

**IN THE UNITED STATES DISTRICT COURT
NORTHERN DISTRICT OF TEXAS
DALLAS DIVISION**

M3 GIRL DESIGNS, LLC
Plaintiff,

v.

BLUE BROWNIES, LLC
KRISTA DUDTE, and
ROBERT DUDTE
Defendants.

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CIVIL ACTION NO. 3-09CV2390-F

**APPENDIX TO DEFENDANTS’ MOTION FOR RECONSIDERATION OF THE
COURT’S SUMMARY JUDGMENT ORDER**

The following documents are submitted in support of Defendants’ Motion for Reconsideration of the Court’s Summary Judgment Order:

- Exhibit A – www.archive.org screen captures of the Goldie Garcia Glitter Art website.....3-11
- Exhibit B – PDF copies of www.kategrenier.com.....12-47
- Exhibit C - Defendants’ (Redacted) Amended Reply to Plaintiff’s Response to Defendants’ Motion for Partial Summary Judgment, Docket No. 113 D (Part One).....48-74

Respectfully submitted,

Charles W. Hanor
Charles W. Hanor, P.C.
750 Rittiman Road
San Antonio, Texas 78209
Telephone: (210) 829-2002
Fax: (210) 829-2001

By /s/ Charles Hanor
Charles W. Hanor
Texas Bar No. 08928800

ATTORNEYS FOR DEFENDANTS

CERTIFICATE OF SERVICE

I certify that the foregoing was served with the Clerk of Court on December 16, 2011 and on Defendants' counsel by Electronic Mail (ECF-Pacer) using the ECF system, which will send notification of such filing to the following:

D. Scott Hemingway
Hemingway & Hansen, L.L.P.
1700 Pacific Avenue, Suite 4800
Dallas, TX 75201
Counsel for Plaintiff
shemingway@hemlaw.org

/s/ Charles Hanor

EXHIBIT A



33 captures

1 Apr 01 - 1 Mar 11

MAR

APR

MAY

Close



1

2001

2002

Help



Goldie Garcia

glitter art

- ★ bottle-cap art
- ★ car art
- ★ art pins
- ★ shrines
- ★ about Goldie



Please call me at 505/ 341-1444 to place orders! The shopping cart is under development.

Goldie Garcia's Glitter Art     00482

1620 Griegos NW, Albuquerque, NM 87107 USA

505/ 341-1444 Phone · www.goldiegarcia.com

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Goldie Garcia

glitter art

★ bottle-cap art

Click to see a detail view.



Each of Goldie's Bottle Caps is unique, handmade, and one-of-a-kind, embellished with glitter, stars, rhinestones, set in high-tech plastic. If you would like a special icon not shown above, select "Special Request" and describe it in the select menus below. You can supply the image, or Goldie can select one from her extensive collection. Please note that special orders require 3-4 weeks delivery.

Bottle Cap Art	Price	Qty	Image
Magnets	6.00	Qty:	...Select Image
Pins	10.00	Qty:	...Select Image
Pet Tags	10.00	Qty:	...Select Image

Key Rings	13.00	Qty:	...Select Image
Earrings	25.00	Qty:	...Select Image
Earrings w/dangle	28.00	Qty:	...Select Image
Bolo Tie	25.00	Qty:	...Select Image

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Goldie Garcia

glitter art

★ about Goldie

Story and photography by *Don Toomey*.

Reproduced with permission from the Winter 1998 issue of *Tradición Revista*, pp 84-88.



In the beginning it was your everyday bottlecaps with miniature saint's pictures embedded in plastic. Now it's elaborate shrines devoted to the santos or recognizable personages of the twentieth century whose images are embedded in plastic and surrounded by marbles, pieces of cast-off jewelry and an amazing variety of the everyday detritus of our throw-away culture. Yet these works by Goldie Garcia are both unique and compelling pieces of contemporary Latino art.

Goldie Garcia was born in Albuquerque, New Mexico. Her father came from Mexico, and she believes his birthplace was Cuernavaca but notes that the location seems to change each time her father tells of his origins.

Her mother's family was the German-Jewish Jake Gold family that settled in Santa Fe. Her Hispanic roots on her father's side go back to the early 1900's whereas her mother's New Mexican Hispanic roots go back to the middle 1800s. Goldie was raised in a family of nine children and she is second to eldest. She notes that her parents were always on hand, but being the eldest girl in the family, she devoted much of her time to taking care of the younger children.

She was brought up in a Hispanic Catholic cultural setting, but one that emphasized the so-called "American Way." However, she did not grow up speaking Spanish and only learned it later on. She attended St. Francis Xavier parochial school on South Broadway from kindergarten to the ninth grade, and there the nuns discouraged any Spanish from being spoken in the classroom and reinforced the prohibition by cracking knuckles with a ruler. Goldie says, "When I was taking Spanish in college and was called upon, I would freeze because of this conditioned childhood experience." After sixth grade, her father bought some property in the North Valley where she attended Garfield Junior High and then went on to Valley High School.



After graduation she followed her father's admonition, "You first learn to type, and then you

get a steady job!" She did so for a few years working as a secretary for reliable firms, but her superiors all kept telling her that she could go only so far without more education. Replying to this advice, she started taking night classes at TVI when she was twenty-three years old. Later on, she took additional college preparatory courses at the University of New Mexico, then quit her job and went to school full-time.



During this time Goldie began to do standup comedy at some of the local night spots. During her last year at UNM she decided she wanted to broaden her life, moved to Boston, and enrolled in the liberal arts program at Harvard University. She says, "It was a wonderful experience for me to go to such a school and be accepted into this program." She remained in Boston for eight years and notes that the first three years were very difficult for her. The weather was terrible, and she found the people cold, abrasive, and very materialistic. Still, she realized that for her future this program was the chance of a lifetime. Between semesters she would return to New Mexico to reconnect with her roots. While working on her degree she did standup comedy in the Boston area, worked as a hostess at "To Catch a Rising Star," and as a secretary in a real estate firm.

During this interval she had also married but found that her husband did not share her dreams for the future. They divorced, she moved to Los Angeles and worked at a variety of jobs. However, Goldie did not find Los Angeles to her liking and returned to New Mexico in 1991. Returning to Albuquerque with a degree from Harvard University, she found that she still could not get a job contrary to what she had been led to believe about the merits of additional education. She was told that she was overqualified. She jokes, "This was somewhat ironic since before I had an education I could get any job, and now with an education I was overqualified and regarded as a threat." Finally, she was able to get a part-time job as a waitress at an old Town French restaurant called La Crepe Michele in addition to pursuing her standup comedy routines.

When asked about her desire to become a standup comic she said, "I believe that coming from a large family where I was always joking around, entertaining, and trying to keep the younger siblings happy had a lot to do with it." She added that her entire family seems to have a really good sense of humor. Goldie has performed as a comic throughout New Mexico and locally at "Laffs." As an established comedienne, she has also performed at clubs in Arizona, Colorado, Boston, San Francisco, and elsewhere. As an interesting insight into the various phases of comedy, she pointed out that you go through many different stages. First is the real corny stage, then you try to grow up and go through the angry stage, then into a profanity stage. Then it dawns on you that if you keep this up you are not going to get work, so you go back to the clean stage.



Some people insult easily, so a Hispanic woman comic has to be very careful of stereotyping. Goldie said, "I came from a stereotypical family. I was a little señorita when I was growing up, and when you talk about this on stage you tend to trouble some Hispanics who deny their heritage. Now I concentrate on talking just about my life experiences." She added that she has more resistance from Hispanic males since they are not used to a woman with a strong mind and outgoing personality. She also noted that there were problems with some Anglos because they believed that she should stay in her place. Goldie says, "I didn't understand what that was, but they seemed to have determined it for me by stereotyping me in their minds." Despite those prickly attitudes, Goldie is still an active standup comic and only recently did a one-week run at "Laffs" and a show for the New Mexico Endowment for the Humanities.



Goldie Garcia describes how she became involved with her unique and funky art form: When I would come back to New Mexico during semester breaks, I would see my sisters struggling to make ends meet, and here I was with my life going so well. Feeling that I should do something to help them, I advised them to become involved doing "Latino Art." I recalled to them that when we were kids growing up on South Broadway, there were altars to the Virgin of Guadalupe every December, and we had processions in the streets with mariachi bands playing the marches. The altars would be wrapped in colored foil along with fresh flowers and blinking Christmas lights and with a lot of colorful glitter on the shrines. This was an expression of my culture that was so prevalent, but my sisters kept saying that we don't have the time. So when I returned to New Mexico for good and found myself hungry, and with job opportunities closed to me, I decided I ought to take some of my own advice."

