

**UNITED STATES DISTRICT COURT
CENTRAL DISTRICT OF CALIFORNIA**

KATZKIN LEATHER, INC.,
Plaintiff,

v.

ROADWIRE, LLC,
Defendant.

CV 20-2093 DSF (RAOx)

Order DENYING Katzkin
Leather, LLC's Motion for
Summary Judgment (Dkt. 152)
and GRANTING Roadwire,
LLC's Motion for Summary
Judgment (Dkt. 155)

Plaintiff Katzkin Leather, LLC moves for partial summary judgment on its claims for counterfeiting, trade dress infringement, unfair competition, and trademark infringement. Dkt. 152-1 (Katzkin Mot.). Defendant Roadwire, LLC opposes. Dkt. 175 (Roadwire Opp'n). Roadwire moves for summary judgment on Katzkin's claims. Dkt. 155-1 (Roadwire Mot.). Katzkin opposes. Dkt. 171 (Katzkin Opp'n). The Court deems these matters appropriate for decision without oral argument. See Fed. R. Civ. P. 78; Local Rule 7-15. Katzkin's motion is DENIED. Roadwire's motion is GRANTED.

I. UNDISPUTED FACTS

Katzkin manufactures and sells aftermarket leather automotive upholstery products in the United States. DSUF ¶ 3.¹ It markets and

¹ Citations to DSUF refer to Katzkin's Statement of Disputed and Genuine Issues of Material Fact, dkt. 172, which incorporates Roadwire's proposed uncontroverted facts and Katzkin's responses to those facts. Citations to PSUF refer to Roadwire's Statement of Genuine Disputes, dkt. 176, which incorporates Katzkin's proposed uncontroverted facts and Roadwire's responses to those facts. Where the Court cites to a disputed fact, the Court

advertises its products to car manufacturers and dealerships, independent car interior installers, and consumers through its website, katzkin.com, and to its selling partners, which include car manufacturers and dealerships and automotive restyling shops, at katzkintoolbox.com. Id. ¶ 4.

Roadwire also sells aftermarket leather upholstery products in the United States. Id. ¶ 1. It owns the websites roadwire.com, roadwireleather.com, and sales.roadwire.com. Id. ¶ 2.

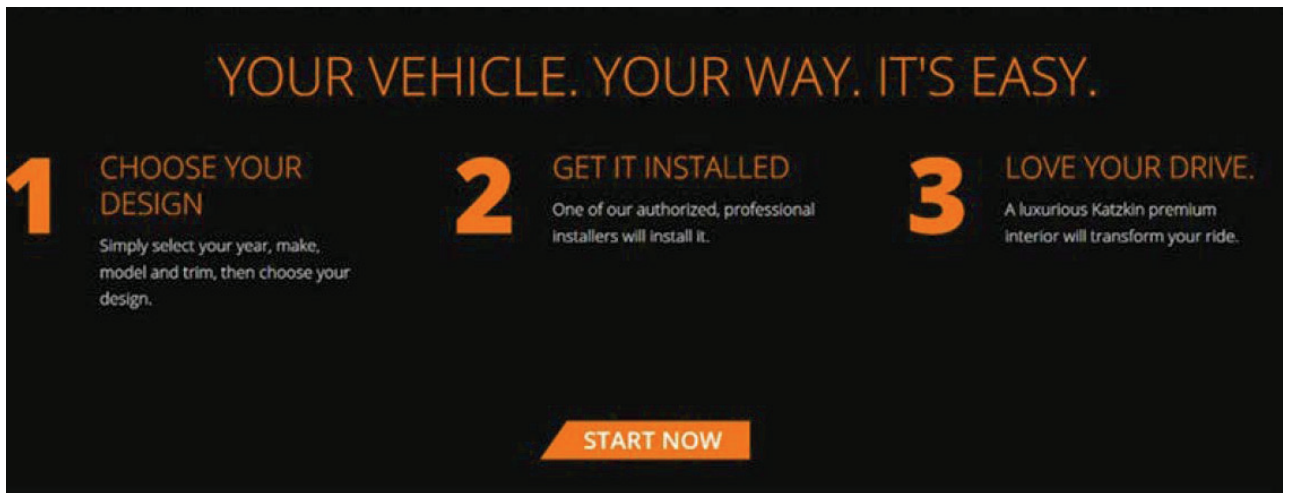
Roadwire and Katzkin are direct competitors. PSUF ¶ 6.

Katzkin owns a trademark registration for “LOVE YOUR DRIVE”² for “Automotive interior trim of leather and vinyl for cars and trucks; upholstery for cars and trucks; Leather accessories, namely, leather coverings for vehicle interior surfaces; Fitted leather coverings for automobile interior surfaces; Automotive interior trim; Seat covers for vehicles; Door panels for land vehicles.” DSUF ¶ 6. “LOVE YOUR DRIVE” is Katzkin’s trademark registered on August 22, 2017 with its first use in commerce on May 1, 2017. Id. ¶ 5; PSUF ¶ 1. Since 2010, Katzkin has spent money to promote and advertise its business and has used “LOVE YOUR DRIVE” in those advertisements and promotions.” PSUF ¶ 28.

has found the dispute was not valid or was irrelevant, unless otherwise indicated. The Court has independently considered the admissibility of the evidence and has not considered facts that are irrelevant or based on inadmissible evidence.

