UNITED STATES DISTRICT COURT
SOUTHERN DISTRICT OF NEW YORK

LOUIS VUITTON MALLETIER, S.A.,

Plaintiff,

-v-

MY OTHER BAG, INC.,

Defendant.

14-CV-3419 (JMF)

OPINION AND ORDER

JESSE M. FURMAN, United States District Judge:

Defendant My Other Bag, Inc. ("MOB") sells simple canvas tote bags with the text "My Other Bag . . ." on one side and drawings meant to evoke iconic handbags by luxury designers, such as Louis Vuitton, Chanel, and Fendi, on the other. MOB's totes — indeed, its very name — are a play on the classic "my other car . . ." novelty bumper stickers, which can be seen on inexpensive, beat up cars across the country informing passersby — with tongue firmly in cheek — that the driver's "other car" is a Mercedes (or some other luxury car brand). The "my other car" bumper stickers are, of course, a joke — a riff, if you will, on wealth, luxury brands, and the social expectations of who would be driving luxury and non-luxury cars. MOB's totes are just as obviously a joke, and one does not necessarily need to be familiar with the "my other car" trope to get the joke or to get the fact that the totes are meant to be taken in jest.

Louis Vuitton Malletier, S.A. ("Louis Vuitton"), the maker of Louis Vuitton bags, is perhaps unfamiliar with the "my other car" trope. Or maybe it just cannot take a joke. In either case, it brings claims against MOB with respect to MOB totes that are concededly meant to evoke iconic Louis Vuitton bags. More specifically, Louis Vuitton brings claims against MOB

for trademark dilution and infringement under the Lanham Act, 15 U.S.C. § 1125(c); a claim of trademark dilution under New York law; and a claim of copyright infringement. MOB now moves for summary judgment on all of Louis Vuitton's claims; Louis Vuitton cross moves for summary judgment on its trademark dilution claims and its copyright infringement claim, and moves also to exclude the testimony of MOB's expert and to strike the declarations (or portions thereof) of MOB's expert and MOB's founder and principal. For the reasons that follow, MOB's motion for summary judgment is granted and Louis Vuitton's motions are all denied.

BACKGROUND

The relevant facts, taken from the Complaint and admissible materials submitted in connection with the pending motions, are either undisputed or described in the light most favorable to Louis Vuitton. *See Costello v. City of Burlington*, 632 F.3d 41, 45 (2d Cir. 2011). Louis Vuitton is a world-renowned luxury fashion house known for its high-quality handbags and other luxury goods. (Local Civil Rule 56.1 Statement Material Facts Louis Vuitton Malletier, S.A. Mot. Summ. J. (Docket No. 65) ("Louis Vuitton SOF") ¶ 2). Louis Vuitton bags often sell for thousands of dollars (*see* Def. My Other Bag's Statement Undisputed Material Facts Pursuant Local Civil Rule 56.1 (Docket No. 53) ("MOB SOF") ¶ 13), and the company invests substantial sums in creating and maintaining a sense of exclusivity and luxury, (*see id.* ¶ 14). As a result, several of Louis Vuitton's designs and trademarks are famous and well-recognized icons of wealth and expensive taste. In particular, Louis Vuitton's Toile Monogram design — "a repeating pattern featuring the interlocking, stylized letters 'L' and 'V' and three stylized flower designs" (Louis Vuitton SOF ¶ 3), depictions of which appear in an appendix to this Opinion ("Op. App.") (*see* Op. App., Figs. A-B) — has become "the defining signature of the Louis Vuitton brand," (Louis Vuitton SOF ¶ 4). Louis Vuitton has registered trademarks in

the Toile Monogram (*id.* ¶ 6) and in the component stylized flower designs, (*id.* ¶ 7). Two other iconic Louis Vuitton designs, the Monogram Multicolore and the Damier, have achieved comparable levels of recognition and are also registered as trademarks. (*See id.* ¶¶ 9-21). By all accounts, and as the discussion below will make clear, Louis Vuitton aggressively enforces its trademark rights. (*Id.* ¶ 35).

MOB was founded by Tara Martin in 2011. (MOB SOF ¶ 11). As noted, the name "My Other Bag" was inspired by novelty bumper stickers, which can sometimes be seen on inexpensive cars claiming that the driver's "other car" is an expensive, luxury car, such as a Mercedes. (Decl. Tara Martin Supp. Def.'s Mot. Summ. J. (Docket No. 52) ¶ 3). MOB produces and sells canvas tote bags bearing caricatures of iconic designer handbags on one side and the text "My Other Bag . . ." on the other. Several of MOB's tote bags — one of which is depicted in the appendix to this Opinion (*see* Op. App., Figs. C-D) — display images concededly designed to evoke classic Louis Vuitton bags. (*See* MOB SOF ¶¶ 21-22; Louis Vuitton SOF ¶¶ 55-59, 79-80). As the appendix illustrates, the drawings use simplified colors, graphic lines, and patterns that resemble Louis Vuitton's famous Toile Monogram, Monogram Multicolore, and Damier designs, but replace the interlocking "LV" and "Louis Vuitton" with an interlocking "MOB" or "My Other Bag." (*See also id.* ¶¶ 47, 49). MOB markets its bags as "[e]co-friendly, sustainable tote bags playfully parodying the designer bags we love, but practical enough for everyday life." (Decl. Sharon Calhoun Supp. Mot. Summ. J. Louis Vuitton Malletier, S.A. (Docket No. 66) ("Calhoun Decl."), Ex. 25 at LVMA7194). While Louis Vuitton sells its handbags for hundreds, if not thousands, of dollars apiece, MOB's totes sell at prices between thirty and fifty-five dollars. (Louis Vuitton SOF ¶ 42). Its website and other marketing play up the idea that high-priced designer bags cannot be used to carry around, say, dirty gym clothes or

