

Expert Report of David J. Franklyn  
*AirWair Int'l v. ITX USA LLC*, 3:19-cv-07641 (N.D. Cal)

EXPERT REPORT OF DAVID J. FRANKLYN

**I. QUALIFICATIONS**

1. I am currently a professor of Law and Business at Golden Gate University. I hold a dual appointment between the GGU School of Law and Ageno School of Business. Within the GGU School of Law, I teach Intellectual Property Law. Within the Ageno School of Business, I teach a variety of marketing and survey design classes. I am also the Director of the McCarthy Institute, and editor-in-chief and coauthor of McCarthy's Desk Encyclopedia of Intellectual Property Law.
2. Formerly, between 2000 and 2018, I was a professor of Law and Executive Director of the McCarthy Institute for Intellectual Property and Technology Law at USF and Director of the Center for the Empirical Study of Trademark Law (CEST). There, I taught law school classes on trademark law, patent law, copyright law, trade secret law and other forms of intellectual property.
3. I have consulted and/or qualified as an expert witness on behalf of clients in numerous cases involving trade dress, consumer perception and behavior issues and related damages issues, including in matters in the United States (federal and various state courts), Asia, the European Union, the Middle East and South America.
4. Specifically, I have conducted trademark analysis and consumer perception surveys in a number of trade dress cases, including but not limited to the matters referenced in Exhibit A and have consulted with a number of companies involving trade dress claim interpretation and feature evaluation issues.
5. Additionally, I am the winner of the 2016 Rossman Award for the more significant contribution to IP scholarship for the article *The Problem of Mop Heads In the Era of Apps: Toward more Rigorous Standards Of Value Apportionment In Contemporary Patent Law*, 98 Journal of the Patent and Trademark Office Society (2016).
6. In addition to my survey research experience, I hold a J.D. from University of Michigan Law School. Additional biographical material, including lists of testimony and publications, is provided in Exhibit A.

**II. ASSIGNMENT**

7. I was retained by AirWair International to provide an expert evaluation of the expert report submitted by Caroline de Baere in the matter of *AirWair Int'l v. ITX USA LLC*, 3:19-cv-07641. As part of this evaluation, I was asked to opine on Ms. de Baere's analysis of the registration, secondary meaning, and functionality.
8. In rendering this opinion, I reviewed and evaluated the following materials, including:
  1. The First Amended Complaint filed by 3:19-cv-07641.
  2. ITX USA LLC's Answer and Counterclaims.

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3. AirWair's Registered Trade Dress Registrations Nos:
    1. 2,437,750
    2. 2,437,751
    3. 2,102,468
    4. 5,067,689
    5. 5,067,692
  4. Declaration of Caroline de Baere and Exhibits
  5. Pictures of AirWair's Dr. Martens products
  6. Pictures of Pull & Bear's Derby shoes with topstitching, White platform boots, Black platform derby shoes, and Faux suede lace front chunky sole boots in taupe.
9. I also relied on my knowledge, skills and experience as an intellectual property law professor, my knowledge of trademark and patent law, and my experience and expertise in designing and developing consumer surveys for how products develop distinctive design elements, trademarks and secondary meaning in the market for consumers.
10. Several statements in sections of this report may include footnotes to various declarations, exhibits, citations to the record, statutes, case law, or other materials that provide a factual and/or legal basis for my statements. The basis of my opinions is not limited to these citations, but may also include my own knowledge, understanding, and analysis of the facts and law.

### III. SUMMARY OF OPINIONS<sup>1</sup>

11. It is my opinion that Ms. de Baere begins her analysis with two faulty presumptions about registration that cascade and call into question the validity of her entire report.
12. First, Ms. de Baere misrepresents the elements and misunderstands the construction of AirWair's design registrations. She does not interpret the drawings and their demarcation lines accurately or according to the plain language of the registrations that the USPTO has examined and approved as valid. These registrations include both word descriptions and drawings that define the registered marks. These descriptions and drawings are typical of those commonly used in trade dress registrations in the United States. In addition, Ms. de Baere fails to consider the specimen showing use of the mark, which is required by USPTO procedure. Those specimens, as filed in each of the registrations, provide clear guidance as to the mark as it is also described in words and drawings.
13. Second, Ms. de Baere incorrectly presumes that AirWair's entire trade dress is encompassed in the written description of the registration. However, the protectable AirWair trade dress is not limited to the words in the registration, but rather includes all of the design elements that are used in commerce and have gained secondary meaning. To turn the analysis into literal claim construction essentially subverts trademark law into patent law.