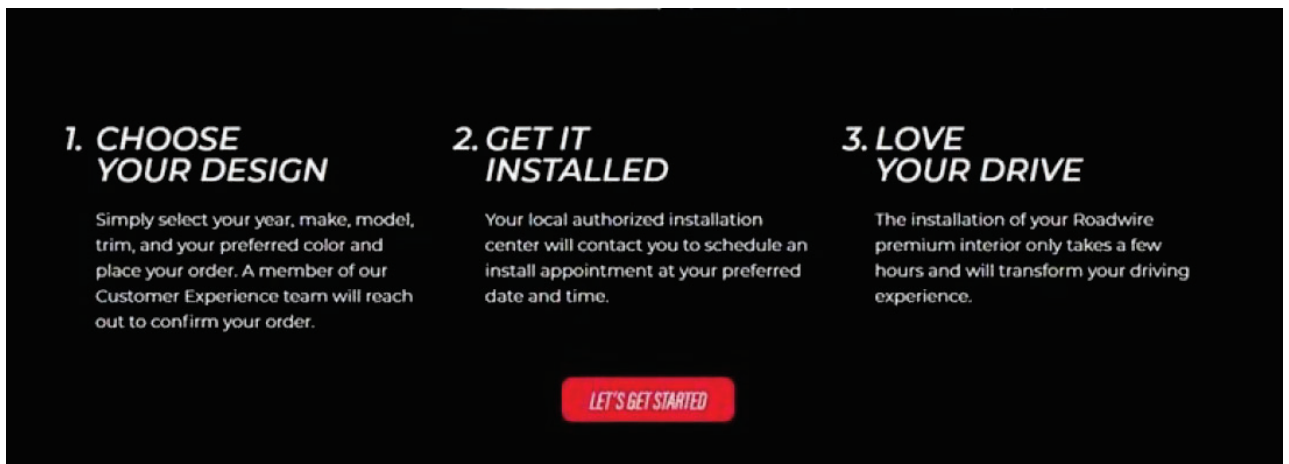
² The parties variously refer to “LOVE YOUR DRIVE,” “Love Your Drive,” and “love your drive,” all of which appear to refer to the same trademark.

Katzkin’s use of “LOVE YOUR DRIVE” appears as follows on its website:



Dkt. 1 (Compl.) ¶ 31. Katzkin does not have registered trademarks for the phrases “CHOOSE YOUR DESIGN” or “GET IT INSTALLED,” which also appear on katzkin.com. DSUF ¶ 47.

Roadwire’s roadwireleather.com website became viewable to the public in around July 2019. *Id.* ¶ 11. The phrase “LOVE YOUR DRIVE” appeared on roadwireleather.com from July 2019 to March 2020, when Katzkin initiated this action, and on Facebook advertising from July 2019 through at least August 2019 and perhaps through December 2019. *Id.* ¶¶ 13-14, 18, 50-51. “Love Your Drive” appeared as follows:



Compl. ¶ 28. The Facebook advertisement was posted through the “Roadwire Leather” account and stated in relevant part, “Simply choose your design, have it installed by a Roadwire professional and love your drive!” Id. ¶ 63.



Roadwire has not used the phrase “love your drive” on roadwireleather.com since March 2020, and has instead used the phrase “transform your drive” to advertise its automotive interior leather seat covers:

<p>1. START YOUR DESIGN</p> <p>Select your make, model, year, cabin type, preferred seat design and color and submit. Our Customer Experience team will reach out to confirm your selections and provide a price quote.</p>	<p>2. GET IT INSTALLED</p> <p>When you're ready to place your order, your local authorized installation center will contact you to schedule an install appointment at your preferred date and time.</p>	<p>3. TRANSFORM YOUR DRIVE</p> <p>The installation of your Roadwire premium interior only takes a few hours and will transform your driving experience.</p>
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[LET'S GET STARTED](#)

DSUF ¶¶ 44-45; PSUF ¶ 12. The sales.roadwire.com website did not and currently does not use the phrase “LOVE YOUR DRIVE.” PSUF ¶ 35.

II. LEGAL STANDARD

“A party may move for summary judgment, identifying each claim or defense – or the part of each claim or defense – on which summary judgment is sought. The court shall grant summary judgment if the movant shows 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). “This burden is not a light one.” In re Oracle Corp. Sec. Litig., 627 F.3d 376, 387 (9th Cir. 2010). But the moving party need not disprove the opposing party’s case. Celotex Corp. v. Catrett, 477 U.S. 317, 323 (1986). Rather, if the moving party satisfies this burden, the party opposing the motion must set forth specific facts, through affidavits or admissible discovery materials, showing that there exists a genuine issue for trial. Id. at 323-24; Fed. R. Civ. P. 56(c)(1). A non-moving party who bears the burden of proof at trial as to an element essential to its case must make a showing sufficient to establish a genuine dispute of fact with respect to the existence of that element of the case or be subject to summary judgment. See Celotex Corp., 477 U.S. at 322.

