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9 Attorneys for Plaintiff KIINI LLC

10 UNITED STATES DISTRICT COURT
11 CENTRAL DISTRICT OF CALIFORNIA
12

13 KIINI LLC, a New York LLC,

14 Plaintiff,

15 v.

16 VICTORIA'S SECRET STORES
BRAND MANAGEMENT, Inc., a
17 Delaware corporation, et al.,

18 Defendants.
19

) CASE NO. 2:15-CV-8433

) Assigned: Hon. Fernando M. Olguin

) **PLAINTIFF'S PROPOSED JURY
INSTRUCTIONS**

) Pre-Trial Conf. Date: March 24, 2017
Trial Date: April 11, 2017
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1 **1.1A Duty of Jury (Court Reads and Provides Written Instructions)**

2

3 Ladies and gentlemen: You are now the jury in this case. It is my duty to
4 instruct you on the law.

5

6 These instructions are preliminary instructions to help you understand the
7 principles that apply to civil trials and to help you understand the evidence as you
8 listen to it. You will be allowed to keep this set throughout the trial to which to refer.
9 This set of instructions is not to be taken home and must remain in the jury room
10 when you leave in the evenings. At the end of the trial, I will give you a final set of
11 instructions. It is the final set of instructions which will govern your deliberations.

12

13 You must not infer from these instructions or from anything I may say or do as
14 indicating that I have an opinion regarding the evidence or what your verdict should
15 be.

16

17 It is your duty to find the facts from all the evidence in the case. To those facts
18 you will apply the law as I give it to you. You must follow the law as I give it to you
19 whether you agree with it or not. And you must not be influenced by any personal
20 likes or dislikes, opinions, prejudices, or sympathy. That means that you must decide
21 the case solely on the evidence before you. You will recall that you took an oath to
22 do so.

23

24 In following my instructions, you must follow all of them and not single out
25 some and ignore others; they are all important.

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28 Source: Model Civ. Jury Instr. 9th Cir. 1.1A (2007)

1.1B Duty of Jury (Court Reads Instructions Only)

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Ladies and gentlemen: You are now the jury in this case. It is my duty to instruct you on the law.

You must not infer from these instructions or from anything I may say or do as indicating that I have an opinion regarding the evidence or what your verdict should be.

It is your duty to find the facts from all the evidence in the case. To those facts you will apply the law as I give it to you. You must follow the law as I give it to you whether you agree with it or not. And you must not be influenced by any personal likes or dislikes, opinions, prejudices, or sympathy. That means that you must decide the case solely on the evidence before you. You will recall that you took an oath to do so.

In following my instructions, you must follow all of them and not single out some and ignore others; they are all important.

Source: Model Civ. Jury Instr. 9th Cir. 1.1B (2007)

1 **1.2 Claims and Defenses**

2
3 To help you follow the evidence, I will give you a brief summary of the
4 positions of the parties:

5
6 The plaintiff claims that defendant committed direct copyright infringement of
7 plaintiff's registered BATHING SUIT ART #1, defendant committed unfair
8 competition, defendant committed trade dress infringement of plaintiff's trade dress,
9 defendant committed infringement of plaintiff's registered trademark, and defendant
10 committed unfair competition and unfair business practices. The plaintiff has the
11 burden of proving these claims.

12
13 The defendant denies those claims [and also contends that [defendant's
14 counterclaims and/or affirmative defenses]]. [The defendant has the burden of proof
15 on these [counterclaims and/or affirmative defenses.]]

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17 The plaintiff denies [defendant's counterclaims and/or affirmative defenses].
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20 Source: Model Civ. Jury Instr. 9th Cir. 1.2 (2007)
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1.3 Burden of Proof—Preponderance of the Evidence

When a party has the burden of proof on any claim or affirmative defense by a preponderance of the evidence, it means you must be persuaded by the evidence that the claim or affirmative defense is more probably true than not true.

You should base your decision on all of the evidence, regardless of which party presented it.

Source: Model Civ. Jury Instr. 9th Cir. 1.3 (2007)

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1.6 What is Evidence

The evidence you are to consider in deciding what the facts are consists of:

- 1. the sworn testimony of any witness;
- 2. the exhibits which are received into evidence; and
- 3. any facts to which the lawyers have agreed.

Source: Model Civ. Jury Instr. 9th Cir. 1.6 (2007)

1 **1.7 What is Not Evidence**

2
3 In reaching your verdict, you may consider only the testimony and exhibits
4 received into evidence. Certain things are not evidence, and you may not consider
5 them in deciding what the facts are. I will list them for you:
6

7 (1) Arguments and statements by lawyers are not evidence. The lawyers are
8 not witnesses. What they have said in their opening statements, [will say in their]
9 closing arguments, and at other times is intended to help you interpret the evidence,
10 but it is not evidence. If the facts as you remember them differ from the way the
11 lawyers have stated them, your memory of them controls.
12

13 (2) Questions and objections by lawyers are not evidence. Attorneys have a
14 duty to their clients to object when they believe a question is improper under the rules
15 of evidence. You should not be influenced by the objection or by the court’s ruling
16 on it.
17

18 (3) Testimony that has been excluded or stricken, or that you have been
19 instructed to disregard, is not evidence and must not be considered. In addition
20 sometimes testimony and exhibits are received only for a limited purpose; when I
21 [give] [have given] a limiting instruction, you must follow it.
22

23 (4) Anything you may have seen or heard when the court was not in session is
24 not evidence. You are to decide the case solely on the evidence received at the trial.
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27 Source: Model Civ. Jury Instr. 9th Cir. 1.7 (2007)
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1.8 Evidence for Limited Purpose

Some evidence may be admitted for a limited purpose only.

When I instruct you that an item of evidence has been admitted for a limited purpose, you must consider it only for that limited purpose and for no other.

[The testimony [you are about to hear] [you have just heard] may be considered only for the limited purpose of [describe purpose] and for no other purpose.]

Source: Model Civ. Jury Instr. 9th Cir. 1.8 (2007)

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1.9 Direct and Circumstantial Evidence

Evidence may be direct or circumstantial. Direct evidence is direct proof of a fact, such as testimony by a witness about what that witness personally saw or heard or did. Circumstantial evidence is proof of one or more facts from which you could find another fact. You should consider both kinds of evidence. The law makes no distinction between the weight to be given to either direct or circumstantial evidence. It is for you to decide how much weight to give to any evidence.

Source: Model Civ. Jury Instr. 9th Cir. 1.9 (2007)

1 **1.10 Ruling on Objections**

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3 There are rules of evidence that control what can be received into evidence.

4 When a lawyer asks a question or offers an exhibit into evidence and a lawyer on the

5 other side thinks that it is not permitted by the rules of evidence, that lawyer may

6 object. If I overrule the objection, the question may be answered or the exhibit

7 received. If I sustain the objection, the question cannot be answered, and the exhibit

8 cannot be received. Whenever I sustain an objection to a question, you must ignore

9 the question and must not guess what the answer might have been.

10

11 Sometimes I may order that evidence be stricken from the record and that you

12 disregard or ignore the evidence. That means that when you are deciding the case,

13 you must not consider the evidence that I told you to disregard.

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16 Source: Model Civ. Jury Instr. 9th Cir. 1.10 (2007)

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1 **1.11 Credibility of Witnesses**

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3 In deciding the facts in this case, you may have to decide which testimony to
4 believe and which testimony not to believe. You may believe everything a witness
5 says, or part of it, or none of it. Proof of a fact does not necessarily depend on the
6 number of witnesses who testify about it.

7
8 In considering the testimony of any witness, you may take into account:

- 9
10 (1) the opportunity and ability of the witness to see or hear or know the
11 things testified to;
12
13 (2) the witness’s memory;
14
15 (3) the witness’s manner while testifying;
16
17 (4) the witness’s interest in the outcome of the case and any bias or
18 prejudice;
19
20 (5) whether other evidence contradicted the witness’s testimony;
21
22 (6) the reasonableness of the witness’s testimony in light of all the
23 evidence; and
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25 (7) any other factors that bear on believability.

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27 The weight of the evidence as to a fact does not necessarily depend on the
28 number of witnesses who testify about it.