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<sup>1</sup> Analysis underlying these opinions follows in Section 5 of my report. I reserve the right to amend or supplement these opinions based on review of additional materials, including but not limited to, additional evidence, pleadings, discovery, or testimony of witnesses from depositions or trial.

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14. The actionable trade dress registrations at issue here are summarized as follows:
  - a. 2,437,750 Trade Dress Mark Registration ('750): The yellow welt stitch located around the perimeter of footwear.
  - b. 2,437,751 Trade Dress Mark Registration ('751): The combination of yellow stitching in the welt area and a two-tone grooved sole edge.
  - c. 2,102,468 Trade Dress Mark Registration ('468): The design of an undersole.
  - d. 5,067,689 Trade Dress Mark Registration ('689): The design of a sole edge including longitudinal ribbing and a dark color band over a light color.
  - e. 5,067,692 Trade Dress Mark Registration ('692): Longitudinal ribbing and a dark color band over a light color on the outer sole edge, welt stitching, and a tab located at the top back heel of footwear.
15. It is my opinion that AirWair's registered trade dress is unambiguous, valid, and protectable. Moreover, the registered trade dress claims form the foundation, but not the boundary, of the protectable designs, which includes the totality of design as it appears to ordinary consumers in commerce. In addition, Ms. de Baere fails to note that the first three registrations are incontestable, which means that the any arguments regarding lack of secondary meaning are inapplicable to those registrations to which a conclusive presumption of distinctiveness attaches.
16. It is also my opinion that, where there is an overall similarity of appearance of the subject items an inference of copying is likely.
17. Reviewing Ms. de Baere's conclusions regarding functionality of the trademark, I conclude that she has failed to apply the tests for functionality that she herself references.<sup>2</sup> While she agrees that individual elements of trade dress may be functional without the trade dress as a whole being considered functional (citing *Clicks Billiards, Inc. v. Sixshooters, Inc.*, 251 F.3d 1252, 1259 (9<sup>th</sup> Cir. 1998)), she then ignores the law and proceeds to conduct her analysis of individual features. Moreover, that analysis is flawed because it is based on her intentional misreading of the AirWair trade dress registrations (as discussed below). When Ms. de Baere does purport to analyze functionality of the "Common Elements" (which are apparently derived from US Reg. 5,067,692—"longitudinal ribbing and a dark color band over a light color on the outer sole edge, welt stitching and a tab located at the top back heel of footwear") the analysis is based on her misreading of the '692 registration and incorrectly applies the test of functionality to that particular combination of features. Note that Ms. de Baere does not analyze functionality with regard to any of the other registrations and therefore her opinion is of no significance with regard to any registration other than the '692 registration. As explained below, it is my opinion that AirWair's trade dress is not

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<sup>2</sup> Initial Expert Report of Caroline de Baere at ¶46 (citing to *Blumenthal Distrib., Inc. v. Herman Miller, Inc.*, 963 F.3d 14 859, 865 (9<sup>th</sup> Cir. 2020); *Disc Golf Association, Inc. v. Champion Discs, Inc.*, 158 F.3d 1002, 1006 (9<sup>th</sup> Cir. 1998)).

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essential to the use or purpose of the footwear. In fact, the footwear examples cited by Ms. de Baere prove exactly this point, as they appear to contain features that are dissimilar to the registered trade dress and are apparently nonetheless successful in the marketplace. They demonstrate that there are alternative design elements available to footwear designers.

18. Ms. de Baere also mentions aesthetic functionality in her report and I considered her opinions from that perspective as well. I conclude that any opinion based on aesthetic functionality is without foundation. Ms. de Baere does not apply the agreed legal test for aesthetic functionality—whether restriction of use of the claimed features would impose a “*significant non-reputational disadvantage on competitors.*”<sup>3</sup> Therefore, it is uncertain from her report whether she intends to base her opinion on utilitarian functionality as she argues or on aesthetic functionality, which she also mentions. As explained below, I conclude that there is no significant non-reputational disadvantage to competitors from AirWair’s exclusive use of its trademarks, including the elements described in the ‘692 registration as a source indicator for its footwear.
19. In my opinion, Ms. de Baere’s unreasonably narrow reading of the trade dress, her analysis which excludes from consideration some elements of the trade dress, including non-functional design elements, her focus of individual elements rather than the combination of features claimed by AirWair and her failure to consider all of the factors required by law to determine functionality, render her opinion on functionality incorrect and without foundation.
20. Ms. de Baere’s conclusions regarding confusing similarity of the challenged footwear with AirWair’s registered trademarks are not founded on a sound consideration of the factors which are required under Ninth Circuit law.<sup>4</sup> While Ms. de Baere cites the proper legal standard, she fails to consider each of the required factors. In addition, Ms. de Baere bases her opinion of confusing similarity entirely on her own observations. As a professional footwear designer in the business for many years, her opinion regarding similarity of the goods or likelihood of confusion is irrelevant; this issue must be considered from the perspective of the ordinary consumer of the type of goods at issue.

