vehicle insurance policy; or
   (iii) a computer-generated bill issued by a utility company dated within 60 days of the application or post-registration document filing date.

(b) For a juristic entity, documentation showing that the address is the applicant’s or registrant’s business headquarters, such as one of the following:
   (i) the most recent final annual or quarterly report or other similar report; or
   (ii) a current certificate of good standing for the corporation or other business entity issued by a federal or state government agency.

3. Post-office box, “care of,” and other lack of street address

In most cases, a post-office box address, “care of” address, or similar variation cannot be a domicile address. If an applicant or registrant lists such an address as its domicile, or lacks a street address entirely, the applicant or registrant will be required to provide a street address. Alternatively, an applicant may demonstrate that the listed address is, in fact, its domicile.

The following procedures will apply to these requirements:

If an applicant lists as its domicile a post-office box address or “care of” address or similar variation, or no street address at all, the examining attorney or post registration specialist will require the applicant’s or registrant’s street address. 37 C.F.R. §2.32(a).

If the applicant or registrant adds a non-U.S. street address as its domicile, the USPTO will follow the procedures in Section I.A.1. If the applicant or registrant adds a U.S. street address as its domicile, the USPTO will follow the procedures in Section I.A.2.

If the applicant does not amend the listed domicile to a street address, and fails to demonstrate that the listed address is the domicile, the examining attorney will issue a final
action as to the requirements regarding domicile and all other unresolved refusals and/or requirements, if the application is otherwise in condition for final action. If the registrant does not amend the listed domicile to a street address, and fails to demonstrate that the listed address is the domicile, the post-registration specialist will issue a second action maintaining the requirements regarding domicile and all other unresolved refusals and/or requirements.

4. Waiver of requirement to make domicile public

In an extraordinary situation, an individual applicant or registrant may seek a waiver of the requirement to make public their domicile address by filing a Petition to the Director. See 37 C.F.R. §2.146(a)(5) and TMEP §1708. In such cases, when filing the application or registration maintenance document, the applicant or registrant may enter “Petition” in the street address field of the TEAS form and separately file a petition to waive the requirement to make public their domicile address. If a petition is granted, the applicant or registrant must also provide an address where mail can be received. Contact the Petitions Office by email at TMPetitionQuestion@uspto.gov or by phone at 571-272-8950 for more information. Filing a petition does not extend the time for responding to an outstanding Office action or other statutory deadline.

5. Multiple owners

If there are multiple owners, and one of the owners is U.S.-domiciled, a U.S. attorney is not required, unless the U.S. address appears to be incorrect.

6. U.S. Government entities or federally recognized American Indian and Alaska Native tribes with U.S. street address or U.S. post-office box address

No further inquiry regarding domicile is required.

B. Submissions that are Subject to the Requirements of the Rule

1. Documents Filed Before August 3, 2019

If a new application, or an application- or registration-related document, was submitted prior to August 3, 2019, but was not examined until on or after that date, the rule requirements for domicile, U.S. attorney, and bar information will be applied as follows:

a. Application and Registration Documents

- If the document requires no further action by the applicant or registrant, the examining attorney or post-registration specialist will approve it without making any requirements for domicile, U.S. attorney, and/or bar information, including a statement of good standing, as to that filing.
- If the examining attorney or post-registration specialist must issue a first or supplemental Office action, and there is already a qualified U.S. attorney of record who was appointed before August 3, 2019, the examining attorney or post-registration specialist will not require bar information or a statement of good standing.
- If the examining attorney or post-registration specialist must issue a first or supplemental Office action, and there is no qualified U.S. attorney of record, the Office action will include the requirements regarding domicile and appointment of U.S. counsel, when appropriate, per Section 1.A. 37 C.F.R. §§2.11, 2.32(a)(2),
2.189. If the requirement is made in a supplemental Office action, it raises a new issue that requires a nonfinal action.

b. **Petitions, Requests for Reinstatement, or Post-publication Amendments**

If a petition, request for reinstatement, or post-publication amendment was submitted prior to August 3, 2019, but is not decided or examined until on or after August 3, 2019, the USPTO will not require appointment of a U.S. attorney as to those filings.

c. **Examiner’s Amendment without Prior Authorization**

If an application filed prior to August 3, 2019 is otherwise in condition for publication on first action, or a submission filed prior to August 3, 2019 resolves all outstanding issues, but it is necessary to issue an examiner’s amendment without prior authorization, the examining attorney may issue the examiner’s amendment and approve for publication or issue without requiring domicile, U.S. counsel, and/or bar information. See TMEP §707.02.

d. **Partial Abandonment**

If a partial abandonment advisory was issued prior to August 3, 2019 and no response is received, the examining attorney may issue an examiner’s amendment without prior authorization deleting the goods, services, and/or classes to which the refusal or requirement pertained and then approve the application for publication without requiring domicile, U.S. counsel, and/or bar information. See TMEP §707.02.

e. **Suspension**

If an application filed prior to August 3, 2019 is in condition for suspension, or a response filed prior to August 3, 2019 puts an application in condition for suspension, the examining attorney should suspend the application. If it is necessary to issue another Office action when the application is removed from suspension, the requirements for domicile, U.S. counsel, and/or bar information will be made, if appropriate, at that time. If the application is in condition for approval for publication when removed from suspension, the examining attorney will approve it for publication without making the additional requirements.

f. **TEAS Plus Status**

If the application was filed prior to August 3, 2019, it does not lose TEAS Plus status for failure to provide attorney representation and/or bar information. If the application was filed on or after August 3, 2019, and the applicant has a foreign address, the TEAS Plus form will require designation of a U.S. attorney and provision of bar information in order to meet the filing requirements for TEAS Plus. The form will also require the bar information when filed by a U.S. attorney who is representing a U.S.-domiciled applicant, because bar information is required for any TEAS Plus applicant who designates an attorney. The relevant fields require the entering of information in order to validate the TEAS Plus application. However, if the application includes clearly invalid bar information, or the bar information is later determined to be invalid, the application will lose TEAS Plus status and be subject to the processing fee.
2. Application and Registration Documents Filed on or after August 3, 2019

a. Trademark Act Section 1 and/or Section 44

If the USPTO receives a trademark application filed on or after August 3, 2019 by a foreign-domiciled applicant that does not include appointment of U.S. counsel, with a filing basis under Section 1 and/or Section 44, 15 U.S.C. §§1051, 1126, the examining attorney will conduct a complete review of the application and issue an Office action that includes the requirement for U.S. counsel, as well as any other refusals and/or requirements.

If, after a complete review of an application filed by a foreign-domiciled applicant, the examining attorney determines that it would otherwise be in condition for publication upon first action, the examining attorney must nevertheless issue an Office action requiring the applicant to appoint a U.S. attorney. The applicant will have six months to respond to the Office action. 37 C.F.R. §2.65(a).

To appoint or designate a U.S. attorney, or add bar information, the applicant should (1) submit a TEAS Revocation, Appointment, and/or Change of Address of Attorney/Domestic Representative form and (2) submit a TEAS response to Office action form indicating that the attorney appointment form has been submitted. Note that if the applicant is represented by a recognized Canadian trademark attorney or agent, the U.S. attorney appointment is still necessary, but the U.S. attorney cannot appear by signing a response to the Office action and must first be appointed using the TEAS Revocation, Appointment, and/or Change of Address of Attorney/Domestic Representative form before submitting a response to the Office action. See Section III below.

b. Trademark Act Section 66(a)

Foreign-domiciled applicants who submit an application based on Section 66(a) (Madrid application), 15 U.S.C. §1141f, are also subject to the requirement to appoint a U.S. attorney. Madrid applications are initially filed with the International Bureau (IB) of the World Intellectual Property Organization and subsequently transmitted to the USPTO. There is currently no provision for designating a U.S. or any other local attorney in an application filed with the IB. Therefore, until an application submitted to the IB provides for such designation, the USPTO will not enforce the requirement to appoint a U.S. attorney prior to publication for those Madrid applications that comply with all formalities and statutory requirements when received by the USPTO, such that the application is in condition for publication upon first action.

However, if the examining attorney issues an Office action that includes any substantive refusals and/or requirements, the examining attorney will also include a requirement to appoint a U.S. attorney or otherwise follow the procedures in Sections I.A.1-I.A.5, as appropriate.

c. Statements of Use

Statements of use are reviewed by the ITU/Divisional Unit to determine whether they are timely and in compliance with the minimum filing requirements listed in Rule 2.88(c). 37 C.F.R. §2.88(c); TMEP §1109.02. The USPTO will follow its current procedures regarding statements of use that are untimely. TMEP §1109.02. A statement of use filed by a foreign-domiciled applicant that does not include appointment of U.S. counsel and that is timely and meets the minimum filing requirements under Rule 2.88(c) will be referred to the examining attorney for examination on the merits. The examining attorney will conduct a complete
review of the statement of use and issue an Office action that includes the requirements regarding appointment of U.S. counsel discussed in Section I.A, as well as any other refusals and/or requirements. 37 C.F.R. §§2.11, 2.32(a)(2), 2.189.

d. Post-Registration Documents

If the USPTO receives a post-registration document under Sections 7, 8, 9, 15, or 71, 15 U.S.C. §§1057, 1058, 1059, 1065, 1141(k), filed by a foreign-domiciled registrant that does not include appointment of U.S. counsel, the post-registration specialist will examine the filing in accordance with current examination guidelines by conducting a complete review of the document and issuing an Office action that includes the requirement for domicile, and for U.S. counsel, when appropriate, as well as any other refusals and/or requirements. 37 C.F.R. §2.11(b).

e. Petitions to the Director, Requests for Reinstatement, and Post-Publication Amendments

If the USPTO receives a petition to the Director, a request for reinstatement, or a post-publication amendment filed by a foreign domiciliary, an attorney or paralegal in the Office of the Deputy Commissioner for Trademark Examination Policy will notify the petitioner that appointment of U.S. counsel is required and of any other deficiencies. The applicant or registrant will be granted 60 days to appoint U.S. counsel and to supplement the petition or request for reinstatement, as appropriate. If the applicant or registrant does not appoint U.S. counsel and submit any additional necessary information within the time allowed, the petition or request for reinstatement will be denied or the amendment will not be entered. Filing a petition does not extend the time for responding to an outstanding Office action or other statutory deadline.

3. Trademark Trial and Appeal Board (TTAB) Proceedings

Regarding proceedings before the TTAB, if it is necessary to require a foreign-domiciled party to obtain a U.S. attorney, generally the TTAB will suspend the proceedings and inform the party of the time frame within which it must obtain a U.S. attorney.

4. Review on Petition of Requirement for a U.S. Attorney

If the USPTO issues an Office action that (1) maintains only a requirement for U.S. counsel and/or additional information under Rule 2.11 (a), (b), and/or (c), or (2) maintains only the requirement for the TEAS Plus processing fee under Rule 2.22(c) in addition to one or all of those requirements, an applicant’s or registrant’s recourse for seeking review is limited to a petition to the Director under Rule 2.146. 37 C.F.R. §§2.11(f), 2.146, 2.165, 2.186, 7.40.

II. RECOGNITION OF REPRESENTATIVES AND REQUIREMENT FOR BAR INFORMATION

Under amended Rules 2.22(a)(21) and 2.32(a)(4), a U.S. attorney must provide the attorney’s name, postal address, email address, and bar information as a requirement for a TEAS Plus application or a complete trademark application. 37 C.F.R. §§2.22(a)(21), 2.32(a)(4). Moreover, amended Rule 2.17(b)(3) makes the requirement for bar information applicable to recognized attorneys in all trademark filings. 37 C.F.R. §2.17(b)(3). The requirement for bar information is not tied to the domicile of the applicant and is required of all attorneys representing applicants at the USPTO, except as discussed above in Section I.B.1. Bar information includes (1) the applicable U.S. state, Commonwealth, or territory,
(2) the year of admission, (3) the bar number, if applicable, and (4) a statement that the attorney is a registered and active member in good standing of the bar of the listed U.S. state, Commonwealth, or territory.

As of August 3, 2019, the majority of the TEAS forms include specific fields to enter attorney bar information for the attorney of record. The information will not be required for other appointed attorneys. If attorney bar information and/or the statement that the attorney is an active member in good standing of the referenced bar is omitted or incomplete, the examining attorney will issue an Office action requiring the bar information and/or statement of active bar membership in good standing.

In cases where bar information is required and all other outstanding issues may be resolved by examiner’s amendment, the examining attorney may email or call the U.S. attorney about the outstanding issues, obtain the bar information, and ask that he or she agree to a statement of good standing, if it is not already in the record.

If bar information is obtained by examiner’s amendment, the amendment will indicate only that the bar information has been completed and provided. The USPTO will not display it in the public record. Bar information entered on a TEAS form will be hidden only if it is entered in the bar information fields on the attorney information page of the form.

If a submission includes clearly invalid attorney identification information, the examining attorney or post-registration specialist must send an email to the TM Policy mailbox. The USPTO will notify the applicant or registrant that the listed attorney does not appear to be a qualified practitioner. In such cases, correspondence must be sent directly to the applicant or registrant at the address specified in the initial application or post-registration maintenance document. Therefore, the examining attorney or post-registration specialist may be instructed to remove the attorney identification information from the correspondence section of the Trademark database and enter the applicant’s or registrant’s address, or the examining attorney may send a request to a legal instruments examiner to do so. In addition, for a foreign-domiciled applicant, any Office action issued must make requirements for appointment of U.S. Counsel and domicile, if applicable.

If the bar information appears valid on its face, but circumstances calling into question the veracity of the information arise, the examining attorney or post-registration specialist must (1) proceed as discussed above regarding correcting the correspondence address to that of the applicant or registrant, and (2) issue an Office action notifying the applicant or registrant that the listed attorney does not appear to be a qualified practitioner or has not consented to represent the applicant or registrant. In addition, the Office action must include a requirement for the attorney’s identification information (including bar credentials) if appropriate, and a domicile requirement, as applicable.

### III. RECIPROCAL RECOGNITION

Foreign attorneys and agents must be granted reciprocal recognition by the USPTO pursuant to Rule 11.14(c) and (f) in order to practice before the USPTO in trademark matters. The final rule removes reciprocal recognition of foreign patent attorneys and agents to practice before the USPTO in trademark matters. 37 C.F.R. §11.14(c)(1). Additionally, the rule requires in any trademark matter where a reciprocally recognized foreign trademark

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1 “Clearly invalid attorney identification information” includes, e.g., John Doe, a series of question marks or letters/numerals, a single name, the word “test,” or the listed attorney does not appear to be a qualified practitioner, or the listed attorney has not consented to represent the applicant.
attorney or agent is representing an applicant, registrant, or party to a proceeding whose domicile is not in the U.S., a qualified U.S. attorney must also be appointed as the applicant’s or registrant’s representative who will file documents with the USPTO and with whom the USPTO will correspond. 37 C.F.R. §11.14(c)(2).

Currently, only Canadian attorneys and agents are reciprocally recognized under Rule 11.14(c)(1) and their representation is limited to applicants, registrants, and parties located in Canada (Canadians). On or after August 3, 2019, Canadian trademark attorneys and agents continue to be authorized to represent Canadian parties in trademark matters before the USPTO as additionally appointed practitioners, so long as they remain registered and in good standing in Canada and are formally reciprocally recognized by the USPTO’s Office of Enrollment and Discipline (OED). Currently reciprocally recognized Canadian patent attorneys and agents may complete prosecution of an application or post-registration maintenance filing (for which they are listed as the representative) which was pending with the USPTO before August 3, 2019, but may not handle new trademark matters.

With regard to documents filed before August 3, 2019 by a reciprocally recognized Canadian trademark or patent attorney or agent in a matter for a Canadian applicant or registrant, the USPTO will follow the same procedures as those discussed above in Section I. For example:

- If the document requires no further action by the applicant or registrant, the USPTO will not require appointment of a U.S. attorney as to that filing.
- If a first or supplemental Office action must be issued, the Office action will include the requirement for appointment of a U.S. attorney. If the requirement is made in a supplemental Office action, it raises a new issue that requires a nonfinal action.

With regard to trademark documents filed with the USPTO on or after August 3, 2019, Canadian applicants and registrants must appoint U.S. counsel and may also appoint a Canadian trademark attorney or agent who is formally reciprocally recognized by OED as an additional practitioner. On or after August 3, 2019, reciprocally recognized Canadian trademark attorneys and agents may:

- Prepare, sign, and file new applications (TEAS Plus applications require designation of a U.S. attorney).
- Prepare and sign other application- and registration-related submissions, including responses and other formal communications; a U.S. attorney must file the submissions with the USPTO and authorize any examiner’s amendments.
- Contact the assigned examining attorney by phone or email to discuss the application status, the contents of the examining attorney’s Office action, and possible responses to the Office action.
- Receive courtesy copies of USPTO communications.
SportFuel, Inc. v. PepsiCo, Inc.

932 F.3d 589 (7th Cir. 2019)

Eat Like the Pros with "The SportFuel Bar®," made in Chocolate with 12 g Bone Broth Protein + Hemp + Pumpkin Seeds!

To get more information on this product, click here
SportFuel, Inc. v. PepsiCo, Inc.

The court found Gatorade:
(a) did not use Sports Fuel as an indicator of source (subtitle to house mark; no rhyme);
(b) use is descriptive (industry use and disclaimer); and
(c) adopted the phrase in good faith.
Competitive Marketing
Competitive Marketing
Mac Book says get a Surface Laptop
Stouffer v. Nat’l Geographic Partners, LLC
Stouffer v. Nat’l Geographic Partners, LLC

- 10th Circuit hadn’t adopted or rejected the Rogers test outlined in Rogers v. Grimaldi (2d Cir. 1989).
- Rogers attempts to balance trademark rights and free speech/artistic expression.
- A trademark in an expressive work is only infringing if “(1) the use of the mark has no artistic relevance to the underlying work whatsoever, or (2) it has some artistic relevance, but explicitly misleads as to the source or the content of the work.”
Stouffer v. Nat’l Geographic Partners, LLC

Did the junior user have a genuine artistic motive for using the senior user’s mark or other Lanham Act-protected property right?

• Do the senior and junior users use the mark to identify the same kind, or a similar kind, of goods or services?
• To what extent has the junior user added his or her own expressive content to the work beyond the mark itself?
• Does the timing of the junior user’s use in any way suggest a motive to capitalize on popularity of the senior user’s mark?
• In what way is the mark artistically related to the underlying work, service, or product?
• Has the junior user made any statement to the public, or engaged in any conduct known to the public, that suggests a non-artistic motive?
• Has the junior user made any statement in private, or engaged in any conduct in private, that suggests a non-artistic motive?
EZ Pedo, Inc. v. Mayclin Dental Studio, Inc., 284 F. Supp. 3d 1065 (E.D. Cal. 2018), aff’d Case. No. 18-15806 (9th Cir. 2019)

Timothy C. Matson, Esq.
Claim of trade dress infringement in “look and feel” of advertisements employing identical stock photograph
Claim of trade dress infringement in “look and feel” of similar non-stock photographs
Claim of trade dress infringement in color and “look and feel” of computer-aided drawings (CADs)
Claim of trade dress infringement in “look and feel” of gears and slogan “engineered for”
Trade dress claims dismissed by U.S. District Court for Eastern District of California

• “Trade dress” is considered a “symbol” or “device” within the definition of “trademark.” Wal-Mart Stores, Inc. v. Samara Brothers, Inc., 529 U.S. 205, 209-10 (2000).

