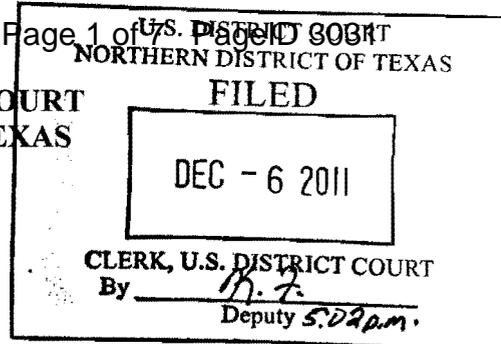


UNITED STATES DISTRICT COURT  
NORTHERN DISTRICT OF TEXAS  
DALLAS DIVISION



M3GIRL DESIGNS, LLC,

Plaintiff,

v.

BLUE BROWNIES, LLC, ET AL,

Defendants.

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Case No. 3:09-cv-2390-F

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**ORDER DENYING DEFENDANTS' MOTION FOR PARTIAL SUMMARY  
JUDGMENT ON PLAINTIFF'S TRADE DRESS CLAIMS**

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BEFORE THE COURT is Defendants Blue Brownies, LLC's, Krista Dudte's, Robert Dudte's, and Shannon Dunn's Motion for Partial Summary Judgment on Plaintiff's Trade Dress Claims, filed on August 8, 2011 (Docket No. 81). Plaintiff M3Girl Designs, LLC filed a sealed response on August 29, 2011. Having considered the arguments of the parties and for the following reasons, the Court DENIES Defendants' Motion.<sup>1</sup>

**I. Factual and Procedural Background**

Plaintiff in this case is M3Girl Designs, LLC ("M3Girl"), a Texas limited liability company that designs, manufactures, and sells bottlecap jewelry.

Defendants in this case are Blue Brownies, LLC ("Blue Brownies"), Krista Dudte, Robert Dudte, and Shannon Dunn (d/b/a Lizards and Lace Children's Boutique) ("Lizards and Lace"). Blue Brownies is an Arkansas limited liability company that designs, manufactures, and sells bottlecap jewelry. The Dudtes are co-owners and officers/directors of Blue Brownies. Lizards

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<sup>1</sup> This Order resolves Docket No. 81.

and Lace is a Tennessee retailer and vendor of Blue Brownies jewelry.

M3Girl designs, manufactures, and sells jewelry made from “conventional soft-drink bottlecap[s] with crowned ridges around the edge[s].” Docket No. 72, at 4 ¶ 13. M3Girl decorates the interior surfaces of the bottlecaps with various words, symbols, and colors. Under the trademark “SnapCaps®,” M3Girl markets the decorated bottlecaps as interchangeable, magnetic jewelry, which can be attached to a necklace, anklet, hairclip, or bracelet. M3Girl also produces three versions of “keeper” metal boards that allow customers to display the bottlecaps with the designs facing outwardly.

Blue Brownies also designs, manufactures, and sells jewelry made from conventional soft-drink bottlecaps. M3Girl alleges Blue Brownies decorates the interior surfaces of its bottlecaps with many of the same or similar words, symbols, and colors as M3Girl’s jewelry and also produces and sells four versions of “keeper” metal boards for displaying them. M3Girl claims Blue Brownies has used the name “Click It Caps” to describe its bottlecap jewelry on its website and has similarly marketed its bottlecaps as interchangeable, magnetic jewelry that can be attached to a necklace, anklet, hairclip, or bracelet.

Based on the foregoing allegations, M3Girl raises claims against Defendants for federal trademark infringement and federal false designation/description, as well as six additional claims related to trade dress: (1) state law trade dress infringement; (2) state law dilution by blurring; (3) state law dilution by tarnishment; (4) state law “palming off”; (5) state law unfair competition; and (6) federal trade dress infringement. Docket No. 72.

In the instant Motion, Defendants request partial summary judgment in their favor on all of M3Girl’s claims related to trade dress, arguing M3Girl’s bottlecap jewelry does not merit trade dress protection as a matter of law. Docket No. 82. For the following reasons, the Court

DENIES Defendants' Motion.