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Source: Model Civ. Jury Instr. 9th Cir. 1.11 (2007)

1 **1.12 Conduct of the Jury**

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3 I will now say a few words about your conduct as jurors.

4

5 First, you are not to discuss this case with anyone, including members of your
6 family, people involved in the trial, or anyone else; this includes discussing the case
7 in internet chat rooms or through internet “blogs,” internet bulletin boards or e-mails.
8 Nor are you allowed to permit others to discuss the case with you. If anyone
9 approaches you and tries to talk to you about the case, please let me know about it
10 immediately;

11

12 Second, do not read or listen to any news stories, articles, radio, television, or
13 online reports about the case or about anyone who has anything to do with it;

14

15 Third, do not do any research, such as consulting dictionaries, searching the
16 Internet or using other reference materials, and do not make any investigation about
17 the case on your own;

18

19 Fourth, if you need to communicate with me simply give a signed note to the
20 [bailiff] [clerk] [law clerk] to give to me; and

21

22 Fifth, do not make up your mind about what the verdict should be until after
23 you have gone to the jury room to decide the case and you and your fellow jurors
24 have discussed the evidence. Keep an open mind until then.

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26 Finally, until this case is given to you for your deliberation and verdict, you are
27 not to discuss the case with your fellow jurors.

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Source: Model Civ. Jury Instr. 9th Cir. 1.12 (2007)

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1.14 Taking Notes

If you wish, you may take notes to help you remember the evidence. If you do take notes, please keep them to yourself until you and your fellow jurors go to the jury room to decide the case. Do not let note-taking distract you. When you leave, your notes should be left in the [courtroom] [jury room] [envelope in the jury room]. No one will read your notes. They will be destroyed at the conclusion of the case.

Whether or not you take notes, you should rely on your own memory of the evidence. Notes are only to assist your memory. You should not be overly influenced by your notes or those of your fellow jurors.

Source: Model Civ. Jury Instr. 9th Cir. 1.14 (2007)

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1.18 Bench Conferences and Recesses

From time to time during the trial, it [may become] [became] necessary for me to talk with the attorneys out of the hearing of the jury, either by having a conference at the bench when the jury [is] [was] present in the courtroom, or by calling a recess. Please understand that while you [are] [were] waiting, we [are] [were] working. The purpose of these conferences is not to keep relevant information from you, but to decide how certain evidence is to be treated under the rules of evidence and to avoid confusion and error.

Of course, we [will do] [have done] what we [can] [could] to keep the number and length of these conferences to a minimum. I [may] [did] not always grant an attorney’s request for a conference. Do not consider my granting or denying a request for a conference as any indication of my opinion of the case or of what your verdict should be.

Source: Model Civ. Jury Instr. 9th Cir. 1.18 (2007)

1 **1.19 Outline of Trial**

2

3 Trials proceed in the following way: First, each side may make an opening
4 statement. An opening statement is not evidence. It is simply an outline to help you
5 understand what that party expects the evidence will show. A party is not required to
6 make an opening statement.

7

8 The plaintiff will then present evidence, and counsel for the defendant may
9 cross-examine. Then the defendant may present evidence, and counsel for the
10 plaintiff may cross-examine.

11

12 After the evidence has been presented, I will instruct you on the law that
13 applies to the case and the attorneys will make closing arguments.

14

15 After that, you will go to the jury room to deliberate on your verdict.

16

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18 Source: Model Civ. Jury Instr. 9th Cir. 1.19 (2007)

1 **2.4 Deposition in Lieu of Live Testimony**

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3 A deposition is the sworn testimony of a witness taken before trial. The

4 witness is placed under oath to tell the truth and lawyers for each party may ask

5 questions. The questions and answers are recorded. When a person is unavailable to

6 testify at trial, the deposition of that person may be used at the trial.

7

8 The deposition of [witness] was taken on [date]. You should consider

9 deposition testimony, presented to you in court in lieu of live testimony, insofar as

10 possible, in the same way as if the witness had been present to testify.

11

12 Do not place any significance on the behavior or tone of voice of any person

13 reading the questions or answers.

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16 Source: Model Civ. Jury Instr. 9th Cir. 2.4 (2007)

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2.10 Use of Interrogatories of A Party

Evidence [will now be] [was] presented to you in the form of answers of one of the parties to written interrogatories submitted by the other side. These answers [have been] [were] given in writing and under oath, before the actual trial, in response to questions that were submitted in writing under established court procedures. You should consider the answers, insofar as possible, in the same way as if they were made from the witness stand.

Source: Model Civ. Jury Instr. 9th Cir. 2.10 (2007)

2.11 Expert Opinion

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Some witnesses, because of education or experience, are permitted to state opinions and the reasons for those opinions.

Opinion testimony should be judged just like any other testimony. You may accept it or reject it, and give it as much weight as you think it deserves, considering the witness's education and experience, the reasons given for the opinion, and all the other evidence in the case.

Source: Model Civ. Jury Instr. 9th Cir. 2.11 (2007)

3.1 Duty to Deliberate

When you begin your deliberations, you should elect one member of the jury as your presiding juror. That person will preside over the deliberations and speak for you here in court.

You will then discuss the case with your fellow jurors to reach agreement if you can do so. Your verdict must be unanimous.

Each of you must decide the case for yourself, but you should do so only after you have considered all of the evidence, discussed it fully with the other jurors, and listened to the views of your fellow jurors.

Do not hesitate to change your opinion if the discussion persuades you that you should. Do not come to a decision simply because other jurors think it is right.

It is important that you attempt to reach a unanimous verdict but, of course, only if each of you can do so after having made your own conscientious decision. Do not change an honest belief about the weight and effect of the evidence simply to reach a verdict.

Source: Model Civ. Jury Instr. 9th Cir. 3.1 (2007)

3.2 Communication With Court

If it becomes necessary during your deliberations to communicate with me, you may send a note through the [marshal] [bailiff], signed by your presiding juror or by one or more members of the jury. No member of the jury should ever attempt to communicate with me except by a signed writing; I will communicate with any member of the jury on anything concerning the case only in writing, or here in open court. If you send out a question, I will consult with the parties before answering it, which may take some time. You may continue your deliberations while waiting for the answer to any question. Remember that you are not to tell anyone—including me—how the jury stands, numerically or otherwise, until after you have reached a unanimous verdict or have been discharged. Do not disclose any vote count in any note to the court.

Source: Model Civ. Jury Instr. 9th Cir. 3.2 (2007)

3.3 Return of Verdict

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A verdict form has been prepared for you. After you have reached unanimous agreement on a verdict, your presiding juror will fill in the form that has been given to you, sign and date it, and advise the court that you are ready to return to the courtroom.

Source: Model Civ. Jury Instr. 9th Cir. 3.3 (2007)

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3.4 Additional Instructions of Law

At this point I will give you a further instruction. By giving a further instruction at this time, I do not mean to emphasize this instruction over any other instruction.

You are not to attach undue importance to the fact that this was read separately to you. You shall consider this instruction together with all of the other instructions that were given to you.

[Insert text of new instruction.]

You will now retire to the jury room and continue your deliberations.

Source: Model Civ. Jury Instr. 9th Cir. 3.4 (2007)

1 **17.1 Copyright—Defined (17 U.S.C. § 106)**

2
3 Copyright is the exclusive right to copy. This right to copy includes the
4 exclusive rights to:

- 5
- 6 (1) authorize, or make additional copies, or otherwise reproduce the
7 copyrighted work in copies;
- 8
- 9 (2) recast, transform, adapt the work, that is prepare derivative works
10 based upon the copyrighted work;
- 11
- 12 (3) distribute copies of the copyrighted work to the public by sale or
13 other transfer of ownership; and
- 14
- 15 (4) display publicly a copyrighted pictorial work, or graphic work.
- 16

17 It is the owner of a copyright who may exercise these exclusive rights to copy.
18 The term “owner” includes an assignee. Here the assignee of the copyright is KIINI
19 LLC. In general, copyright law protects against production, adaptation and
20 distribution of substantially similar copies of the owner’s copyrighted work without
21 the owner’s permission. An owner may enforce these rights to exclude others in an
22 action for copyright infringement.