messy groceries, while its casual canvas totes can. (Calhoun Decl., Ex. 25 at LVMA7190-LVMA7192 ("[T]his luncheon worthy designer bag doesn't fit in at the gym, BUT My Other Bag . . . DOES . . . ."); *see also* Louis Vuitton SOF ¶ 65).

THE SUMMARY JUDGMENT STANDARD

Summary judgment is appropriate where the admissible evidence and the pleadings demonstrate "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); *see also Johnson v. Killian*, 680 F.3d 234, 236 (2d Cir. 2012) (per curiam). A dispute over an issue of material fact qualifies as genuine "if the evidence is such that a reasonable jury could return a judgment for the nonmoving party." *Anderson v. Liberty Lobby, Inc.*, 477 U.S. 242, 248 (1986); *accord Roe v. City of Waterbury*, 542 F.3d 31, 35 (2d Cir. 2008). The moving party bears the initial burden of demonstrating the absence of a genuine issue of material fact. *See Celotex Corp. v. Catrett*, 477 U.S. 317, 325 (1986). "In moving for summary judgment against a party who will bear the ultimate burden of proof at trial, the movant's burden will be satisfied if he can point to an absence of evidence to support an essential element of the nonmoving party's claim." *Goenaga v. March of Dimes Birth Defects Found.*, 51 F.3d 14, 18 (2d Cir. 1995) (citing *Celotex*, 477 U.S. at 322-23); *accord PepsiCo, Inc. v. Coca-Cola Co.*, 315 F.3d 101, 105 (2d Cir. 2002) (per curiam).

In ruling on a motion for summary judgment, all evidence must be viewed "in the light most favorable to the non-moving party," *Overton v. N.Y. State Div. of Military & Naval Affairs*, 373 F.3d 83, 89 (2d Cir. 2004), and the court must "resolve all ambiguities and draw all permissible factual inferences in favor of the party against whom summary judgment is sought," *Sec. Ins. Co. of Hartford v. Old Dominion Freight Line, Inc.*, 391 F.3d 77, 83 (2d Cir. 2004). When, as in this case, both sides move for summary judgment, the district court is "required to

assess each motion on its own merits and to view the evidence in the light most favorable to the party opposing the motion, drawing all reasonable inferences in favor of that party." *Wachovia Bank, Nat'l Ass'n v. VCG Special Opportunities Master Fund, Ltd.*, 661 F.3d 164, 171 (2d Cir. 2011). Thus, "neither side is barred from asserting that there are issues of fact, sufficient to prevent the entry of judgment, as a matter of law, against it." *Heublein, Inc. v. United States*, 996 F.2d 1455, 1461 (2d Cir. 1993).

To defeat a motion for summary judgment, a non-moving party must advance more than a "scintilla of evidence," *Anderson*, 477 U.S. at 252, and demonstrate more than "some metaphysical doubt as to the material facts," *Matsushita Elec. Indus. Co., Ltd. v. Zenith Radio Corp.*, 475 U.S. 574, 586 (1986). The non-moving party "cannot defeat the motion by relying on the allegations in [its] pleading or on conclusory statements, or on mere assertions that affidavits supporting the motion are not credible." *Gottlieb v. Cty. of Orange*, 84 F.3d 511, 518 (2d Cir. 1996) (citation omitted). Affidavits submitted in support of, or opposition to, summary judgment must be based on personal knowledge, must "set forth such facts as would be admissible in evidence," and must show "that the affiant is competent to testify to the matters stated therein." *Patterson v. Cty. of Oneida*, 375 F.3d 206, 219 (2d Cir. 2004) (quoting Fed. R. Civ. P. 56(e)).

DISCUSSION

As noted, Louis Vuitton asserts three categories of claims against MOB. First, Louis Vuitton brings trademark dilution claims under both New York and federal law. (Compl. (Docket No. 2) ¶¶ 73-80, 87-92). Second, Louis Vuitton alleges that MOB's totes infringe its trademarks under federal law. (*Id.* ¶¶ 58-72). And third, Louis Vuitton contends that MOB's totes violate federal copyright law. (*Id.* ¶¶ 81-86). The Court will address each in turn.

DOCKET ALARM

Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

Real-Time Litigation Alerts

Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

Advanced Docket Research

With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

Analytics At Your Fingertips

Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

LAW FIRMS
Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

FINANCIAL INSTITUTIONS
Litigation and bankruptcy checks for companies and debtors.

E-DISCOVERY AND LEGAL VENDORS
Sync your system to PACER to automate legal marketing.