The “mere existence of *some* alleged factual dispute between the parties will not defeat an otherwise properly supported motion for summary judgment; the requirement is that there be no *genuine* issue of *material* fact.” Anderson v. Liberty Lobby, Inc., 477 U.S. 242, 247-48 (1986). An issue of fact is a genuine issue if it reasonably can be resolved in favor of either party. Id. at 250-51. “The mere existence of a scintilla of evidence in support of the [non-movant’s] position will be insufficient; there must be evidence on which the jury . . . could find by a preponderance of the evidence that the [non-movant] is entitled to a verdict” Id. at 252. “Only disputes over facts that might affect the outcome of the suit under the governing law will properly preclude the entry of summary judgment.” Id. at 248.

“[A] district court is not entitled to weigh the evidence and resolve disputed underlying factual issues.” Chevron Corp. v. Pennzoil Co., 974 F.2d 1156, 1161 (9th Cir. 1992). Summary judgment is improper ‘where divergent ultimate inferences may reasonably be drawn from the undisputed facts.’” Fresno Motors v. Mercedes Benz USA, LLC, 771 F.3d 1119, 1125 (9th Cir. 2014). Instead, “the inferences to be drawn from the underlying facts must be viewed in the light most favorable to the party opposing the motion.” Matsushita Elec. Indus. Co. v. Zenith Radio Corp., 475 U.S. 574, 587-88 (1986) (internal quotation marks and ellipsis omitted).

“[W]hen parties submit cross-motions for summary judgment, each motion must be considered on its own merits.” Fair Hous. Council of Riverside Cnty., Inc. v. Riverside Two, 249 F.3d 1132, 1136 (9th Cir. 2001) (simplified). In doing so, the Court must consider the evidence submitted in support of both motions before ruling on each of them. Id.

III. DISCUSSION

A. Evidentiary Objections

“A district court’s ruling on a motion for summary judgment may only be based on admissible evidence.” Oracle, 627 F.3d at 385. A party seeking to admit evidence bears the burden of proof to show its admissibility. Id. “At the summary judgment stage, [the court does]

not focus on the admissibility of the evidence's form. [The court] instead focus[es] on the admissibility of its contents." Fraser v. Goodale, 342 F.3d 1032, 1036 (9th Cir. 2003).

Generally, an objection to evidence on the ground that it is "irrelevant . . . [is] duplicative of the summary judgment standard itself" and thus "redundant" and unnecessary to consider here. Burch v. Regents of Univ. of Cal., 433 F. Supp. 2d 1110, 1119 (E.D. Cal. 2006); see also Anderson, 477 U.S. at 248 ("Factual disputes that are irrelevant or unnecessary will not be counted.").

1. Katzkin's Objections

Katzkin submitted fifteen pages of evidentiary objections, totaling hundreds of individual objections. Dkt. 173 (Katzkin Objections). The Court will not scrutinize each objection and give a full analysis of identical objections to purported evidence. See Doe v. Starbucks, Inc., No. SACV 08-0582 AG (CWx), 2009 WL 5183773, at *1 (C.D. Cal. Dec. 18, 2009) (addressing "only objections to evidence that is central to the issues discussed in this Order"); see also Capitol Recs., LLC v. BlueBeat, Inc., 765 F. Supp. 2d 1198, 1200 n.1 (C.D. Cal. 2010) ("In motions for summary judgment with numerous objections, it is often unnecessary and impractical for a court to methodically scrutinize each objection and give a full analysis of each argument raised." (quoting Doe, 2009 WL 5183773, at *1)).

In making its decision, the Court examined the underlying evidence cited by the parties and did not rely on any inadmissible evidence.

2. Roadwire's Objections

Roadwire makes substantial, but more targeted objections. Roadwire objects to numerous statements in the declarations of Tim Clyde, Dara Ward, Theo Mandel, and Suzelle Smith. Dkt. 191 (Roadwire Objections).

a. Clyde Declaration

Roadwire objects to twelve paragraphs of the Declaration of Tim Clyde, Dkt. 171-1. Roadwire Objections at 3-4 (Nos. 1-12). Roadwire asserts that the Clyde Declaration is a sham on the grounds that Clyde testified in deposition that he did not know if Katzkin created the frequently asked questions (FAQs) on its website, but in paragraphs 8 and 11 he declares Katzkin wrote the FAQs. Id. Roadwire similarly objects to paragraph 17 because Clyde states exactly how many “unique visitors” the Katzkin website had in June 2017, but Clyde had “no knowledge of that information while testifying” in deposition. Id. at 7.