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25 Source: Model Civ. Jury Instr. 9th Cir. 17.1 (2007)

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17.2 Copyright—Subject Matter—Generally (17 U.S.C. § 102)

The work BATHING SUIT ART #1 involved in this trial is known as a pictorial or graphic work, such as a two-dimensional or three-dimensional works of fine, graphic and applied art, photograph, print or art reproduction.

You are instructed that a copyright may be obtained in BATHING SUIT ART #1.

This work can be protected by the copyright law. Only that part of the work comprised of original works of authorship fixed in any tangible form of expression from which it can be perceived, reproduced, or otherwise communicated, either directly or with the aid of a machine or device is protected by the Copyright Act.

Source: Model Civ. Jury Instr. 9th Cir. 17.2 (2007)

1 **17.4 Copyright Infringement—Elements—Ownership and Copying (17 U.S.C. §**
2 **501(a)–(b))**

3

4 Anyone who copies original elements of a copyrighted work during the term of
5 the copyright without the owner’s permission infringes the copyright.

6

7 On the plaintiff’s copyright infringement claim, the plaintiff has the burden of
8 proving both of the following by a preponderance of the evidence:

9

10 1. the plaintiff is the owner of a valid copyright; and

11

12 2. the defendant copied original elements from the copyrighted work.

13

14 If you find that the plaintiff has proved both of these elements, your verdict
15 should be for the plaintiff. If, on the other hand, the plaintiff has failed to prove
16 either of these elements, your verdict should be for the defendant.

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19 Source: Model Civ. Jury Instr. 9th Cir. 17.4 (2007)

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17.5 Copyright Infringement—Ownership of Valid Copyright—Definition (17 U.S.C. §§ 201–205)

The plaintiff is the owner of a valid copyright in BATHING SUIT ART #1 if the plaintiff proves by a preponderance of the evidence that:

- 1. the plaintiff’s work is original; and
- 2. the plaintiff received a transfer of the copyright.

A person who holds a copyright may obtain a certificate of registration from the Copyright Office of the Library of Congress. This certificate is sufficient to establish the facts stated in the certificate, unless outweighed by other evidence in this case.

The evidence in this case includes Exhibit _____, a certificate of copyright registration from the Copyright Office. You are instructed that the certificate is prima facie evidence that there is a valid copyright in BATHING SUIT ART #1.

Source: Model Civ. Jury Instr. 9th Cir. 17.5 (2007)

1 **17.6 Copyright Interests—Authorship (17 U.S.C. § 201(a))**

2

3 The creator of an original work is called the author of that work. An author

4 originates or “masterminds” the original work, controlling the whole work’s creation

5 and causing it to come into being.

6

7 Others may help or may make valuable or creative contributions to a work.

8 However, such a contributor cannot be the author of the work unless that contributor

9 caused the work to come into being. One must translate an idea into a fixed, tangible

10 expression in order to be the author of the work. Merely giving an idea to another

11 does not make the giver an author of a work embodying that idea.

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14 Source: Model Civ. Jury Instr. 9th Cir. 17.6 (2007)

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1 **17.10 Copyright Interests—Assignee (17 U.S.C. § 201(d)(1))**

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3 In this case, the plaintiff does not claim to be the author of the copyright at

4 issue. Instead, the plaintiff claims that it received the copyright by virtue of

5 assignment from the work’s author so that the plaintiff is now the assignee of the

6 copyright.

7

8 A copyright owner may transfer to another person all or part of the owner’s

9 property interest in the copyright; that is, the right to exclude others from copying the

10 work. The person to whom the copyright is transferred becomes the owner of the

11 copyright in the work.

12

13 To be valid, the transfer must be in writing. The person to whom this right is

14 transferred is called an assignee. The assignee may enforce this right to exclude

15 others in an action for copyright infringement.

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18 Source: Model Civ. Jury Instr. 9th Cir. 17.10 (2007)

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17.12 Copyright Infringement—Originality

An original work may include or incorporate elements taken from prior works; works from the public domain; or works owned by others, with the owner’s permission. The original parts of the plaintiff’s work are the parts created:

- 1. independently by the work’s author, that is, the author did not copy it from another work; and
- 2. by use of at least some minimal creativity.

In copyright law, the “original element” of a work need not be new or novel.

Source: Model Civ. Jury Instr. 9th Cir. 17.12 (2007)

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17.13 Copyright Interests—Derivative Work (17 U.S.C. §§ 101, 106(2))

A copyright owner is entitled to exclude others from creating derivative works based upon the owner’s copyrighted work. The term derivative work refers to a work based on one or more pre-existing works, such as a translation, art reproduction, abridgement, condensation, or any other form in which the pre-existing work is recast, transformed, or adapted. Accordingly, the owner of a copyrighted work is entitled to exclude others from recasting, transforming or adapting the copyrighted work without the owner’s permission.

Source: Model Civ. Jury Instr. 9th Cir. 17.13 (2007)

17.15 Copying—Access and Substantial Similarity

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Instruction 17.4 states that the plaintiff has the burden of proving that the defendant copied original elements from the plaintiff’s copyrighted work. The plaintiff may show the defendant copied from the work by showing by a preponderance of the evidence that the defendant had access to the plaintiff’s copyrighted work and that there are substantial similarities between the defendant’s work and original elements of the plaintiff’s work.

If a plaintiff shows the defendant had access to the plaintiff’s work and that there is a substantial similarity between the infringed and infringing works, a presumption of copying arises shifting the burden to the defendant to rebut or to show that the alleged infringing work was independently created.

Source: Model Civ. Jury Instr. 9th Cir. 17.15 (2007)

1 **17.16 Copyright Infringement—Copying—Access Defined**

2

3 As part of its burden in Instruction 17.4, if plaintiff relies on defendants’ access

4 to the work to prove that defendant copied plaintiff’s work, the plaintiff must show

5 by a preponderance of the evidence that the defendant had access to the plaintiff’s

6 work. You may find that the defendant had access to the plaintiff’s work if the

7 defendant had a reasonable opportunity to view the plaintiff’s work before the

8 defendant’s work was created.

9

10 Access may be shown by:

- 11
- 12 1. the plaintiff’s work being widely disseminated; or
- 13
- 14 2. a similarity between the plaintiff’s work and the defendant’s work
- 15 that is so “striking” that it is highly likely the works were not created
- 16 independent of one another.

17

18

19 Source: Model Civ. Jury Instr. 9th Cir. 17.16 (2007)

1 **17.17 Substantial Similarity—Extrinsic Test; Intrinsic Test**

2

3 An exact copy of a copyrighted work is an infringement. There can also be

4 infringement if the copy is not exact, so long as it is substantially similar.

5

6 To determine whether two works are substantially similar, we apply a two-part

7 test. The extrinsic test is an objective comparison of specific expressive elements; it

8 focuses on the articulable similarities between the two works. The intrinsic test is a

9 subjective comparison that focuses on whether the ordinary, reasonable audience

10 would find the works substantially similar in the total concept and feel of the works.

11

12 First, you must apply the extrinsic test. Because copyright law protects

13 expression of ideas, not ideas themselves, we distinguish protectable from

14 unprotectable elements and ask only whether the protectable elements in two works

15 are substantially similar. In comparing plaintiff’s BATHING SUIT ART #1 and

16 defendant’s CROCHET SWIMSUITS, you must examine the similarities in their

17 objective details in appearance, including, but not limited to, the subject matter,

18 shapes, colors, materials and arrangement of the representations.

19

20 Original selection, coordination and arrangement of unprotectable elements

21 may be protectable expression, and similarities in color arrangements are probative of

22 copying.

23

24 A challenged work need not copy a copyrighted work in its entirety in order to

25 infringe that work. It is enough that the challenged work appropriated a substantial

26 portion of plaintiff’s work. A substantial portion means any portion that is protected

27 and recognizable as part of plaintiff’s copyrighted work. For example, publishing a

28

1 single chapter of a Harry Potter novel without permission from the copyright holder
2 is more than sufficient for infringement.

3

4 Second, at the intrinsic stage, you should look whether an ordinary, reasonable
5 observer would consider the copyrighted and challenged works substantially similar
6 in the total concept and feel.

7

8 Where the defendant has a high degree of access to the copyrighted work, a
9 lower standard of proof of substantial similarity is required between the copyrighted
10 work and the allegedly infringing work.