Dreams play an important part in Goldie's life, and along with dreams and her own intuition she began to develop some thoughts about glitzy, funky art. She started off by placing pictures of saints and little crystals on slabs of metal, and people would actually buy them. Then it dawned on her that maybe there was something in this after all. Goldie doesn't claim to have a business mind, but she believes that necessity seems to help out in developing one. Her bottlecap art came to her one day while out walking and she picked up a Budweiser beer cap. She said, "You know there are millions of discarded bottle caps all around us." She gathered up a bunch, placed a small image of Our Lady of Guadalupe among them, and put a sprinkle of glitter and plastic over it.



At first she believed they were pretty sacrilegious, but then it seemed that a saint among bottle caps could also be regarded as a personal social commentary. Goldie developed a process and made earrings, pins, and keychains from her bottle caps. Before long the line had taken off. Goldie refers to these as her "Latino Art" and notes that they do have a very contemporary kitsch quality to them. She definitely gets mixed reactions from them with some customers loving them while others think they are the tackiest things they have ever seen. Goldie believes all the beauty in these lies in their overall glitter. To some it represents a return to childhood and simpler times.

Now that Goldie had developed a product, she was therefore a businesswoman; but how does one get started in business? The answer proved close at hand when she heard about an organization called ACCION. This is a wonderful organization located in Albuquerque designed to help anyone get started in business primarily through business loans. You apply for a first loan of up to five hundred dollars, then your next step upward is a seven hundred dollar loan, then you pay off your debt and expand your loan potential up to a maximum of twenty-five thousand dollars. Anyone who can prove she is a responsible businessperson can qualify for an ACCION loan. Goldie took advantage of this program and over a period of time acquired and paid off loans for a company car, a computer setup, and a website.

For the last few years Goldie Garcia has been creating various types of shrines incorporating both the contemporary and religious aspects of her "Latino Art." The idea of the shrines developed quite suddenly one night. The night she was informed that her father had just been diagnosed with cancer. She said, "That night I made my first shrine; it just came out of the blue. I seem to have creative spurts when I suffer pain: the physical emotion seems to spur the creative urge. The shrines have been some of her best sellers, and they allow Goldie the opportunity to explore different aspects of her funky art. She has done shrines to Our Lady of Guadalupe, Jesus, Princess Diana, Fida Kahlo, and many other contemporary and



Of the materials Goldie utilizes in her art, recycled bottle caps are a prime item. These she uses for her earrings, refrigerator magnets, key chains, pins, and other small items. Wholesalers supply the various plastics she uses and the safety equipment used in the process. She has taught herself the special techniques needed to produce her art and has even copyrighted the fifteen-step process it requires.

Another sort of whimsical art that Goldie has developed is her "Car Crosses." These were designed to replace those "hula girls" one sees on car dashboards. The crosses are made of popsicle sticks glued together and wrapped with various colored ribbons, then graced with a bottlecap and sprinkled with liberal quantities of glitter. Attached to each cross is a written label that notes they are a protection from potholes and everyday trash. If it is hung from the rear mirror with the bottlecap facing outward, the driver is assured protection from drunk drivers; alternatively, if the central bottlecap is facing outwards, the driver is protected from bad country western music and backseat drivers.

Goldie Garcia applied to become a participant in Contemporary Hispanic Market in 1993. She submitted a variety of her bottlecap art to the judges (the shrine had not developed by then) and was immediately accepted into the Market. She finds joy in attending Market and considers the entire annual process as a rite of passage as really a ritual. Goldie believes that some of her art has a religious appeal for many people, and in fact she claims she has learned more about the santos from her customers than they have learned from her. Some tell her of their personal experiences in which the saints appeared to them or even did some favor for them, and Goldie regards this as a sign of trust to be privy to these personal stories. She hopes that when customers purchase her work that they will take away a deeper respect for realizing that we are more than a stereotype and that we do have something to consider a culture.



As to recognition and awards for her art, Goldie noted that her work is part of the current exhibit Recycling that was at the Museum of International Folk Art and has since gone to Tacoma, Washington, and Palm Springs. The art is also in the traveling exhibition. Goldie's unique art can be found at Mariposa Galleries in Albuquerque and Santa Fe, at Karen Miphi Gallery in Santa Fe, and at other outlets, among them Montez Gallery, Bustamonte Gallery, and the Museum of International Folk Art Store in Santa Fe. Her work is also shown in museum gift shops in Chicago, New York, San Francisco, and San Diego. Goldie says, however, "I hold my finer, large pieces for the Contemporary Hispanic Market."



When Goldie was asked what she would like to do in the future she replied, "I do have a serious desire to learn how to carve bultos. I think my approach to bulto carving and painting would make for an interesting combination especially with my trademark glitter. I look at the traditional devotional art and I am mesmerized as to how they accomplish such beautiful creations. The entire process seems to be fascinating."

Goldie Garcia creates a unique line of very contemporary art ranging from bottlecap earrings to religious and secular shrines, and her works of art convey great feeling and a profound sense of social commentary.

Don Toomey is a staff writer for Tradición Revista.

Goldie's work can be found in the collections of Al Pacino, Julia Roberts, Paul Rodriguez, Laura Dern, and Billy Bob Thornton.

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EXHIBIT B



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our specialty is magnetic expressions from recycled bottle caps. handmade in the usa. made to enjoy! our bottle cap magnets make fabulous & unique gifts. use them anywhere! these trendy magnets are the perfect accessory for any kitchen's fridge! don't have a fridge? check out our magnetic boards and displays!



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magnet six-packs

what's hot



keep calm



chocolate



cowgirl



cupcake



dog lover



planet earth



les fleurs



flower power



girlfriends



insects



inspire



farmers market



ooh la la



peace



pin-up girls



shoes!



shopping



#1 teacher



girls rule



text jargon



veg-out



wine



yoga

what's new



australia



baseball



chicago bears



chicago bulls



chicago cubs



chicago blackhawks



chicago white sox



(D) democrat



the divine



easter



colours of india



magnolia



namaste



new orleans



the queen



(R) republican



holiday cheer



seattle 2011



st. patty's day



tailgating



tennis



uffda

drinking



beer



cheers!



coffee



happy hour



tea



wine

food & sweets



cheese



chocolate



coffee



cupcake



doughnuts



ice cream



kiss the cook



farmers market



sugar baby



sushi



tea



veg-out



wine

love



bachelorette



pride



romance



sexy



valentine's day



wedding

icons



keep calm



the divine



les fleurs



flower power



colours of india



insects



kablam



namaste



ooh la la



peace



pin-up girls



pointing finger



under the sea

miscellaneous



bookworm



cowgirl



(D) democrat



home sweet home



inspire



kiss the cook



in the kitchen



luck



office



pointing finger



(R) republican



shopping

women



bachelorette



cowgirl



girlfriends



hope



island girl



mom



mum



ooh la la



pin-up girls



the queen



shoes!



shopping



girls rule

tween & child



artist



baby bliss



ballet



it's a boy!



#1 dad



dance diva



edward (twilight)



flower power



it's a girl!



jacob



kablam



miss manners



mom



peace



soccer



#1 teacher



girls rule



text jargon

celebrations



baby bliss



bachelorette



birthday



it's a boy!



congrats



it's a girl!



happy hour



l'chaim



luck



retirement



wedding

sports & games



got balls?



baseball



bike



gone fishin'



golf



hockey



running



skiing



soccer



tailgating



tennis



yoga

colleges & teams



auburn



go beavs!



bozeman



go bruins!



chicago bears



chicago bulls



chicago cubs



chicago blackhawks



chicago white sox



duck lover



ILLINOIS



Tailgating



RAVENS



Redskins



SALISBURY

university of illinois

penn state
tailgating

ravens

redskins



tailgating



UConn



go dawgs

outdoors



bike



birding



cabin life



planet earth



on the farm



gone fishin'



les fleurs



in the garden



at the lake



farmers market



outdoors



national park



at sea



skiing



summer fun



surf's up!



winter
wonderland

beach



at the beach



hula girl



island girl



at sea



surf's up!



under the sea

practices



artist



ballet



cowboy



dance diva



democrat



on the farm



in the garden



get 'em



hula girl



jet setter



knitting



I chaim



music



pride



redneck



rock'n'roll



#1 teacher



uffda



veg-out



yoga



zen

animals



alpaca



birding



cat lover



dog lover



on the farm



horse lover



insects



llama lover



under the sea

americana



army proud



baseball



coast guard



(D) democrat



democrat



marine corps



navy



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(R) republican



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military



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army proud



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canada



chicago



colorado



the divine



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flathead valley



french



georgia



galapagos islands



hawaii



illinois



indiana



colours of india



island girl



italian



japan



jet setter



kauai



kentucky



louisiana



long beach



los angeles



magnolia



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maui



Maryland



maine



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miami



minnesota



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montana



mexico



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newport beach



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seattle 2011



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texas



tennessee



uffda



usa



virginia



viva vegas



washington



washington DC



wisconsin

languages



french



italian

holiday



easter



halloween



hanukah



holiday cheer



st. patty's day



valentine's day



christmas

SMILE AND BE MERRY! YARNAHOLIC GIVE LOVE CHALLAH BACK! CUTE AS A CUPCAKE EAT DIRTY BFF CABIN FEVER BLOOM SUPERMAN
BEER THIRTY JOIE DEVIVRE BEAUTIFUL DREAMERS
CIAOBELLA WHAT A WONDERFUL WORLD HAUNTED BY WATERS SCREW IT

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they love us!