#### IV. LEGAL PRINCIPLES AND METHODOLOGY

21. In rendering my opinion, I relied in part on the legal principles articulated below and applied these legal principles in 1) assessing the validity of the AirWair Dr. Martens trade dress, 2) assessing the defense of functionality, and 3) assessing secondary meaning.
22. Trademark and patent law cover different types of intellectual property. A trademark is any word, name, symbol, or design, or any combination thereof, used in commerce to identify and distinguish the goods of one manufacturer or seller from those of another and to indicate the source of the goods.<sup>5</sup>

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<sup>3</sup> *Id.*

<sup>4</sup> *adidas Am., Inc. v. Skechers USA, Inc.*, 890 F.3d 747, 755 (9th Cir. 2018).

<sup>5</sup> See 15 U.S.C. § 1127.

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23. Accordingly, I have applied well-known principles of federal trademark law, federal and state court decisions, treatise content, and my knowledge of the law as a trademark professor in rendering these opinions.

#### **IV(A). Trade Dress**

24. Trade dress refers to the “total image of a product” and may include features such as “size, shape, color, color combinations, texture or graphics.”<sup>6</sup>

25. A trade dress includes a product design that is so distinctive it has a “source-identifying appearance.”<sup>7</sup> In other words, anything that reminds consumers of or connects consumers to the brand can be in the realm of trademark or trade dress protection.

26. Trade dress generally includes three categories: Packages and containers, visual image, and the shape and design of the product itself.<sup>8</sup>

27. Trade dress is the entire composition of source denoting elements.<sup>9</sup>

28. The test for trade dress infringement is likelihood of confusion.<sup>10</sup>

29. “A defendant cannot avoid liability for infringing a trade dress by segregating out individual elements of the trade dress as defined by plaintiff and arguing that no one of these is valid and protectable in and of itself... This has been the rule for close to a century.”<sup>11</sup>

30. When analyzing the totality of trade dress elements (“tout ensemble”) to determine likelihood of confusion, the analysis must be conducted according to perception of an average buyer—not of an expert product designer.<sup>12</sup>

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<sup>6</sup> *Continental Laboratory Products, Inc. v. Medax Intern., Inc.* (S.D. Cal. 2000) 114 F.Supp.2d 992, 997. The design of a product, as well as its packaging, both are part of its “trade dress.” (*Magic Kitchen LLC v. Good Things Internat., Ltd.* (2007) 153 Cal.App.4th 1144, 1155, citing *Fuji Kogyo Co., Ltd. v. Pacific Bay Intern., Inc.* (6th Cir. 2006) 461 F.3d 675, 683.).

<sup>7</sup> *Blumenthal Distrib., Inc. v. Herman Miller, Inc.*, 963 F.3d 859, 864 (9th Cir. 2020). See also *TrafFix Devices, Inc. v. Mktg. Displays, Inc.*, 532 U.S. 23, 28, 121 S.Ct. 1255, 149 L.Ed.2d 164 (2001) (“The design or packaging of a product may acquire a distinctiveness which serves to identify the product with its manufacturer or source; and a design or package which acquires this secondary meaning ... is a trade dress[.]”).

<sup>8</sup> *Id.* at 864 (“In addition to using distinctive names, logos, packages, or labels to identify its products, a seller can also design the products themselves to have distinctive, source-identifying appearances. Such appearances can receive protection under trademark law against infringement and dilution.”).

<sup>9</sup> *Id.*

<sup>10</sup> § 8:15. Comparing trade dresses to determine infringement, 1 McCarthy on Trademarks and Unfair Competition § 8:15 (5th ed.) (“The test of trade dress infringement is the same as the traditional test of trademark infringement: is there a likelihood of confusion resulting from the accused trade dress?”).

<sup>11</sup> § 8:2. Trade dress compared to trademarks—Focus on totality of elements of the “trade dress”, 1 McCarthy on Trademarks and Unfair Competition § 8:2 (5th ed.).