11

12 If you find infringement under both the intrinsic and extrinsic tests, you must
13 return a verdict of infringement.

14

15 Source/Authority: *L.A. Printex Industries, Inc. v. William Carter Co.*, 2013 WL
16 979270, No. 09-2449 AK., (C.D.Cal. Jan. 25, 2013) (Jury Instructions); *Cavalier v.*
17 *Random House, Inc.*, 297 F.3d 815 (9th Cir. 2002); *Benay v. Warner Bros. Entm't*,
18 607 F.3d 620 (9th Cir. 2010); *Oracle America, Inc. v. Google Inc.*, 2011 WL
19 13060257, No. CV 10-03561 WHA (DMR) (N.D.Cal. Oct. 15, 2011) (Jury
20 Instructions).

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17.22 Copyright—Damages (17 U.S.C. § 504)

If you find for the plaintiff on the plaintiff’s copyright infringement claim, you must determine the plaintiff’s damages. The plaintiff is entitled to recover the actual damages suffered as a result of the infringement. In addition, the plaintiff is also entitled to recover any profits of the defendant attributable to the infringement. The plaintiff must prove damages by a preponderance of the evidence.

Source: Model Civ. Jury Instr. 9th Cir. 17.22 (2007)

17.23 Copyright—Damages—Actual Damages (17 U.S.C. § 504(b))

The copyright owner is entitled to recover the actual damages suffered as a result of the infringement. “Actual damages” means the amount of money adequate to compensate the copyright owner for the reduction of the fair market value of the copyrighted work caused by the infringement. The reduction of the fair market value of the copyrighted work is the amount a willing buyer would have been reasonably required to pay a willing seller at the time of the infringement for the actual use made by the defendant of the plaintiff’s work. That amount also could be represented by the lost license fees the plaintiff would have received for the defendant’s unauthorized use of the plaintiff’s work.

Source: Model Civ. Jury Instr. 9th Cir. 17.23 (2007)

1 **17.24 Copyright—Damages—Defendant’s Profits (17 U.S.C. § 504(b))**

2

3 In addition to actual damages, the copyright owner is entitled to any profits of
4 the defendant attributable to the infringement. You may not include in an award of
5 profits any amount that you took into account in determining actual damages.

6

7 You may make an award of the defendant’s profits only if you find that the
8 plaintiff showed a causal nexus between the infringement and the defendant’s gross
9 revenue.

10

11 The defendant’s profit is determined by subtracting all expenses from the
12 defendant’s gross revenue.

13

14 The defendant’s gross revenue is all of the defendant’s receipts from the sale of
15 a product containing or using the copyrighted work. The plaintiff has the burden of
16 proving the defendant’s gross revenue by a preponderance of the evidence.

17

18 Expenses are all operating costs and production costs incurred in producing the
19 defendant’s gross revenue. The defendant has the burden of proving the defendant’s
20 expenses by a preponderance of the evidence.

21

22 Unless you find that a portion of the profit from the sale of a product
23 containing or using the copyrighted work is attributable to factors other than use of
24 the copyrighted work, all of the profit is to be attributed to the infringement. The
25 defendant has the burden of proving the percentage of the profit, if any, attributable to
26 factors other than infringing the copyrighted work.

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28 Source: Model Civ. Jury Instr. 9th Cir. 17.24 (2007)

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15.1 Definition—Trademark (15 U.S.C. § 1127)

A trademark is any word, name, symbol, device, or any combination thereof, used by a person to identify and distinguish that person’s goods from those of others and to indicate the source of the goods, even if that source is generally unknown.

A person who uses the trademark of another may be liable for damages.

Source: Model Civ. Jury Instr. 9th Cir. 15.1 (2007)

15.2 Definition—Trade Dress (15 U.S.C. § 1125(a))

Trade dress is the non-functional physical detail and design of a product or its packaging, which indicates or identifies the product’s source and distinguishes it from the products of others.

Trade dress is the product’s total image and overall appearance, and may include features such as size, shape, color, color combinations, texture, or graphics. In other words, trade dress is the form in which a person presents a product or service to the market, its manner of display.

A trade dress is non-functional if, taken as a whole, the collection of trade dress elements is not essential to the product’s use or purpose even though certain particular elements of the trade dress may be functional.

Trade dress concerns the overall visual impression created in the consumer’s mind when viewing the non-functional aspects of the product and not from the utilitarian or useful aspects of the product. In considering the impact of these non-functional aspects, which are often a complex combination of many features, you must consider the appearance of features together, rather than separately.

A person who uses the trade dress of another may be liable for damages.

Source: Model Civ. Jury Instr. 9th Cir. 15.2 (2007)

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15.3 Definition—Trade Name/Commercial Name (15 U.S.C. § 1127)

A trade name is any word or words, a symbol, or combination of words and symbol, used by a person to identify that person’s business and to distinguish it from the business of others. A trade name symbolizes the reputation of a person’s business as a whole. By comparison, a trademark identifies a person’s goods.

Any person who uses the trade name of another may be liable for damages.

If a person owns a trade name, then that person has the exclusive right to use the name or to control the use of confusingly similar variations of the name by others in the market.

Source: Model Civ. Jury Instr. 9th Cir. 15.3 (2007)

1 **15.4 Trademark Liability—Theories and Policies (15 U.S.C. §§ 1114(1), 1125(a))**

2

3 The trademark laws balance three often-conflicting goals: 1) protecting the
4 public from being misled about the nature and source of goods and services, so that
5 the consumer is not confused or misled in the market; 2) protecting the rights of a
6 business to identify itself to the public and its reputation in offering goods and
7 services to the public; and 3) protecting the public interest in fair competition in the
8 market.

9

10 The balance of these policy objectives vary from case to case, because they
11 may often conflict. Accordingly, each case must be decided by examining its specific
12 facts and circumstances, of which you are to judge.

13

14 In my instructions, I will identify types of facts you are to consider in deciding
15 if the defendant is liable to the plaintiff for violating the trademark law. These facts
16 are relevant to whether the defendant is liable for:

17

18 1. infringing plaintiff's registered trademark rights, by using a trademark
19 in a manner likely to cause confusion among consumers;

20

21 2. unfairly competing, by using a trademark in a manner likely to cause
22 confusion as to the origin or quality of plaintiff's goods;

23

24 3. unfairly competing, by using trade dress in a manner likely to cause
25 confusion as to the origin or quality of plaintiff's goods;

26

27 4. infringing plaintiff's trade name, by using similar corporate, business
28 or professional names in a manner likely to cause confusion about the

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source of products in the minds of consumers; and

5. false advertising, by making a false statement that was material and that tended to deceive consumers, injuring the plaintiff in the market.

Source: Model Civ. Jury Instr. 9th Cir. 15.4 (2007)

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15.5 Infringement—Elements and Burden of Proof—Trademark (15 U.S.C. § 1114(1))

On the plaintiff’s claim for trademark infringement, the plaintiff has the burden of proving each of the following elements by a preponderance of the evidence that:

1. “KIINI” is a valid, protectable trademark;
2. the plaintiff owns “KIINI” as a trademark;
3. the defendant used “TEENY” a mark similar to “KIINI” without the consent of the plaintiff in a manner that is likely to cause confusion among ordinary purchasers as to the source of the goods; and
4. the plaintiff was damaged by the defendant’s infringement.

If you find that each of the elements on which the plaintiff has the burden of proof has been proved, your verdict should be for the plaintiff. If, on the other hand, the plaintiff has failed to prove any of these elements, your verdict should be for the defendant.

Source: Model Civ. Jury Instr. 9th Cir. 15.5 (2007)

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15.6 Infringement—Elements and Burden of Proof—Trade Dress (15 U.S.C. 1125(a)(1))

On the plaintiff’s claim for trade dress infringement, the plaintiff has the burden of proving by a preponderance of the evidence each of the following elements:

1. The overall commercial image of the KIINI bikini featuring BATHING SUIT ART #1 is distinctive;
2. the plaintiff owns the overall commercial image of the KIINI bikini featuring BATHING SUIT ART #1 as trade dress;
3. the overall commercial image of the KIINI bikini featuring BATHING SUIT ART #1 is nonfunctional;
4. the defendant used trade dress similar to the overall commercial image of the KIINI bikini featuring BATHING SUIT ART #1 without the consent of the plaintiff in a manner that is likely to cause confusion among ordinary purchasers as to the source of the defendant’s goods; and
5. the plaintiff was damaged by the defendant’s infringement.