- "perfect...for the girl who likes to show off her eco-enthusiasm"
 - seventeen, november 2008
- "fab eye-candy for your frigidaire"
 - minneapolis picks,
- "champagne taste on a beer budget"
 - shine, holly days
- "uniquely fabulous"
 - funky finds
- "inspirational, provocative"
 - new age retailer, michelle jones, 2008—best of show SFIGF
- "disarmingly charming, eclectic and sophisticated"
 - pamela biery, 2006
- "playful, nostalgic magnets"
 - décor green, may 2008
- "funky modern"
 - pampered puppy, january 2007
- "it's folk art meets function meets civility!"
 - surprise.com, may 2007
- "loved not only by our customers but by everyone in the office as well!"
 - see jane work
- "quirky, fun magnets... let us indulge in cutness, guilt free."
 - metro, tina chada
- "all [kate's] creations have a strong graphic thread throughout the imagery, typography & color"
 - cecily ink
- "they're cute, they're collectable, they're green"
 - the artisans
- "not just any ordinary bottle-cap... [they] speak a whimsical, fun and uplifting language that will bring a smile to your face each time you walk by your refrigerator."
 - planet pink n'green





SMILEANDBEMERRY!YARNAHOLICGIVELOVECHALLAHBACKICUTEASACUPCAKEEATDIRTBFFCABINFEVERBLOOMSUPERMAN
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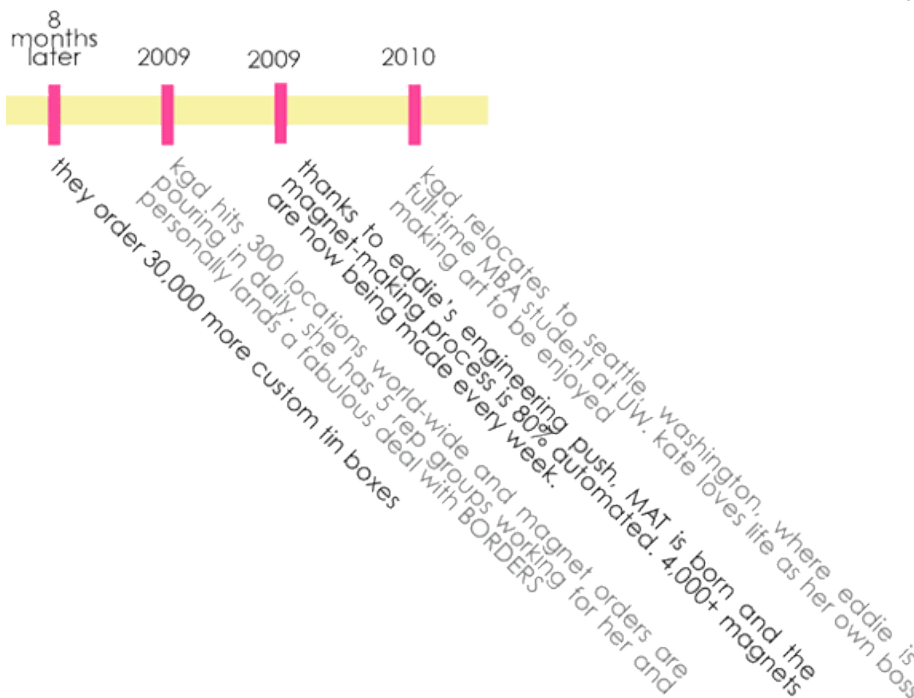
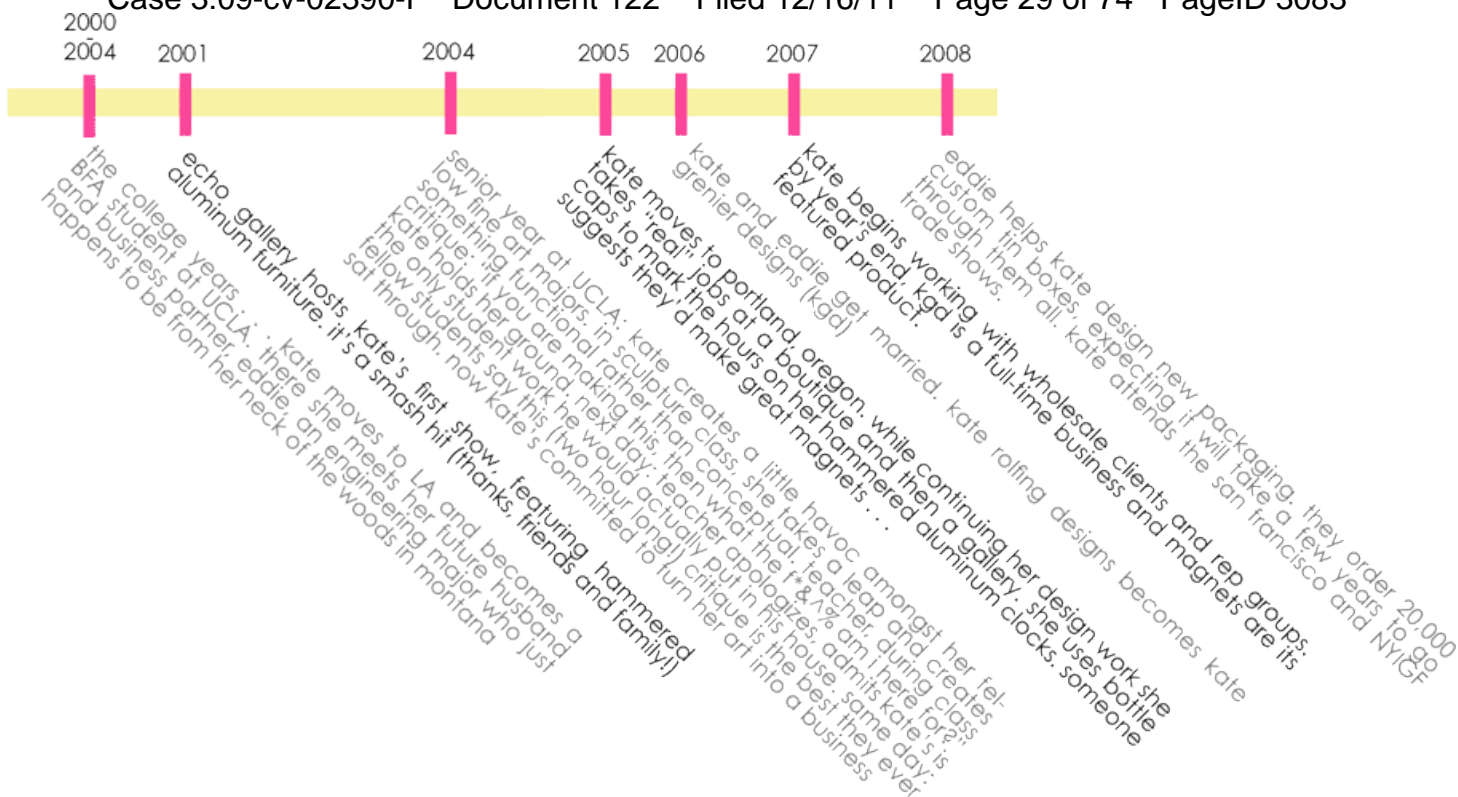
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what's important

our timeline





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waterloo records & video
austin

it's a party
coppell

national cowgirl museum
fort worth

main street news
dallas

whole earth provision co.
austin

great paperworks
midland

ruby
fort worth

candle princess
harker heights

the six floor museum at dealey
plaza
dallas

pitchforks & tablespoons

austin

frontier texas

abilene

texas star trading

abilene

collections corner

abilene

plum crazy

post

big texan gift shop

amarillo

quarter horse outfitters

amarillo

bsa hospital gift shop

amarillo

uncommon graphics

lubbock

georgia st. mall

amarillo

hila

houston

buchanan's bungalow

houston

henfeathers

fredericksburg

book people

austin

contemporary arts museum

houston

random

dallas

spice home furnishings

waco

wild about music

austin

bleu frog

corpus christi

the women's museum

dallas

hyatt regency lost pines resort

cedar creek

buckhorn saloon & museum

san antonio

hotel limpia

fort davis

the mix
hewitt

blue bell creameries
brenham

oh yeah!
bee cave

redenta's garden shops
arlington

san antonio visitor center
san antonio

write now!
houston

der kuchen laden
fredericksburg

paper affair - lovers lane
dallas

paper affair - plano
plano

paper affair - frisco
frisco

embellish nails & boutique
austin

Theatre Under the Stars
Houston

susan eisen inc
el paso

the bath hut
tomball

amon carter
fort worth

suggestions? know a shop
that isn't listed but would
possibly enjoy our product?
please let us know!