• Trade dress must be a definite and tangible “thing,” such as labels, wrappers, containers used in the packaging of a product, or even the look of a product or its packaging.

• Supreme Court has recognized trade dress right in the appearance and design of Mexican-style restaurants, including exterior, identifying sign, floor plan, décor, menu and servers’ uniforms. Two Pesos, Inc. v. Taco Cabana, Inc., 505 U.S. 703, 768 (1992)
Summary judgment affirmed on appeal by 9th Circuit

- Vague aspects such as a product’s marketing theme and its “overall appearance” or “look” generally cannot be exclusively owned by one seller as its “trade dress.”

- Short-term, isolated advertisements employing common stock images do not qualify as protectable trade dress as a matter of law.

- Nothing inherently distinctive about photographs of smiling children and crowns.

- Color and product design can never qualify as inherently distinctive; protectable trade dress can only be established through “secondary meaning.”

• Copyright infringement claim may be commenced when the U.S. Copyright Office registers a copyright.

• Registration is akin to an administrative exhaustion requirement that the owner must satisfy before suing to enforce rights.

• Upon registration of the copyright, a copyright owner can recover for infringement that occurred before and after registration.

• A statute awarding “costs” will not be construed as authorizing an award of litigation expenses beyond the six categories enumerated in 28 U.S.C. §§ 1821 and 1920 absent an explicit statutory instruction to that effect.


• Award of $12.8 million for expert witness fees, e-discovery and jury consulting fees overturned because these items are not recoverable under 28 U.S.C. §§ 1821, 1920 and not enumerated in 17 U.S.C. § 505.
Timothy C. Matson, Esq.
612-607-7000
tmatson@foxrothschild.com
EZ PEDO, INC., a California corporation, Plaintiff-Appellant,

v.

MAYCLIN DENTAL STUDIO, INC., DBA Kinder Krows, a Minnesota corporation, Defendant-Appellee.

No. 18-15806
D.C. No. 2:16-cv-00731-KJM-CKD

MEMORANDUM*

Appeal from the United States District Court for the Eastern District of California
Kimberly J. Mueller, District Judge, Presiding

Argued and Submitted March 13, 2019
San Francisco, California

Before: SILER,** TASHIMA, and McKEOWN, Circuit Judges.

EZ Pedo, Inc. (“EZ Pedo”) argues that the district court erred in concluding that EZ Pedo’s Beach Girl, Blue CAD, and Gears trade dress was not inherently distinctive. We have jurisdiction under 15 U.S.C. § 1121 and 28 U.S.C. § 1291.

* This disposition is not appropriate for publication and is not precedent except as provided by Ninth Circuit Rule 36-3.

** The Honorable Eugene E. Siler, United States Circuit Judge for the U.S. Court of Appeals for the Sixth Circuit, sitting by designation.
We review de novo the district court’s grant of partial summary judgment in favor of Mayclin Dental Studio, Inc. (“Mayclin”), and affirm. *Arce v. Douglas*, 793 F.3d 968, 975–76 (9th Cir. 2015).

We need not decide whether the district court erred in concluding that EZ Pedo failed to adequately define its claimed trade dress, because whether adequately defined or not, none of the trade dress at issue is inherently distinctive. The Beach Girl trade dress consists of information about EZ Pedo, descriptions and illustrations of its product (pediatric zirconia crowns) and a picture of that product’s ultimate user (a child). The Blue CAD trade dress adds nothing more than a particular color, which the Supreme Court has held cannot alone be inherently distinctive. *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 162–63 (1995). The Gears trade dress is merely a commonplace image combined with a two-word phrase. Such trade dress does not “immediately signal a brand or a product source.” *Wal-Mart Stores, Inc v. Samara Bros., Inc.*, 529 U.S. 205, 212–13 (2000) (internal quotation marks and alterations omitted).

EZ Pedo does not argue on appeal that its claimed trade dress has secondary meaning, so the trade dress infringement claims must fail. *Clicks Billiards, Inc. v. Sixshooters, Inc.*, 251 F.3d 1252, 1258 (9th Cir. 2001).

**AFFIRMED.**
United States Court of Appeals for the Ninth Circuit

Office of the Clerk
95 Seventh Street
San Francisco, CA 94103

Information Regarding Judgment and Post-Judgment Proceedings

Judgment
• This Court has filed and entered the attached judgment in your case. Fed. R. App. P. 36. Please note the filed date on the attached decision because all of the dates described below run from that date, not from the date you receive this notice.

Mandate (Fed. R. App. P. 41; 9th Cir. R. 41-1 & -2)
• The mandate will issue 7 days after the expiration of the time for filing a petition for rehearing or 7 days from the denial of a petition for rehearing, unless the Court directs otherwise. To file a motion to stay the mandate, file it electronically via the appellate ECF system or, if you are a pro se litigant or an attorney with an exemption from using appellate ECF, file one original motion on paper.

Petition for Panel Rehearing (Fed. R. App. P. 40; 9th Cir. R. 40-1)
Petition for Rehearing En Banc (Fed. R. App. P. 35; 9th Cir. R. 35-1 to -3)

(1) A. Purpose (Panel Rehearing):
• A party should seek panel rehearing only if one or more of the following grounds exist:
  ► A material point of fact or law was overlooked in the decision;
  ► A change in the law occurred after the case was submitted which appears to have been overlooked by the panel; or
  ► An apparent conflict with another decision of the Court was not addressed in the opinion.
• Do not file a petition for panel rehearing merely to reargue the case.

B. Purpose (Rehearing En Banc)
• A party should seek en banc rehearing only if one or more of the following grounds exist:
Consideration by the full Court is necessary to secure or maintain uniformity of the Court’s decisions; or
The proceeding involves a question of exceptional importance; or
The opinion directly conflicts with an existing opinion by another court of appeals or the Supreme Court and substantially affects a rule of national application in which there is an overriding need for national uniformity.

(2) Deadlines for Filing:
• A petition for rehearing may be filed within 14 days after entry of judgment. Fed. R. App. P. 40(a)(1).
• If the United States or an agency or officer thereof is a party in a civil case, the time for filing a petition for rehearing is 45 days after entry of judgment. Fed. R. App. P. 40(a)(1).
• If the mandate has issued, the petition for rehearing should be accompanied by a motion to recall the mandate.
• See Advisory Note to 9th Cir. R. 40-1 (petitions must be received on the due date).
• An order to publish a previously unpublished memorandum disposition extends the time to file a petition for rehearing to 14 days after the date of the order of publication or, in all civil cases in which the United States or an agency or officer thereof is a party, 45 days after the date of the order of publication. 9th Cir. R. 40-2.

(3) Statement of Counsel
• A petition should contain an introduction stating that, in counsel’s judgment, one or more of the situations described in the “purpose” section above exist. The points to be raised must be stated clearly.

(4) Form & Number of Copies (9th Cir. R. 40-1; Fed. R. App. P. 32(c)(2))
• The petition shall not exceed 15 pages unless it complies with the alternative length limitations of 4,200 words or 390 lines of text.
• The petition must be accompanied by a copy of the panel’s decision being challenged.
• An answer, when ordered by the Court, shall comply with the same length limitations as the petition.
• If a pro se litigant elects to file a form brief pursuant to Circuit Rule 28-1, a petition for panel rehearing or for rehearing en banc need not comply with Fed. R. App. P. 32.
The petition or answer must be accompanied by a Certificate of Compliance found at Form 11, available on our website at www.ca9.uscourts.gov under Forms.

You may file a petition electronically via the appellate ECF system. No paper copies are required unless the Court orders otherwise. If you are a pro se litigant or an attorney exempted from using the appellate ECF system, file one original petition on paper. No additional paper copies are required unless the Court orders otherwise.

**Bill of Costs (Fed. R. App. P. 39, 9th Cir. R. 39-1)**
- The Bill of Costs must be filed within 14 days after entry of judgment.
- See Form 10 for additional information, available on our website at www.ca9.uscourts.gov under Forms.

**Attorneys Fees**
- Ninth Circuit Rule 39-1 describes the content and due dates for attorneys fees applications.
- All relevant forms are available on our website at www.ca9.uscourts.gov under Forms or by telephoning (415) 355-7806.

**Petition for a Writ of Certiorari**
- Please refer to the Rules of the United States Supreme Court at www.supremecourt.gov

**Counsel Listing in Published Opinions**
- Please check counsel listing on the attached decision.
- If there are any errors in a published opinion, please send a letter in writing within 10 days to:
  - Thomson Reuters; 610 Opperman Drive; PO Box 64526; Eagan, MN 55123 (Attn: Jean Green, Senior Publications Coordinator);
  - and electronically file a copy of the letter via the appellate ECF system by using “File Correspondence to Court,” or if you are an attorney exempted from using the appellate ECF system, mail the Court one copy of the letter.
UNITED STATES COURT OF APPEALS
FOR THE NINTH CIRCUIT

Form 10. Bill of Costs

Instructions for this form: http://www.ca9.uscourts.gov/forms/form10instructions.pdf

9th Cir. Case Number(s)

Case Name

The Clerk is requested to award costs to (party name(s)):

I swear under penalty of perjury that the copies for which costs are requested were actually and necessarily produced, and that the requested costs were actually expended.

Signature  Date

(use “s/[typed name]” to sign electronically-filed documents)

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TOTAL: $  

*Example: Calculate 4 copies of 3 volumes of excerpts of record that total 500 pages [Vol. 1 (10 pgs.) + Vol. 2 (250 pgs.) + Vol. 3 (240 pgs.)] as:
No. of Copies: 4; Pages per Copy: 500; Cost per Page: $.10 (or actual cost IF less than $.10);
TOTAL: 4 x 500 x $.10 = $200.

Feedback or questions about this form? Email us at forms@ca9.uscourts.gov

Form 10  Rev. 12/01/2018
284 F.Supp.3d 1065
United States District Court, E.D. California.

EZ PEDO, INC., a California corporation, Plaintiff,
v.
MAYCLIN DENTAL STUDIO, INC., a Minnesota corporation, individually and dba Kinder Krowns; and Does 1–10, 1 Defendants.

1 Plaintiff has neither identified the DOE defendants, nor shown good cause for their missing identities. The federal rules provide for dismissing unnamed defendants that, absent good cause, are not served within 90 days of the complaint. Fed. R. Civ. P. 4(m). Accordingly, the DOE defendants will be DISMISSED.

No. 2:16–cv–00731–KJM–CKD
| Signed February 14, 2018 |
| Filed 02/15/2018 |

Synopsis

Background: Manufacturer of pediatric dental crowns brought action against competitor, alleging, inter alia, trade dress and trademark infringement claims under the Lanham Act. Competitor moved for partial summary judgment.

Holdings: The District Court, Kimberly Mueller, J., held that:

[1] manufacturer did not sufficiently identify ways in which its advertisements were inherently distinctive, and

[2] manufacturer’s advertisements had not acquired secondary meaning.

Motion granted.

West Headnotes (11)

[1] Trademarks
Form, Features, or Design of Product as Marks; Trade Dress
Trade dress protection is broader than that for trademarks: trade dress protection pertains to a product’s image and overall impression; trademark protection pertains to a product's particular features. Lanham Trade-Mark Act § 43, 15 U.S.C.A. § 1125(a).

Cases that cite this headnote

[2] Trademarks
Form, Features, or Design of Product as Marks; Trade Dress
Trade dress protection under the Lanham Act most commonly pertains to tangible items such as product design and product packaging, though unique arrangements and displays may also constitute trade dress. Lanham Trade-Mark Act § 43, 15 U.S.C.A. § 1125(a).

Cases that cite this headnote

[3] Trademarks
Distinctiveness; secondary meaning
Claimants seeking trade dress protection under the Lanham Act bear a strenuous burden to show the claimed trade dress serves the role of identifying the owner as a source, either by showing the trade dress is inherently distinctive or that over time it has acquired distinctiveness, also known as secondary meaning. Lanham Trade-Mark Act § 43, 15 U.S.C.A. § 1125(a).

1 Cases that cite this headnote

Trade dress
Pediatric dental crown manufacturer failed to meet its burden to identify ways in which its three print advertisements were inherently distinctive, as required to support its claim that advertisements constituted trade dress, and were thus entitled to protection under Lanham Act; while manufacturer asserted that its three print advertisements featuring a stock photo of a girl on a beach, a graphic of gears, and a dark blue computer-aided drawing of a tooth were distinctive, manufacturer did not identify shapes, sizes, dimensions, or specific elements
within each advertisement that combined to constitute distinctive trade dress, and without such specificity, it was impossible to know what distinctive combination of ingredients deserved protection. Lanham Trade-Mark Act § 43, 15 U.S.C.A. § 1125(a).

Cases that cite this headnote

[5] **Trademarks**
   - Distinctiveness; secondary meaning

To be inherently distinctive, in support of a trade dress claim under the Lanham Act, claimed trade dress must be so unique, in context, that a buyer will rely on it to differentiate the source of the product with which it is associated. Lanham Trade-Mark Act § 43, 15 U.S.C.A. § 1125(a).

Cases that cite this headnote

[6] **Trademarks**
   - Distinctiveness; secondary meaning

Print advertisements by pediatric dental crown manufacturer had not acquired secondary meaning, as required to establish that advertisements constituted trade dress entitled to protection under Lanham Act; manufacturer's advertisements had not been in market for long enough to have acquired distinctiveness over time, since each one had appeared for less than a year prior to competitor's alleged copying, advertising images did not share a consistent theme, nor was there any indication consumers associated advertisements with manufacturer, particularly since advertising images had never appeared on manufacturer's product or product packaging. Lanham Trade-Mark Act § 43, 15 U.S.C.A. § 1125(a).

Cases that cite this headnote

[7] **Trademarks**
   - Distinctiveness; secondary meaning

Even if claimed trade dress is not inherently distinctive, in support of a trade dress claim under the Lanham Act, a claimant may prove acquired distinctiveness over time, also known as secondary meaning. Lanham Trade-Mark Act § 43, 15 U.S.C.A. § 1125(a).

Cases that cite this headnote

[8] **Trademarks**
   - Distinctiveness; secondary meaning

Trade dress develops secondary meaning, entitling it to protection under the Lanham Act, when in the minds of the public, the primary significance of the claimed trade dress is to identify the source of the product rather than the product itself. Lanham Trade-Mark Act § 43, 15 U.S.C.A. § 1125(a).

Cases that cite this headnote

[9] **Federal Civil Procedure**
   - Copyright, trademark, and unfair competition cases

**Trademarks**
   - Distinctiveness; secondary meaning

To survive summary judgment on a trade dress claim under the Lanham Act based on a theory of secondary meaning, the claimant must file sufficient evidence to allow a reasonable juror to find that a substantial segment of consumers and potential consumers associate the alleged trade dress with a single source of the product. Lanham Trade-Mark Act § 43, 15 U.S.C.A. § 1125(a).

Cases that cite this headnote

[10] **Trademarks**
   - Trade dress

Secondary meaning of trade dress, as would support trade dress protection under the Lanham Act, can be established through direct evidence, such as consumer surveys or consumer testimony, or through circumstantial evidence, such as the length of time the mark has been used, the extent of advertising, and the volume of sales. Lanham Trade-Mark Act § 43, 15 U.S.C.A. § 1125(a).

Cases that cite this headnote

Trade dress

Evidence the defendant deliberately copied the claimed trade dress may, when accompanied by other corroborating evidence, permit the court to infer the trade dress had acquired secondary meaning, in support of a claim for trade dress protection under the Lanham Act. Lanham Trade-Mark Act § 43, 15 U.S.C.A. § 1125(a).

C. EZ–Pedo's Claimed Trade Dress

1. “Beach Girl”

Plaintiff's claimed “Beach Girl” trade dress derives from an advertisement that centers on a stock photograph of a young girl on the beach that plaintiff downloaded in December 2013 from a third-party website, iStockphoto.com. Statement of Undisputed Facts (“SUF”) 2, ECF No. 43; see also Pl.'s SUF Responses, ECF No. 45–1. Plaintiff did not create or take this photograph, see SUF 2–3, nor does the record show plaintiff owns or owned exclusive rights to it. Although EZ–Pedo has never printed the Beach Girl image on its product packaging, SUF 14, beginning in March 2014, EZ–Pedo used the Beach

2. EZ–Pedo sells its pediatric zirconia crowns to dentists throughout the United States. Id. ¶¶ 11, 12. Defendant is a Minnesota corporation and competitor that sells similar pediatric zirconia crowns under the business name Kinder Krowns. Id. ¶ 6.

Because the formal statement of undisputed facts omits basic, undisputed background information, the court cites plaintiff's complaint for certain information. See generally Compl.

B. The Parties' Dispute

EZ–Pedo asserts defendant has intentionally copied four of EZ–Pedo's dental crown advertisements, and brings eight claims: Three federal Lanham Act claims, brought under 15 U.S.C. § 1051 et seq.; three California law claims and two Minnesota law claims. See id. ¶¶ 48–85 Defendant moves for partial summary judgment on a discrete issue: Whether plaintiff owns valid and protectable trademark or trade dress rights in three of the four advertisements it alleges defendant copied, as is required to succeed on plaintiff's Lanham Act claims. See generally Mot. Plaintiff's opposition focuses only on trade dress, not trademark. See generally Opp'n. When asked at hearing, plaintiff's counsel confirmed its focus is solely on trade dress. The court thus treats plaintiff's omission of any trademark discussion as a concession that its Lanham Act claims as to the three advertisements at issue here derive exclusively from trade dress rights. See United States v. Kitsap Physicians Serv., 314 F.3d 995, 999 (9th Cir. 2002) (omitting evidence in summary judgment opposition brief constitutes waiver of arguments relating to that evidence). This order therefore assesses whether a reasonable fact finder could find the three advertising campaigns constitute protectable trade dress.

Cases that cite this headnote
Girl advertisement in print distributed at the 2014 annual meetings of the California Society of Pediatric Dentistry (“CSPD”) and the American Academy of Pediatric Dentistry (“AAPD”), both organizations also featured the Beach Girl advertisement in their trade journals; and EZ–Pedo displayed the image on secondary pages of EZ–Pedo’s website. Fisher Decl., 3 ECF *1068 No. 45–3, ¶¶ 9–10. For years, pediatric crown manufacturers, including plaintiff and defendant, have used photos of children to market and promote pediatric crowns, and the photos have appeared in trade journals and magazines. SUF 15–16 (citing pediatric dentist trade journal photos of smiling children contained in defendant's Exhibits I and Q attached to ECF No. 44, and deposition excerpts attached as Exhibits N, R, P to ECF No. 44).

Jeffrey Fisher is a co-founder and the director of EZ–Pedo, Inc. Fisher Decl. ¶ 1.