If you find that each of the elements on which the plaintiff has the burden of proof has been proved, your verdict should be for the plaintiff. If, on the other hand, the plaintiff has failed to prove any of these elements, your verdict should be for the defendant.

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Source: Model Civ. Jury Instr. 9th Cir. 15.6 (2007)

1 **15.7 Infringement—Elements—Presumed Validity and Ownership—Registered**
2 **Trademark (15 U.S.C. §§ 1057, 1065 and 1115)**

3
4 I gave you instruction number 15.5 that requires the plaintiff to prove by a
5 preponderance of the evidence that the trademark is valid and protectable and that the
6 plaintiff owns the trademark. A valid trademark is a word, name, symbol, device, or
7 any combination of these, that indicates the source of goods and distinguishes those
8 goods from the goods of others. A trademark becomes protectable after it is used in
9 commerce.

10
11 One way for the plaintiff to prove trademark validity is to show that the
12 trademark is registered. An owner of a trademark may obtain a certificate of
13 registration issued by the United States Patent and Trademark Office and may submit
14 that certificate as evidence of the validity and protectability of the trademark covered
15 by that certificate.

16
17 Exhibit __ is a certificate of registration from the United States Patent and
18 Trademark Office. It was submitted by the plaintiff as proof of the validity of the
19 trademark.

20
21 The facts recited in this certificate are: that the mark “KIINI” consisting of the
22 lettering/wording “KIINI” with a design comprised of bold type in lowercase and a
23 triangle tittle on each of the “I” letters is a valid and protectable trademark for
24 beachwear, registered by Ipek Irgit.

25
26
27 Source: Model Civ. Jury Instr. 9th Cir. 15.7 (2007)

28

1 **15.8 Infringement—Elements—Validity—Unregistered Marks**
2

3 Instruction 15.5 requires the plaintiff to prove by a preponderance of the
4 evidence that plaintiff’s trade dress, the overall commercial image of the KIINI bikini
5 featuring BATHING SUIT ART #1, is valid. Valid trade dress is either:
6

- 7 1. inherently distinctive; or
8
9 2. descriptive, but has acquired a secondary meaning.
10

11 Only valid trade dress can be infringed. Only if you determine plaintiff proved
12 by a preponderance of the evidence that the plaintiff’s trade dress, the overall
13 commercial image of the KIINI bikini featuring BATHING SUIT ART #1, is valid
14 trade dress should you consider whether plaintiff owns it or whether defendant’s
15 actions infringed it.
16

17 Only if you determine that plaintiff’s trade dress, the overall commercial image
18 of the KIINI bikini featuring BATHING SUIT ART #1, is not inherently distinctive
19 should you consider whether it is descriptive but became distinctive through the
20 development of secondary meaning, as I will direct in Instruction 15.10.
21

22
23 Source: Model Civ. Jury Instr. 9th Cir. 15.8 (2007)
24
25
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28

1 **15.9 Infringement—Elements—Validity—Unregistered Mark—Distinctiveness**

2
3 **Strength as a Likelihood of Confusion Factor**

4
5 How strongly a trade dress indicates that a good comes from a particular
6 source, even if unknown, is an important factor to consider in assessing its validity
7 and in determining whether the trade dress used by the defendant creates for
8 consumers a likelihood of confusion with the plaintiff’s trade dress under instruction
9 15.16.

10
11 The plaintiff asserts that the overall commercial image of the KIINI bikini
12 featuring BATHING SUIT ART #1 is a valid and protectable trade dress for its
13 swimwear. The plaintiff contends that the defendant’s use of those similar designs in
14 connection with the defendant’s swimwear infringes plaintiff’s trade dress and is
15 likely to cause confusion about the origin of goods associated with that trade dress.
16 In order to determine if the plaintiff has met its burden of showing that the overall
17 commercial image of the KIINI bikini featuring BATHING SUIT ART #1 is a valid
18 trade dress, you should classify it on the spectrum of trade dress distinctiveness that I
19 will explain in this instruction.

20
21 An inherently distinctive trade dress is a design, symbol or device, or
22 combination of them, which intrinsically identifies a particular source of a good in the
23 market. The law assumes that an inherently distinctive trade dress is one that almost
24 automatically tells a consumer that it refers to a brand or a source for a product, and
25 that consumers will be predisposed to equate the trade dress with the source of a
26 product.

1 Trade dress is inherently distinctive if the total impression it gives the
2 consumer is one that identifies it as coming from a specific origin or source, whether
3 or not that source is known to the consumer. Inherently distinctive trade dress helps
4 consumers identify the product, distinguishing the plaintiff’s product from that
5 produced by others, such as the defendant.

6
7 You should consider the total visual impression of the trade dress, not each
8 element of it in isolation. Inherently distinctive trade dress often uses common, non-
9 distinctive elements when considered individually. However, it is the combination of
10 elements and the total impression that the dress conveys to the consumer that shows if
11 it is distinctive.

12
13 For instance, if an example of apple-flavored candy were the product, the
14 modification involving the trade dress for that product would indicate that the trade
15 dress would be:

16
17 **Generic**, if sold in red, plastic wrappers so that they looked like small round
18 balls. Because they share a shape and color that many other candies have, the maker
19 of the round apple flavored candy would not be able to get trade dress protection for
20 this packaging. The red plastic wrapping on the small, round candy does not
21 distinctively indicate any particular maker of candy, whatever its flavor.

22
23 **Descriptive**, if the producer sold the candy in a small plastic apple-shaped
24 container. The packaging describes a characteristic of the product—it tastes like
25 apple. This trade dress can only be protected if it acquires secondary meaning (e.g.,
26 while it does not “immediately” indicate the source of the candy, with time there may
27 be proof that the small plastic apple container became known to children as the
28 product of this particular maker of this apple flavored candy).

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Suggestive, if the producer were to sell the candy in a box shaped like a school text book. The text book appearance of the box connotes a characteristic of the product, allowing the consumer to infer something about the product from the trade dress. Here, the book packaging suggesting the idea of children bringing an apple to school to share with their favorite teacher, and that perhaps they can bring the candy in lieu of the apple. This can suggest to the consumer that the candies have an apple flavor.

Arbitrary, if the candy were sold in a box shaped like a television, with a screen in which you could see the small, apple flavored candy. It would also be arbitrary if packaged in a container of some fanciful, new and previously unknown shape. It is totally unrelated to the apple flavored candy, whether using the shape of the television that has no relation to an apple flavored candy, or fanciful, previously unknown shape.

Source: Model Civ. Jury Instr. 9th Cir. 15.9 (2007)

1 **15.10 Infringement—Elements—Validity—Distinctiveness—Secondary Meaning**

2
3 If you determined in Instruction 15.9 that the overall commercial image of the
4 KIINI bikini featuring BATHING SUIT ART #1 is descriptive, you must consider
5 the recognition that the mark has among prospective purchasers. This market
6 recognition is called the trade dress’s “secondary meaning.”

7
8 A trade dress acquires a secondary meaning when it has been used in such a
9 way that its primary significance in the minds of the prospective purchasers is not the
10 product itself, but the identification of the product with a single source, regardless of
11 whether consumers know who or what that source is. You must find that the
12 preponderance of the evidence shows that a significant number of the consuming
13 public associates the overall commercial image of the KIINI bikini featuring
14 BATHING SUIT ART #1 with a single source, in order to find that it has acquired
15 secondary meaning.

16
17 You may consider the following factors when you determine whether the
18 overall commercial image of the KIINI bikini featuring BATHING SUIT ART #1 has
19 acquired a secondary meaning:

- 20
21 1. Purchaser Perception. Whether the people who purchase the product
22 that bears the claimed trade dress associate the trade dress with the
23 assignee;
24
25 2. Advertisement. To what degree and in what manner the assignee may
26 have advertised under the claimed trade dress;
27
28 3. Demonstrated Utility. Whether the assignee successfully used this

1 trade dress to increase the sales of its product;

2
3 4. Extent of Use. The length of time and manner in which the assignee
4 used the claimed trade dress;

5
6 5. Exclusivity. Whether the assignee's use of the claimed trade dress was
7 exclusive;

8
9 6. Copying. Whether the defendant intentionally copied the assignee's
10 trade dress; and

11
12 7. Actual Confusion. Whether the defendant's use of the plaintiff's trade
13 dress has led to actual confusion.