<sup>12</sup> *Chun King Sales, Inc. v. Oriental Foods*, 136 F. Supp. 659, 664, 108 U.S.P.Q. 400 (S.D. Cal. 1955), *judgment aff'd in part, rev'd in part on other grounds*, 244 F.2d 909, 113 U.S.P.Q. 404 (9th Cir. 1957) (“[I]n determining likelihood to create confusion, the cases just cited teach that the tout ensemble of the article as it appears to the average buyer is to be considered.”).

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#### IV(B). Functionality

31. A feature is functional as a matter of law if it is "essential to the use or purpose of the article or if it affects the cost or quality of the article."<sup>13</sup>
32. In evaluating the functionality defense, courts generally consider several non-dispositive factors such as:
  - a. whether the design yields a utilitarian advantage;
  - b. whether alternative designs are available;
  - c. whether advertising touts the utilitarian advantages of the design; and
  - d. whether the particular design results from a comparatively simple or inexpensive method of manufacture.<sup>14</sup>
33. The crucial question is "whether the [] design itself, as the claimed protectable trade dress or mark, plays a functional role in the overall product."<sup>15</sup>
34. Functionality looks at whether the overall combination of elements, taken as a whole, is functional.<sup>16</sup> No one factor is dispositive.<sup>17</sup> A product may have individually functional elements and still be non-functional as a whole.<sup>18</sup>
35. A design feature that only makes the product easy to identify and unique cannot be connected to consumer demands for the functions of the product, and hence cannot be considered functional.
36. Aesthetic functionality is a version of the functionality defense that is only relevant where a design confers "a significant non-reputation-related disadvantage."<sup>19</sup> Stated another way, a design is aesthetically functional if it "confers a significant benefit that cannot practically be duplicated by the use of alternative designs."<sup>20</sup>

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<sup>13</sup> *Traffix Devices, Inc. v. Mktg. Displays, Inc.*, 532 U.S. 23, 33, 58 USPQ2d 1001, 1006 (2001); *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 165, 34 USPQ2d 1161, 1163-64 (1995); *Inwood Labs., Inc. v. Ives Labs., Inc.*, 456 U.S. 844, 850, n.10, 214 USPQ 1, 4, n.10 (1982).

<sup>14</sup> *Disc Golf Association, Inc. v. Champion Discs, Inc.*, 158 F.3d 1002, 1006 (9th Cir. 1998).

<sup>15</sup> *Id.* at 1008.

<sup>16</sup> *Clicks Billiards, Inc. v. Sixshooters, Inc.*, 251 F.3d 1252, 1259 (9th Cir. 2001).

<sup>17</sup> *Valu Eng'g, Inc. v. Rexnord Corp.*, 278 F.3d 1268, 1274-75 (Fed. Cir. 2002).

<sup>18</sup> In a recent appellate decision out of the 7th Circuit, *Bodum USA, Inc. v. A Top New Casting Inc.*, 927 F.3d 486 (7th Circuit 2019), the court upheld the validity of the trade dress in the Bodum coffee carafe, finding that the challenger's expert had not demonstrated that the design features of Bodum's carafe (e.g., the silver domed top, wide C-shaped handle, metal spokes around the glass) were entirely functional in their design choice. Although each of those elements had some functional purpose, there were other obvious designs that could have been used, and therefore the trade dress could encompass particular design features that contributed to the desirable look and feel of the particular design chosen by Bodum. In other words, even functional design elements were within the scope of Bodum's unique and valid trade dress in the shape and configuration of its coffee carafe.

<sup>19</sup> See note 10. See also § 7:80. Uneven use of the aesthetic functionality theory in the modern courts, 1 McCarthy on Trademarks and Unfair Competition § 7:80 (5th ed.).

<sup>20</sup> Restatement Third, Unfair Competition § 17, comment c.

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37. The aesthetic functionality doctrine has varying levels of support and some courts have rejected it outright. Some scholars have suggested that defensive aesthetic functionality is “bad law, poor policy, and provides no coherent rules.”<sup>21</sup>

#### **IV(C). Secondary Meaning**

38. A showing of secondary meaning is generally only required to protect trademarks that are not incontestable or inherently distinctive.<sup>22</sup>

39. Secondary meaning is primarily created by an association between the designation and a single source.<sup>23</sup>

40. Secondary meaning tests vary in different jurisdictions, but generally orient around the same core factors. For purposes of this opinion, the *Transgo*<sup>24</sup> factors will be used and include:

- a. Whether actual purchasers of the product bearing the claimed trade [dress] associate the trade [dress] with the producer,
- b. The degree and manner of advertising under the claimed trade [dress],
- c. The length and manner of use of the claimed trade [dress] and,
- d. Whether use of the claimed trade [dress] has been exclusive.