Under the “sham affidavit rule,” a party generally cannot rely on a declaration that contradicts a prior sworn statement. Yeager v. Bowlin, 693 F.3d 1076, 1080 (9th Cir. 2012) (quoting Van Asdale v. Int’l Game Tech., 577 F.3d 989, 998 (9th Cir. 2009)). The rule “‘should be applied with caution’ because it is in tension with the principle that the court is not to make credibility determinations when granting or denying summary judgment.” Id. “In order to trigger the sham affidavit rule, the district court must make a factual determination that the contradiction is a sham, and the ‘inconsistency between a party’s . . . testimony and subsequent affidavit must be clear and unambiguous to justify striking the affidavit.” Id.

The Court has reviewed Clyde’s deposition testimony. He testified that he did not have a record demonstrating that a Katzkin employee wrote the FAQs on its website, but he named the person he believed wrote them, based on his discussion with other Katzkin personnel. Dkt. 155-4 (Clyde Dep.) at 185:6-25. The statement in his declaration is not a sham because his statement does not contradict his testimony that he believed a Katzkin employee wrote the FAQs. Additionally, Roadwire does not cite deposition testimony that contradicts the number of “unique visitors” to Katzkin’s website stated in Clyde’s declaration. Roadwire asserts that Clyde had no knowledge of facts related to “unique visitors” when testifying but does not cite to any portion of the deposition confirming that either. And Clyde may have learned that information later.

Roadwire also objects to statements in paragraphs 12-14 and 16-19 of the Clyde Declaration as lacking foundation, calling for a legal conclusion, and constituting an improper expert opinion. Roadwire Objections at 5-8. The Court does not base its decision on any of the statements to which Roadwire objects.

b. Declaration of Dara Ward

Roadwire objects to paragraph 4 of the Declaration of Dara Ward, dkt. 171-2, on the grounds that the description of a Facebook feed and the presence of advertisements on Facebook lacks foundation and is an improper expert opinion. Roadwire Objections at 9 (No. 13). The Court does not rely on the information in paragraph 4 of the Ward Declaration.

c. Declaration of Theo Mandel

Roadwire objects to statements in paragraphs 2-16 of the Declaration of Theo Mandel, Ph.D., dkt. 171-3 (Mandel Decl.), on the grounds that they lack foundation, have no basis for an expert opinion, call for a legal conclusion, constitute improper testimony as to ultimate legal issues, or are “not based on sound science or any cognizable methodology.” Roadwire Objections at 9-17 (Nos. 14-32).

The Court does not rely on the Mandel Declaration except to the extent discussed below.

d. Declaration of Suzelle Smith

Roadwire objects to Exhibit 13 to the Declaration of Suzelle Smith, dkt. 171-8, on the grounds that it lacks foundation, calls for a legal conclusion, constitutes improper testimony as to ultimate legal issues, and is “not based on sound science or any cognizable methodology.” Roadwire Objections at 17 (No. 33). Exhibit 13 consists of excerpts from the deposition of Dr. Theo Mandel discussing whether elements of the Katzkin and Roadwire websites are functional, and the Court does not rely on these excerpts in its decision.

e. Mandel's Expert Report

As a follow-up to its previously-filed motion to exclude Mandel's expert report (dkt. 90), Roadwire objects to the report as an unsworn expert report that is also inadmissible as hearsay because it is an out-of-court statement offered to prove the truth of the matters asserted in the report. See, e.g. PSUF ¶ 23 (objecting to Mandel Report as hearsay and as an unsworn report); Opp'n to Katzkin Mot. at 9.

“Expert opinion is admissible and may defeat summary judgment if it appears the affiant is competent to give an expert opinion and the factual basis for the opinion is stated in the affidavit, even though the underlying factual details and reasoning upon which the opinion is based are not.” Bulthuis v. Rexall Corp., 789 F.2d 1315, 1318 (9th Cir. 1985). However, an unauthenticated expert report is inadmissible on summary judgment. Orr v. Bank of Am., NT & SA, 285 F.3d 764, 773 (9th Cir. 2002) (“We have repeatedly held that unauthenticated documents cannot be considered in a motion for summary judgment.”).

In its Reply in support of its motion, Katzkin submitted a supplemental declaration from Mandel (1) confirming that his report includes information that he either has “personal knowledge of, was information provided in discovery by the parties and/or was information of the type and nature that experts in [his] areas of expertise normally rely on in forming opinions”; and (2) reaffirming the contents of his report. Dkt. 187-1. This authentication of Mandel's report is sufficient.

B. Liability

1. Trademark Infringement

Katzkin brings a trademark infringement claim under 15 U.S.C. § 1114(1)(a), which states:

(1) Any person who shall, without the consent of the registrant –

(a) use in commerce any reproduction, counterfeit, copy, or colorable imitation of a registered mark in connection with the sale, offering for sale, distribution, or advertising of any goods or services on or in connection with which such use is likely to cause confusion, or to cause mistake, or to deceive . . . shall be liable in a civil action by the registrant for the remedies hereinafter provided.