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magnet displays

miscellaneous



CRAVE seattle
book



large magnetic
board



small magnetic
board



magetic vase

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magnet singles

note: singles are shown by theme rather than individual designs. if you desire a specific single, please place your order from it's theme and specify in the comments box which single from the theme you would like.

what's hot



keep calm



chocolate



planet earth



fight for your dreams



happy hour



pin-up girls



girls rule



TXT jargon



wine

what's new



bacon



got balls?



baseball



doughnuts



on the farm



gone fishin'



hockey



ice cream



insects



kablam!



peace



rock'n'roll



under the sea

drinking



beer



cheers!



coffee



happy hour



tea



wine

food & sweets



bacon



chocolate



coffee



cupcake



doughnuts



ice cream



in the kitchen



sugar baby



tea



veg-out

love



pride



romance



sexy



valentine's day



wedding

icons



insects



ooh la la



peace



pin-up girls



pointing finger



under the sea



vintage

miscellaneous



bookworm



keep calm



fight for your dreams



home sweet home



inspire



in the kitchen



office



vintage

women



bachelorette



champagne tastes



chocolate



cowgirl



dance diva



dirty girl



girlfriends



hope



hula girl



island girl



mom



ooh la la



pin-up girls



shopping

tween & child



artist



ballet



it's a boy!



dad



dance diva



duckie



it's a girl!



kablam!



miss manners



mom



shopping



soccer



#1 teacher



girls rule



TXT jargon

celebrations



baby bliss



bachelorette



birthday



it's a boy!



congrats!



dad



it's a girl!



luck



retirement



wedding

sports & games



got balls?



baseball



dance diva



golf



hockey



skiing



soccer



surf's up!



yoga

colleges & teams



go beavs!



go bruins!



go dawgs!



duckie

outdoors



planet earth



on the farm



gone fishin'



in the garden



at the lake



outdoors



national park



summer fun!



winter
wonderland

beach



at the beach



hula girl



island girl



at sea



surf's up!



under the sea

practices



artist



ballet



bookworm



cowboy



cowgirl



on the farm



gone fishin'



jet-setter



in the kitchen



knitting



l'chaim



music



pride



redneck



rock'n'roll



#1 teacher



yoga



zen

animals



alpaca



birding



cat lover



dog lover



horse lover



insects



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military



army



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galapagos islands



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hawaii



italian



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mexico



miami



montana



new york city



oregon



paris



portland



pittsburgh



seattle



san francisco



texas



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viva vegas



vermont



washington DC

holiday



halloween



hanukah



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valentine's day



christmas

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magnet duos

what's hot



dishwasher



planet earth

what's new



all i want...



bacon



santa



love seals

food & sweets



bacon

love



saint or sinner?

miscellaneous



dishwasher



reminders

women



keep going!



hope



island girl



reminders

colleges & teams



go tigers!



orange+black



blue+red



blue+white



go colts



crimson cream



crimson+white



green+yellow



gold+black



burnt orange+white



white+maroon



orange+blue



purple+gold



red+black



roll tide

outdoors



planet earth

beach



island girl



love seals

animals



good+bad dog

location & travel



jet-setter

holiday



all i want...



santa



saint or sinner?

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BEER THIRTY JOIE DEVIVRE BEAUTIFUL DREAMERS
CIAOBELLA WHAT A WONDERFUL WORLD HAUNTED BY WATERS SCREWIT

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magnet trios

drinking



and be merry!

holiday



peace love joy

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six-packs



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display

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EXHIBIT C

IN THE UNITED STATES DISTRICT COURT
NORTHERN DISTRICT OF TEXAS
DALLAS DIVISION

M3 GIRL DESIGNS, LLC
Plaintiff,

v.

BLUE BROWNIES, LLC
KRISTA DUDTE, and
ROBERT DUDTE
Defendants.

§
§
§
§
§
§
§
§
§

CIVIL ACTION NO. 3-09CV2390-F

DEFENDANTS' AMENDED REPLY TO PLAINTIFF'S RESPONSE TO
DEFENDANTS' MOTION FOR PARTIAL SUMMARY JUDGMENT
ON PLAINTIFF'S TRADE DRESS CLAIMS (Part One)

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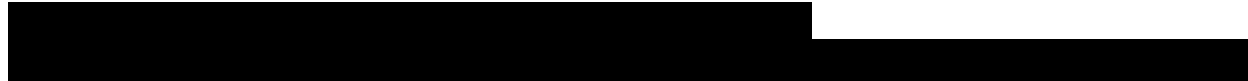
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Rules

Fed. R. Evid. 40819
Fed. R. Evid. 70217,18

To Plaintiff’s Response to Defendants’ Motion for Partial Summary Judgment on Plaintiff’s Trade Dress Claims (the “Response”), Defendants file this Reply, as follows:

I. INTRODUCTION

The arguments in Plaintiff’s Response repeat several times—often word-for-word¹—but are either meritless, irrelevant, or unpersuasive, and nevertheless do not overcome Plaintiff’s lack of competent summary judgment evidence to show that a genuine issue of material fact exists regarding the functionality of its asserted trade dress.

II. APPLICABLE LAW

A. Plaintiff’s Burden to Prove Non-functional Trade Dress

The law is that, unless a product is protected by a valid patent or copyright, “functional product features may be copied freely by competitors in the marketplace” because they “do not qualify for trade dress protection.” *Eppendorf-Netheler-Hinz GMBH v. Ritter GMBH*, 289 F.3d 351, 355 (5th Cir. 2002). The Lanham Act recognizes this precept for promoting competition by requiring that “the person who asserts trade dress protection has the burden of proving that the matter sought to be protected is not functional.” 15 U.S.C. § 1125(a)(3). Thus, the Act imposes a “statutory presumption that [product] features are deemed functional until proved otherwise.” *Traffix Devices v. Mktg. Displays, Inc.*, 532 U.S. 23, 30 (U.S. 2001). This heavy burden of proof on the plaintiff is meant to limit trade dress protection “only to incidental, arbitrary or ornamental product features *which identify the source of the product*” rather than the product itself. *Eppendorf*, 289 F.3d at 355 (emphasis added). Accordingly, if sufficient evidence is not

¹ There are also striking similarities between some of these arguments and statements made in the filed declaration of Dallas patent lawyer Steven E. Ross. See Pl.’s SEALED Ex. 9, Dkt. 96-1, App. 154–72. Mr. Ross’s apparent expert report, however, is inadmissible and should not be considered by the Court. See *infra* at 17.

present that would enable a reasonable trier of fact to find that the asserted trade dress is *non-functional*, summary judgment in favor of the defendant is proper. *See generally Traffix*, 532 U.S. at 26–35.

B. Functionality Tests for Asserted Trade Dress

Under the traditional 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 Labs., Inc. v. Ives Labs., Inc.*, 456 U.S. 844, 850 n.10 (1982); *Eppendorf*, 289 F.3d at 355. Under the “competitive necessity” test, a product feature is also functional “if exclusive use of the feature would put competitors at a significant non-reputation-related disadvantage.” *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 165 (1995); *Eppendorf*, 289 F.3d at 356 (holding the Fifth Circuit’s “utilitarian” test “virtually identical to the ‘competitive necessity’ test . . . [and] still valid as a secondary test”). When a product feature is functional, however, there is no need to consider the “competitive necessity” test, the availability of alternative designs, or proof of secondary meaning. *See Traffix*, 532 U.S. at 33–34; *Eppendorf*, 289 F.3d at 355–56.

A guiding principle for functionality analysis is the purpose of trade dress protection: “[T]o ‘secure the owner of the [trade dress] the goodwill of his business and to protect the ability of consumers to distinguish among competing producers.’” *Eppendorf*, 289 F.3d at 355 (quoting *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 774 (1992)). Unlike the purpose of patent law, which is to encourage invention, trade dress protects “the value of identifying symbols.” *Id.* (quoting J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition*, § 6:3 (4th ed. 2001)). In contrast, a functional feature of a product relates to its value *as a product* rather than as a source identifier. *U.S. Golf Ass’n v. St. Andrews Sys., Data-Max, Inc.*, 749 F.2d 1028, 1033

(3d Cir. 1984) (emphasis added). Stated another way, “[a] feature is non-functional if, when omitted, nothing of substantial value in the goods is lost.” *Id.* at 1034 (quoting Restatement of Torts § 274 cmt. a).