Plaintiff contends it stopped investing in this trade dress within four months after its first use, in July 2014, after discovering defendant had copied it for use and displayed it in AAPD's July 2014 print journal. Fisher Decl. ¶¶ 13–14.

2. “Gears”
Plaintiff crafted its claimed Gears trade dress in mid–2014. Id. ¶ 17. This design appears in an advertisement that depicts a photograph of metal gears plaintiff downloaded from a third-party website; the photograph is placed beside the slogan, “engineered for a precision fit,” which plaintiff first used in flyers, brochures and on secondary website pages, in mid–2014. SUF 19, 22. Plaintiff has never used this image on product packaging. SUF 21. Plaintiff contends it stopped using this trade dress in June 2015, after discovering defendant had copied it to advertise its “Less Prep” crown line on its company website. Fisher Decl. ¶¶ 18–19. As shown below, plaintiff's Gears advertising incorporates images of two white tooth crowns viewed from the side; Defendant's incorporates an image of a blue crown viewed from the bottom.

See Fisher Decl. ¶ 18 (Figure 4).

3. “Blue CAD”
Plaintiff's claimed “Blue CAD” trade dress depicts a computer-aided drawing (“CAD”) of a deep-blue-colored tooth with visible contours. See Compl. ¶¶ 35–40. The software program “3Shape 3D Viewer,” through which the drawing was created, opens in such a manner to display images as one of three default color choices: Purple, grey or deep blue, with the actual color applied to the image selected by the user. See Vladimir Scherbak Decl., ECF No. 45–6, ¶ 6(b)-(g). Plaintiff first used this Blue–CAD image at a trade show in mid–2013. Fisher Decl. ¶ 5. Then, in 2014, plaintiff began associating the Blue–CAD image with a specific “V2” crown line. Id. ¶ 6. The Blue–CAD image was featured in plaintiff's print advertising, trade-show banners, brochures, flyers and on its website. Id. (“[w]e used it in thousands of printed materials that were distributed to pediatric dentists at trade shows, in flyers, and through other media”); SUF 25. Plaintiff has never displayed the Blue–CAD image on its physical products or product packaging. Plaintiff says it did start placing small blue dots on its V2 crowns in 2014; these dots, however, are not depicted in the summary judgment record, and there is no representation they are shaped like a tooth. See Fisher Decl. ¶ 7; see also Pl.'s Ex. A (attached to Fisher Decl.), ECF No. 45–4. Plaintiff contends defendant began copying the Blue–CAD advertisement in May 2014, by using the image shown below on its website, www.kinderkrowns.com, to market and sell its own line of “Less Prep” crowns. Fisher Decl. ¶ 8.
II. LEGAL STANDARDS

A. Summary Judgment

A court will grant summary judgment “if ... there is no genuine dispute as to any material fact and the movant is entitled to judgment as a matter of law.” Fed. R. Civ. P. 56(a).

The “threshold inquiry” is whether “there are any genuine factual issues that properly can be resolved only by a finder of fact because they may reasonably be resolved in favor of either party.” Anderson v. Liberty Lobby, Inc., 477 U.S. 242, 250, 106 S.Ct. 2505, 91 L.Ed.2d 202 (1986).

The moving party bears the initial burden of showing the district court “there is an absence of evidence to support the nonmoving party's case.” Celotex Corp. v. Catrett, 477 U.S. 317, 325, 106 S.Ct. 2548, 91 L.Ed.2d 265 (1986). Then the burden shifts to the non-movant to show “there is a genuine issue of material fact ....” Matsushita Elec. Indus. Co. v. Zenith Radio Corp., 475 U.S. 574, 585, 106 S.Ct. 1348, 89 L.Ed.2d 538 (1986). In carrying their burdens, both parties must “cit[e] to particular parts of materials in the record ...; or show [ ] that the materials cited do not establish the absence or presence of a genuine dispute, or that an adverse party cannot produce admissible evidence to support the fact.” Fed. R. Civ. P. 56(e) (1); see also Matsushita, 475 U.S. at 586, 106 S.Ct. 1348 (“[the non-movant] must do more than simply show that there is some metaphysical doubt as to the material facts”). Also, “[o]nly disputes over facts that might affect the outcome of the suit under the governing law will properly preclude the entry of summary judgment.” Anderson, 477 U.S. at 247–48, 106 S.Ct. 2505.

In deciding summary judgment, the court draws all inferences and views all evidence in the light most favorable to the non-movant. Matsushita, 475 U.S. at 587–88, 106 S.Ct. 1348, “Where the record taken as a whole could not lead a rational trier of fact to find for the [non-movant], there is no 'genuine issue for trial.’” Id. at 587, 106 S.Ct. 1348 (quoting First Nat'l Bank of Ariz. v. Cities Serv. Co., 391 U.S. 253, 289, 88 S.Ct. 1575, 20 L.Ed.2d 569 (1968)).

B. Trade Dress Protection

The Lanham Act is the federal statute governing trademark and trade dress protection, unfair competition and false advertising. See 15 U.S.C. § 1051 et seq. The Act defines when trademark and trade dress owners are entitled to federal judicial protection against infringement. A trademark can be a word, such as the brand name “McDonald's”; a phrase, such as “I'm lovin' it”; a logo, such as golden arches; a symbol; or some other mark that identifies the mark's owner as a product's source. Wal–Mart Stores, Inc. v. Samara Bros., Inc., 529 U.S. 205, 209, 120 S.Ct. 1339, 146 L.Ed.2d 182 (2000) (citing 15 U.S.C. § 1127 for legal definition of trademark, which says “any word, name, symbol, or device, or any combination thereof [used or intended to be used] to identify and distinguish [a producer’s] goods ... from those manufactured or sold by others and to indicate the source of the goods ...”). The Act prohibits competitors from copying trademarks another competitor has registered, if such copying would confuse consumers about the product's origin. 15 U.S.C. § 1114 (2006) (trademark infringement).

[1] The Lanham Act also protects against infringing upon a seller's unregistered trade dress. 15 U.S.C. § 1125(a) (2012); see also Wal–Mart Stores, Inc., 529 U.S. at 209, 120 S.Ct. 1339 (citing 15 U.S.C. § 1125(a) ). Trade dress protection is broader than that for trademarks: Trade dress protection pertains to a product's image and overall impression; trademark protection pertains to a product's particular features. Two Pesos, Inc. v. Taco Cabana, Inc., 505 U.S. 763, 768, 112 S.Ct. 2753, 120 L.Ed.2d 615 (1992); Clicks Billiards, Inc. v. Sixshooters, Inc., 251 F.3d 1252, 1257 (9th Cir. 2001) (“Trade dress refers generally to the total image, design, and appearance of a product and may include features such as size, shape, color, color combinations, texture, or graphics.”) (citation and quotations omitted). At trial, a trade dress infringement plaintiff has the burden to prove, by a preponderance of the evidence, that (1) its claimed trade dress is distinctive; (2) plaintiff owns the claimed trade dress; (3) the trade dress is nonfunctional; and (4) the defendant's use of a similar trade dress, without plaintiff's consent, is likely to cause consumer confusion as to “the source, sponsorship, affiliation, or approval” of plaintiff's...
Trade dress most commonly pertains to tangible items such as product design and product packaging. See, e.g., \textit{Qualitex v. Jacobson Prods.}, 514 U.S. 159, 166, 115 S.Ct. 1300, 131 L.Ed.2d 248 (1995) (dry cleaning pads’ green-gold color scheme); \textit{Mattel, Inc. v. Walking Mountain Prods.}, 353 F.3d 792, 808 (9th Cir. 2003) (Barbie doll’s distinctive appearance); \textit{Vision Sports, Inc. v. Melville Corp.}, 888 F.2d 609, 613–15 (9th Cir. 1989) (clothing logo’s color scheme and graphics); \textit{AmBrit, Inc. v. Kraft, Inc.}, 812 F.2d 1531, 1535–37 (11th Cir. 1986) (Klondike ice cream bar’s size; silver, blue and white wrapper; the foil’s pebbled texture; polar bear and sunburst images). But unique arrangements and displays may also constitute trade dress. See, e.g., \textit{Two Pesos}, 505 U.S. at 763, 112 S.Ct. 2753 (Mexican restaurant chain’s look and décor); \textit{Pebble Beach Co. v. Tour 18 I Ltd.}, 155 F.3d 526, 542 (5th Cir. 1998) (golf course layout); \textit{Best Cellars Inc. v. Grape Finds at Dupont, Inc.}, 90 F.Supp.2d 431 (S.D.N.Y. 2000) (wine shop bottle display).

Although the parties have not identified, and the court has not found, any case law extending trade dress protection to promotional flyers or advertisements, as EZ–Pedo contends the court should do here, the closest analogues appear to be the Eleventh Circuit’s extension of trade dress protection to a “marketing idea,” in \textit{Orig. Appalachian Artworks, Inc. v. Toy Loft, Inc.}, 684 F.2d 821, 831 (11th Cir. 1982), and the increasing acceptance of trade dress protection for a website’s overall look and feel, see, e.g., \textit{Lepton Labs, LLC v. Walker}, 55 F.Supp.3d 1230, 1239 (C.D. Cal. 2014) (website’s features and functionality).

Despite the potential breadth of trade dress protection, this Lanham Act provision is not an invitation to shotgun litigation: Claimants bear a strenuous burden to show the claimed trade dress serves the role of identifying the owner as a source, either by showing the trade dress is inherently distinctive or that over time it has acquired distinctiveness, also known as secondary meaning. \textit{TrafFix Devices, Inc. v. Mkgt. Displays, Inc.}, 532 U.S. 23, 30, 121 S.Ct. 1255, 149 L.Ed.2d 164 (2001); \textit{Wal–Mart}, 529 U.S. at 211, 120 S.Ct. 1339.

Defendant through its motion challenges EZ–Pedo’s ability to claim that trade dress protection applies to its Blue CAD, Beach Girl and Gears images. The core dispute centers on whether EZ–Pedo can satisfy the essential requirement of distinctiveness by meeting its burden to show the images are distinctive, either inherently or by virtue of having attained secondary meaning.

A. Inherent Distinctiveness

EZ–Pedo argues each one of its three advertisements qualifies as inherently distinctive trade dress because each contains “beautiful, glamorous, fanciful, recognizable” imagery. Opp’n at 7.

Proving inherent distinctiveness is demanding. To be inherently distinctive, claimed trade dress must be so unique, in context, that a buyer will rely on it to differentiate the source of the product with which it is associated. \textit{Wal–Mart}, 529 U.S. at 213, 120 S.Ct. 1339; cf. \textit{AmBrit, Inc.}, 812 F.2d at 1536 (emphasizing uniqueness of ice cream wrapper; explaining it is “not a basic shape or common design. Rather ... [the] wrapper with its square size, bright coloring, pebbled texture, polar bear and sunburst images, and distinctive style of printing is a complex composite of size, color, texture and graphics.... [creating] a distinctive visual impression["]”) (citation omitted). The Supreme Court has cautioned against applying vague tests for inherent distinctiveness, noting such tests “facilitate[ ] plausible threats of suit against new entrants based upon alleged inherent distinctiveness[,]” which in turn stifles competition. \textit{Wal–Mart}, 529 U.S. at 213, 120 S.Ct. 1339; cf. \textit{Fuddruckers, Inc. v. Doc’s B.R. Others, Inc.}, 826 F.2d 837, 844 (9th Cir. 1987) (explaining, before \textit{Wal–Mart} decided, that “overall impression may receive protection,” but denying such protection where the claimed trade dress “was simply not the sort of arbitrary or uncommon trade dress that might qualify as inherently distinctive.”) (citation omitted).

Since \textit{Wal–Mart}, the Ninth Circuit has not revisited the articulation of a trade dress claimant’s burden in proving inherent distinctiveness, but district courts within the circuit have interpreted the term as requiring manifestly unique arrangements. See \textit{Morton & Bassett, LLC v. Organic Spices, Inc.}, No. 15-CV-01849-HSG, 2017 WL 1425908, at *6 (N.D. Cal. Apr. 21, 2017) (defining the ultimate question as “whether the ... combination of elements is so unique, unusual or unexpected in this market that one can assume without proof that it will automatically be perceived by customers as an indicator of origin["]”) (citations and quotations omitted); \textit{Homeland Housewares, LLC v. Euro–Pro Operating LLC}, 2014 WL 6892141, at *8–9 (C.D. Cal. Nov. 5, 2014) (faulting plaintiff for
not “clearly articulat[e] what comprises their claimed trade dress” and “not sufficiently identify[ing] the particular elements of the packaging that they seek to protect”;

Spark Indus., LLC v. Kretek Int'l, Inc., No. CV 14-5726-GW ASX, 2014 WL 4365736, at *8 (C.D. Cal. Aug. 28, 2014) (“Spark is left with a fairly routine color scheme, graphic layout, and choice of font...if the Court were to presume source identification based on these mundane differentiating characteristics, the Court does not see what types of trade dress would not be inherently distinctive.”) (original emphasis).

Courts elsewhere also have required a plaintiff do more than just point to the “overall look”; it must “articulat[e]” the specific elements which comprise its distinct dress.

Landscape Forms, Inc. v. Columbia Cascade Co., 113 F.3d 373, 381 (2d Cir. 1997); see also Fair Wind Sailing, Inc. v. Dempster, 764 F.3d 303, 306 (3d Cir. 2014) (“[I]t is the plaintiff's duty to articulate the specific elements which comprise its distinct dress.”) (brackets and quotations omitted); Gen. Motors Corp. v. Lanard Toys, Inc., 468 F.3d 405, 415 (6th Cir. 2006) (requiring specific list of elements that comprise trade dress; warning “[i]t will not do to solely identify in litigation a *1073 combination as ‘the trade dress.’”) (citation omitted); see also J. Thomas McCarthy, McCarthy on Trademarks and Unfair Competition § 8:3 (4th ed. 2014) (“[T]he discrete elements which make up the [trade dress claim] should be separated out and identified in a list.”).

Here, EZ–Pedo has not done enough to withstand summary judgment based on inherent distinctiveness. EZ–Pedo merely brands each advertisement in its entirety as trade dress, rather than defining what shapes, sizes, dimensions or specific elements within each advertisement combine to create a distinctive trade dress. See Opp'n at 8.

1. Beach Girl

Specifically, EZ–Pedo's claimed Beach Girl trade dress contains a single stock photograph of a child on a beach that plaintiff downloaded from a third-party website. SUF 3, 5. Also, just below the photograph, there are white tooth composites, dark-colored text describing these zirconia crowns and EZ–Pedo's logo and contact information. SUF 3, 5; Opp'n at 10. Although EZ–Pedo describes the advertisement using adjectives like “unique” and “distinctive,” without specificity the court cannot evaluate whether the claimed trade dress is inherently distinctive. As currently defined, the court and competitors remain in the dark as to what EZ–Pedo purports to own. Are competitors never to advertise using the same third-party stock photograph? Can they use the same photograph, but pair it with different text, logo and company information?

2. Gears

EZ–Pedo's claimed Gears trade dress is also vaguely defined. The Gears advertisement depicts a graphic of gears accompanied by an “engineered for” slogan. Plaintiff has not shown what elements combine with this slogan to create protectable trade dress. For instance, is plaintiff claiming to own the right to arrange any image of metallic gears next to a slogan containing the words “engineered for”? Does the font matter? Do the color, size and shape of the gears matter? Can the word “engineered” be used without the preposition “for”?

3. Blue CAD

The Blue CAD trade dress likewise lacks detail. It is unclear whether plaintiff's claimed trade dress focuses on computer-aided shaded teeth with the same vertices and angles, or only when depicted in the same deep-blue color. Can a competitor use the same image, but in deep red?

4. Conclusion

Without the requisite specificity plaintiff's trade dress claims cannot proceed to trial under an inherent distinctiveness theory. See Savant Homes, Inc. v. Collins, 809 F.3d 1133, 1149 (10th Cir. 2016) (affirming summary judgment denial; emphasizing no genuine triable issue where claimant specifically listed purportedly distinctive elements but advanced no “facts indicating that these nine elements are original or unique so as to make the alleged trade dress inherently source-identifying.”). Courts routinely refuse to advance such vaguely defined claims because “[w]ithout ... a precise expression of the character and scope of the claimed trade dress ... courts will be unable to evaluate how unique and unexpected the design elements are in the relevant market.” Landscape Forms, 113 F.3d at 381 (vacating preliminary injunction). “Courts will also be unable to shape narrowly-tailored relief if they do not know what distinctive combination of ingredients deserves protection.” Id. “And if a court is unable to identify what types of designs will infringe a trade dress, how is a competitor ... to know what new designs would be subject to challenge ...?” *1074 Yurman Design, Inc. v. P. A. J., Inc., 262 F.3d 101, 117 (2d Cir. 2001) (citation omitted) (partially reversing court's judgment notwithstanding verdict); see also Jeffrey Milstein, Inc. v. Greger, Lawlor, Roth, Inc., 58 F.3d 27, 32 (2d Cir. 1995)
(affirming dismissal with prejudice; warning courts against overextending trade dress protection to overgeneralized ideas, as doing so could “tie up a product or marketing idea” and “undermine” laws designed to avoid monopolizing products and ideas). Vague descriptions may also cause “jurors viewing the same line of products [to] conceive the trade dress in terms of different elements and features” and so the verdict may drive from “inconsistent findings.”

In sum, because it has not clearly defined its claimed trade dress, plaintiff has raised no triable issue as to inherent distinctiveness. See Abercrombie & Fitch Stores, Inc. v. Am. Eagle Outfitters, Inc., 280 F.3d 619, 634 (6th Cir. 2002) (explaining the inability to describe exactly which design aspects merit protection signals an improperly general claim) (citation omitted). The court grants summary judgment for defendant on this theory.

B. Secondary Meaning

[6] [7] [8] [9] [10] [11] Even if a claimed trade dress is not inherently distinctive, a claimant may prove acquired distinctiveness over time, also known as “secondary meaning.” Wal–Mart Stores, 529 U.S. at 211, 120 S.Ct. 1339. Trade dress develops secondary meaning “when in the minds of the public, the primary significance of the [claimed trade dress] is to identify the source of the product rather than the product itself.” Id. (citation and quotations omitted). To survive summary judgment, the claimant must file sufficient evidence to allow a reasonable juror to find that a “substantial segment of consumers and potential consumers” associate the alleged trade dress with a single source of the product. Levi Strauss & Co. v. Blue Bell, Inc., 778 F.2d 1352, 1354 (9th Cir. 1985) (citation and quotations omitted); see also Savant Homes, 809 F.3d at 1141 (granting summary judgment where plaintiff raised no factual issue as to secondary meaning); PaperCutter, Inc. v. Fay’s Drug Co., 900 F.2d 558, 564 (2d Cir. 1990) (“The existence of secondary meaning is a question of fact with the burden of proof on the party claiming exclusive rights in the designation.”). Secondary meaning can be established through direct evidence, such as consumer surveys or consumer testimony, or through circumstantial evidence, such as the “length of time the mark has been used, the extent of advertising, and the volume of sales.” Levi Strauss & Co. v. Blue Bell, Inc., 778 F.2d 1352, 1358 (9th Cir. 1985) (citation and quotations omitted). Evidence the defendant deliberately copied the claimed trade dress may, when accompanied by other corroborating evidence, permit the court to infer the trade dress had acquired secondary meaning. Fuddruckers, 826 F.2d at 844–45 (explaining evidence of copying, without more, does not prove secondary meaning; “[c]ompetitors may intentionally copy product features for a variety of reasons unrelated to secondary meaning”); cf. Clicks, 251 F.3d at 1262, 1264 (claimant entitled to inference of secondary meaning based on evidence of intentional imitation paired with “substantial evidence” from consumer surveys showing “trade dress... had acquired secondary meaning.”).