To prevail, Katzkin must establish that (1) it has a valid, protectable trademark or trade dress; and (2) the alleged infringer's use of the same or a similar mark causes a likelihood of confusion in the minds of the relevant consuming public. See Fuddruckers, Inc. v. Doc's B.R. Others, Inc., 826 F.2d 837, 841 (9th Cir. 1987). "The confusion must be probable, not simply a possibility." Murray v. Cable Nat'l Broad. Co., 86 F.3d 858, 860 (9th Cir. 1996) (internal quotation marks omitted).

"Because of the intensely factual nature of trademark disputes, summary judgment is generally disfavored in the trademark arena." Rearden LLC v. Rearden Com., Inc., 683 F.3d 1190, 1202 (9th Cir. 2012). Nevertheless, both parties seek summary judgment here. Roadwire contends Katzkin cannot prevail on its trademark infringement claim because (1) Roadwire's use of the phrase "Love Your Drive" was a non-trademark use as it was not used as a source identifier; and (2) Katzkin cannot establish likelihood of confusion. Roadwire Mot. at 20-21. In its own motion, Katzkin argues that it should prevail because Roadwire's use of "Love Your Drive" is likely to cause confusion. Katzkin Mot. at 3.³

³ Katzkin also argues that Roadwire's use of the phrase "Transform Your Drive" constitutes trademark infringement, but the Court disregards this argument because Katzkin does not have trademark rights in "Transform Your Drive." See Katzkin Mot. at 5. That Katzkin also uses the word "transform" on its website does not mean it can prevent Roadwire from using that word as well. The Court also rejects Katzkin's attempt to claim infringement of "Transform Your Drive" because Katzkin did not assert a

a. Likelihood of Confusion

To determine whether a defendant's use of a mark is likely to confuse consumers, courts look to the eight Sleekcraft factors: "(1) strength of the mark; (2) proximity of the goods; (3) similarity of the marks; (4) evidence of actual confusion; (5) marketing channels used; (6) degree of care likely to be exercised by the consumer; (7) defendant's intent in selecting the mark; and (8) likelihood of expansion of the product lines." AMF Inc. v. Sleekcraft Boats, 599 F.2d 341, 348-49 (9th Cir. 1979). "[T]his multi-factor approach must be applied in a flexible fashion." Rearden LLC., 683 F.3d at 1209 (recognizing that the Sleekcraft factors are "not a rote checklist"). "A determination may rest on only those factors that are most pertinent to the particular case before the court, and other variables besides the enumerated factors should also be taken into account based on the particular circumstances." Id. "The [Sleekcraft] test is a fluid one and the plaintiff need not satisfy every factor, provided that strong showings are made with respect to some of them." Survivor Media, Inc. v. Survivor Prods., 406 F.3d 625, 631 (9th Cir. 2005).

The Court finds a reasonable consumer would not be likely to be confused by Roadwire's use of "Love Your Drive." Several of the Sleekcraft factors weigh heavily in Roadwire's favor.

Strength of the mark: Through Mandel's report, Katzkin argues its mark is strong because its meaning is unrelated to automotive interiors in general, and it is not descriptive or suggestive of a seat cover. Mandel Report at 53. While the Court agrees that the phrase "Love Your Drive" does not specifically relate to automotive interiors and does not describe a seat cover, it does have a clear relationship to vehicles

trademark infringement claim based on that phrase after Roadwire changed the phrase on its website from "love your drive" to "transform your drive" following the filing of the Complaint. In any event, Katzkin's arguments are not convincing.

because of the word “drive.” The Court finds this factor weighs somewhat in favor of Katzkin.

Proximity of the Goods and Marketing Channels Used: Roadwire and Katzkin are direct competitors and sell similar goods: leather car interiors and related products. DSUF ¶¶ 1, 3; PSUF ¶ 6. The competitive proximity of their products is therefore high, and this factor favors Katzkin. Both Katzkin and Roadwire advertise their products through similar online marketing channels by advertising their products online to consumers, as well as to restylers, who frequently sell both Katzkin and Roadwire products. DSUF ¶ 56. Additionally, while Roadwire contends its Facebook advertising at issue in this case was limited to interest in just two truck models and targeted individuals residing in California and Texas, *id.* ¶ 19, this does not mean Roadwire and Katzkin are not in close competitive proximity with respect to their leather interior products in general. This factor also weighs in Katzkin’s favor.

Similarity of the Marks: Most notably, however, the factor of similarity of the marks weighs in Roadwire’s favor. Similarity of two marks “must be considered in light of the way the marks are encountered in the marketplace” Lindy Pen Co. v. Bic Pen Corp., 725 F.2d 1240, 1245 (9th Cir. 1984). It is undisputed that Roadwire used the phrase “love your drive” on its website until it changed the website following the filing of this suit, DSUF ¶ 51, but viewing the parties’ use of “Love Your Drive” in the context in which they appeared to consumers, the Court finds a reasonable consumer would not be likely to be confused despite the use of the same phrase.