C. Functionality Analysis of Asserted Trade Dress “As a Whole”

Trade dress refers to “the total image or overall appearance of a product,” the features of which serve to identify the product’s source. *E.g., McNeil Nutritionals, LLC v. Heartland Sweeteners, LLC*, 511 F.3d 350, 357 (3d Cir. 2007). However, while “a collection of functional features . . . does not necessarily make the combination of those features functional,” *Pebble Beach Co. v. Tour 18 I Ltd.*, 155 F.3d 526, 538 (5th Cir. 1998), it also follows that the inclusion of a non-functional feature does not necessarily render the product as a whole non-functional. *See Textron Inc. v. U.S. Int’l Trade Comm’n*, 753 F.2d 1019, 1025 (Fed. Cir. 1985) (“[T]he right to copy better working designs would, in due course, be stripped of all meaning if overall functional designs were accorded trademark protection because they included a few arbitrary and nonfunctional features.”).

More important, “where the whole is nothing other than the assemblage of functional parts, . . . it is semantic trickery to say that there is still some sort of separate ‘overall appearance’ which is nonfunctional.” *Leatherman Tool Group, Inc. v. Cooper Indus.*, 199 F.3d 1009, 1013 (9th Cir. 1999). That is, to warrant trade dress protection, “the overall combination of functional features . . . must be configured in an arbitrary, fanciful, or distinctive way.” *Antioch Co. v. Western Trimming Corp.*, 347 F.3d 150, 158 (6th Cir. 2003). Conversely, where the configuration of functional components was influenced by “engineering necessity,” the asserted trade dress as a whole has been held functional. *Id.* at 158–59; *see also Eppendorf*, 289 F.3d at

358; *Tie Tech, Inc., v. Kinedyne Corp.*, 296 F.3d 778, 786 (9th Cir. 2002); *Leatherman Tool Group*, 199 F.3d at 1013.

█ [REDACTED]

A functional product configuration is also not protectable trade dress “simply because an investment has been made to encourage the public to associate a particular functional feature with a single manufacturer or seller.” *Traffix*, 532 U.S. at 34–35. [REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

III. ARGUMENT

A. Plaintiff's Asserted Trade Dress Consists of [REDACTED] Functional Features

This case is based on two products: bottle cap magnets and elastic choker washer necklaces. [REDACTED] However, Plaintiff deconstructs these two products into disparate elements, alleging that its trade dress includes one or more of the following five product features:

- (1) a slim choker necklace, colored or white, fabric;
- (2) an attachment having a metallic sheen tied on a knot at the front of the choker [sic] 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 [sic] 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.

[REDACTED]

See Pl.’s Second Amended Complaint, Dkt. 72, ¶ 13. Plaintiff asserts that its trade dress also includes every “permutation” of these five elements. Pl.’s Response, Dkt. 96, pp. 3–5, 30–31.⁴

Plaintiff, along with dozens of other craft makers, markets and sells (1) elastic choker necklaces made of variously colored woven nylon, each with a shiny steel fender washer tied to it in a knot (hereinafter “elastic choker washer necklaces”), *see, e.g.*, Def.’s Ex. J, Dkt. 83-10; [REDACTED], and (2) standard crown-ridged soft-drink bottle caps, each containing a decorative design on its internal surface and a magnet glued on its top surface (hereinafter “bottle cap magnets”), *see, e.g.*, Def.’s Ex. K, Dkt. 83-11; [REDACTED]. The bottle cap magnets can be stuck to any ferrous surface and are commonly referred to as refrigerator magnets. They can also be interchangeably “snapped” to elastic choker washer necklaces to form “interchangeable, bottle cap necklaces.” *See, e.g.*, Def.’s Ex. J, Dkt. 83-10; Def.’s Ex. K, Dkt. 83-11; [REDACTED]. Plaintiff does not market and sell all of the hypothetical combinations—proposed by Plaintiff—that do not in fact represent the “total image or overall appearance” of actual products. A random combination of these elements cannot possibly be trade dress.

1. Elements of elastic choker washer necklaces

Plaintiff’s retail website depicts necklaces made with at least two different fabrics in a variety of colors. These include variously colored suede-like necklaces as well as variously colored elastic nylon chokers. Def.’s Ex. J, Dkt. 83-10. Both types of necklaces have a standard zinc plated steel fender washer attached using a simple slip knot. In comparison, both types of necklaces could reflect a combination of Plaintiff’s first two asserted trade dress elements, except

⁴ This argument seems to imply that a functionality analysis is required for potentially thirty-two separate assertions of trade dress.

for the fact that the suede-like necklaces are too long to be used as chokers. [REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

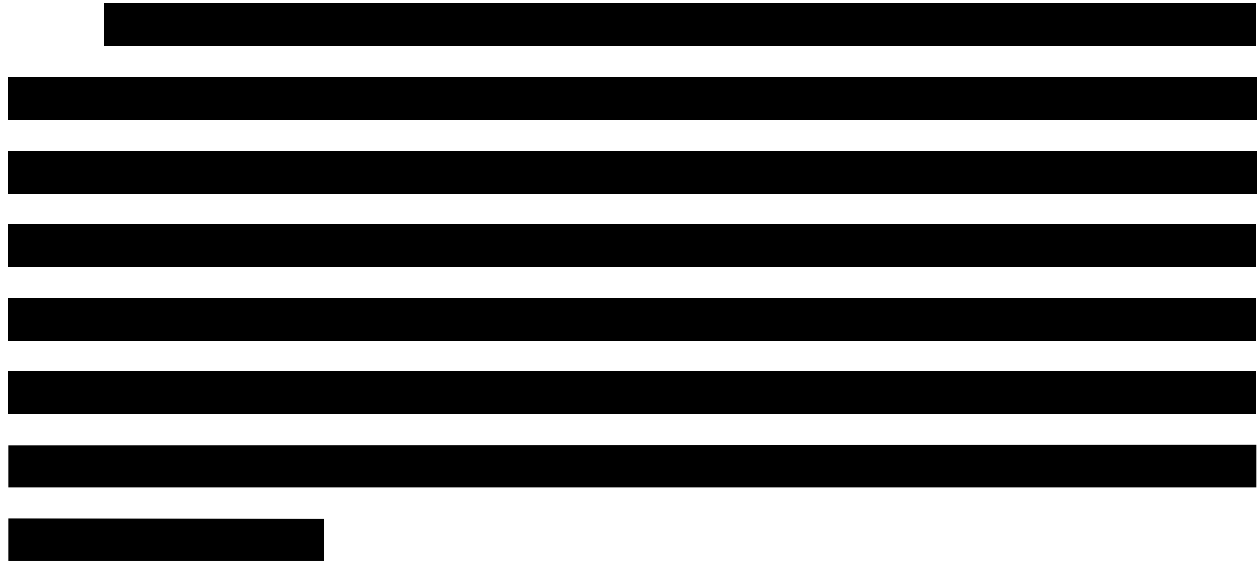
Even if this language were construed narrowly to only encompass Plaintiff’s actual elastic choker washer necklaces, the asserted trade dress elements nevertheless describe functional product features. Nylon choker necklaces use inexpensive, mass produced elastic fabric so that they can be worn by consumers of various sizes and can be easily slipped on and off without troubling with a clasp or similar device. The undeniable purpose of the attached washers is to magnetically and interchangeably join the choker necklaces to bottle cap magnets, resulting in necklaces with pendants being bottle cap magnets rather than plain washers. Zinc plated steel fender washers are simply one of the least expensive types of ferrous metal discs that can be attracted to magnets.⁵ Fender washers are also easily attached with a simple slip knot without the added costs of using special tools and more elaborate fabrication methods. Accordingly, this combination of functional features is influenced by “engineering necessity” for

⁵ Steel fender washers can be purchased at any hardware store and are typically zinc plated steel, making them shiny and magnetic. Brass, stainless steel, sterling silver and other non-ferrous fender washers would not work because they would not stick to bottle cap magnets.

making [REDACTED] interchangeable, bottle cap jewelry a practical reality. *Cf. Antioch*, 347 F.3d at 158–59; *Eppendorf*, 289 F.3d at 358. Consequently, there is nothing arbitrary, fanciful, or distinctive about tying a washer to an elastic nylon choker necklace.