14
15 Descriptive marks are protectable only to the extent you find they acquired
16 distinctiveness through secondary meaning by the public coming to associate the
17 mark with a particular source. Descriptive trade dress is entitled to protection only as
18 broad as the secondary meaning it has acquired, if any. If it has acquired no
19 secondary meaning, it is entitled to no protection and cannot be considered a valid
20 trade dress.

21
22 The plaintiff has the burden of proving that the overall commercial image of
23 the KIINI bikini featuring BATHING SUIT ART #1 has acquired a secondary
24 meaning. The defendant has the burden of proving that the overall commercial image
25 of the KIINI bikini featuring BATHING SUIT ART #1 lacks a secondary meaning.

26
27 The mere fact that the plaintiff is using the overall commercial image of the
28 KIINI bikini featuring BATHING SUIT ART #1, or that the plaintiff began using it

1 before the defendant, does not mean that the trade dress has acquired secondary
2 meaning. There is no particular length of time that a trade dress must be used before
3 it acquires a secondary meaning.

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Source: Model Civ. Jury Instr. 9th Cir. 15.10 (2007)

1 **15.11 Infringement—Elements—Validity—Trade Dress—Non-Functionality**
2 **Requirement**

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A product feature is functional if it is essential to the product’s use or purpose, or if it affects the product’s cost or quality. It is non-functional if its shape or form makes no contribution to the product’s function or operation. If the feature is part of the actual benefit that consumers wish to purchase when they buy the product, the feature is functional. However, if the feature serves no purpose other than as an assurance that a particular entity made, sponsored or endorsed the product, it is non-functional.

To determine whether a product’s particular shape or form is functional, you should consider whether the design as a whole is functional, that is whether the whole collection of elements making up the design or form are essential to the product’s use or purpose.

You should assess the following factors in deciding if the product feature is functional or non-functional:

1. The Design’s Utilitarian Advantage. In considering this factor, you may examine whether the particular design or product feature yield a utilitarian advantage over how the product might be without that particular design or product feature. If there is a utilitarian advantage from having the particular design or feature, this would weigh in favor of finding the design or feature is functional; if it seems merely ornamental, incidental, or arbitrary it is more likely to be nonfunctional;

2. Availability of Alternate Designs. In considering this factor, you may

1 examine whether an alternate design could have been used, so that competition
2 in the market for that type of product would not be hindered by allowing only
3 one person to exclusively use the particular design or configuration. For this to
4 be answered in the affirmative, the alternatives must be more than merely
5 theoretical or speculative. They must be commercially feasible. The
6 unavailability of a sufficient number of alternate designs weighs in favor of
7 finding the design or feature is functional;

8
9 3. Advertising Utilitarian Advantage in the Design. In considering this
10 factor, you may examine whether the particular design or configuration has
11 been touted in any advertising as a utilitarian advantage, explicitly or
12 implicitly. If a seller advertises the utilitarian advantages of a particular feature
13 or design, this weighs in favor of finding that design or feature is functional;
14 and

15
16 4. The Design's Method of Manufacture. In considering this factor, you
17 may examine whether the particular design or feature result from a relatively
18 simple or inexpensive method of manufacture. If the design or feature is a
19 result of a particularly economical production method, this weighs in favor of
20 finding the design or feature is functional; if the feature is essential to the use
21 or purpose of the device or affects its cost or quality, it is more likely
22 functional.

23
24 The plaintiff has the burden of proving non-functionality by a preponderance
25 of the evidence in order to show that the trade dress is valid and protected from
26 infringement.

27
28 Source: Model Civ. Jury Instr. 9th Cir. 15.11 (2007)

1 **15.12 Infringement—Elements— Ownership—Generally**
2

3 The law entitles the trade dress owner to exclude others from using that trade
4 dress.

5
6 A person acquires the right to exclude others from using a trade dress by being
7 the first to use it in the marketplace.
8

9 If the plaintiff’s overall commercial image of the KIINI bikini featuring
10 BATHING SUIT ART #1 is not inherently distinctive, but the plaintiff has shown
11 that the trade dress is descriptive and that the trademark has acquired secondary
12 meaning, the plaintiff has the burden of showing by a preponderance of the evidence
13 that the plaintiff’s the overall commercial image of the KIINI bikini featuring
14 BATHING SUIT ART #1 had gained secondary meaning before the defendant first
15 began to use trade dress similar to the overall commercial image of the KIINI bikini
16 featuring BATHING SUIT ART #1.
17

18 Trade dress is “used” for purposes of this instruction when it is transported or
19 sold in commerce and the trade dress is attached to the product, or placed on its label
20 or container.
21

22 If you find by a preponderance of the evidence that the plaintiff has not shown
23 that the plaintiff used the overall commercial image of the KIINI bikini featuring
24 BATHING SUIT ART #1 before the defendant’s use of trade dress similar to the
25 overall commercial image of the KIINI bikini featuring BATHING SUIT ART #1,
26 then you cannot conclude that the plaintiff is the owner of the trade dress for purposes
27 of Instruction 15.7.
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Source: Model Civ. Jury Instr. 9th Cir. 15.12 (2007)

1 **15.13 Trademark Ownership—Assignee (15 U.S.C. § 1060)**
2

3 The owner of a trade dress or trademark may transfer it to another the owner’s
4 interest in the trade dress or trademark, that is, the right to exclude others from using
5 the trade dress or trademark. This transfer is called an assignment, and the person to
6 whom this right is assigned is called an assignee.
7

8 The assignment must be in writing and signed. To be enforceable, the
9 assignment must include the goodwill of the business connected with the mark.
10

11 An assignee may enforce this right to exclude others in an action for
12 infringement or for unfair competition under 15 U.S.C. § 1125(a).
13

14 The plaintiff is an assignee.
15
16

17 Source: Model Civ. Jury Instr. 9th Cir. 15.13 (2007)
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15.16 Infringement—Likelihood of Confusion—Factors—*Sleekcraft* Test (15 U.S.C. §§ 1114(1) and 1125(a))

You must consider whether the defendant’s use of the trademark or trade dress is likely to cause confusion about the source of the plaintiff’s or the defendant’s goods.

I will suggest some factors you should consider in deciding this. The presence or absence of any particular factor that I suggest should not necessarily resolve whether there was a likelihood of confusion, because you must consider all relevant evidence in determining this. As you consider the likelihood of confusion you should examine the following:

1. Strength or Weakness of the Plaintiff’s Trademark or Trade Dress.

The more the consuming public recognizes the plaintiff’s trademark or trade dress as an indication of origin of the plaintiff’s goods, the more likely it is that consumers would be confused about the source of the defendant’s goods if the defendant uses a similar trademark or trade dress.

2. Defendant’s Use of the Trademark or Trade Dress. If the defendant and plaintiff use their trademark or trade dress on the same, related, or complementary kinds of goods there may be a greater likelihood of confusion about the source of the goods than otherwise.

3. Similarity of Plaintiff’s and Defendant’s Trademark or Trade Dress. If the overall impression created by the plaintiff’s trademark or trade dress in the marketplace is similar to that created by the defendant’s trademark or trade dress in appearance or sound, there is a greater chance that consumers are

1 likely to be confused by defendant's use of a trademark or trade dress.
2 Similarities in appearance, sound or meaning weigh more heavily than
3 differences in finding the trademark or trade dress is similar.
4

5 4. Actual Confusion. If use by the defendant of the plaintiff's trademark
6 or trade dress has led to instances of actual confusion, this strongly suggests a
7 likelihood of confusion. However actual confusion is not required for a finding
8 of likelihood of confusion. Even if actual confusion did not occur, the
9 defendant's use of the trademark or trade dress may still be likely to cause
10 confusion. As you consider whether the trademark or trade dress used by the
11 defendant creates for consumers a likelihood of confusion with the plaintiff's
12 trademark or trade dress, you should weigh any instances of actual confusion
13 against the opportunities for such confusion. If the instances of actual
14 confusion have been relatively frequent, you may find that there has been
15 substantial actual confusion. If, by contrast, there is a very large volume of
16 sales, but only a few isolated instances of actual confusion you may find that
17 there has not been substantial actual confusion.
18

19 5. Defendant's Intent. Knowing use by defendant of the plaintiff's
20 trademark or trade dress to identify similar goods may strongly show an intent
21 to derive benefit from the reputation of the plaintiff's trademark or trade dress,
22 suggesting an intent to cause a likelihood of confusion. On the other hand, even
23 in the absence of proof that the defendant acted knowingly, the use of
24 plaintiff's trademark or trade dress to identify similar goods may indicate a
25 likelihood of confusion.
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27 6. Marketing/Advertising Channels. If the plaintiff's and defendant's
28 goods are likely to be sold in the same or similar stores or outlets, or advertised

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in similar media, this may increase the likelihood of confusion.