Katzkin’s expert, Mandel, opined that Roadwire’s “literal copying” of the “Love Your Drive” mark on its website “create[s] an overall impression of similarity in the marketplace.” Mandel Report at 54. However, the prominent placement of Katzkin’s and Roadwire’s names on their respective websites renders it implausible that a reasonable consumer would be likely to be confused. In Arcona, Inc. v. Farmacy Beauty, LLC, for example, the Ninth Circuit affirmed the district court’s finding on summary judgment that there was no

likelihood of confusion, noting that “it is implausible that a consumer would be deceived because the products had their respective housemarks . . . prominently on the packaging.” 976 F.3d 1074, 1081 (9th Cir. 2020) (citing Pignons S.A. de Mecanique de Precision v. Polaroid Corp., 657 F.2d 482, 487 (1st Cir. 1981) (“[O]therwise similar marks are not likely to be confused where used in conjunction with the clearly displayed name and/or logo of the manufacturer”)); see also Lodestar Anstalt v. Bacardi & Co. Ltd., --- F.4th ---, 2022 WL 1180767, at *21 (9th Cir. Apr. 21, 2022) (when “two parties use the same or similar marks ‘merely as a tagline to their distinctive business names,’ the subordinate position of that tagline mark to their ‘housemarks’ weighs against a likelihood of confusion.”).

While Katzkin and Roadwire each used “Love Your Drive” on their websites, the text immediately below that phrase indicates the name of the company providing the advertisement, and the webpages prominently feature the companies’ names numerous times, including in large, bold font. See dkt. 152-10 (Katzkin website), 152-12 (Roadwire website); see also Compl. ¶ 28 (pre-suit version of Roadwire website). Further, while Katzkin’s website prominently features the phrase “Love Your Drive” in its logo, Roadwire did not. Id. Additionally, while Roadwire admits it used the phrase “Love Your Drive” on a single Facebook post and a YouTube video, PSUF ¶¶ 9, 11, the Facebook advertisement was posted by the “Roadwire Leather” account and used the word “Roadwire” four times in the single advertisement, and the profile image on Roadwire’s Facebook account, which appears in the advertisement, contains Roadwire’s housemark.⁴ This factor weighs in favor of Roadwire.

⁴ The Mandel Declaration states that the YouTube video “walks the viewer through the original roadwireleather.com homepage, where the Love Your Drive phrase is clearly visible.” Mandel Decl. ¶ 3. However, Katzkin’s motion is devoid of any discussion of the YouTube video beyond the mere fact that it contained the phrase “love your drive,” and Katzkin has therefore not met its summary judgment burden of demonstrating infringement through Roadwire’s YouTube video.

Evidence of Actual Confusion: Katzkin presents no evidence of actual confusion by consumers. See Katzkin Mot. at 3-5. In fact, it is undisputed that “Katzkin has no evidence of actual confusion by a customer based on the Roadwire infringement,” DSUF ¶ 56, although Katzkin contends there is “overwhelming evidence of likelihood of confusion.” Id. Mandel refers in his report to a statement made by Katzkin’s representative, Tim Clyde, however, that one customer was confused because he/she thought he/she had bought a Katzkin leather interior but had in fact bought one made by Roadwire. This is unconvincing at best as the sole evidence of actual confusion, and there is no indication that the consumer had viewed Roadwire’s website or advertising before purchasing the Roadwire product, or even that the purchase was made during the time Roadwire was using “love your drive.” See dkt. 164 (Mandel Report) at 54. This factor weighs in Roadwire’s favor.

Degree of Care Exercised by Consumer: Roadwire did not meaningfully brief the degree of care factor. Katzkin addresses this issue only through the Mandel Report, which is discussed below. The Court finds this factor weighs in Roadwire’s favor because neither Roadwire’s nor Katzkin’s websites are “direct sales” websites, meaning a consumer cannot buy a product directly from either website. DSUF ¶ 20.⁵ Both websites “advertise and identify the origin of the products, and then the websites direct consumers to the manufacturers’ contact information, including phone numbers, on each website to purchase the products.” Id. Neither website has a checkout cart, so consumers cannot add an item on either website to their online shopping cart to complete their purchase. Id. Katzkin “sell[s] directly to consumers via its phone sales representatives” instead of through an online checkout cart. Mandel Report at 52. Similarly, Roadwire’s website indicates that consumers can complete the installation process

⁵ It is not clear whether Roadwire’s or Katzkin’s customers must initiate their purchases through the companies directly, or whether consumers can purchase Roadwire and Katzkin products directly from other sources without having to go through Roadwire or Katzkin at all.