Here, EZ–Pedo raises no triable issue regarding secondary meaning. Not one of its promotional advertisements was on the market for more than a year before the alleged infringements happened. Fisher Decl. ¶¶ 5, 8, 13, 17–18; Braun Inc. v. Dynamics Corp. of Am., 975 F.2d 815, 826 (Fed. Cir. 1992) (“A claim of trade dress infringement fails if secondary meaning did not exist before the infringement began.”). Rather, EZ–Pedo concedes its Blonde Girl CAD trade dress had been in use for only four months, from March to July of 2014, before discovering defendant’s similar image, id. ¶¶ 13–14; its Gears trade dress had been in use for less than a year, from mid–2014 through June 2015, before the alleged infringement, id. ¶¶ 17–19; and its Blue CAD trade dress, though first used in mid–2013, was only consistently displayed beginning in 2014, and the alleged infringement occurred in May 2014, id. ¶¶ 5–8. Considering secondary meaning is something acquired through “long use and favorable acceptance,” the short timeframe of EZ–Pedo’s use alone is potentially fatal to its claims. Vuitton Et Fils S.A. v. J. Young Enterp., Inc., 644 F.2d 769, 777 (9th Cir. 1981); see also Co–Rect Prod., Inc. v. Marvy! Advert. Photography, Inc., 780 F.2d 1324, 1330 (8th Cir. 1985) (“To establish secondary meaning, the user must show that the mark or symbol by long and exclusive use...”) (citations and quotations omitted).

Courts frequently reject secondary meaning claims based on similarly short periods. See, e.g., Braun, 975 F.2d at 826 (rejecting secondary meaning argument despite evidence of unsolicited media coverage, television and newspapers advertisements, and sales success; noting “it is difficult for a product to acquire secondary meaning during an 18-month period.”); Cicena Ltd. v. Columbia Telecomm. Grp., 900 F.2d 1546, 1551 (Fed. Cir. 1990) (use for only 18 months is “evidence pointing strongly away from a finding of secondary meaning”); Burke–Parsons–Bowlby Corp. v. Appalachian Log Homes, Inc., 871 F.2d 590, 595–96 (6th Cir. 1989) (characterizing 20 months as “very short” and deeming it strong evidence against inferring secondary meaning); Co–Rect Products, 780 F.2d at 1332 (affirming summary
judgment for defendant; finding “ten months is simply not sufficient time to establish secondary meaning in the market place.”) (citation omitted).

Compounding this potential fatality is the weak nexus between the claimed trade dress and the source the trade dress purportedly identifies. First, there is no consistent theme between the three advertisements, thus diminishing the possibility that consumers associated these advertisements with the same source. Indeed, each advertisement drastically differs from the other two—a blonde girl on the beach, a deep-blue-shaded tooth, and gears next to an “engineered for” slogan. Second, not one of these advertisements was ever placed on EZ–Pedo's product or product packaging, further weakening any association. Although plaintiff maintains it started placing small blue dots on some of its smaller dental crowns to associate the product with the Blue–CAD campaign, this argument is unavailing considering plaintiff has filed no evidence or images pertaining to these alleged blue dots. See Fisher Decl. ¶ 7 & Ex. A.

Moreover, the record is completely devoid of direct evidence suggesting any consumer, let alone “a substantial portion” of consumers, associates any of the alleged trade dress with the EZ–Pedo brand. Cf. Clicks, 251 F.3d at 1262 (finding “substantial evidence” of secondary meaning; “Chief among this evidence was a survey ... purporting to demonstrate that patrons associated the look of Clicks with that establishment and not others.”). Instead, EZ–Pedo has filed a single declaration from its founder, stating “[t]he pediatric dentistry community has come to associate the Blue Crown CAD imagery with EZ–Pedo's products. I know this ... from specific conversations I have had with purchasing pediatric dentists who have stated they recognize the Blue Crown CAD as symbolizing our products.” Fischer Decl. ¶ 7. This vague, self-serving *1076 declaration pertaining to a single advertisement, without any consumer confirmation, raises no triable issue. See Seirus Innovative Accessories, Inc. v. Gordini U.S.A. Inc., 849 F.Supp.2d 963, 985 (S.D. Cal. 2012) (rejecting similarly vague, self-serving declaration).

While EZ–Pedo's founder also emphasizes how frequently EZ–Pedo printed and disbursed the claimed trade dress and highlights which trade journals featured the trade dress, this effort does not salvage these claims. See Fisher Decl. ¶ 6. Although sales success, advertising expenditures and media coverage may show consumers were so exposed to trade dress that they have come to associate it with a single source, the evidence here does not support the possibility of such a finding. EZ–Pedo's evidence again consists solely of the one self-serving declaration containing vague, conclusory facts without any supporting evidence. Fisher Decl. ¶¶ 3, 6 (citing “thousands” of printouts and claiming EZ–Pedo spent “substantial time and energy” promoting the imagery).

Second, that each advertisement was on the market a year at most tempers EZ–Pedo's claim that it expended “substantial” time and money acquiring an association in consumers' minds between it and its products. Third, “prominent display” in a trade journal, see Fisher Decl. ¶ 12, is not the kind of media coverage that shows the “enthusiasm and loyalty” of plaintiff's customers. Cicena Ltd. v. Columbia Telecommunications Grp., 900 F.2d 1546, 1551 (Fed. Cir. 1990).

Based on the record before the court, no reasonable juror could find EZ–Pedo's claimed Beach Girl, Gears or Blue CAD trade dress has acquired secondary meaning. The court therefore will not infer secondary meaning based on the evidence that defendant imitated the claimed trade dress. See Fuddruckers, 826 F.2d at 844–45 (“Competitors may intentionally copy product features for a variety of reasons unrelated to secondary meaning”). Summary judgment for defendant is warranted as to this theory as well.

IV. CONCLUSION

Because plaintiff raises no triable issues regarding either inherent or acquired distinctiveness as to its claimed Beach Girl, Gears and Blue CAD trade dress, the court GRANTS defendant's partial summary judgment motion. Plaintiff's Lanham Act claims remain only to the extent they derive from the one advertising campaign defendant's motion does not address, plaintiff's lavender advertising campaign.

The DOE defendants are DISMISSED.

This resolves ECF No. 42. The Final Pretrial Conference on plaintiff's remaining claims is set for March 15, 2018 at 2:30 p.m., with a jury trial date to be set at the pretrial conference. The parties' joint pretrial statement is due seven days before the conference.

IT IS SO ORDERED.

All Citations

284 F.Supp.3d 1065
No. 18-15806

UNITED STATES COURT OF APPEALS
FOR THE NINTH CIRCUIT

EZ PEDO, Inc., a California corporation,  
Plaintiff-Appellant,

v.

MAYCLIN DENTAL STUDIO, INC., a Minnesota corporation, individually and dba KINDER KROWS,
Defendant-Appellee.

Appeal from the United States District Court for the Eastern District of California  
2:16-CV-00731-KJM-CKD District of California

The Honorable Kimberly J. Mueller, Presiding

DEFENDANT-APPELLEE MAYCLIN DENTAL STUDIO INC.’S ANSWERING BRIEF

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CORPORATE DISCLOSURE STATEMENT

Defendant-Appellee Mayclin Dental Studio, Inc. d/b/a Kinder Krows is a privately held Minnesota corporation that does not have a parent corporation and no publicly-held corporation owns 10% or more of its outstanding shares of stock.
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INTRODUCTION AND SUMMARY OF ARGUMENT

This case involves trade dress claims arising from the use of common, third-party stock photographs and images in isolated print advertisements, promotional materials and secondary web pages that the parties use to market and sell prefabricated zirconia crowns to the pediatric dental market.

In the Complaint, Plaintiff Appellant EZ Pedo, Inc. (“EZ Pedo”) claimed that Defendant-Appellee Mayclin Dental Studio, Inc. d/b/a “Kinder Krows” (“Mayclin”) copied EZ Pedo’s unregistered trade dress in four so-called “advertising campaigns,” giving rise to federal and state claims of trade dress infringement and related claims. ER 199-218. Among other things, EZ Pedo asserted that the “look and feel” of its advertisements became “a recognized symbol of EZ Pedo in the world of pediatric dentistry.” See ER 199. EZ Pedo also asserted that its consistent, well-established and extensive use of and expenditures caused its advertisements to “[take] on a secondary meaning” with its customers so as to create protectable, unregistered common law trade dress rights. See ER 195-207.

However, fact discovery revealed that this was not the case. For years, pediatric crown manufacturers, including EZ Pedo and Mayclin, had used scores of similar and common stock images to market and sell their pediatric crowns. There was nothing unique about EZ Pedo’s stock photographs of smiling children and
images of dental crowns, and EZ Pedo was unable to produce any evidence of acquired distinctiveness through secondary meaning. EZ Pedo’s advertisements were too infrequent, short-lived and isolated to qualify as protectable trade dress. More importantly, EZ Pedo had never placed these images on products or product packaging – the historical mechanism of trade dress rights.

As a result, after the completion of fact discovery, Mayclin moved for partial summary judgment on all trade dress claims related to the three EZ Pedo’s advertisements that used third-party stock photographs or images. Among other things, Mayclin asserted that EZ Pedo could not meet its burden to establish that: (a) its claimed trade dress was “inherently distinctive”; or (b) had acquired distinctiveness through “secondary meaning.” See ER 172. Although EZ Pedo did not claim “inherent distinctiveness” in its Complaint, Mayclin asserted that “trade dress must be defined with particularity,” a claim of an “overall look” is too vague, and there was nothing inherently distinctive about EZ Pedo’s claimed trade dress. ER 172-73.

In its memorandum in opposition to Mayclin’s motion, EZ Pedo asserted for the first time in this litigation that its claimed trade dress was “inherently distinctive,” and did not just acquire distinctiveness through secondary meaning. However, EZ Pedo did nothing to support inherent distinctiveness, merely
claiming in a conclusory fashion that its claimed trade dress was a “fanciful and arbitrary design.” ER 81-82.

In its reply, Mayclin challenged EZ Pedo’s claim of inherent distinctiveness, which included the statement: “Apart from the Beach Girl, Gears and Blue CAD Crown images, what, exactly, is the broader “look and feel” [EZ Pedo] claims [Mayclin] infringed?” ER 61; MR 213-14. ¹ This statement was in direct response to arguments raised in EZ Pedo’s opposition memorandum. However, for some unknown reason EZ Pedo now claims this quote “sandbagged” EZ Pedo because it allegedly raised a new issue, i.e. whether EZ Pedo adequately described its claimed trade dress. See Opening Brief at 2. A review of the transcript makes clear that this was not the case; the District Court correctly noted to Counsel for EZ Pedo that the “argument was it had to be particularized” (see ER 51-52), an argument Mayclin expressly included in its initial briefing. Moreover, and quite tellingly, EZ Pedo suffered no prejudice from the alleged claim of a new issue because throughout this litigation it has never added to or modified the description of its claimed trade dress, including in its Opening Brief.

With respect to the merits of the case, the District Court correctly ruled that EZ Pedo’s Beach Girl, Blue CAD Crown and Gears advertisements do not qualify

¹ In its Opening Brief EZ Pedo did not provide a full quote of this statement. See Opening Brief at p. 19.
as protectable trade dress. The District Court correctly ruled, among things, that EZ Pedo has done nothing to define or explain how its claimed trade dress is inherently distinctive. The District Court also correctly ruled that EZ Pedo raised no triable issue on the issue of secondary meaning because, among other things, the time-frame of prior use was minimal and EZ Pedo did not proffer any direct evidence regarding source-identification between the three advertisements and EZ Pedo’s brand.

EZ Pedo’s appeal only challenges the District Court’s ruling on inherent distinctiveness and the alleged prejudice to EZ Pedo based solely on one misconstrued sentence in a reply brief. For the reasons set forth below, the order of the District Court should be affirmed.

STATEMENT OF JURISDICTION

Mayclin agrees with EZ Pedo’s Statement of Jurisdiction.

STATEMENT OF ISSUES

1. Whether the District Court properly ruled that EZ Pedo’s Beach Girl, Blue CAD Crown and Gears advertisements do not qualify as protectable trade dress?

   A. Do short-term, isolated advertisements employing common stock images qualify as protectable trade dress as a matter of law?
B. Did EZ Pedo describe or establish inherent distinctiveness in the three advertisements it claims Mayclin allegedly infringed?

2. Does EZ Pedo misstate the record regarding the timing and manner of issues and arguments presented to the District Court?

STATEMENT OF THE CASE

A. UNDISPUTED FACTS RELEVANT TO THE ISSUES SUBMITTED FOR REVIEW.

1. Background.

EZ Pedo and Mayclin manufacture and market prefabricated pediatric zirconia crowns to the pediatric dental market in the United States and elsewhere. ER 6, 194. For years, pediatric crown manufacturers, including EZ Pedo and Mayclin, have used scores of photographs of children, as well as teeth and crown images, to advertise and promote their pediatric crowns. MR 82-119, 149, 151, 163-64, 167-70, 197. Examples of advertisements employing smiling children and dental crowns in trade journal and magazine advertisements are legion. MR 82-119, 167-70.

Despite the multitude of advertisements employing common and recurring themes, EZ Pedo asserts that four of its advertisements – three of which are at issue on this appeal – constitute protectable trade dress allegedly infringed by Mayclin. For the reasons set forth below, the court should reject EZ Pedo’s claims.
2. **EZ Pedo’s claimed trade dress.**
   
a. **“Beach Girl”**

   EZ Pedo’s claimed “Beach Girl” trade dress derives from an advertisement “centered around” a stock photograph of a young girl on a beach that EZ Pedo downloaded from a third-party website, istockphoto.com. ER 194-95; MR 5-6, 154-56, 161-62, 199. EZ Pedo did not take or create this photograph, nor did EZ Pedo produce any documentary evidence that it was granted exclusive rights in the photograph by iStockphoto.com or anyone else.\(^2\) MR 5-6, 54-55, 74, 142-43, 154-56, 199-200; ER 93.

   The “Beach Girl” advertisement never appeared on EZ Pedo’s website or on any physical products or product packaging. MR 147, 152-54, 204; ER 195. Rather, EZ Pedo used the “Beach Girl” advertisement during a four-month period starting in late March 2014 and running through July 2014 in two trade journals, on booth and banner displays at two annual trade meetings, and on print and social media related to the two annual trade meetings. ER 93; ER 119-134.

   EZ Pedo’s “Beach Girl” advertisement (depicted in the left image in Figure 1 at page 11 of EZ Pedo’s opening brief) is from the May/June 2014 issue of the

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\(^2\) Although not relied on by the District Court in its order granting partial summary judgment dated February 14, 2018, the standard iStockphoto.com license agreement is non-exclusive and expressly prohibits any licensee – such as EZ Pedo or Mayclin – from claiming trademark or trade dress rights in images purchased. ER 166-71; MR 16-40, 143, 156.
Journal of the American Association of Pediatric Dentistry (“AAPD Journal”). See also ER 94. There is no evidence in the record that the girl depicted in the stock photograph is named “Emmie” or was fitted with EZ Pedo pediatric crowns. See ER 92-94. On the other hand, there is no factual dispute that the photograph used in the “Beach Girl” advertisement is an iStockphoto.com image. ER 194-95; MR 5-6, 154-56, 161-62, 199.

On July 10, 2014, Mayclin downloaded the same photograph from iStockphoto.com for its advertisement in the July 2014 issue of the AAPD Journal (depicted in the right image in Figure 1 at page 11 of EZ Pedo’s appellate brief). MR 121-24, 128-30, 137-140. The only evidence in the record shows that Mayclin selected the photograph – one of the most popular on iStockphoto.com at the time – in no more than a few hours because of an impending deadline for submission of its advertisement to the AAPD Journal. Id. The only evidence in the record shows that Mayclin did not have prior knowledge of EZ Pedo’s “Beach Girl” advertisement when it selected the iStockphoto.com image for its July 2014 advertisement in the AAPD Journal. See MR 138-40; ER 92-95. Moreover, apart from the photograph, the other elements of EZ Pedo’s advertisement and Mayclin’s advertisement (depicted in Figure 1 at page 11 of EZ Pedo’s opening brief) have nothing in common.

In July 2014, or within four months of its first use, EZ Pedo stopped using
the “Beach Girl” advertisement and shifted its resources to other advertisements. ER 95.

b. “Blue CAD Crown”

EZ Pedo’s claimed “Blue CAD Crown” trade dress depicts two computer-aided drawings (or “CADs”) of deep-blue colored tooth with visible contours. ER 204-05. EZ Pedo does not claim trade dress rights in white CAD images of teeth or crowns generally; CAD imaging software is universally used to create actual white crowns for dental patients. ER 48-49, 90-91, 149, 204. Rather, EZ Pedo claims trade dress rights in two specific CAD images of crowns depicted in a “unique shade of blue,” which EZ Pedo claims “is entirely non-functional.” ER 90-91, 144, 149, 204-05.

The software program EZ Pedo used to create the “deep-blue” CAD images is called “3D Viewer,” a third-party software program offered by the company 3Shape. ER 137-38. To create the “Blue CAD Crown” image, EZ Pedo imported CAD images into 3Shape’s “3D Viewer.” ER 137-38. Previous iterations of CAD images created by EZ Pedo prior to importation into 3Shape’s “3D Viewer” were gray, light green, light gray and black. ER 137-38.

3Shape’s “3D Viewer” opens in such a manner as to display an imported CAD image in one of three default color choices – purple, gray or deep blue – with the actual color applied to the image selected by the user. ER 137-38. EZ Pedo
has produced no documentary evidence that 3Shape granted EZ Pedo exclusive rights to the default “deep-blue” color it selected from 3Shape’s “3D Viewer” software. MR 54-55, 74; ER 137-38.

EZ Pedo never displayed the “Blue CAD Crown” on any physical products or product packaging of EZ Pedo.\(^3\) ER 144. Rather, starting in March 2014, EZ Pedo featured the “Blue CAD Crown” advertisement for its V2 crown in print advertising, on trade-show banners, on brochures and flyers, and on a secondary page of EZ Pedo’s website. ER 90-91, 103-07, 112-17, 204-05. The EZ Pedo “Blue CAD Crown” advertisement included numerous words and slogans, including: “Posterior V2\(^{TM}\)” and “Same Great Look. Radical new fit.” ER 204. EZ Pedo has used other colors for its CAD crown advertisements such as a reddish orange CAD image for its Prime SL product. MR 195.