## II. Discussion

### A. Trade Dress

Originally, “‘trade dress’ referred only to the manner in which a product was ‘dressed up’ to go to market with a label, package, display card, and similar packaging elements.” *Jeffrey Milstein, Inc. v. Greger, Lawlor, Roth, Inc.*, 58 F.3d 27, 31 (2d Cir. 1995). Today, trade dress more broadly refers to “the total image and overall appearance of a product,” and “may include features such as the size, shape, color, color combinations, textures, graphics, and even sales techniques that characterize a particular product.” *Sunbeam Prods., Inc. v. W. Bend Co.*, 123 F.3d 246, 251 & n.3 (5th Cir. 1997).

The Lanham Act, 15 U.S.C. § 1125 (2006), creates a cause of action for trade dress infringement, the purpose of which is similar to that of trademark protection: “to ‘secure to the owner . . . the goodwill of his business and to protect the ability of consumers to distinguish among competing producers.’” *Sunbeam*, 123 F.3d at 251 (quoting *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 775 (1992)). Because trade dress law “is not intended to create patent-like rights in innovative aspects of product design,” trade dress protection “extends only to incidental, arbitrary or ornamental product features which identify the source of the product.” *Eppendorf-Netheler-Hinz GMBH v. Ritter GMBH*, 289 F.3d 351, 355 (5th Cir. 2002).

A plaintiff bringing a claim for trade dress infringement under the Lanham Act has the burden of showing two things: (1) the allegedly infringing product feature is not “functional,” and (2) the allegedly infringing product is “likely to cause confusion” with the plaintiff’s product. 15 U.S.C. §§ 1125(a)(1)(A), (a)(3) (2006). While the statute does not expressly require a plaintiff to show his product feature’s distinctiveness, “courts have universally imposed that

requirement” because a plaintiff cannot demonstrate that an infringing product is “likely to cause confusion” without first demonstrating his own product’s distinctiveness. *Wal-Mart Stores, Inc. v. Samara Bros.*, 529 U.S. 205, 210 (2000).

The Lanham Act’s non-functionality requirement prevents trade dress law from hindering competition by granting producers patent-like control over useful, functional features of their products. *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 164 (1995). Whether a product feature is functional is a question of fact, and the plaintiff bears the burden of proving the asserted trade dress is not functional. *Pebble Beach Co. v. Tour 18 I Ltd.*, 155 F.3d 526, 537 (5th Cir. 1998).

Under the traditional *Inwood Labs* functionality test, “a product feature is functional if it is essential to the use or purpose of the article or if it affects the cost or quality of the article.” *Inwood Laboratories, Inc. v. Ives Laboratories, Inc.*, 456 U.S. 844, 851 n.10 (1982). Under the less comprehensive “competitive necessity” test, a product feature is functional “if exclusive use of the feature would put competitors at a significant non-reputation-related disadvantage.” *Qualitex*, 514 U.S. at 165; *see also Eppendorf*, 289 F.3d at 356 (“This court’s ‘utilitarian’ test, with its focus on the ability of competitors to compete effectively in the marketplace, is virtually identical to the ‘competitive necessity’ test . . .”). If a product feature is functional under the traditional *Inwood Labs* test, there is no need to apply the competitive necessity test. *TrafFix Devices, Inc. v. Mktg. Displays, Inc.*, 532 U.S. 23, 33 (2001).

### ***B. M3Girl’s Asserted Trade Dress***

Generally, “it is largely up to the plaintiff to define what aspect [of its product] is claimed as protectable trade dress.” 1 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS & UNFAIR COMPETITION § 7:76 (4th ed. 2011). However, “a product’s trade dress is not, in a legal sense,

the combination of words which a party uses to describe or represent [its] ‘total image.’ Rather, the trade dress *is* that image itself, however it may be represented in or by the written word.” *Maharishi Hardy Blechman Ltd. v. Abercrombie & Fitch Co.*, 292 F. Supp. 2d 535, 545–46 (S.D.N.Y. 2003) (Marrero, J.) (emphasis in original) (citation omitted).