2. Elements of bottle cap magnets

Plaintiff’s retail website depicts bottle cap magnets with many different backgrounds and decorative designs on their internal surfaces. *See, e.g.*, Def’s Ex. K, Dkt. 83-11. Despite the wide variety of potentially copyrightable decorative designs, the product configuration of every one of them consists of a standard crown-ridged soft-drink bottle cap with its edges facing out (to expose the internal surface) and a magnet glued to its top surface. *See, e.g.*, [REDACTED]; *cf.* Def’s Ex. I, Dkt. 83-9. These common features are Plaintiff’s last three asserted trade dress elements.⁶



Even if this language were construed narrowly to only encompass Plaintiff’s actual bottle cap magnets, each with a magnet as the “raised projection having a geometric shape on the top

⁶ What Plaintiff lists as its fourth asserted trade dress element describes the outward position of the bottle cap “on the choker [sic] necklace.” To the extent that Plaintiff markets and sells its bottle cap magnets as a separate product, Defendants’ consider only the portion that concerns the outward position of the bottle cap standing alone rather than in combination with a choker necklace.

surface,”⁷ the asserted trade dress nevertheless describes functional product features [REDACTED]. [REDACTED]. Bottle caps are cheap, have been readily available for over 100 years in standard shapes and sizes appropriate for jewelry and collectibles, and do not require custom cutting or special fabrication. Use of standard, blank bottle caps are, therefore, a necessity for making customized bottle cap jewelry pieces.⁸ Bottle caps also serve the functional purpose of framing the decorative designs on their internal surfaces. More important, Plaintiff does not in any way arbitrarily alter the [REDACTED] design of the bottle caps it uses for an obvious functional reason: the commercial value of the bottle caps lies in the fact that they are standard crown-ridged bottle caps. The functionality of positioning the bottle caps outwardly is to enable third parties to see the decorative designs on their internal surfaces; turning the bottle caps inward would defeat this purpose.⁹ The undeniable purpose of the attached magnets is to interchangeably join the bottle cap magnets to elastic choker washer necklaces (not to mention refrigerators, lockers, and other objects). Accordingly, this combination of functional features is influenced by “engineering necessity” for making [REDACTED] interchangeable, bottle cap jewelry a practical reality. *Cf. Antioch*, 347 F.3d at 158–59; *Eppendorf*, 289 F.3d at 358. Consequently, there is nothing arbitrary, fanciful, or distinctive about gluing a magnet to the top surface of a bottle cap and then displaying it outwardly.

3. Elements of interchangeable, bottle cap necklaces

⁷ Although written in ambiguous terms, what Plaintiff lists as its fifth asserted trade dress element can only refer to the magnet glued to the *top* surface of the bottle cap, particularly when compared to the language of element 4 that describes the outward position of the bottle cap to expose its *internal* surface. Plaintiff as much as admits this fact, *see* Pl.’s Response, Dkt. 96, p. 39 n.9, and there is no evidence to show that it could be anything else.

⁸ Bottle cap blanks are sold in wholesale lots of a 50 (\$4.75) to 3000 (\$129.00) at companies like www.bottlecapco.com to craft makers like Plaintiff and Defendants.

⁹ Designs with the trademarks of bottlers have been placed on the top of bottle caps for many decades but this does not make exposing the inside of the bottle cap any less functional.

Although Plaintiff's elastic choker washer necklaces and bottle cap magnets are predominately displayed and sold as separate products, it is evident that Plaintiff markets them as complementary pieces of interchangeable, bottle cap necklaces. *See, e.g.*, Def.'s Ex. J, Dkt. 83-10; Def's Ex. K, Dkt. 83-11. When joined together, the resulting interchangeable, bottle cap necklaces could only reflect a combination of Plaintiff's first, third, and fourth asserted trade dress elements because the zinc plated steel fender washer and magnet would be hidden from view.¹⁰ [REDACTED]. The functional aspects of the elastic choker washer necklaces and bottle cap magnets are discussed above and do not magically change as a result of their magnetic joinder. Rather, it would be "semantic trickery" to say this assemblage of functional features creates "some sort of separate 'overall appearance' which is nonfunctional." *See Leatherman*, 199 F.3d at 1013. The functionality of these features can be readily confirmed by omitting, [REDACTED], the value of the asserted trade dress from the product itself. *See U.S. Golf Ass'n*, 749 F.2d at 1034; *Kleck*, 145 F. Supp. 2d at 821. If, in perceiving Plaintiff's interchangeable, bottle cap necklaces, one could remove the asserted trade dress elements (i.e., a fabric choker of any color and outwardly positioned, standard crown-ridged bottle cap), the product's value would be extinguished because only the concealed washer and magnet would remain. As a result, these functional features simply have no value for identifying source. The same analytic conclusion is reached [REDACTED] to the elastic choker washer necklaces and bottle cap magnets as separate products.

¹⁰ The fact that the washer and magnet cannot be seen when the two products are used as intended also negates the ability of these features to be trade dress.

[REDACTED]

If the Court gave Plaintiff trade dress protection, it would unjustifiably confer a broad monopoly on not only elastic choker washer necklaces, bottle cap magnets, and interchangeable, bottle cap necklaces, but also every possible variation [REDACTED]

[REDACTED]. Rather than promote competition for the protection of consumers, such a monopoly would effectively put all competitors at a significant non-reputation-related disadvantage by eliminating competition on multiple levels, particularly to the detriment of pre-teen and teen girls in the market for interchangeable, bottle cap magnets and elastic choker washer necklaces. In a nutshell, it would exceed the bounds of sane and reasonable comprehension to hold that anyone

could combine common objects (e.g., bottle caps, magnets, washers, and elastic nylon chokers) using common craft techniques—without adding any distinctive ornamental features—and thereby acquire trade dress protection [REDACTED].

B. Plaintiff Cannot Point To Any Disputed Fact Issue That Its Asserted Trade Dress Is Non-Functional

Ultimately, Plaintiff bears the burden of proving that its asserted trade dress is non-functional. *See supra* at 1–2. Plaintiff’s Response, however, propounds a series of counter-arguments without presenting competent evidence of non-functional trade dress. As a result, Plaintiff cannot present sufficient evidence that would enable a reasonable trier of fact to find that its asserted trade dress is non-functional.

1. Plaintiff incorrectly defines functionality

As a foundation for its arguments, Plaintiff defines functionality by quoting lengthy passages from *Pebble Beach Co. v. Tour 18 I Ltd.*, 155 F.3d 526 (5th Cir. 1998). *See* Pl.’s Response, Dkt. 96, pp. 9, 28, 37. The *Pebble Beach* opinion, however, preceded the Supreme Court’s further explanation of functional trade dress in *Traffix Devices v. Mktg. Displays*, 532 U.S. 23 (2001). Accordingly, the Fifth Circuit Court of Appeals’ thereafter held that “Traffix supersedes the definition of functionality previously adopted by this court.” *Eppendorf*, 289 F.3d at 356. More specifically, the former, less comprehensive “utilitarian” test applied in *Pebble Beach* is now the replaced by the secondary “competitive necessity” test discussed in *Traffix. Id.* Thus, Plaintiff bases many of its arguments on an incorrect definition of functionality.

2. Plaintiff’s reliance on *Smack Apparel*, *Yurman Design*, and *Cosmos Jewelry* is misplaced and unpersuasive

Plaintiff quotes lengthy passages from *Bd. of Supervisors for LSU v. Smack Apparel Co.*, 550 F.3d 465, 488 (5th Cir. 2008), and asserts that Defendants’ arguments parallel those made in *Smack Apparel* and should be rejected in like manner. *See* Pl.’s Response, Dkt. 96, pp. 2 n.2, 5–6, 9 n.5, 12, 29, 32–33, 43. The *Smack Apparel* case involved unlicensed T-shirt designs that incorporated the two color trademark schemes of certain famous universities in combination with printed messages identifying those same famous universities.¹¹ *See Smack Apparel*, 550 F.3d at 472–73. The court did not consider the universities’ two color schemes alone but “the entire context in which the color *and other indicia* [were] presented on the t-shirts.” *Id.* at 475 (emphasis added). Accordingly, the court reasoned that the t-shirts would function just as well as articles of clothing without the universities’ trademarked colors and identifying indicia. *Id.* at 486.¹² Here, the only parallels to draw is analogizing t-shirt colors with Plaintiff’s nylon choker colors, t-shirts with Plaintiff’s bottle caps, and t-shirt designs with the decorative designs on Plaintiff’s bottle caps. Yet, Plaintiff does not assert trade dress in a single color scheme for its nylon chokers or in the decorative designs on the internal surfaces of its bottle caps.¹³ More important, in stark contrast to *Smack Apparel*, Defendants’ do not use any words, messages, symbols, logos, or other identifying indicia on its products that refer to the Plaintiff. [REDACTED]

¹¹ Some selling red and white T-shirts with a covered wagon and burn orange T-shirts with a longhorn symbol at the Texas-OU football game is a prime example.