EZ Pedo contends that beginning in May 2014, or two months after the start of

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\(^3\) The district court properly rejected EZ Pedo’s claim that it placed small blue dots on its V2 crowns in 2014. ER 91, 104. These dots were not depicted in the summary judgment record and there was no evidence the alleged blue dots were shaped like a tooth. ER 90-91, 104. EZ Pedo had disputed the uncontroverted testimony of Brenda Hansen that the Blue CAD Crown image was never applied to product packaging, by submitting the self-serving declaration of Jeff Fisher purporting to claim that “tiny blue labels” were applied to the products themselves. Compare MR 144; ER 91, 104. However, no document in Exhibit A to the Fisher Declaration shows: (a) “tiny blue labels” on products while in the product packaging; or (b) that the “tiny blue labels” are the actually the same as the Blue Crown CAD alleged trade dress depicted in Figures 3 and 4 of EZ Pedo’s Opening Brief. See ER 104.
of its V2 campaign, Mayclin began using an allegedly infringing blue CAD crown in an advertisement for Mayclin’s “Less Prep” or “LP” line of crowns. ER 204-05. The only “Less Prep” or “LP” advertisement of Mayclin with a blue crown that is part of the record is the screenshot of Mayclin’s website depicted on the right side of Figure 5 at page 15 of EZ Pedo’s opening brief (for the “Gears” advertisement). This advertisement and the crown images therein look nothing like EZ Pedo’s claimed “deep-blue” images. Moreover, the image submitted as the allegedly infringing article (depicted on the right side of Figure 4 at page 14 of EZ Pedo’s opening brief) is a lighter blue CAD image and not a Mayclin “Less Prep” or “LP” advertisement.  See ER 92, 205.

c. “Gears”

EZ Pedo’s claimed “Gears” trade dress depicts the face of a watch, two white crowns viewed from the side, and the following words/slogans: “EZ-Seat™ Contours”; “The perfect balance of shape and precision fit”; and “An elegant crown engineered for a precision fit.” ER 206. EZ Pedo did not take or create the photograph of the watch – EZ Pedo downloaded the watch image from the third-party website, istockphoto.com – and EZ Pedo failed to produce any documentary evidence.

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4 EZ Pedo claims the right image in Figure 1 at page 14 of EZ Pedo’s opening brief is Mayclin’s blue “Less Prep” graphic from a Mayclin advertisement, but EZ Pedo has never proffered any evidence of an actual Mayclin advertisement in which this image allegedly appears. See ER 92.
evidence that it was granted exclusive rights in the watch photograph by iStockphoto.com or anyone else. MR 54-55, 74; ER 95, 157-58.

EZ Pedo’s claimed “Gears” trade dress never appeared on any physical products or product packaging. ER 147, 157-59, 165, 206. Starting in or around Mid-2014, EZ Pedo began displaying its advertisement (depicted in the left image of Figure 5 at page 15 of EZ Pedo’s opening brief) on a secondary page of EZ Pedo’s website. ER 95, 206. Other than EZ Pedo’s website, the advertisement may have appeared on a small banner at one trade show, but there is no exhibit in the record of this banner or any other use of the “Gears” advertisement. See ER 102-134, 157-59.

EZ Pedo alleges that in June 2015, it accessed Mayclin’s website and discovered Mayclin’s “Less Prep” advertisement (depicted in the right image of Figure 5 at page 15 of EZ Pedo’s opening brief). ER 95, 207. The Mayclin advertisement appeared on a secondary page of Mayclin’s website and had very little in common with the EZ Pedo advertisement. For example, the Mayclin advertisement did not display a watch face, but rather a stock image of four gears. ER 95, 207. The Mayclin advertisement also had one blue crown viewed from the bottom – not two white crowns viewed from the side – and the following words/slogans: “LPTM < LESS PREP” and “Engineered for Easy Placement.” ER
In contrast, EZ Pedo’s advertisement included, among other things, the following slogan: “An elegant crown engineered for a precision fit.” ER 206.

In June 2015, or within one year or so of displaying its “Gears” advertisement on its website, EZ Pedo stopped using its claimed “Gears” trade dress. ER 96.

d. “Lavender”

EZ Pedo’s Lanham Act claim pertaining to “Lavender” was not a subject of the Mayclin’s motion for partial summary judgment or the District Court’s order dated February 14, 2018 and, therefore, is not a subject of this appeal. See ER 20 (“Plaintiff’s Lanham Act claims remain only to the extent they derive from one advertising campaign defendant’s motion does not address, plaintiff’s lavender advertising campaign.”).6

B. RELEVANT PROCEDURAL HISTORY.

EZ Pedo misstates the record regarding the timing and manner of issues and arguments presented to the District Court.

In its Complaint filed April 7, 2016, EZ Pedo did not assert that its

5 Other competitors also used the word “engineer” in their advertisements. See e.g. MR 96 (“Dentists are Engineers” and “we engineer our crowns without taking short cuts”).

6 Mayclin elected not to move for partial summary judgment on the lavender campaign because, among other things, EZ Pedo produced licenses for the right to use the lavender photograph and image of an EZ Pedo client in its advertisements.
advertising campaigns were “inherently distinctive.” ER 191-218. Rather, EZ Pedo claimed it acquired distinctiveness in unregistered trade dress rights in all four of its advertisements through secondary meaning only, as follows:

“13. Beginning in or about early 2014, EZ-Pedo embarked on a “Beach Girl” marketing campaign designed to accomplish a look and feel across all of EZ-Pedo’s marketing materials and websites. …The entire look and feel of EZ-Pedo’s Beach Girl marketing materials, both in print and online, took on a secondary meaning associated with EZ-Pedo and the quality of its pediatric dental products.”

* * *

23. Through EZ-Pedo’s consistent and well-established use of the lavender trade dress/trademark as a cornerstone of its brand identity, the lavender trade dress and mark have become a recognized symbol of EZ-Pedo in the world of pediatric dentistry. …The lavender trade dress and mark have acquired secondary meaning and have become a valuable marketing and business asset of EZ-Pedo…”

* * *

37. The Blue V2 Crown Mark has acquired secondary meaning and has become a valuable marketing and business asset of EZ-Pedo…”

* * *

43. The look and feel of the gears and “Engineered for” slogan has acquired secondary meaning and has become a valuable marketing and business asset of EZ-Pedo…”

ER 194-95, 199, 205-07. (Complaint, ¶¶ 13, 23, 37, 43.)
In its Answer Mayclin denied EZ Pedo had protectable trade dress rights in the advertisements at issue. ER 178-190. Among other things, Mayclin asserted “[EZ Pedo] is not the owner of any intellectual property right in all or most of the images cited in the Complaint” and “[EZ Pedo] has no protectable interest in the trademarks or trade dress cited in the Complaint.” ER 189 (Affirmative Defenses, ¶¶ 2, 5).

EZ Pedo complains that Mayclin did not file a motion to dismiss to challenge the adequacy of EZ Pedo’s description of its alleged trade dress. However, Mayclin could not serve and file a Fed. R. Civ. P. 12(b)(6) motion to dismiss for failure to state a claim because EZ Pedo plead facts in support of its claim of secondary meaning, which, for purposes of a Rule 12(b)(6) motion, must be taken as true. Thereafter, written discovery and depositions were required to determine, among other things: (1) where EZ Pedo obtained the images for its advertisements; (2) whether EZ Pedo owned or licensed all or some of the photographs and images used for its advertisements; (3) the manner of EZ Pedo’s uses of and expenditures for the advertisements; (4) the time frame of EZ Pedo’s uses of its advertisements; and (5) whether EZ Pedo applied the images to products or product packaging.

After completion of fact discovery, Mayclin served and filed its motion for partial summary judgment on March 24, 2017. ER 159-76. Contrary to EZ Pedo’s
assertion, Mayclin asserted that EZ Pedo was required to establish that its images qualify as protectable trade dress because: (1) its claimed trade dress is nonfunctional; (2) its claimed trade dress serves as a source-identifying role either because it is inherently distinctive or has acquired secondary meaning; and (3) there is a likelihood of consumer confusion. ER 172 (citing Clicks Billiards, Inc. v. Sixshooter, Inc., 251 F.3d 1252, 1258 (9th Cir. 2001)). Mayclin also asserted that “trade dress must be defined with particularity” and a claim of “overall look” is “too vague.” ER 172 (citing J. Thomas McCarthy, McCarthy on Trademarks, § 8:4 (4th Ed. 2016); Abercrombie & Fitch Stores v. American Eagle Outfitter, 280 F.3d 619 (6th Cir. 2002); The Jumpitz Corp. v. Viacomm Intern., Inc., 97 U.S.P.Q. 2d 202, 2010 WL 3238953 (S.D. Cal. 2010)). Although EZ Pedo had not claimed trade dress rights based on “inherent distinctiveness,” Mayclin asserted, among other things, that there is nothing inherently distinctive about common stock images and EZ Pedo had not produced any competent evidence of secondary meaning. See ER 173.

On April 7, 2017, EZ Pedo served and filed its opposition to Mayclin’s motion for partial summary judgment. In its memorandum EZ Pedo raised its claim of unregistered trade dress rights based on alleged “inherent distinctiveness” for the first time in this litigation. ER 67 (“Whether trade dress is protectable depends on its degree of “distinctiveness,” – a question of fact. Here, Plaintiff’s
trade dress is fanciful and nondescriptive.”) EZ Pedo asserted that a reasonable jury could find the “look and feel” of all three advertisements in their totality were inherently distinctive or acquired distinctiveness through secondary meaning. ER 79-82. However, in its opposition memorandum EZ Pedo only specifically claimed that “Beach Girl” was inherently distinctive because it was a “fanciful and arbitrary design.” ER 81-82.

Mayclin’s reply memorandum addressed matters raised for the first time in EZ Pedo’s opposition. MR 209-22. In particular, Mayclin responded to EZ Pedo’s claim of inherent distinctiveness of the total “look and feel” of its advertisements, as follows:

[EZ Pedo] also conflates the concept of a broader “look and feel” of its website, booth designs, marketing materials and “selling image” with the alleged copied elements of specific advertisements at issue. Plaintiff did not include or prominently feature any of the advertisements at issue in this motion on its website, nor did [EZ Pedo] apply any of the images to its product packaging. Plaintiff fails to cite a single authority recognizing trade dress in infrequent and isolated advertisements. Plaintiff also admittedly used numerous other photographs of children, graphic images, and marketing “campaigns,” as have [Mayclin] and other pediatric crown manufacturers. *This begs the question: apart from the Beach Girl, Gears and Blue CAD Crown images, what, exactly, is the broader “look and feel” [EZ Pedo] claims [Mayclin] infringed?* Does [EZ Pedo’s] “look and feel” rights include the scores of other photographs, graphic images, advertisements and marketing materials [EZ Pedo] has employed to sell its products?
As a result, the quote at page 19 of EZ Pedo’s Opening Brief is incomplete, taken out-of-context, and an incorrect basis to assert Mayclin raised an argument about EZ Pedo’s description of its claimed trade dress for the first time in Mayclin’s reply. Mayclin clearly did not.

At the hearing on Mayclin’s motion for partial summary judgment on May 5, 2017, Counsel for Mayclin referenced the argument about a particularized description of trade dress set forth in Mayclin’s opening memorandum, as follows:

McCarthy on Trademarks makes clear that you can’t claim trade dress rights in sort of a broad, undefinable theme. All the retail establishment cases, they identified boom, boom, boom, boom, when you walk in. That is not the case here.

ER 51. Counsel for EZ Pedo responded, in pertinent part, as follows:

That issue, the issue of whether there has been an adequate description of the trade dress, first of all, is more appropriate for a motion to dismiss, a 12(b)(6). …You know, I’d be happy to offer a written description: Here is how we define it. I believe it is in the Complaint – you know, well done in the Complaint. But if it’s not or the Court has a question about is the plaintiff claiming this, I would submit supplemental briefing to say, “Here’s what the definition of that trade dress is.

ER 52.

In response, the District Court channeled Mayclin’s argument of particularity raised in its opening brief, as follows: “Well, I think the argument
was it has to be particularized.” ER 52. EZ Pedo never moved for leave to file a surreply to submit a revised description of its claimed trade dress at any time. Moreover, EZ Pedo did not modify or add to its description of its claimed trade dress in its Opening Brief. See Opening Brief at pp. 28-31.

On February 14, 2018, the District Court defined the core issues raised in Mayclin’s motion for partial summary judgment at ER 172, as follows:

The core dispute centers around whether EZ-Pedo can satisfy the essential element of distinctiveness by meeting its burden to show the images are distinctive, either inherently or by virtue of having attained secondary meaning.

ER 13. On the issue of inherent distinctiveness, the District Court concluded as follows:

Here, EZ-Pedo has not done enough to withstand summary judgment based on inherent distinctiveness. EZ-Pedo merely brands each advertisement in its entirety as trade dress, rather than defining what shapes, sizes, dimensions or specific elements within each advertisement combine to create a distinctive trade dress.

ER 16. On the issue of secondary meaning, the District Court concluded, in pertinent part, as follows:

Here, EZ-Pedo raises no triable issue regarding secondary meaning. Not one of its promotional advertisements was on the market for more than a year before the alleged infringements happened. Rather, EZ-Pedo concedes its Blonde Girl trade dress had been in use for only four months, ...its Gears trade dress has been in use for less than a year, ...and its Blue CAD trade
dress...was only consistently used starting in 2014, and the alleged infringement occurred in May 2014. ...Compounding this potential fatality is the weak nexus between the claimed trade dress and the source the trade dress purportedly identifies. (citations omitted.)

* * *

...Moreover, the record is completely devoid of direct evidence suggesting any consumer, let alone a “substantial portion” of consumers, associates any of the alleged trade dress with the EZ Pedo brand. (citations omitted.)

ER 17-19.

ARGUMENT

I. THE DISTRICT COURT PROPERLY RULED THAT EZ PEDO’S BEACH GIRL, BLUE CAD CROWN AND GEARS ADVERTISEMENTS DO NOT QUALIFY AS PROTECTABLE TRADE DRESS.

A. Short-term, isolated advertisements employing common stock images do not qualify as protectable trade dress as a matter of law.

The Lanham Act is the federal statute governing trademark and trade dress protection, unfair competition and false advertising. 15 U.S.C. § 1051 et seq. (the “Act”). The Act defines “trademark” as “any word, name, symbol, or device, or any combination thereof [used or intended to be used] to identify and distinguish [a producer’s] goods...from those manufactured or sold by others and to indicate the source of the goods.” 15 U.S.C. § 1127. “Trade dress” is considered a “symbol” or “device” within the definition of “trademark.” Wal-Mart Stores, Inc. v. Samara
Section 43(a) of the Act, 15 U.S.C. § 1125(a), is the federal vehicle for the assertion of infringement of unregistered trademarks and trade dress, as well as related claims of unfair competition, false advertising and false designation of origin. 15 U.S.C. § 1125(a); Two Pesos, Inc. v. Taco Cabana, Inc., 505 U.S. 703, 768 (1992); Wal-Mart, 529 U.S. at 209-10 (2000). In order to sustain a claim under Section 43(a), the plaintiff has the burden of proving that (1) the defendant used a mark or trade dress that is (2) confusingly similar to (3) a valid, protectable trademark or trade dress (4) that was owned by the plaintiff. Id.; 9th Circuit Model Jury Instructions, §§ 15.1, 15.7 (emphasis added). See also Brookfield Communications, Inc. v. West Coast Entertainment Corp., 174 F.3d 1036, 1046-47 (9th Cir. 1999) (applying same standard to claims under 15 U.S.C. § 1114(1) and 15 U.S.C. § 1125(a)).

As a general matter, that which may be considered trade dress must be a definite and tangible “thing,” such as labels, wrappers, containers used in the packaging of a product, or even the look of a product or its packaging. Wal-Mart Stores, 529 U.S. at 209 (trade dress historically included only packaging, or “dressing,” of a product, but was expanded to include product design). Ineffable and vague aspects such as a product’s marketing theme and its “overall appearance” or “look” generally cannot be exclusively owned by one seller as its
“trade dress.” See generally J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition* § 8.3 at 8-17 to 8-20, §8.6 at 8-42 (5th ed. 2017) (trade dress must be defined with particularity and “overall look” too vague); *Abercrombie & Fitch Stores v. American Eagle Outfitter, Inc.*, 280 F.3d 619 (6th Cir. 2002). See e.g., *The Jumpitz Corp. v. Viacomm Intern., Inc.*, 97 U.S.P.Q. 2d 202, 2010 WL 3238953 (S.D. Cal. 2010) ("[t]he use of bright, fun colors and whimsical, playful shapes are not quintessential Nickelodeon; they are tools that have been used for years to reach children.")

Here, EZ Pedo’s claim of trade dress rights in the Beach Girl, Blue CAD Crown and Gears advertisements is not only atypical and vague, but also attempts to stretch trade dress protection beyond the scope of recognizable rights. As the District Court correctly observed, “…the parties have not identified, and the court has not found, any case law extending trade dress protection to promotional flyers or advertisements…” ER 12. The District Court also stated, “[d]espite the potential breadth of trade dress protection, this Lanham Act provision is not an invitation to shotgun litigation: Claimants bear a strenuous burden to show the claimed trade dress serves the role of identifying the owner as a source…” *Id.*

The trade dress cases EZ Pedo cites in its Opening Brief all fit squarely within the well-recognized parameters of protectable trade dress, and are all clearly distinguishable from the “look and feel” trade dress claimed by the plaintiff in this
case. Most of the cases cited by EZ Pedo relate to trade dress rights in product packaging, product design, or the unique feature of the actual product itself. For example, in Mattel, Inc. v. Walking Mountain Prods., 353 F.3d 792, 808 (9th Cir. 2003), the Ninth Circuit recognized trade dress rights in well-known “appearance” of the famous Barbie doll. In Louis Vuitton Malletier v. Dooney & Bourke, Inc., 454 F.3d 108, 115 (2d Cir. 2006), the Second Circuit recognized trade dress rights in the unique design and features of the well-known Louis Vuitton handbag. See also Vision Sports, Inc. v. Melville Corp., 888 F.2d 609 (9th Cir. 1989) (trade dress rights in color scheme and graphics of Vision’s logo applied to actual items of clothing); Ambrir, Inc. v. Kraft, Inc., 812 F.2d 1531 (11th Cir. 1986) (combination of Klondike ice cream bar’s size, silver, blue and white wrapper, pebbled texture of foil, polar bear and sunburst images protectable trade dress); August Storck K.G. Nabisco, Inc., 59 F.3d 616 (7th Cir. 1995) (analyzing trade dress of candy packaging and wrapper).

In contrast to these cases, EZ Pedo admittedly did not apply any of images identified in Figures 1 and 3 through 6 of its opening brief to any product or its packaging, and EZ Pedo does not claim any trade dress right in any form, feature or design of any EZ Pedo product itself. See Opening Brief. at 11-16, Figures 1, 3-6.