Here, M3Girl claims its trade dress consists of the thirty-one different combinations of the following elements, including each element standing alone:

- (1) a slim choker necklace, colored or white, fabric;
- (2) an attachment having a metallic sheen tied in a knot at the front of the choker necklace;
- (3) a conventional soft-drink bottlecap with crowned ridges around the edge;
- (4) the crowned ridges of the bottlecap positioned outwardly on the choker necklace with the internal surface of the bottlecap exposed; and/or
- (5) a raised projection having a geometric shape on the top surface of the bottlecap.

Docket No. 72, at 4 ¶ 13; Docket No. 96, at 4 & n.4.

While M3Girl stresses in its brief that its trade dress consists of any one of the five asserted elements standing alone or any combination of two or more of those elements, it is clear from M3Girl’s statements during oral argument of this Motion that the essence of M3Girl’s complaint is that its trade dress consists of jewelry made from bottlecaps with decorated interior surfaces. Therefore, the Court will construe M3Girl’s Second Amended Complaint as seeking trade dress protection for the overall design of its bottlecap jewelry, as opposed to the five asserted elements and their various combinations. *See Maharishi*, 292 F. Supp. 2d at 545–46. However, the Court does not construe M3Girl’s Second Amended Complaint as seeking protection for the magnetic or interchangeable aspects of its jewelry. In fact, M3Girl expressly concedes these aspects are functional and, therefore, unworthy of trade dress protection. Docket

No. 96, at 35–36.

***C. Defendants’ Motion for Summary Judgment***

Summary judgment is proper if the movant can show there is no genuine issue of material fact and the movant is entitled to judgment as a matter of law. FED. R. CIV. P. 56(a); *Willis v. Coca Cola Enters., Inc.*, 445 F.3d 413, 416 (5th Cir. 2006). “The inquiry performed is the threshold inquiry of determining whether there is the need for a trial—whether, in other words, 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 (1986). In conducting this inquiry, the Court will construe the evidence “in the light most favorable to the nonmoving party without weighing the evidence, assessing its probative value, or resolving any factual disputes.” *Williams v. Time Warner Operation, Inc.*, 98 F.3d 179, 181 (5th Cir. 1996).

Here, Defendants focus exclusively on the Lanham Act’s non-functionality requirement, arguing M3Girl’s asserted trade dress is not protectable as a matter of law because each element is independently functional. However, as stated above, the Court does not construe M3Girl’s Second Amended Complaint as seeking trade dress protection for the five independent elements asserted, but rather for the overall design of its bottlecap jewelry. While a product’s overall design may be functional, *e.g.*, *TrafFix*, 532 U.S. at 33 (holding traffic sign’s dual-spring design functioned as a “useful mechanism to resist the force of the wind”), M3Girl’s bottlecap jewelry design is not. Decorated bottlecaps are not “essential to the use or purpose” of jewelry, and the decorated bottlecaps are not “the reason [the product] works.” *See id.* at 34; *see also Abercrombie & Fitch Stores, Inc. v. Am. Eagle Outfitters, Inc.*, 280 F.3d 619, (6th Cir. 2002) (holding clothing designs not functional because designs are not “essential to the use or purpose

of the garments, catalog, and stores they adorn”). Rather, the inclusion of decorated bottlecaps in M3Girl’s jewelry is primarily “arbitrary, incidental, or ornamental.” See *Eppendorf*, 289 F.3d at 355. Because M3Girl’s design is not functional under the traditional *Inwood Labs* test, there is no need to speculate regarding alternative design possibilities. *Traffix*, 532 U.S. at 33.

Defendants also emphasize that M3Girl’s “bottlecap jewelry ‘trade dress’ is the subject of U.S. utility patents and patent applications which show[] its functionality.” Docket No. 82, at 4. However, the parties agree that all patents and/or patent applications are presently pending. Therefore, the Court will not construe pending patent applications related to M3Girl’s asserted trade dress as evidence tending to show the trade dress’s functionality.

### III. Conclusion

Because Defendants have failed to demonstrate M3Girl’s design is functional as a matter of law, Defendants have also failed to establish their entitlement to partial summary judgment regarding Plaintiff’s trade dress claims. It is therefore ORDERED that Defendants’ Motion is DENIED.

IT IS SO ORDERED.

SIGNED this 6<sup>th</sup> day of December, 2011.

  
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Royal Furgeson  
Senior United States District Judge