7. Purchaser's Degree of Care. The more sophisticated the potential buyers of the goods or the more costly the goods, the more careful and discriminating the reasonably prudent purchaser exercising ordinary caution may be. They may be less likely to be confused by similarities in the plaintiff's and defendant's trademark or trade dress.

8. Product Line Expansion. When the parties' products differ, you may consider how likely the plaintiff is to begin selling the products for which the defendant is using the plaintiff's trademark or trade dress. If there is a strong possibility of expanding into the other party's market, there is a greater likelihood of confusion.

Source: Model Civ. Jury Instr. 9th Cir. 15.16 (2007)

1 **15.17 Infringement—Likelihood of Confusion—Factor—Strength of Trademark**

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3 **Strength as a Likelihood of Confusion Factor**

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5 How strongly a trademark indicates that a good comes from a source, even if
6 unknown, is an important factor to consider in Instruction 15.16 for determining
7 whether the trademark used by the defendant creates for consumers a likelihood of
8 confusion with the plaintiff’s mark.

9

10 The plaintiff asserts “KIINI” is a trademark for its swimwear. The plaintiff
11 contends the defendant’s use of similar words in connection with the defendant’s
12 swimwear infringes plaintiff’s trademark and is likely to cause confusion about the
13 origin of goods associated with that trademark.

14

15 **Spectrum of Marks**

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17 Trademark law provides great protection to distinctive or strong trademarks.
18 Conversely, trademarks not as distinctive or strong are called “weak” trademarks and
19 receive less protection from infringing uses. Trademarks that are not distinctive are
20 not entitled to any trademark protection. For deciding trademark protectability,
21 trademarks are grouped into four categories according to their relative strength.
22 These four categories are, in order of strength or distinctiveness: arbitrary, suggestive,
23 descriptive and generic trademarks.

24

25 **Arbitrary Marks.**

26

27 The first category is “inherently distinctive” trademarks. They are considered
28 strong trademarks and are clearly protectable. They involve the arbitrary, fanciful or

1 fictitious use of a word or phrase to designate the source of a product. Such a
2 trademark is a word that in no way describes or has any relevance to the particular
3 product it is meant to identify. It may be a common word used in an unfamiliar way.
4 It may be a newly created (coined) word or parts of common words that are applied in
5 a fanciful, fictitious or unfamiliar way, solely to function as a trademark.

6
7 For instance, the common word “apple” became a strong and inherently
8 distinctive trademark when used by a company to identify the personal computers
9 that company sold. The company’s use of the word “apple” was arbitrary or fanciful
10 because “apple” did not describe and was not related to what the computer was, its
11 components, ingredients, quality, or characteristics. “Apple” was being used in an
12 arbitrary way to designate for consumers that the computer comes from a particular
13 manufacturer or source.

14
15 **Suggestive Marks.**

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17 The next category of trademarks is suggestive marks. These trademarks are
18 also inherently distinctive but are considered weaker than arbitrary trademarks.
19 Unlike arbitrary trademarks, which are in no way related to what the product is or its
20 components, quality, or characteristics, suggestive trademarks suggest some
21 characteristic or quality of the product to which they are attached. If the consumer
22 must use imagination or any type of multi-stage reasoning to understand the
23 trademark’s significance, then the trademark does not describe the product’s features,
24 but suggests them.

25
26 A suggestive use of a word involves consumers associating the qualities the
27 word suggests to the product to which the word is attached. For example, when
28 “apple” is used not to indicate a certain company’s computers, but rather “Apple-A-

1 Day” Vitamins, it is being used as a suggestive trademark. “Apple” does not describe
2 what the vitamins are. However, consumers may come to associate the healthfulness
3 of “an apple a day keeping the doctor away” with the supposed benefits of taking
4 “Apple-A-Day” Vitamins.

5
6 **Descriptive Marks.**

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8 The third category of trademarks is descriptive trademarks. These marks
9 directly identify or describe some aspect, characteristic, or quality of the product to
10 which they are affixed in a straightforward way that requires no exercise of
11 imagination to be understood.

12
13 For instance, the word “apple” is descriptive when used in the trademark
14 “CranApple” to designate a cranberry-apple juice. It directly describes ingredients of
15 the juice. Other common types of descriptive trademarks identify where a product
16 comes from, or the name of the person who makes or sells the product. Thus, the
17 words “Apple Valley Juice” affixed to cider from the California town of Apple
18 Valley is a descriptive trademark because it geographically describes where the cider
19 comes from.

20
21 **Generic Marks.**

22
23 The fourth category of trademarks is entitled to no protection at all. They are
24 called generic trademarks and they give the general name of the product of the
25 plaintiff. They are part of our common language that we need to identify all such
26 similar products. They are the common name for the product to which they are
27 affixed. It is the general name for which the particular product or service is an
28 example.

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It is generic if the term answers the question “what is the product being sold?” If the average relevant consumer would identify the term with all such similar products, regardless of the provider, the term is generic and not entitled to protection as a trademark.

Clearly, the word apple can be used in a generic way and not be entitled to any trademark protection. This occurs when the word is used to identify the fleshy, red fruit from any apple tree.

The computer maker who uses that same word to identify the personal computer, or the vitamin maker who uses that word on vitamins, has no claim for trademark infringement against the grocer who used that same word to indicate the fruit sold in a store. As used by the grocer, the word is generic and does not indicate any particular source of the product. As applied to the fruit, “apple” is simply the common name for what it is that is being sold.

Secondary Meaning and Mark Strength

If you determine a trademark is weak—that is, suggestive or descriptive, you must consider the recognition that the mark has among prospective purchasers. This market recognition is called the trademark’s “secondary meaning.”

A term acquires a secondary meaning when it has been used in such a way that its primary significance in the minds of the prospective purchasers is not the product itself, but the identification of the product with a single source, regardless of whether consumers know who or what that source is. You must find that the preponderance of the evidence shows that a significant number of the consuming public associates

1 “KIINI” with a single source, in order to find that it has acquired secondary meaning.

2

3 You may consider the following factors when you determine whether “KIINI”
4 has acquired a secondary meaning:

5

6 1. Purchaser Perception. Whether the people who purchase the product
7 that bears the claimed trademark associate the trademark with the
8 assignee;

9

10 2. Advertisement. To what degree and in what manner the assignee may
11 have advertised under the claimed trademark;

12

13 3. Demonstrated Utility. Whether the assignee successfully used this
14 trademark to increase the sales of its product;

15

16 4. Extent of Use. The length of time and manner in which the assignee
17 used the claimed trademark;

18

19 5. Exclusivity. Whether the assignee’s use of the claimed trademark was
20 exclusive;

21

22 6. Copying. Whether the defendant intentionally copied the assignee’s
23 trademark; and

24

25 7. Actual Confusion. Whether the defendant’s use of the plaintiff’s
26 trademark has led to actual confusion.

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1 If a suggestive trademark has such secondary meaning, it becomes stronger. If it has
2 developed no secondary meaning, it remains a weak trademark.

3

4 On the other hand, descriptive trademarks are protectable only to the extent
5 you find they acquired distinctiveness through secondary meaning by the public
6 coming to associate the mark with a particular source. Descriptive trademarks are
7 entitled to a protection only as broad as the secondary meaning they have acquired, if
8 any. If they have acquired no secondary meaning, they are entitled to no protection.