EZ Pedo’s reliance on the overall “look and feel” cases involving retail
establishments – such as a restaurant, a pool hall or a grocery store – is also misplaced. For example, in *Two Pesos* the Supreme Court recognized trade dress right in the appearance and design of the *Taco Cabana* chain of Mexican-style restaurants, including the exterior, identifying sign, floor plan, décor, menu and servers’ uniforms. 505 U.S. at 769. In *Clicks Billiards, Inc. v. Sixshooters Inc.*, 251 F.3d 1252, 1259 (9th Cir. 2001), the Ninth Circuit denied summary judgment to a pool hall operator claiming trade dress rights in the design, decor and other features of the *Sixshooters* pool hall establishments. *Accord Fuddruckers’s, Inc. v. Doc’s BR Others, Inc.*, 826 F.2d 837 (9th Cir. 1987) (trade dress rights in design and decor of *Fuddruckers’s* hamburger restaurants). In *Stephen W. Boney, Inc. v. Boney Service, Inc.*, 127 F.3d 821 (9th Cir. 1997), the Ninth Circuit concluded there were no trade dress rights in dark wood paneling, large produce areas and low produce-display “gondolas” in grocery stores). *See also T-Mobile US Inc. v. Aio Wireless, LLC*, 991 F. Supp. 2d 888, 905-06 (S.D. Tex. 2014) (T-Mobile’s unique Magenta color had acquired trade dress distinctiveness through secondary meaning based on long term and extensive use in retail stores and on promotional materials).

In contrast to these cases, EZ Pedo does not claim trade dress rights in particular elements of the overall “look and feel” of a retail establishment. Rather, EZ Pedo is claiming trade dress rights in a few infrequent and isolated
advertisements out of the scores of similar advertisements by EZ Pedo, Mayclin and others in the pediatric dental market. See Opening Brief at 11-16, Figures 1, 3-6.

Finally, EZ Pedo cites to a couple of federal district court cases from California recognizing the possibility of trade dress rights in the overall “look and feel” of a website. See Opening Brief at 24 (citing Ingrid & Isabel, LLC v. Baby Be Mine, LLC, 70 F. Supp. 3d 1105 (N.D. Cal. 2014); Salt Optics, Inc. v. Jand, Inc., 2011 U.S. Dist. LEXIS 156237 (C.D. Cal. Mar. 4, 2011). The website cases are inapposite for two reasons. First, although numerous documents illustrating EZ Pedo’s web pages have been produced in this litigation, EZ Pedo submitted only one screen shot of its web page in opposition to Mayclin’s motion for partial summary judgment. ER 112. This page depicts a secondary page from EZ Pedo’s website from September 24, 2014, showing a different advertisement from that displayed in Figures 1 and 3 through 6 of EZ Pedo’s Opening Brief. (Id.) All other exhibits submitted by EZ Pedo are print advertisements. Second, EZ Pedo has not asserted that the “look and feel” of this page or any other page from its website constitutes protectable trade dress, or that Defendant has copied that “look and feel.”

In any event, the Ninth Circuit has yet to extend trade dress rights to the “look and feel” of websites, see Ingrid, 70 F. Supp. 3d at 1135-37, and a number of

Finally, EZ Pedo suggests that “courts have extended trade dress protection to elements of advertising campaigns “on television, in print advertisements, and outdoor advertisements,” in addition to simple colors or themes used as retail storefront. *See* Opening Brief at p. 24 (citing *T-Mobile, supra*, 991 F. Supp. 2d at 905-06.) EZ misstates the holding of *T-Mobile*. In that case the Southern District of Texas recognized T-Mobile’s unique Magenta color as protectable trade dress based on acquired distinctiveness through secondary meaning. T-Mobile had used the Magenta color for over 10 years by featuring it prominently in brick-and-mortar retail store where over 90% of their products and services are purchased, on products and product packaging, on websites, on promotional items, and in over $4 billion in advertising campaigns over the ten-year period. *T-Mobile*, 991 F. Supp. 2d at 897-902, 905-06. EZ Pedo has not and cannot make such claims here.

Here, the Beach Girl advertisement never appeared on Plaintiff’s website, the Gears and Blue CAD Crown images were only featured on secondary pages of
its website, and, most importantly, none of the specific images were affixed to Plaintiff’s product packaging. Moreover, EZ Pedo used the Beach Girl, Blue CAD Crown and Gears advertisements for a short time frame before the allegedly infringing advertisements, and discontinued use of Beach Girl and Gears after nominal, short-term use altogether.

Under the facts of this case, EZ Pedo does not cite to a single authority where a court recognized trade dress rights in short-term, isolated advertisements using common stock images. As a result, the Court should affirm the order of the District Court dated February 14, 2018 granting Mayclin’s motion for partial summary judgment on EZ Pedo’s trade dress claims relating to the Beach Girl, Blue CAD Crown and Gears advertisements.

B. **EZ Pedo can provide no description of “inherently distinctive” trade dress it claims Mayclin allegedly infringed.**

To establish ownership of protectable unregistered trade dress, the plaintiff bears the burden of proving that its claimed trade dress is: (1) distinctive; and (2) non-functional. *See* 9th Circuit Model Jury Instructions, § 15.7 (citing 15 U.S.C. § 1125(a)(1)). To establish distinctiveness, the plaintiff has the burden of proving that the mark is either: (a) inherently distinctive or (2) has acquired distinctiveness through secondary meaning among the relevant consuming population. *Two Pesos*, 505 U.S. at 769; *Wal-Mart Stores*, 529 U.S. at 210-11.

As the District Court correctly noted, “[p]roving inherent distinctiveness is
demanding.” ER 13. To be inherently distinctive, the claimed trade dress must be so unique, in context, that a buyer will rely on it to differentiate the source of the product for which it is associated. *Wal-Mart*, 529 U.S. at 213. Certain things – such as color and product design – can never qualify as inherently distinctive, and can only be judicially protected or registered by the U.S. Patent & Trademark Office on a showing of secondary meaning. *Qualitex Co. v. Johnson Products*, Co., 514 U.S. 159, 163 (1995); *Wal-Mart*, 529 U.S. at 213 (“In the case of product design, as in the case of color, we think consumer predisposition to equate the feature with the source does not exist.”)

The Supreme Court has also cautioned against applying vague tests for inherent distinctiveness, noting such tests “facilitate[] plausible threats of suit against new entrants based on alleged inherent distinctiveness.” *Wal-Mart*, 529 U.S. at 213.; *Fuddrucker’s, supra*, 826 F.2d at 844 (9th Circuit explaining, before *Wal-Mart* decided, that “overall impression may receive protection,” but denying such protection where the claimed trade dress “was simply not the sort of arbitrary or uncommon trade dress that might qualify as inherently distinctive.”) (citation omitted)).

Moreover, the traditional spectrum of generic, descriptive, suggestive, arbitrary and fanciful does not apply to non-word designations such as shapes, images and designs. *Duranco Products, Inc. v. Joy Plastics Enterprises, Ltd.*, 40
F.3d 1431, 1440 (3d. Cir. 1994) (“[W]e do not think it helpful or proper to transplant the categorical distinctiveness inquiry developed for [word] trademarks to product configurations….); Amazing Spaces, Inc. v. Metro Mini Storage, 608 F.3d 225, 241 (5th Cir. 2010) (“As the district court discovered, the challenge of placing the Star Symbol into Abercrombie’s constellation of [word mark] categories is a futile endeavor”; the court affirmed that a five-pointed star is not inherently distinctive.)

As the District Court noted, since Wal-Mart the Ninth Circuit has not revisited the articulation of a trade dress claimant’s burden in proving inherent distinctiveness, but district courts within the circuit have interpreted the term as requiring manifestly unique arrangements. See Morton & Bassett, LLC v. Organic Spices, Inc., 2017 WL 1425908, at *6 (N.D. Cal. Apr. 21, 2017 (defining the ultimate question as “whether the…combination of elements is so unique, unusual or unexpected in the market that one can assume without proof that it will automatically be perceived by customers as an indicator of origin[.]”) (citations and quotations omitted); Homeland Housewares, LLC v. Euro-Pro Operating LLC, 2014 U.S. Dist. LEXIS 156675, at *8-9 (C.D. Cal. Nov. 5, 2014) (faulting plaintiff for not “clearly articulat[ing] what comprises their claimed trade dress” and “not sufficiently identify[ing] the particular elements of packaging they seek to protect”); Spark Indus., LLC v. Kretek Int’l, Inc., 2014 WL 4365736, at *8 (C.D.
Cal. Aug. 28. 2014) (“Spark is left with a fairly routine color scheme, graphic layout, and choice of font…if the Court were to presume source identification based on these mundane characteristics, the Court could not see what types of trade dress would not be inherently distinctive.”) (emphasis in original.)

Courts elsewhere also have required a claimant do more than just point to an “overall look”; it must “articulat[e] the specific elements which comprise its distinct dress.” Landscape Forms, Inc. v. Columbia Cascade Co., 113 F.3d 373, 381 (2d. Cir. 1997); see also Fair Wind Sailing, Inc. v. Dempster, 764 F.3d 303, 306 (3d. Cir. 2014) (“[I]t is the plaintiff’s duty to articulate the specific elements which comprise its distinct trade dress.” (brackets and quotation omitted); Gen. Motors Corp. v. Lannard Toys, Inc., 468 F.3d 404, 415 (6th Cir. 2006) (requiring specific list of elements that comprise trade dress, warning “[i]t will not do to solely identify in litigation a combination as ‘the trade dress.’”) (citations omitted.).

Applying these well-settled principles, the District Court properly held that EZ Pedo cannot withstand summary judgment on inherent distinctiveness. Here, EZ Pedo asserts its trade dress claims do not arise from Mayclin’s use of any specific third-party photograph or graphic, but rather from infringement of the entire “look and feel” of EZ Pedo’s trade dress. In so doing, EZ Pedo conflates the concept of a broader “look and feel” of its website, booth designs, marketing
materials and “selling image” with the alleged copied elements of the specific advertisements at issue.

Moreover, a simple review of EZ Pedo’s comparative side-by-side depiction of the parties’ respective advertisements clearly belies EZ Pedo’s proposition of a broader “look and feel.” See Opening Brief, Figures 1, 3-6. The third-party stock photograph and images were admittedly “central” to EZ Pedo’s alleged trade dress, and EZ Pedo cites to no other elements of the claimed “look and feel” that were allegedly copied by Mayclin. ER 92-93, 119-34, 194-95; MR 5-6, 154-56, 161-62, 199; Opening Brief at 28-32.

1. The District Court correctly ruled the “Beach Girl” advertisement is not inherently distinctive.

In its Opening Brief, EZ Pedo’s description of the claimed “Beach Girl” trade dress references the second sentence of paragraph 13 of EZ Pedo’s Complaint. See Opening Brief at 28; ER 194-95. The first part of the one-sentence description provides a detailed 24-word description of the iStockphoto.com stock photograph identified at page 11 of EZ Pedo’s Opening Brief. The second part remainder of the description references “white tooth composites” and a vague statement about “dark text containing information about the zirconia crowns, and identifying logos and contact information.” Id. EZ Pedo did not add to or modify this description, and the District Court actually came up with a more detailed description of the other elements of the “Beach Girl” trade dress than EZ Pedo. See
Clearly, without the stock photograph of a smiling girl (which EZ Pedo adequately describes), EZ Pedo would never have asserted a trade dress claim against Mayclin for the advertisement depicted in Figures 1 at page 11 of EZ Pedo’s Opening Brief. EZ Pedo does not (and cannot) cite to any other elements of the “look and feel” of the “Beach Girl” advertisement that were allegedly copied by Mayclin. *See Abercrombie, supra*, 280 F.3d at 634 (the inability to describe which design aspects merit protection signals an improperly general claim). Moreover, EZ Pedo has admittedly used numerous other photographs of smiling children and tooth composites/crowns, as have Mayclin and other pediatric crown manufacturers. MR 82-119, 149, 151, 163-64, 167-70, 197.

Based on the foregoing, there is nothing “inherently distinctive” about the “look and feel” of the “Beach Girl” advertisement as an unregistered source indicator for EZ Pedo’s products, and no possible description by EZ Pedo will make it so.

2. The District Court correctly ruled the Blue CAD Crown advertisement is not inherently distinctive.

The District Court was correctly dismissive of EZ Pedo’s description of the Blue CAD Crown trade dress claim set forth in portions of paragraphs 35 and 36 of the Complaint, as follows:

Rather than using the white color of the crowns for the
CAD model, EZ-Pedo developed a unique shade of dark blue to apply to its V2 crown CAD models. ...The unique shade of blue is entirely nonfunctional.”

ER 204. EZ Pedo does nothing different here. In its Opening Brief EZ Pedo asserts its claimed trade dress can also be easily understood from a cursory review of Figure 7 of its Opening Brief, and claims trade dress rights “in a deep-blue CAD image of a tooth with contour lines.” See Opening Brief at 29. Therefore, EZ Pedo does not claim or describe any other element in its Blue CAD Crown advertisement, or any broader “look and feel,” that is either inherently distinctive or was allegedly infringed by Mayclin. Id.

As set forth above, color and product design can never qualify as inherently distinctive, and can only be judicially protected or registered by the U.S. Patent & Trademark Office on a showing of secondary meaning. Qualitex, 514 U.S. at 163; Wal-Mart, 529 U.S. at 213. Here, EZ Pedo’s claimed trade dress rights go entirely to color and product design. Moreover, EZ Pedo has admittedly used numerous other images of crowns (including an orange CAD crown image), as have Mayclin and other pediatric crown manufacturers. MR 82-119, 149, 151, 163-64, 167-70, 197. As a result, there is nothing “inherently distinctive” about the CAD crown image using a default color generated by third-party software, and no description of by EZ Pedo will make it so.
3. **The District Court correctly ruled that the “Gears” advertisement is not inherently distinctive.**

Applying well-settled law and trade dress principles, the District Court correctly concluded that “Gears” is not inherently distinctive as a matter of law. EZ Pedo’s description of the claimed trade dress in the “Gears” advertisement is even more insufficient than either Beach Girl or Blue CAD Crown, cherry-picking two elements out of many in the advertisement, as follows:

There is no mystery to what EZ Pedo claims with respect to the scope of this trade dress; EZ Pedo claims **gears imagery paired with a slogan using the words “Engineered for...”** to market prefabricated pediatric zirconia crowns.

*See* Opening Brief at 32 (citing ER 206-07) (emphasis added.). Thus, EZ Pedo actually ignores all other elements of its “Gears” advertisement, and does not claim any broader “look and feel” that is either inherently distinctive or was allegedly copied by Mayclin. *Id.*

There is nothing inherently distinctive about EZ Pedo’s use of a third-party stock image of the face of a watch. *See* Opening Brief at p. 5. There is nothing inherently distinctive about the use of the words “Engineered for.” *Id.* Moreover, of the three advertisements at issue, a simple review of the side-by-side depiction of the parties’ respective advertisements in Figure 5 demonstrates that Mayclin’s advertisement has very little in common with the EZ Pedo advertisement. For example, the Mayclin advertisement did not display a watch face, but rather a stock
image of four gears. ER 95, 207. The Mayclin advertisement had one blue crown viewed from the bottom – not two white crowns viewed from the side – and the following words/slogans: “LPTM < LESS PREP” and “Engineered for Easy Placement.” ER 95, 207. Other competitors use the word “engineered.” In contrast, EZ Pedo’s advertisement included, among other things, the following slogan: “An elegant crown engineered for a precision fit.” ER 206.

Based on the foregoing, there is nothing “inherently distinctive” in the cited elements of EZ Pedo’s “Gears” advertisement, and no description of by EZ Pedo will make it so. See Savant Homes, Inc. v. Collins, 809 F.3d 1133, 1149 (10th Cir. 2016) (affirming summary judgment denial; emphasizing no genuine triable issue where claimant specifically listed purportedly distinctive elements but advanced no "facts indicating that these elements are original or unique so as to make the alleged trade dress inherently source-identifying").

II. EZ PEDO MISSTATES THE TIMING AND MANNER OF PRESENTATION OF ARGUMENTS TO THE DISTRICT COURT.

EZ Pedo claims it was prejudicial error for the District Court to dismiss EZ Pedo’s trade dress claims on the grounds that EZ Pedo had not sufficiently defined the scope of its trade dress, asserting that the argument was first raised in

7 Other competitors also used the word “engineer” in their advertisements. See e.g. MR 96 (“Dentists are Engineers” and “we engineer our crowns without taking short cuts”).
Mayclin’s reply brief. See Opening Brief at p. 34. EZ Pedo’s assertion is based on a clear misstatement of the record and should be rejected.

First, in the Complaint EZ Pedo did not claim that any of its advertisements were “inherently distinctive.” ER 191-218. Rather, EZ Pedo claimed distinctiveness through secondary meaning only. ER 194-95, 199, 206-07.

Second, although EZ Pedo had not claimed trade dress rights based on “inherent distinctiveness,” in its opening brief on partial summary judgment Mayclin asserted, among other things, that “trade dress must be defined with particularity” and there is nothing inherently distinctive about EZ Pedo’s advertisements employing common stock images. See ER 173.

Third, in its opposition memorandum to Mayclin’s motion for partial summary judgment, EZ Pedo introduced for the first time in this litigation its claim that its unregistered trade dress rights were “inherently distinctive.” ER 67 (“Whether trade dress is protectable depends on its degree of “distinctiveness,” – a question of fact. Here, Plaintiff’s trade dress is fanciful and nondescriptive.”)

Fourth, EZ Pedo inserts a partial, out-of-context quote from Mayclin’s reply brief to assert that Mayclin raised the issue of a particularized description of its trade dress for the first time in its reply. See Opening Brief at p. 34. The full quote makes clear that Mayclin was responding to EZ Pedo’s assertion of inherent distinctiveness in the overall “look and feel” of its advertisements. MR 213-14. It
is axiomatic that a reply may respond to any claims asserted in a non-movant’s opposition brief. See e.g., Fed. R. Civ. App. P. 27(a)(4).

Fifth, EZ Pedo never moved for leave to submit a surreply.

Sixth, in its Opening Brief to this Court, EZ Pedo did not add to or modify the descriptions of its claimed trade dress contained in the Complaint. See Opening Brief at pp. 28-31. Thus, EZ Pedo cannot demonstrate any prejudice based in its inaccurate description of the record. See Pfizer, Inc. v. Teva Pharmaceuticals USA, Inc., 518 F.3d 1353, 1359 n. 5 (Fed. Cir. 2008) (allowing issue to be considered on appeal where party claiming issue raised too late in district court proceedings below could not demonstrate it was prejudiced).

Based on the foregoing, the District Court did not err in dismissing EZ Pedo’s trade dress claims on the ground that, among other things, EZ Pedo did not sufficiently describe its trade dress.
CONCLUSION

For the reasons set forth above, this Court should affirm the judgment dismissing EZ Pedo’s Lanham Act claims and remand the case to the District Court for further proceedings on remaining claims.