¹² Additionally, while *Smack Apparel* reaffirmed the Fifth Circuit’s rejection of aesthetic functionality, Defendants have not and do not contend that Plaintiff’s asserted trade dress can only be functional in an aesthetic sense. Rather, Defendants base their arguments on the traditional functionality test and secondarily on the competitive necessity test, both of which are recognized in the Fifth Circuit. *See supra* at 2.

¹³ Rather, Plaintiff claims that any color choker necklace or bottle cap would infringe its “trade dress.”

[REDACTED]

[REDACTED]

Plaintiff quotes lengthy passages from *Yurman Design, Inc. v. Golden Treasure Imports, Inc.*, 275 F. Supp. 2d 506 (S.D.N.Y. 2003), and argues that “Defendants’ attempt to interject functional limitations into the Plaintiff’s trade dress . . . from ‘out-dated’ pleadings.” See Pl.’s Response, Dkt. 96, pp. 7–8, 36. Defendants have addressed the functional aspects of Plaintiff’s asserted trade dress elements as described in its Second Amended Complaint, which is a “live” pleading. More important, the quoted passage concerned an argument regarding a failure “to identify the specific elements of the trade dress that [the plaintiffs] seek to protect.” *Yurman Design*, 275 F. Supp. 2d at 510. Here, Defendants do not argue that Plaintiff has failed to specifically identify what Plaintiff contends is its asserted trade dress.

Plaintiff also quotes *Yurman Design* and argues that Defendants can avoid “a significant non-reputation-related competitive disadvantage” by using alternative designs. See Pl.’s Response, Dkt. 96, pp. 10–11, 37–38, 42. The quoted passage concerned an analysis under the secondary “competitive necessity” test in response to an argument based on aesthetic functionality. See *Yurman Design*, 275 F. Supp. 2d at 512. Here, Defendants do not argue that Plaintiff’s trade dress is aesthetically functional. In addition, because Defendants have shown that Plaintiff’s asserted trade dress is functional under the traditional test, there is no need to consider the “competitive necessity” test or alternative designs. See *Traffix*, 532 U.S. at 33–34; *Eppendorf*, 289 F.3d at 355–56. Furthermore, as a practical consideration, bottle cap magnets require the use of standard bottle caps.

Plaintiff further quotes *Yurman Design* and argues that Defendants cannot show that Plaintiff's asserted trade dress is functional based on any patent application. *See* Pl.'s Response, Dkt. 96, pp. 13–14, 44–45. The quoted passage concerned an expired utility patent on a cable design that the plaintiffs in that case used in combination with jewels and other jewelry elements. *See Yurman Design*, 275 F. Supp. 2d at 511–12. The court reasoned the patent was insufficient to establish functionality for two reasons: (1) the plaintiffs did not base their trade dress claims merely on the cable design, and (2) the aesthetic value of the cable design, as just one of other artistic elements, outweighed its functional benefit. *Id.* Here, Plaintiff's pending utility patent application relates to the functional features described in its asserted trade dress. *See* Def.'s SEALED Ex. Y, Dkt. 86, M3G 03848–49. Moreover, the functional benefits of these features far outweigh any marginal aesthetic value inherent to elastic nylon chokers, washers, bottle caps, and magnets. As a result, the Court should consider Plaintiff's utility patent application as “strong evidence” of functionality, as explained in Part Two of this Reply.

Plaintiff also quotes *Cosmos Jewelry, Ltd. v. Po Sun Hun Co.*, 2009 U.S. App. Lexis 6187 (9th Cir. Mar. 24, 2009), and summarily contends that “Plaintiff's jewelry trade dress should be protected for the same reasons.” *See* Pl.'s Response, Dkt. 96, pp. 6, 33. This argument lacks persuasive force. *Cosmos Jewelry* is an unpublished memorandum opinion with no precedential value. *See Cosmos Jewelry*, 2009 U.S. App. Lexis 6187, at *1. More important, the court in *Cosmos Jewelry* was compelled to affirm the adverse trade dress determination based on the “clearly erroneous” standard of review (for fact-findings at trial) “and not any determinations on the law.” *Id.* at *2–3. Given this constraint, the court reasoned the district court's finding of non-functionality, based on a “*distinctive* use of common techniques, such as shiny edges and

sandblasting, . . . merely for creating the *distinctive* aesthetic appearance of Wong jewelry,” was not clearly erroneous under Ninth Circuit precedents. *Id.* at *4 (emphasis added). Here, Plaintiff’s asserted trade dress does not describe a distinctive use of common techniques to *create* a distinctive aesthetic appearance because Plaintiff does not in any way arbitrarily alter the [REDACTED] functional designs of the elastic choker washer necklaces and bottle cap magnets themselves. Rather, Plaintiff’s asserted trade dress describes a combination of [REDACTED] functional features. Moreover, Plaintiff merely uses common arts and crafts techniques to join common objects in the easiest and most efficient manner. *See, e.g.*, Def.’s Ex. A, Dkt. 83-1; *cf.* Def.’s Ex. G, Dkt. 83-7. [REDACTED]. At best, the decorative and potentially copyrightable designs on the internal surfaces of the bottle caps create the only aesthetic appearance of Plaintiff’s products; however, Plaintiff does not and cannot assert trade dress in any of these decorative and potentially copyrightable designs.

3. Plaintiff’s evidence of alternative designs is irrelevant

Plaintiff references certain exhibits and pictures to argue that Defendants can avoid competitive disadvantage in the market for pre-teen and teen jewelry by using alternative designs. *See* Pl.’s Response, Dkt. 96, pp. 10–11, 21, 38–41. This evidence is irrelevant. Because Defendants have shown that Plaintiff’s asserted trade dress is functional, there is no need to consider alternative designs. *See Traffix*, 532 U.S. at 33–34; *Eppendorf*, 289 F.3d at 355–56. The availability of equally efficient options also does not change the analysis when alternative designs will serve the same purpose. *See Specialized Seating, Inc. v. Greenwich Indus., L.P.*, 616 F.3d 722, 727 (7th Cir. 2010) (reasoning an x-frame chair design “is functional not because it is the only way to do things, but because it represents one of many solutions to a problem”). For

example, the purpose of the zinc plated steel washers attached to the nylon chokers and the magnets glued to the top of the bottle caps is to magnetically join them to form interchangeable, bottle cap necklaces. These features are functional because use of any other non-visible metallic and magnetic objects would serve the same purpose. Even under the “competitive necessity” test, Plaintiff’s evidence of available alternatives is misleading and irrelevant. For example, Plaintiff’s suggestions for using round or square metal discs instead of bottle caps, and using chains with hooks and loops instead of nylon chokers tied to washers, would result in *different* products. This is the same as saying that a jewelry maker can effectively compete in the market for diamond stud earrings by selling dangling pearl earrings instead. In this case, the relevant market is for consumers seeking interchangeable, bottle cap magnet necklaces, not the entire jewelry market or even the pre-teen and teen jewelry market. If Plaintiff were to have a monopoly on [REDACTED] interchangeable, bottle cap magnet necklaces, there would clearly be no competition in that market based on a non-reputation related competitive disadvantage.

4. Plaintiff’s “functionality” expert is unqualified and his report inadmissible

Plaintiff supports some of its arguments based on the report of an apparent “functionality” expert, Dallas patent lawyer Steven E. Ross. Pl.’s Response, Dkt. 96, pp. 2, 10–11, 20–21, 38, 41. While expert testimony is admissible when it will assist the trier of fact in understanding the evidence or determining a disputed issue of fact, *see* Fed. R. Evid. 702, it is well established that legal opinion evidence about what the law is and how the law should apply to the facts of a particular case—whether given by lawyers, law professors, or other experts—is inadmissible. *See Pinal Creek Group v. Newmont Mining Corp.*, 352 F. Supp. 2d 1037, 1042–43 (D. Az. 2005); *In re Initial Pub. Offering Sec. Litig.*, 174 F. Supp. 2d 61, 64–65 (S.D.N.Y. 2001)

(citing *Snap-Drape, Inc. v. Comm'r*, 98 F.3d 194, 198 (5th Cir. 1996); *Nieves-Villanueva v. Soto-Rivera*, 133 F.3d 92, 100 (1st Cir. 1997); *Weston v. Wash. Metro. Area Transit Auth.*, 78 F.3d 682, 684 n.4 (D.C. Cir. 1996); *United States v. Sinclair*, 74 F.3d 753, 757–58 n.1 (7th Cir. 1996); *Peterson v. City of Plymouth*, 60 F.3d 469, 475 (8th Cir. 1995); *Berry v. City of Detroit*, 25 F.3d 1342, 1353 (6th Cir. 1994); *Aguilar v. Int'l Longshoremen's Union Local # 10*, 966 F.2d 443, 447 (9th Cir. 1992); *United States v. Leo*, 941 F.2d 181, 196 (3rd Cir. 1991); *Montgomery v. Aetna Cas. & Sur. Co.*, 898 F.2d 1537, 1541 (11th Cir. 1990); *Specht v. Jensen*, 853 F.2d 805, 807 (10th Cir. 1988) (en banc); *Adalman v. Baker, Watts & Co.*, 807 F.2d 359, 368 (4th Cir. 1986)). Here, the declaration of Mr. Ross is nothing more than duplicative legal arguments of mere advocacy. See Pl.'s SEALED Ex. 9, Dkt. 96-1, App. 154–72. Thus, this declaration is inadmissible legal opinion evidence.