after submitting an online form, after which they are contacted by an installer authorized by either Roadwire or Katzkin, see dkt. 152-12, and therefore they would have another opportunity to verify which company's products they were purchasing. Mandel opines that vehicle owners are not likely to examine the origin of their automotive interior and instead "are likely to accept the recommendation of the dealer from whom they purchased the car, or from the automotive shop they visit to inquire about replacing the vehicle interior." Mandel Report at 60. This appears to support Roadwire's position, not Katzkin's, because it suggests the websites or other advertising are not an important factor at all, or at least that the relevant analysis may actually be whether the dealer or automotive shop – and not the typical consumer – would be likely to be confused. Moreover, Mandel does not provide any support for this opinion, and he does not purport to have expertise in consumers' purchasing habits as they pertain to purchases of vehicle interiors, or related or similar products. He instead purports to have experience in "user interface design and user research, marketing, including use of intellectual property such as trademarks and trade dress, branding, consumer psychology, including online visual and interactive formats, trademarks, [and] registered trade slogans" Id. at 6. The Court therefore accords little weight to Mandel's opinion regarding consumer habits with respect to aftermarket vehicle interiors.

Defendant's Intent: Katzkin also does not argue that Roadwire intended to infringe Katzkin's registered mark by using the phrase "Love Your Drive" on its website. While Mandel states in his expert report that Roadwire knew "Love Your Drive" was trademarked, his only support for this conclusion is that the phrase has been trademarked by Katzkin since 2017. See Mandel Report at 54-55. But this conclusion is not based on any expertise Mandel purports to have and would not be helpful to the trier of fact as it does not require expertise at all. Additionally, in support of its argument that there is no likelihood of confusion, Roadwire argues that it removed the trademarked phrase from its website immediately after Katzkin

initiated this action. DSUF ¶ 51. This factor weighs in Roadwire’s favor.

The Court finds the Sleekcraft factors weigh in Roadwire’s favor. See Lodestar, 2022 WL 1180767 at *22 (holding no likelihood of confusion when only four Sleekcraft factors weighed against likelihood of confusion because the factors favoring confusion were “overwhelmingly offset” by factors weighing against confusion). Katzkin has not met its burden of demonstrating a likelihood of confusion, and Roadwire has met its burden of establishing there is no genuine dispute that a consumer would not be likely to be confused about the origin of Roadwire’s products.

b. Non-Trademark/Fair Use

Roadwire asserts a “classic fair use” defense, which applies when “the defendant has used the plaintiff’s mark to describe the defendant’s own product.” Cairns v. Franklin Mint Co., 292 F.3d 1139, 1150 (9th Cir. 2002). The classic fair use test “complements the likelihood of customer confusion analysis set forth in Sleekcraft” and does not replace it. Id. (emphasis removed). “To establish a classic fair use defense, a defendant must prove” that (1) “Defendant’s use of the term is not as a trademark or service mark”; (2) “Defendant uses the term ‘fairly and in good faith’”; and (3) Defendant uses the term only to describe its goods or services. Id. at 1151. “[T]he classic fair use defense is not available if there is a likelihood of customer confusion as to the origin of the product.” Id. Because the Court has found there is no triable issue of fact as to consumer confusion, the Court does not reach Roadwire’s fair use defense.

The Court GRANTS Roadwire’s motion as to the trademark infringement claim and DENIES Katzkin’s motion as to that claim.

2. Trade Dress

Katzkin and Roadwire both move for summary judgment on Katzkin’s trade dress infringement claim. Katzkin Mot. at 10; Roadwire Mot. at 9. This claim is based on Katzkin’s argument that

Roadwire copied the “look and feel” of Katzkin’s website. See Katzkin Mot. at 13 (“Roadwire’s website substantially imitates the overall look and feel of the Katzkin website, including use of the Love Your Drive mark to promote the sales of its virtually identical automotive interior leather seats”).

“To sustain a claim for trade dress infringement, [Katzkin] must prove: (1) that its claimed dress is nonfunctional; (2) that its claimed dress serves a source-identifying role either because it is inherently distinctive or has acquired secondary meaning; and (3) that the defendant’s product or service creates a likelihood of consumer confusion.” Clicks Billiards, Inc. v. Sixshooters, Inc., 251 F.3d 1252, 1258 (9th Cir. 2001).

“A trade dress has acquired secondary meaning when consumers associate the design features with a particular producer.” adidas Am., Inc. v. Skechers USA, Inc., 890 F.3d 747, 754 (9th Cir. 2018). “Some of the relevant factors for determining secondary meaning include the exclusivity, manner, and length of use of the trade dress, the amount and manner of advertising, the amount of sales, and proof of intentional copying by the defendant.” Id.

Likelihood of confusion “turns on whether a reasonably prudent consumer would be confused about the source of the goods bearing the marks.” Id. at 755.