DATED: October 10, 2018

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CERTIFICATE OF COMPLIANCE

I certify that this brief complies with the type-volume limitation of Fed. R. App. P. 32(a)(7)(B) because this brief contains 8,474 words, excluding the parts of the exempted by Fed. R. App. P. 32(a)(7)(B)(iii).

This brief complies with the typeface requirements of Fed. R. App. P. 32(a)(5) and the type style requirements of Fed. R. App. P. 32(a)(6) because this brief has been prepared in a proportionality spaced typeface using Microsoft Word 2016 14-point Times New Roman.

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CERTIFICATE OF SERVICE

I hereby certify that I electronically filed the foregoing with the Clerk of the Court for the United States Court of Appeals for the Ninth Circuit by using the appellate CM/ECF system on October 10, 2018.

I certify that all participants in the case are registered CM/ECF users and that service will be accomplished by the appellate CM/ECF system.

/s/ Timothy C. Matson
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STATEMENT OF RELATED CASES

Pursuant to Circuit Rule 28-2.6, Defendant-Appellee states that it is not aware of any related cases pending in this Court.
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EZ PEDO, INC.

UNITED STATES DISTRICT COURT  
FOR THE EASTERN DISTRICT OF CALIFORNIA

EZ PEDO, INC., a California corporation,  

Plaintiff,  

vs.  

MAYCLIN DENTAL STUDIO, INC.,  
a Minnesota corporation, individually  
and dba KINDER KROWSNS; and  
DOES 1-10,  

Defendants.

Case No.

COMPLAINT FOR:

(1) TRADE DRESS/TRADEMARK INFRINGEMENT  
(2) FEDERAL UNFAIR COMPETITION AND FALSE ADVERTISING  
(3) CALIFORNIA STATE UNFAIR COMPETITION  
(4) CALIFORNIA STATE FALSE ADVERTISING  
(5) FALSE DESIGNATION OF ORIGIN  
(6) MINNESOTA DECEPTIVE TRADE PRACTICES  
(7) MINNESOTA STATE FALSE ADVERTISING  
(8) COMMON LAW UNFAIR COMPETITION

JURY TRIAL DEMANDED

EZ PEDO, INC.’S COMPLAINT
Plaintiff EZ PEDO, INC. ("Plaintiff" or "EZ-Pedo") complains and alleges against MAYCLIN DENTAL STUDIO, INC., a Minnesota corporation, individually and dba KINDER KROWN; and DOES 1 - 10 (collectively, "Defendants") as follows.

**JURISDICTION AND VENUE**

1. This action arises under the federal trademark/unfair competition statute (the "Lanham Act"), 15 U.S.C. § 1051 *et seq.*, and under the laws of the State of California and the State of Minnesota. This Court has subject matter jurisdiction over the federal trade dress, false advertising, and unfair competition claims pursuant to 15 U.S.C. § 1121 and 28 U.S.C. §§ 1331,1332, 1338, and 1367. The Court has subject matter jurisdiction over the related California and Minnesota state law claims pursuant to 28 U.S.C. §§ 1338 and 1367.

2. The amount in controversy between the parties exceeds $75,000.00.

3. This Court has personal jurisdiction over Defendants because Defendants have established minimum contacts within this forum. Defendants have begun regularly and continuously marketing, advertising, offering to sell, and selling their dental crown products in this judicial district, including through the use of marketing and advertising materials which are the subject of this Complaint. Defendants have also sold, and continue to sell, the dental crown products in this judicial district that bear confusing product packaging that infringes upon Plaintiff’s trade dress, unregistered trademarks, and other intellectual property rights. Additionally, this Court has personal jurisdiction over Defendants because Defendants have conducted tortious acts that have caused injury within this State and within this judicial district, and the claims alleged herein arise out of such tortious acts. Defendants have purposefully availed themselves of this Court’s jurisdiction by willfully infringing the trade dress and trademarks owned by Plaintiff which, as Defendants knew, had its principal place of business in California at all relevant times.
4. Venue is proper in this judicial district under 28 U.S.C. §§ 1391(b) and (c) because Defendants have extensive contacts with, and conduct business within, the State of California and this judicial district; Defendants have caused Kinder Krowns dental products to be advertised, promoted, and sold in this judicial district; the causes of action asserted in this Complaint arise out of Defendants’ contacts with this judicial district; and because Defendants have caused tortious injury to Plaintiff in this judicial district.

THE PARTIES

5. Plaintiff EZ-Pedo is a corporation organized and existing under the laws of the State of California with its principal place of business in Loomis, California. EZ-Pedo was the first company to manufacture prefabricated pediatric zirconia crowns and obtain clearance to market those products in the United States. EZ-Pedo owns and operates the website www.ezpedo.com.

6. On information and belief, Defendant MAYCLIN DENTAL STUDIO, INC. (“MDS”) is a corporation organized and existing under the laws of the State of Minnesota with its principal place of business in St. Louis Park, Minnesota. On information and belief, MDS markets and sells pediatric dental crowns under the fictitious business name KINDER KROWNS. On information and belief, MDS owns and operates numerous websites including, but not limited to, www.kinderkrowns.com.

7. Plaintiff is presently unaware of the true names of the Defendants identified in the Complaint under the fictitious names DOES 1-10. On information and belief, DOES 1-10 are unlawfully and unfairly using, without authorization, Plaintiff’s trademarks and trade dress, and confusingly similar variations thereof, in connection with the marketing and sale of pediatric dental products. Plaintiff will amend its Complaint to identify the names of the DOE Defendants as they are discovered.
FACTUAL BACKGROUND

Nature of the Claims

8. This action arises out of Defendants’ willful conduct in copying the look and feel of Plaintiff’s trade dress/trademarks with intent to cause confusion among consumers in an effort to unfairly compete with Plaintiff. Plaintiff and Defendants are two predominant makers of prefabricated pediatric zirconia dental crowns – with Plaintiff being the original source of such crowns.

9. As described in detail below, Defendants have engaged in a pattern and practice of copying numerous advertising campaigns published by Plaintiff, followed by publishing their confusingly similar copies of Plaintiff’s advertisements in the same trade publications and other sources with the intent to confuse consumers and pass off their crowns.

10. Finally, Defendants falsely advertise the quality of their crowns and make misleading and deceptive assertions regarding Plaintiff’s crowns citing a study that does not support Defendants’ factual assertions of superiority.

Plaintiff’s Business

11. Plaintiff is a leading marketer and manufacturer of prefabricated pediatric zirconia dental crowns in the United States. EZ-Pedo crowns have been the most biocompatible and naturally esthetic pediatric crown option on the market since 2010.

12. EZ-Pedo supplies its pediatric zirconia crowns (and supporting materials and services) to dentists in the United States and beyond. Over the last six years, EZ-Pedo has earned a strong reputation for quality, value, and service.

Plaintiff’s “Beach Girl” Marketing and Promotional Campaign

13. Beginning in or about early 2014, EZ-Pedo embarked on a “Beach Girl” marketing and sales campaign designed to accomplish a particular look and feel across all of EZ-Pedo’s marketing materials and websites. The campaign was centered around a unique, nonfunctional stock photograph of a curly-haired girl on
the beach in a white dress with magenta flowers, with white tooth composites
below, dark text containing information about the zirconia crowns, and identifying
logos and contact information. The entire look and feel of EZ-Pedo’s Beach Girl
marketing materials, both in print and online, took on a secondary meaning
associated with EZ-Pedo and the quality of its pediatric dental products. The look
and feel of the Beach Girl campaign was and is the unregistered trademark of EZ-
Pedo.

14. EZ-Pedo’s marketing team invested extensive time and money into
growing and exploiting the Beach Girl campaign. Specifically, EZ-Pedo
incorporated the look and feel of the Beach Girl campaign across all of its
marketing media, including, but not limited to:

  • Banners and booth design at the 2014 California Society of
    Pediatric Dentistry (“CSPD”) Annual Meeting;
  • Website advertisement with the CSPD;
  • American Association of Pediatric Dentistry (“AAPD”)
    Postcard Mailer 2014;
  • Social media;
  • AAPD Banner;
  • AAPD 2014 Annual Meeting banners and booth design;
  • CSPD Journal print advertisement; and
  • AAPD Journal print advertisement.

15. In or about July of 2014, with full knowledge of EZ-Pedo’s Beach Girl
campaign, Defendants chose—out of all of the photographs in the world—the exact
same photograph, to market and promote their pediatric dental crown products. In
addition to running an intentionally confusing advertisement in the AAPD Journal,
MDS misappropriated the entire look and feel of EZ-Pedo’s Beach Girl Marketing
campaign by using it across all Kinder Krowns marketing materials including on
the Kinder Krowns website and directly on Kinder Krowns products.
16. Defendants’ intentional misappropriation of EZ-Pedo’s Beach Girl marketing campaign and unlawful use in Defendants’ product packaging, marketing materials, and websites caused widespread confusion in the dental crown market and among the general public. On information and belief, following Defendants’ intentional infringement of the look and feel of the Beach Girl marketing campaign, numerous dentists who were EZ-Pedo’s then-current or potential customers were confused for a period of time by Kinder Krowns’ Beach Girl advertisements and product packaging. On information and belief, an even greater number of customers or potential customers remain confused and continue to purchase products from Kinder Krowns under the false belief that Kinder Krowns is associated with, or the same as, EZ-Pedo.
17. As a result of the widespread actual confusion caused by Defendants, EZ-Pedo was forced to protect its customers, who had come to associate a certain level of quality of zirconia crown with the look and feel of EZ-Pedo’s marketing materials, by terminating EZ-Pedo’s Beach Girl campaign to prevent any further confusion with the Kinder Krows product line. Specifically, EZ-Pedo was forced to redesign its website overnight in an attempt to mitigate the confusion caused by Kinder Krows’ July 2014 AAPD Journal advertisement. EZ-Pedo therefore suffered the loss of its investment in building recognizable trade dress and additionally suffered extensive lost profits from sales as a result of the actual confusion in the market caused by Defendants.

18. Examples of EZ-Pedo’s advertising efforts that were cancelled and/or removed from use to protect consumers from confusion include the following Beach Girl marketing materials:

![Figure 3](image-url)
19. On information and belief, Defendants unfairly and unlawfully profited and continue to profit from the actual confusion caused by Defendants’ willful infringement on EZ-Pedo’s Beach Girl promotional materials and trade dress.

*Plaintiff’s “Lavender” Marketing and Promotional Campaign*

20. In order to strengthen the EZ-Pedo brand, marketing, and trade dress following Defendants’ unlawful and intentional infringement on EZ-Pedo’s Beach Girl promotional materials, EZ-Pedo embarked on a new marketing campaign in early 2015 designed to further differentiate EZ-Pedo’s zirconia crowns from the competitors and from the infringing Kinder Krowns materials. For this new campaign, EZ-Pedo began using photographs of the actual patients from pediatric dentistry practices that use EZ-Pedo’s zirconia crowns. This resulted in the additional cost of generating original photographic content for EZ-Pedo’s new advertising campaign. The decision to use original photographs of actual patients was intended as a means of guarding against any further attempts by Defendants to steal the look and feel of EZ-Pedo’s advertisements.

21. In or about early 2015, EZ-Pedo launched its “Lavender” marketing and promotional campaign. The Lavender promotional materials have a unique look and feel that EZ-Pedo’s customers and potential customers have come to associate with the quality of EZ-Pedo’s zirconia crowns. The unique look and feel of the Lavender campaign incorporates several unique elements, including a field of lavender flowers with green leaf accents, a strawberry-blonde girl with curly hair wearing a flowery headband and a white flowing dress, white text across the lavender background, two model dental crowns often in the lower portion of the page, a round seal/shape often in the left half of the page, and several other elements that combine to make the entire look and feel of EZ-Pedo’s Lavender trade dress distinguishable.
Figure 4

(Examples of EZ-Pedo’s Lavender marketing and promotional materials)

22. The hallmark of EZ-Pedo’s Lavender promotional campaign is the unique lavender color. EZ-Pedo developed and began using its lavender trade dress in 2015. Since that time, EZ-Pedo has used the lavender trade dress/unregistered trademark consistently and prominently in its marketing and promotional materials throughout the world.

23. Through EZ-Pedo’s consistent and well-established use of the lavender trade dress/trademark as a cornerstone of its brand identity, the lavender trade dress and mark has become a recognized symbol of EZ-Pedo in the world of pediatric dentistry. Through its continuous use and promotion of the lavender trade dress and mark in the United States, EZ-Pedo has developed and owns common law rights to the trade dress and mark in connection with pediatric zirconia crown products across the country. The products and services sold by EZ-Pedo under the lavender trade dress and mark have earned great commercial success in the United States. The lavender trade dress and mark have acquired secondary meaning and have become a valuable marketing and business asset of EZ-Pedo which signifies to pediatric dentists and to the consuming public a standard of quality of products and services originating exclusively from EZ-Pedo.
24. EZ-Pedo’s marketing team invested extensive time and money into growing and exploiting the Lavender campaign. Specifically, EZ-Pedo incorporated the look and feel of the Lavender campaign across all of its marketing media, including, but not limited to:

- The CSPD 2015 Summer Bulletin;
- EZ-Pedo’s May 2015 AAPD video reel;
- EZ-Pedo’s company Facebook page;
- EZ-Pedo’s company Twitter page;
- EZ-Pedo’s YouTube channel;
- EZ-Pedo’s 2015 Parent Brochure;
- AAPD 2015 Annual Meeting banners and booth design;
- EZ-Pedo’s 2015 Magazines; and
- Throughout EZ-Pedo’s website.

25. On information and belief, after EZ-Pedo began developing the Lavender marketing campaign, Defendants decided that they would soon lose the unlawful advantage they had gained from misappropriating the look and feel of EZ-Pedo’s Beach Girl marketing and promotional campaign unless they once again copied the look and feel of EZ-Pedo’s new trade dress, unregistered trademarks, and marketing materials, to maintain the confusion in the pediatric crown market. On information and belief, Defendants determined that copying EZ-Pedo’s Lavender campaign would compound the confusion in the market by: (1) reinforcing the confusion of many pediatric dentists and consumers who had previously seen Defendants’ infringing Beach Girl materials; and (2) confusing thousands of new pediatric dentists and consumers.

26. With full knowledge of EZ-Pedo’s Lavender campaign, Defendants began blatantly and intentionally infringing on EZ-Pedo’s Lavender marketing materials and misappropriating the entire look and feel of EZ-Pedo’s Lavender trade dress and promotional materials.
27. On December 1, 2015, the AAPD contacted EZ-Pedo to notify EZ-Pedo that the AAPD had inadvertently allowed the publication of an infringing advertisement for zirconia dental crowns in its Journal which was likely to confuse EZ-Pedo’s customers and potential customers into associating the source of the advertisement, and the products marketed therein, with EZ-Pedo. The advertisement, which had been unlawfully created and placed by MDS doing business as Kinder Krowns, intentionally copied the look and feel of EZ-Pedo’s Lavender campaign. AAPD’s notification message stated that the advertisement “wasn’t caught until it went to print.” The message additionally stated, “They will be changing it for the future. It’s about 4 pages from your ad placement. Imitation is the highest form of flattery, right? As my team said, it just looks like EZ Pedo placed 2 ads.”
28. Upon further investigation, EZ-Pedo discovered that the photograph Defendants selected for their infringing lavender advertisements was an internet stock photograph that originally depicted a girl prominently wearing blue butterfly wings. On information and belief, Defendants used photo-editing software to remove the wings with the intent of making the advertisement look almost identical to EZ-Pedo’s Lavender campaign materials.

(Figure 6)

(Original internet stock photograph) (Defendants’ photo-edited advertisement)

29. Defendants’ intentional infringement on EZ-Pedo’s Lavender marketing campaign caused widespread confusion in the dental crown market. On information and belief, industry members and organizations mistakenly contacted and placed purchases with Kinder Krowns instead of EZ-Pedo as a result of the confusing advertising.

30. In addition to running an intentionally confusing advertisement in the Pediatric Dentistry Today ("PDT") Magazine, the official magazine provided by the AAPD, Defendants unlawfully used EZ-Pedo’s Lavender trade dress/trademarks and misappropriated the entire look and feel of EZ-Pedo’s Lavender campaign by using it across all Kinder Krowns marketing materials including on the Kinder Krowns website and directly on Kinder Krowns’ products at trade shows.
(December 2015 photograph of the Kinder Krowns booth displaying infringing
lavender trade dress at a trade show in Las Vegas, Nevada)

31. As a result of the widespread actual confusion caused by Defendants, EZ-Pedo suffered the loss and dilution of its investment in building recognizable trade dress and has additionally suffered extensive lost profits from sales that have been wrongfully diverted to Defendants.

32. Defendants’ misappropriation of two successive marketing campaigns had a compound effect that resulted in exponentially greater confusion in the market and conclusively demonstrated that Defendants’ infringement was carried out intentionally and as part of an unlawful pattern and practice of creating confusion.

33. In response to Kinder Krown’s’ blatant attempts to confuse consumers regarding the source and/or affiliation of its products, EZ-Pedo contacted Brandon Richards, Director of Client Services for Kinder Krows, to demand that Kinder Krows cease its infringement of the Lavender promotional materials and trade dress/trademarks. In response, Mr. Richards denied having seen EZ-Pedo’s
Lavender promotional materials while acknowledging the blatant similarity of the
Kinder Krowns materials.

34. On information and belief, Defendants unfairly and unlawfully
profited and continue to profit from the actual confusion caused by Defendants’
willful infringement on the look and feel of EZ-Pedo’s Lavender campaign.

**Plaintiff’s Blue V2 Crown CAD Promotional Materials**

35. In early 2014, EZ-Pedo began using computer-aided drawing (“CAD”)
models of its pediatric “V2” crown products in its advertising and promotional
materials, as well as on its website. Rather than using the white color of the crowns
for the CAD models, EZ-Pedo developed a unique shade of dark blue to apply to its
V2 crown CAD models.

**Figure 8**

![Image of Blue V2 Crown]

*Posterior V2™*  
*Same great look, Radical new fit.*

EZ-Pedo’s all new posterior V2™ crowns with redesigned EZ Seat™ contours not only require less
tooth reduction but now seat in half the time. With a roomier internal cavity and slightly broader
bucco-lingual dimensions, they are precision milled to bring out the best in morphology and ease
of fit so you can finally experience a crown that will perform as good as it looks.

*(EZ-Pedo’s CSPD Flyer dated March 2014)*

36. The unique shade of blue is entirely nonfunctional. EZ-Pedo
developed and began using its Blue V2 Crown CAD trade dress/unregistered
trademark on its website and in print advertisements in or about March of 2014 in
connection with EZ-Pedo’s V2 crowns, which require less tooth reduction (meaning less preparation) and which seat in half the time as compared with certain competing crowns. Since that time, EZ-Pedo has used the Blue V2 Crown trade dress/trademark consistently and prominently in its marketing and promotional materials throughout the world.

37. The Blue V2 Crown Mark has acquired secondary meaning and has become a valuable marketing and business asset of EZ-Pedo which signifies to pediatric dentists and to the consuming public a standard of quality of products and services originating exclusively from EZ-Pedo.