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11 Source: Model Civ. Jury Instr. 9th Cir. 15.17 (2007)

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1 **15.24 Trademark Damages—Actual or Statutory Notice (15 U.S.C. § 1111)**

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3 In order for plaintiff to recover damages, the plaintiff has the burden of proving
4 by a preponderance of the evidence that defendant had either statutory or actual
5 notice that the plaintiff’s trademark was registered.

6

7 Defendant had statutory notice if:

8

9 1. plaintiff displayed with the trademark the words “Registered in U.S.
10 Patent and Trademark Office” or

11

12 2. plaintiff displayed with the trademark the words “Reg. U.S. Pat. &
13 Tm. Off.” or

14

15 3. plaintiff displayed the trademark with the letter R enclosed within a
16 circle, thus ®.

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19 Source: Model Civ. Jury Instr. 9th Cir. 15.24 (2007)

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1 **15.25 Trademark Damages—Plaintiff’s Actual Damages (15 U.S.C. § 1117(a))**

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 If you find for the plaintiff on the plaintiff’s infringement claim and find that the defendant had statutory notice or actual notice of the plaintiff’s registered trade dress or trademark, you must determine the plaintiff’s actual damages.

 The plaintiff has the burden of proving actual damages by a preponderance of the evidence. Damages means the amount of money which will reasonably and fairly compensate the plaintiff for any injury you find was caused by the defendant’s infringement of the plaintiff’s registered trademark or trade dress.

You should consider the following:

1. The injury to the plaintiff’s reputation;
2. The injury to plaintiff’s goodwill, including injury to the plaintiff’s general business reputation;
3. The lost profits that the plaintiff would have earned but for the defendant’s infringement. Profit is determined by deducting all expenses from gross revenue;
4. The expense of preventing customers from being deceived;
5. The cost of future corrective advertising reasonably required to correct any public confusion caused by the infringement.

1 When considering prospective costs (e.g., cost of future advertising, expense of
2 preventing customers from being deceived), you must not overcompensate.
3 Accordingly, your award of such future costs should not exceed the actual damage to
4 the value of the plaintiff's trade dress at the time of the infringement by the
5 defendant.

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8 Source: Model Civ. Jury Instr. 9th Cir. 15.25 (2007)

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1 **15.26 Trademark Damages—Defendant’s Profits (15 U.S.C. § 1117(a))**

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3 In addition to actual damages, the plaintiff is entitled to any profits earned by
4 the defendant that are attributable to the infringement, which the plaintiff proves by a
5 preponderance of the evidence. You may not, however, include in any award of
6 profits any amount that you took into account in determining actual damages.

7

8 Profit is determined by deducting all expenses from gross revenue.

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10 Gross revenue is all of defendant’s receipts from using the trademark or trade
11 dress in the sale of a product. The plaintiff has the burden of proving a defendant’s
12 gross revenue by a preponderance of the evidence.

13

14 Expenses are all operating and production costs incurred in producing the gross
15 revenue. The defendant has the burden of proving the expenses and the portion of the
16 profit attributable to factors other than use of the infringed trademark or trade dress
17 by a preponderance of the evidence.

18

19 Unless you find that a portion of the profit from the sale of the defendant’s
20 swimwear using the trade dress is attributable to factors other than use of the
21 trademark or trade dress, you shall find that the total profit is attributable to the
22 infringement.

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25 Source: Model Civ. Jury Instr. 9th Cir. 15.26 (2007)

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1 **15.27 Trademark Damages—Intentional Infringement (15 U.S.C. § 1117(b))**

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3 If you find that the defendant infringed the plaintiff’s trademark or trade dress,
4 you must also determine whether the defendant used the trademark or trade dress
5 intentionally, knowing it was an infringement.

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8 Source: Model Civ. Jury Instr. 9th Cir. 15.27 (2007)

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1 **Federal Unfair Competition**

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3 Plaintiff KIINI has claimed that defendant Victoria’s Secret Stores Brand
4 Management, Inc. has engaged in unfair competition. To establish this claim, KIINI
5 has the burden of proving each of the following by a preponderance of the evidence:
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7 1. Victoria’s Secret Stores Brand Management, Inc. used in commerce a
8 false designation of origin, false description of fact, misleading description of
9 fact, false representation of fact, or misleading representation of fact on or in
10 connection with any goods or container for goods;
11

12 2. The use of the false designation of origin or misleading description of
13 fact is likely to cause confusion as to the origin of Victoria’s Secret Stores
14 Brand Management, Inc.’s goods; the affiliation or association of Victoria’s
15 Secret Stores Brand Management, Inc. with KIINI; or the approval by KIINI of
16 Victoria’s Secret Stores Brand Management, Inc.’s sale of goods in markets
17 that were not in fact authorized by KIINI; and
18

19 3. KIINI was and is likely to be damaged by Victoria’s Secret Stores
20 Brand Management, Inc.’s actions.
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23 Source/Authority: 15 U.S.C. 1125(a)(1); 90 Am. Jur. Proof of Facts 3d 95 (Originally
24 published in 2006); BIOTAB NUTRACEUTICALS, INC., a California corporation,
25 Plaintiff, v. BEAMONSTAR, LLC, an Arizona limited liability company; Jeff
26 Bolanos, an individual dba Beamonstar; Beamonstar Products, Inc., an Arizona
27 corporation; and Does 1 through 100, Inclusive, Defendants., 2011 WL 13006813
28 (C.D.Cal.)

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Federal Unfair Competition Damages—Defendant’s Profits (15 U.S.C. § 1117(a))

In addition to actual damages, the plaintiff is entitled to any profits earned by the defendant that are attributable to the unfair competition, which the plaintiff proves by a preponderance of the evidence. You may not, however, include in any award of profits any amount that you took into account in determining actual damages.

Profit is determined by deducting all expenses from gross revenue.

Gross revenue is all of defendant’s receipts from unfairly competing in the sale of a product. The plaintiff has the burden of proving a defendant’s gross revenue by a preponderance of the evidence.

Expenses are all operating and production costs incurred in producing the gross revenue. The defendant has the burden of proving the expenses and the portion of the profit attributable to factors other than unfair competition by a preponderance of the evidence.

Unless you find that a portion of the profit from the sale of the defendant’s swimwear is attributable to factors other than unfair competition, you shall find that the total profit is attributable to the infringement.

Source: Model Civ. Jury Instr. 9th Cir. 15.26 (2007)

1 **California Unfair Competition**

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3 Plaintiff KIINI contends that defendant Victoria’s Secret Stores Brand
4 Management, Inc. has engaged in unfair competition in violation of California
5 statutory law and common law.

6
7 If you find that Victoria’s Secret Stores Brand Management, Inc. has engaged
8 in trademark infringement, trade dress infringement, copyright infringement or
9 federal unfair competition, you should also find that they have engaged in California
10 statutory and common law unfair competition.

11
12 If you find that Victoria’s Secret Stores Brand Management, Inc. has not
13 engaged in trademark infringement, trade dress infringement, copyright infringement
14 or federal unfair competition, then you should find that they have not engaged in
15 California statutory and common law unfair competition.

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18 Authority: *Enesco Corp. v. Price/Costco, Inc.*, 146 F.3d 1083, 1084 n.1 (9th Cir.
19 1998); Cal. Bus. & Prof. Code § 17200; Ninth Circuit Manual of Model Jury
20 Instructions: Civil § 15.5 (2010); *Cleary v. News Corp.*, 30 F.3d 1255, 1262-63 (9th
21 Cir. 1994)

1 **California Unfair Competition Damages—Defendant’s Profits**

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In addition to actual damages, the plaintiff is entitled to any profits earned by the defendant that are attributable to the unfair competition, to the extent that it is restitutionary, which the plaintiff proves by a preponderance of the evidence. You may not, however, include in any award of profits any amount that you took into account in determining actual damages.

Profit is determined by deducting all expenses from gross revenue. Expenses are all operating and production costs incurred in producing the gross revenue.

Authority: *Matoff v. Brinker Rest. Corp.*, 439 F. Supp. 2d 1035 (C.D. Cal. 2006)

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Dated: February 3, 2017

HOWARTH & SMITH

By: /s/ Suzelle M. Smith

Suzelle M. Smith

Attorneys for Plaintiff KIINI LLC