In support of its argument that there is a likelihood of confusion, Katzkin argues: (1) “Roadwire copied the overall look and feel of Katzkin’s trade dress to promote the identical product”; (2) “the copying was done with knowledge of Katzkin’s trade dress”; and (3) “Dr. Mandel’s unrebutted expert opinion is that ‘without the names Roadwire or Katzkin on the page, for a consumer viewing the page, it is very difficult, if not impossible, to keep the two websites distinguished.’” Katzkin Mot. at 15. But even if the first two statements are true, Katzkin has not met its burden of establishing that no genuine disputes of fact exist as to likelihood of confusion. Mandel’s statement that a consumer viewing the websites would not be

able to keep them distinguished “without the names Roadwire or Katzkin on the page” is inapposite because both webpages feature the companies’ names in several places on each website. See dkts. 152-10 and 152-12.⁶ Moreover, the parties do not cite any case law stating whether the trier of fact should ignore the companies’ names from the websites in considering the trade dress claim, or why doing so would be a relevant endeavor here.

The Court finds Katzkin has not met its burden of establishing likelihood of confusion, and Roadwire has met its burden of establishing that no reasonable consumer would be likely to be confused. The Court GRANTS Roadwire’s motion as to the trade dress claim and DENIES Katzkin’s motion as to that claim.

3. Unfair Competition

Katzkin’s unfair competition claim is based on its trademark and trade dress infringement claims, and Katzkin’s unfair competition claim rises and falls with those claims. Compl. ¶¶ 108-124. The Court therefore GRANTS Roadwire’s motion and DENIES Katzkin’s motion as to the unfair competition claim.

4. Counterfeiting

Katzkin and Roadwire both move for summary judgment on Katzkin’s claim for counterfeiting under 15 U.S.C. § 1114 *et seq.* Katzkin Mot. at 9; Roadwire Mot. at 7.

“Any person who . . . use[s] in commerce any reproduction, counterfeit, copy, or colorable imitation of a registered mark in connection with the sale, offering for sale, distribution, or advertising of any goods or services on or in connection with which such use is likely to cause confusion, or to cause mistake, or to deceive . . . shall be liable in a civil action by the registrant for the remedies hereinafter

⁶ This is similar to the mistake made by Lodestar’s expert, who “failed properly to address how consumers would encounter the [mark at issue] in the marketplace.” Lodestar, 2022 WL 1180767 at *21.

provided.” 15 U.S.C. § 1114(1)(a). In considering a counterfeiting claim, “[a] court should not myopically focus on only the alleged counterfeit marks to the exclusion of the entire product or even common sense.” Arcona, 976 F.3d at 1080.

Roadwire cites Boost Beauty, LLC. v. Woo Signatures, LLC., No. 2:18-CV-02960-CAS (Ex), 2019 WL 560277, at *6 (C.D. Cal. Feb. 11, 2019) for the proposition that the mere use of a trademarked term on the internet is not sufficient to establish a counterfeiting claim. Roadwire Mot. at 8-9. Roadwire contends that because its use of the phrase “Love Your Drive” was on its website and Facebook advertising and not on the physical goods it sells, it cannot as a matter of law have counterfeited Katzkin’s mark. Id. But in Boost Beauty, the defendant was alleged to have used the trademark by purchasing internet search terms that “a consumer would never see.” Boost Beauty, 2019 WL 560277 at *6 n.1. Here it is undisputed that Roadwire used the trademarked phrase “Love Your Drive” on its public website and online advertising in connection with the same products for which the mark is registered. See Louis Vuitton Malletier, S.A. v. Akanoc Sols., Inc., 658 F.3d 936, 946 (9th Cir. 2011) (holding a counterfeit mark is defined as “(1) a non-genuine mark identical to the registered, genuine mark of another, where (2) the genuine mark was registered for use on the same goods to which the infringer applied the mark”).

The court in Boost Beauty did not consider the likelihood of confusion element, which the Ninth Circuit subsequently clarified is a requirement for a counterfeiting claim. See Arcona, 976 F.3d at 1079 (“[A] counterfeit claim requires a showing of likelihood of confusion under Section 1114.”). Katzkin cites a Ninth Circuit case articulating that a presumption of likelihood of confusion “arises when intent to cause confusion is coupled with the use of a counterfeit mark or a mark virtually identical to a previously registered mark.” Katzkin Mot. at 10 (citing Louis Vuitton, 658 F.3d at 945). Katzkin argues this standard is met because Roadwire used “love your drive” on its website, but does not address the intent requirement. See id. Katzkin has therefore not met its burden of establishing that a presumption of likelihood of confusion applies.

Therefore, for the reasons explained above, Katzkin has not met its burden of establishing likelihood of confusion, and Roadwire has met its burden. The Court GRANTS Roadwire's motion as to the counterfeiting claim and DENIES Katzkin's motion as to that claim.

5. Equitable Relief

Katzkin argues it is entitled to injunctive relief and Roadwire's profits from its use of "Love Your Drive." Katzkin Mot. at 18. Because the Court grants summary judgment to Roadwire as to the trademark infringement claim and denies Katzkin's motion, Katzkin cannot prevail on its request for equitable relief.

IV. CONCLUSION

The Court GRANTS Roadwire's motion for summary judgment and DENIES Katzkin's motion for summary judgment.

IT IS SO ORDERED.

Date: May 6, 2022



Dale S. Fischer
United States District Judge