38. With full knowledge of EZ-Pedo’s use of blue crown CADs as a source-indicator for EZ-Pedo’s products, Defendants began blatantly and intentionally using confusingly similar dark blue crown drawings in Defendants’ website and marketing materials in 2014, calling it their “Less Prep” or “LP” line of crowns:

![Figure 9](image)

(Plaintiff’s Blue V2 Crown Mark dated March 2014) (Defendants’ infringing LP blue crown dated May 2014)

39. In addition to creating confusion in the pediatric dentistry market that resulted in lost sales for EZ-Pedo, Defendants’ infringement on EZ-Pedo’s Blue V2 Crown trade dress/trademark perpetuated the confusion that Defendants had created
by copying two successive EZ-Pedo marketing campaigns as more fully alleged above.

40. On information and belief, Defendants unfairly and unlawfully profited and continue to profit from the actual confusion caused by Defendants’ willful infringement on EZ-Pedo’s Blue V2 Crown trade dress/trademark.

**Plaintiff’s Gears and “Engineered for” Slogan**

41. EZ-Pedo began using images of gears and the unregistered trademark of the words “Engineered for” on its website and marketing materials in or about May of 2014. Since that time, EZ-Pedo has used the gears and “Engineered for” slogan consistently and prominently in its marketing and promotional materials throughout the world.

![Image of gears and contours]

**Figure 10**

*(EZ-Pedo’s website depicting gears and the “Engineered for” slogan)*

42. The look and feel of the gears and “Engineered for” slogan has acquired secondary meaning and has become a valuable marketing and business
asset of EZ-Pedo which signifies to pediatric dentists and to the consuming public a
standard of quality of products and services originating exclusively from EZ-Pedo.

43. With full knowledge of EZ-Pedo’s use of gear imagery and the
“Engineered for” slogan, Defendants began blatantly and intentionally using
confusingly similar images of gears along with the words “Engineered for” in
Defendants’ website and marketing materials in 2014:

Figure 11

![EZ-Pedo Gear Images]

*(Plaintiff’s website July 2014) (Defendants’ website June 2015)*

44. In addition to creating confusion in the pediatric dentistry market that
resulted in lost sales for EZ-Pedo, Defendants’ infringement on EZ-Pedo’s
“Engineered for” Mark and gear imagery perpetuated the confusion that Defendants
had created by copying two successive EZ-Pedo marketing campaigns and EZ-
Pedo’s Blue V2 Crown trade dress/trademark as more fully alleged above.

45. On information and belief, Defendants unfairly and unlawfully
profited and continue to profit from the actual confusion caused by Defendants’
willful infringement on the look and feel of EZ-Pedo’s “Engineered for” slogan and
gear imagery trade dress/trademark.

**Defendants’ False Durability Claims**

46. In addition to running advertisements that confuse consumers
regarding the source of their pediatric crown products, Defendants’ websites often
portray false and misleading information about EZ-Pedo’s products and about
Kinder Krowns’ products, which information is intended to confuse consumers and persuade them to purchase competing Kinder Krowns products instead of EZ-Pedo crowns. For example, prominently displayed on the homepage of the Kinder Krowns website is the claim that Kinder Krowns are “THE MOST DURABLE PEDIATRIC-ZIRCONIA-CROWN.” Immediately adjacent to this false claim is a chart purporting to compare durability rates of pediatric crowns and falsely depicting EZ-Pedo’s crowns as the least durable:

**Figure 12**

![Chart showing durability comparison](image)

*(Kinder Krowns’ false and misleading durability claim on its website)*

47. Kinder Krowns’ chart references a study of fracture resistance to a level of clinical insignificance and deceptively equates that data with clinical durability. Because the mean force required to fracture all three brands of crown in the study exceeded the maximum bite force of a child, Defendants’ claims that the study demonstrates that its crown is the most durable pediatric zirconia crown, and that EZ-Pedo’s crowns are less durable, are misleading to pediatric dentists and potential consumers. Indeed, even the study upon which Kinder Krowns bases its false durability claim states, “All three crown types were found to withstand the maximum bite force of pediatric patients as determined in a previous study.”
FIRST CLAIM FOR RELIEF

FEDERAL TRADE DRESS/TRADEMARK INFRINGEMENT

AGAINST ALL DEFENDANTS

(15 U.S.C. § 1125(a))

48. Plaintiff repeats, realleges, and incorporates by reference, as though fully set forth herein, the allegations contained in all prior and subsequent paragraphs of this Complaint.

49. Since 2014, Defendants have been and are manufacturing, advertising, distributing, marketing, promoting, offering for sale, and selling commercially in interstate commerce pediatric dental crown products using the look and feel of Plaintiff’s trade dress and unregistered trademarks. Defendants’ use of the look and feel of Plaintiff’s trade dress and trademarks in association with Defendants’ products is likely to cause confusion and Plaintiff is informed and believes, and based thereon alleges, that such use has caused dentists and consumers confusion that Defendants’ products are commissioned by, sponsored by, or affiliated with Plaintiff.

50. Defendants’ use of the look and feel of Plaintiff’s trade dress and trademarks is without the permission of Plaintiff. Plaintiff is informed and believes, and based thereon alleges, that Defendants knew of the considerable commercial success of Plaintiff’s pediatric crown business. Plaintiff is informed and believes, and based thereon alleges, that Defendants willfully used the look and feel of Plaintiff’s trade dress and trademarks in connection with the sale, offering for sale, distribution and/or advertising of the Defendants’ products in a manner likely to cause confusion, or to cause mistake, or to deceive customers that Defendants’ products are Plaintiff’s products or are authorized by Plaintiff.

51. Defendants’ actions described above and specifically, without limitation, their unauthorized use of the look and feel of Beach Girl, Lavender, Blue V2 Crown, and “Engineered for” trade dress/trademarks, and confusingly similar
variations thereof, in commerce to advertise, promote, market, and sell Kinder
Krons pediatric crown products throughout the United States including California,

52. The actions of Defendants, if not enjoined, will continue. Plaintiff has
suffered and continues to suffer damages in an amount to be proven at trial
consisting of, among other things, diminution in the value of and goodwill
associated with the Beach Girl, Lavender, Blue V2 Crown, and “Engineered for”
trademarks and trade dress, and injury to Plaintiff’s business. Plaintiff is therefore
entitled to injunctive relief pursuant to 15 U.S.C. § 1125.

53. Pursuant to 15 U.S.C. §§ 1117 and 1125, Plaintiff is entitled to recover
damages in an amount to be determined at trial, profits made by Defendants on
sales of Kinder Krons products, and the costs of this action.

SECOND CLAIM FOR RELIEF

FEDERAL UNFAIR COMPETITION AND FALSE ADVERTISING

AGAINST ALL DEFENDANTS

(15 U.S.C. § 1125(a))

54. Plaintiff repeats, realleges, and incorporates by reference, as though
fully set forth herein, the allegations contained in all prior and subsequent
paragraphs of this Complaint.

55. Defendants’ actions described above and specifically, without
limitation, their unauthorized copying of the look and feel of the Beach Girl
marketing, Lavender marketing, Blue V2 Crown marketing, and “Engineered for”
marketing trade dress and trademarks, and confusingly similar variations thereof, in
commerce to advertise, promote, market, and sell Kinder Krons pediatric crown
products throughout the United States including California, and Defendants’
 misleading and deceptive durability claims regarding Plaintiff’s products and
Defendants’ products, constitute unfair competition and false advertising in
56. Pediatric dentists and consumers are likely to be misled and deceived by Defendants’ representations regarding Plaintiff’s and Defendants’ pediatric dental products.

57. Defendants knew or should have known that their statements were false or likely to mislead.

58. As an actual and proximate result of Defendants’ willful and intentional actions, Plaintiff has suffered damages in an amount to be determined at trial, and unless Defendants are enjoined, Plaintiff will continue to suffer irreparable harm and damage to its business, reputation, and goodwill.

59. Pursuant to 15 U.S.C. § 1117, Plaintiff is entitled to recover damages for Defendants’ Lanham Act violations, an accounting for profits made by Defendants on sale of Kinder Krowns pediatric crown products, as well as recovery of the costs of this action. Furthermore, Plaintiff is informed and believes, and on that basis alleges, that Defendants’ conduct was undertaken willfully and with the intention of causing confusion, mistake or deception, making this an exceptional case entitling Plaintiff to recover additional damages and reasonable attorneys’ fees.

THIRD CLAIM FOR RELIEF

CALIFORNIA STATUTORY UNFAIR COMPETITION AGAINST ALL DEFENDANTS

(California Business and Professions Code § 17200, et seq.)

60. Plaintiff repeats, realleges, and incorporates by reference, as though fully set forth herein, the allegations contained in all prior and subsequent paragraphs of this Complaint.

61. Defendants’ actions described above and specifically, without limitation, their unauthorized use of the look and feel of the Beach Girl, Lavender, Blue V2 Crown, and “Engineered for” trade dress and trademarks, and confusingly similar variations thereof, in commerce to advertise, promote, market, and sell Kinder Krowns pediatric crown products throughout the United States including
California, and Defendants use of misleading durability claims regarding Plaintiff’s products and Defendants’ products, constitute unfair competition in violation of the statutory law of the State of California, Cal. Bus. & Prof. Code § 17200, *et seq.*, and, as a result, Plaintiff has suffered and will continue to suffer damage to its business, reputation, and goodwill.

62. As a direct and proximate result of Defendants’ willful and intentional actions, Plaintiff has suffered damages in an amount to be determined at trial, and unless Defendants are restrained, Plaintiff will continue to suffer irreparable harm and damage.

**FOURTH CLAIM FOR RELIEF**

**CALIFORNIA STATUTORY FALSE ADVERTISING AGAINST ALL DEFENDANTS**

(California Business and Professions Code § 17500, *et seq.*)

63. Plaintiff repeats, realleges, and incorporates by reference, as though fully set forth herein, the allegations contained in all prior and subsequent paragraphs of this Complaint.

64. Defendants’ actions described above and specifically, without limitation, their unauthorized use of the look and feel of Beach Girl, Lavender, Blue V2 Crown, and “Engineered for” trade dress and trademarks, and confusingly similar variations thereof, in commerce to advertise, promote, market, and sell Kinder Krowns pediatric crown products throughout the United States including California, and Defendants use of misleading durability claims regarding Plaintiff’s products and Defendants’ products, constitute false advertising in violation of the statutory law of the State of California, Cal. Bus. & Prof. Code § 17500, *et seq.*, and, as a result, Plaintiff has suffered and will continue to suffer damage to its business, reputation, and goodwill.

65. As a direct and proximate result of Defendants’ willful and intentional actions, Plaintiff has suffered damages in an amount to be determined at trial, and
unless Defendants are restrained, Plaintiff will continue to suffer irreparable harm and damage.

FIFTH CLAIM FOR RELIEF
FALSE DESIGNATION OF ORIGIN
AGAINST ALL DEFENDANTS
(15 U.S.C. § 1125(a))

66. Plaintiff repeats, realleges, and incorporates by reference, as though fully set forth herein, the allegations contained in all prior and subsequent paragraphs of this Complaint.

67. Plaintiff is informed and believes, and on that basis alleges, that Defendants have used and are using the look and feel of Plaintiff’s trade dress and trademarks identified above to sell, market, and promote, Defendants’ products with the intent of passing off and confusing the public into believing that Defendants’ products originate with, are commissioned by, and/or are sponsored by Plaintiff.

68. Defendants’ above-recited acts constitute false designation of origin, false description of fact, false representation, unfair competition, and false affiliation, connection, or association in violation of Section 43(a) of the Lanham Act, 15 U.S.C. § 1125(a), as such acts are likely to deceive customers and prospective customers into believing that Defendants’ products are from or sponsored by Plaintiff and that Defendants are associated with Plaintiff.

69. If not enjoined by the Court, Defendants will continue to sell Defendants’ products in commerce, which products will be attributed to having emanated from Plaintiff. Plaintiff, however, has no control over the nature and quality of Defendants’ products, and any fault or objection with said products will adversely affect future sales by Plaintiff of its products.

70. Plaintiff is informed and believes, and thereon alleges, that as a result of these acts, Defendants have been, and will continue to be, unjustly enriched by
profits that Defendants have made in connection with their distribution and/or sale of Defendants’ products.

71. Plaintiff is informed and believes, and based thereon alleges, that Defendants’ continuing infringement has inflicted, and unless restrained by this Court will continue to inflict, great and irreparable harm upon Plaintiff entitling Plaintiff to an injunction enjoining Defendants from engaging in further acts of infringement.

72. Plaintiff is informed and believes, and based thereon alleges, that as a direct and proximate result of Defendants’ foregoing acts, Plaintiff has suffered and is entitled to an award of monetary damages in an amount not yet determined. Plaintiff is also entitled to its attorneys’ fees and costs of suit herein.

73. Plaintiff is informed and believes, and based thereon alleges, that Defendants’ acts were in conscious and willful disregard for Plaintiff’s rights, and the resulting damage to Plaintiff is such as to warrant the trebling of damages in order to provide just compensation.

SIXTH CLAIM FOR RELIEF

MINNESOTA DECEPTIVE TRADE PRACTICES ACT

AGAINST ALL DEFENDANTS

(Minn. Stat. § 325D.43-325D.48)

74. Plaintiff repeats, realleges, and incorporates by reference, as though fully set forth herein, the allegations contained in all prior and subsequent paragraphs of this Complaint.

75. Defendants have, in the course of their business, copied and used the look and feel of Plaintiff’s trade dress and trademarks in a manner that has caused and will continue to cause a likelihood of confusion or a likelihood of misunderstanding as to the source, sponsorship, approval, or association of Defendants’ products. Defendants’ use of Plaintiff’s trade dress and trademarks is likely to cause damage to Plaintiff. By engaging in these activities, Defendant has,
and is, engaged in deceptive trade practices within the meaning of Minn. Stat. § 325D.43, et seq.

76. Plaintiff is entitled to an injunction pursuant to Minn. Stat. § 325D.45 subd. 1 and all other appropriate relief available to it at law.

77. Defendant has willfully engaged in the described deceptive trade practices knowing them to be deceptive. Plaintiff should therefore be awarded its reasonable attorneys’ fees and costs pursuant to Minn. Stat. § 325D.45 subd. 2.

SEVENTH CLAIM FOR RELIEF
MINNESOTA STATE FALSE ADVERTISING
AGAINST ALL DEFENDANTS
(Minn. Stat. § 325F.67)

78. Plaintiff repeats, realleges, and incorporates by reference, as though fully set forth herein, the allegations contained in all prior and subsequent paragraphs of this Complaint.

79. Defendants’ actions described above and specifically, without limitation, their deceptive and misleading material assertions regarding the durability of Plaintiff’s products and Defendants’ products, constitute false advertising in violation of the statutory law of the State of Minnesota, Minn. Stat. § 325F.67, and, as a result, Plaintiff has suffered and will continue to suffer damage to its business, reputation, and goodwill.

80. Pursuant to Minn. Stat. § 8.31, subd. 3a, Plaintiff, having suffered injury as a result of Defendants’ deceptive and misleading material assertions, is entitled to recover its damages, costs and disbursements, including costs of investigation, reasonable attorneys’ fees, and other equitable relief as determined by the Court.
EIGHTH CLAIM FOR RELIEF
COMMON LAW UNFAIR COMPETITION
AGAINST ALL DEFENDANTS

81. Plaintiff repeats, realleges, and incorporates by reference, as though fully set forth herein, the allegations contained in all prior and subsequent paragraphs of this Complaint.

82. Defendants’ actions described above and specifically, without limitation, their unauthorized use of the look and feel of the Beach Girl, Lavender, Blue V2 Crown, and “Engineered for” trade dress and trademarks, and confusingly similar variations thereof, in commerce to advertise, promote, market, and sell Kinder Krowns pediatric crown products throughout the United States including California, and Defendants use of misleading durability claims regarding Plaintiff’s products and Defendants’ products, constitute unfair competition at common law.

83. By reason of Defendants’ actions in connection with Defendants’ products, Plaintiff has suffered and will continue to suffer, irreparable injury to its rights, and has suffered, and will continue to suffer damage to its business, reputation, and goodwill, unless and until Defendants are enjoined from continuing their wrongful acts.

84. By reason of Defendants’ actions in connection with Defendants’ products, Plaintiff has been damaged in an amount not presently ascertained, and such damage will continue and increase unless and until Defendants are enjoined from continuing their wrongful acts.

85. Plaintiff is informed and believes, and on that basis alleges, that Defendants conduct in this cause of action is willful, wanton, malicious, oppressive, and in conscious disregard of Plaintiff’s rights in its trade dress and trademarks, justifying the imposition of punitive and exemplary damages under California Civil Code § 3294.
PRAYER FOR RELIEF

WHEREFORE, Plaintiff prays that this Court enter judgment against Defendants as follows:

1. That Plaintiff be granted injunctive relief under 15 U.S.C. § 1051 et seq., California Business and Professions Code §§ 17200 and 17500 et seq., and Minn. Stat. § 325D.45. Specifically, that Defendants and all of their respective officers, agents, servants, representatives, employees, attorneys, and all other persons acting in concert with them be enjoined from:

   (a) using EZ-Pedo’s Beach Girl, Lavender, Blue Crown, and “Engineered for” trade dress and trademarks, and confusingly similar variations thereof, in connection with the marketing, promotion, advertising, sale, or distribution of any pediatric dental products or services;

   (b) directly or indirectly engaging in false advertising in the promotion of Kinder Krows pediatric crown products;

   (c) infringing, diluting and/or tarnishing the distinctive quality of EZ-Pedo’s Beach Girl, Lavender, Blue Crown, and “Engineered for” trade dress and trademarks; and

   (d) unfairly competing with Plaintiff in any manner.

2. That Defendants be required to deliver up to Plaintiff for destruction any literature, catalogs, signs, advertising material, and the like bearing any of Plaintiff’s trademarks or trade dress and any confusingly similar variations thereof for products neither originating from nor authorized by Plaintiff.

3. That Defendants, within thirty (30) days after service of judgment with notice of entry thereof upon them, be required to file with the Court and serve upon Plaintiff’s attorneys a written report, under oath, setting forth in detail the manner in which Defendants have complied with paragraphs 1 and 2 above.

4. That Defendants be required to account for and pay over to Plaintiff their profits and the cumulative damages sustained by Plaintiff by reason of
Defendants’ unlawful acts of trade dress/trademark infringement, false designation of origin, dilution, false advertising, and unfair competition herein alleged, that the amount of recovery be increased as provided by the law, up to three times, and that interest and costs be awarded to Plaintiff.

5. That the Court order disgorgement and/or restitution of Defendants’ profits to Plaintiff.

6. That Plaintiff be awarded its reasonable costs and attorneys’ fees.

7. That Plaintiff be awarded punitive damages.

8. That Plaintiff be awarded such other and further relief as the Court may deem equitable.

DATED: April 7, 2016

BUCHALTER NEMER
A Professional Corporation

By: /s/ Paul J. Fraidenburgh

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