In addition, an expert witness must be qualified “by knowledge, skill, experience, training, or education” in the subject matter of his testimony. See Fed. R. Evid. 702. Mr. Ross is not qualified to give an opinion on jewelry design, much less interchangeable, bottle cap necklaces. His qualifications include that he has a BS and MS in mechanical engineering before attending law school at SMU. See Pl.'s SEALED Ex. 9, Dkt. 96-1, App. 155–57; see also http://www.rossipg.com/sross_bio.html. While he may be a highly skilled patent attorney, he has no discernible experience in craft art like the subject bottle cap magnets and elastic choker washer necklaces in this case.

Accordingly, the Court does not need and should not consider any duplicative arguments from another lawyer to understand the law on trade dress and determine as a matter of law the functionality of bottle cap magnets and elastic choker washer necklaces.

C. Plaintiff's "Preliminary Issues" Arguments Are Irrelevant

Financial Resources: Plaintiff argues that the present case proves it does not have a business practice of bringing baseless suits to push out competition in the bottle cap jewelry market because it has a financially inferior position in this particular litigation. Pl.'s Response, Dkt. 96, pp. 24–25. This argument is untenable.¹⁴ Defendants' defense fund is less than half of Plaintiff's resources. It just so happens that Plaintiff has sued the only mom and pop competitor that can afford to defend itself.

Settlement Agreements: Plaintiff argues that its settlement agreements with competitors are proof of the validity of its trade dress claims. Pl.'s Response, Dkt. 96, p. 25. This argument has no merit. Evidence of an agreement to compromise a claim is not relevant or admissible to prove the validity of the claim. Fed. R. Evid. 408. Plaintiff has not and cannot cite any authority to support that a settlement agreement can prove the validity of a plaintiff's former or current claims. As a practical matter, parties to a lawsuit may have any number of reasons to settle their dispute, including lack of financial resources, a cost-benefit decision to avoid costly litigation, a desire to avoid the emotional turmoil of a trial, or to simply make peace. None of these reasons would retroactively or prospectively prove the validity of Plaintiff's claims, even if the Rules of Evidence did not apply.

Scope of Motion: Plaintiff argues that Defendants' Motion mistakenly seeks to resolve Plaintiff's trademark claims in addition to its trade dress claims. Pl.'s Response, Dkt. 96, p. 26. The clear intent of the Motion is to dispose of the six trade dress causes of action in Counts I

¹⁴ Plaintiff is paying its attorney \$425.00 per hour. Defendants' insurance carrier is paying Defendants' attorney \$175.00 per hour.

through V and VIII of Plaintiff’s complaint.¹⁵ See Def.’s Motion, Dkt. 81, p. 1. The analysis of Plaintiff’s trade dress claims under the Lanham Act will be “dispositive of its corresponding claims under Texas law.” See *Amazing Spaces, Inc. v. Metro Mini Storage*, 608 F.3d 225, 235 n.7 (5th Cir. 2010).

CAPSTERS book: Plaintiff argues that Defendants’ emphasis on the CAPSTERS book is misplaced because it does not show any of the different permutations of Plaintiff’s asserted trade dress and there is no evidence that anyone was aware of or purchased the book. Pl.’s Response, Dkt. 96, 26–27. The CAPSTERS book shows the functionality and permutations of Plaintiff’s trade dress [REDACTED]

[REDACTED]. The CAPSTERS book provides evidence that [REDACTED] decorated bottle caps, bottle cap magnets, and bottle cap jewelry—including bottle cap necklaces—publicly existed before Plaintiff began marketing and selling its products. See *supra* at 11. Therefore, these arguments are irrelevant.

Tabberone website: Plaintiff argues that the Defendants want the Court to rely on information from the “Tabberone” website to determine that Plaintiff’s claims “in the present matter” are invalid. Pl.’s Response, Dkt. 96, p. 27. This is incorrect. In recounting certain procedural facts in the case, Defendants’ referenced the Tabberone website in one footnote concerning Plaintiff’s invalid copyright claims because Plaintiff plagiarized its designs. See Def.’s Brief, Dkt. 82, p. 5 n.3.

D. Plaintiff’s Evidence of Secondary Meaning Is Irrelevant, Inadmissible, and Insufficient

¹⁵ Unfortunately, page 6 of part one of Defendants’ memorandum in support of the Motion mistakenly listed Count VI of Plaintiff’s complaint. For the record, the Motion does not seek to resolve Plaintiff’s trademark claims.

Plaintiff argues that its survey evidence, and evidence of marketing efforts, sales levels, and settlement agreements provide proof of secondary meaning. Pl.’s Response, Dkt. 96, pp. 6–7, 18, 33–34. This motion is directed to the functionality of Plaintiff’s asserted trade dress. Defendants’ have shown there is no genuine issue of material fact regarding the functionality of Plaintiff’s trade dress. Where the functionality of asserted trade dress is shown, evidence of secondary meaning becomes irrelevant. *See Traffix*, 532 U.S. at 33. Thus, Plaintiff’s marketing survey, survey expert report, and documents summarizing Plaintiff’s marketing efforts and sales levels are irrelevant. In addition, the settlement agreements are irrelevant because there is nothing significant about such agreements to show that consumers associate alleged trade dress with a particular source.

Plaintiff also argues that its evidence of secondary meaning, as a presumed consequence, provides proof of the non-functionality of its trade dress. Pl.’s Response, Dkt. 96, pp. 33–34. This argument is incorrect. Plaintiff has the burden to prove non-functionality and secondary meaning as separate elements of a claim for trade dress infringement. *See McNeil Nutritionals*, 511 F.3d at 357. Plaintiff does not and cannot cite any authority to support that evidence of secondary meaning mutates functional trade dress into non-functional trade dress.¹⁶

Nevertheless, the documents that summarize Plaintiff’s marketing efforts and sales levels would be insufficient to prove secondary meaning. Although “volume of sales,” “amount and manner of advertising,” and “nature of use of the . . . trade dress in newspapers and magazines” are relevant factors to consider, courts in the Fifth Circuit generally require an objective survey

■ [REDACTED]

to establish secondary meaning. *See, e.g., Amazing Spaces*, 608 F.3d at 247–49. This is so because secondary meaning is an empirical inquiry into the public’s mental association between the alleged trade dress and trade dress holder. *Id.* at 247–48. Here, the survey is inadmissible for the reasons stated in Part Two of this Reply. In addition, none of Plaintiff’s sales and marketing evidence addresses consumer perceptions of its products, let alone public association of its alleged trade dress. Plaintiff also cannot claim the monopolistic and exclusive right to produce interchangeable, bottle cap magnets and elastic choker washer necklaces simply because significant promotional investment and market dominance may have caused some consumers to associate it with the [REDACTED] functional features of its products. *Cf. Traffix*, 532 U.S. at 34–35.

IV. CONCLUSION

For the reasons set forth above, Defendants respectfully request that the Court dismiss Plaintiff’s trade dress claims with prejudice because Plaintiff’s asserted trade dress consists of [REDACTED] functional features with no significance for identifying source, and there is no genuine issue of material fact as to the functionality of Plaintiff’s asserted trade dress.

Respectfully submitted,

Charles W. Hanor
Charles W. Hanor, P.C.
750 Rittiman Road
San Antonio, Texas 78209
Telephone: (210) 829-2002
Fax: (210) 829-2001



By _____
Charles W. Hanor
Texas Bar No. 08928800

ATTORNEYS FOR DEFENDANTS

CERTIFICATE OF SERVICE

I certify that the foregoing was served with the Clerk of Court on October 4, 2011 and on Defendants' counsel by Electronic Mail (ECF-Pacer) using the ECF system, which will send notification of such filing to the following:

D. Scott Hemingway
Hemingway & Hansen, L.L.P.
1700 Pacific Avenue, Suite 4800
Dallas, TX 75201
Counsel for Plaintiff
shemingway@hemlaw.org



Charles W. Hanor