#### **V. ANALYSIS**

41. It is my opinion that AirWair’s trade dress is presumptively valid and enforceable. AirWair’s trade dress was first used in commerce as early as 1984 in the United States.<sup>25</sup> AirWair’s earliest trade dress registration dates from 1997 (US Reg. 2,102,468). The Yellow Welt Stitch mark and the combination of Yellow Welt Stitch and Two Tone Grooved Sole Edge (US Reg. Nos. 2,437,750 and 2,437,751) were registered on March 27, 2001. These marks are now incontestable and have been incontestable for more than 10 years. AirWair’s registrations for its Two Tone Grooved Sole Edge mark and for the combination of Two Tone Grooved Sole Edge, Welt Stitch and Heel Tab (US Reg. Nos. 5,067,689 and 5,067,692) have been on the Principal Register of the USPTO since October 25, 2016 and have met all of the requirements for trade dress registration.<sup>17</sup>

42. Based on my evaluation of the AirWair trade dress registrations, the AirWair trade dress was examined by USPTO attorneys, who evaluated the submitted trade dress in AirWair’s registration including the description of the mark in words, the drawings and the submitted specimens and found that the trade dress met the legal requirements to qualify as a lawful and enforceable trade dress. These registrations comport with the USPTO requirements and

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<sup>21</sup> § 7:82. “Defensive” aesthetic functionality, 1 McCarthy on Trademarks and Unfair Competition § 7:82 (5th ed.).

<sup>22</sup> 15 U.S.C.A. § 1065 (West).

<sup>23</sup> “Secondary meaning has been defined as association, nothing more.” *Carter-Wallace, Inc. v. Procter & Gamble Co.*, 434 F.2d 794, 802, 167 U.S.P.Q. 713 (9th Cir. 1970).

<sup>24</sup> *Transgo, Inc. v. Ajac Transmission Parts Corp.*, 768 F.2d 1001, 1015 (9th Cir. 1985).

<sup>25</sup> See First Amended Complaint, *AirWair Int'l v. ITX USA LLC*, 3:19-cv-07641 (Feb. 21, 2020) and US Registrations 2,102,468, 2,437,750, 2,437,751, 5,067,689, and 5,067,692.

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the words, drawings and specimens combined are typical of those submitted by trademark owners and accepted by the USPTO for registration of trade dress.

43. Registration with the USPTO carries with it a presumption of validity and the exclusive right to use it in commerce.<sup>26</sup> A challenger of the validity of a registered trademark bears the burden of asserting a valid defense such as lack of secondary meaning or functionality.
44. Ms. de Baere ignores and makes no reference to the incontestable status of AirWair's trade dress as described in US Reg. Nos. 2,437,750 (yellow welt stitch located around the perimeter of footwear) 2,437,751 (combination of yellow stitching in the welt area and a two-tone grooved sole edge) and 2,102,468 (DMS undersole design). A mark that obtains incontestable status receives an irrebuttable presumption of distinctiveness, and arguments about lack of secondary meaning do not apply to incontestable marks. One of the primary policy reasons behind incontestable status is to "avoid having the validity of trademarks litigated endlessly."<sup>27</sup>

**V(A). Ms. de Baere's Analysis is Premised on a Faulty Interpretation of AirWair's Trade Dress.**

45. A trademark or trade dress registration is the starting point to understanding the rights at issue and the analysis must flow out of a proper foundation. The USPTO examination, registration, and amendment process ensure clarity of description and meaning for marks.<sup>28</sup> The examination process specifically evaluates the role of multiple elements within a mark (such as the '692 Design) to ensure that registered descriptions are clear and includes instructions for marks that comprise multiple elements,<sup>29</sup> include color,<sup>30</sup> and use broken lines to indicate position.<sup>31</sup>
46. An inaccurate understanding of the registration itself can taint the entire subsequent analysis. ITX's expert, Ms. de Baere, states in her Initial Expert Report that she is "unclear as to the meaning of some language used in AirWair's registration's claims," continuing on to quote the written language for '750, '689, and '692 registrations.<sup>32</sup> An improper construction of the registration language subsequently leads to an improper application of functionality and likelihood of confusion analysis.<sup>33</sup>

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<sup>26</sup> Lanham Act § 33(a). *Adidas Am., Inc. v. Skechers USA, Inc.*, 149 F. Supp. 3d 1222, 1234 (D. Or. 2016), *aff'd in part, rev'd in part*, 890 F.3d 747 (9th Cir. 2018) ("A mark registered under Section 2 of the Lanham Act is presumed valid, and the holder of a registered mark is presumed to have the exclusive right to use it in commerce.").

<sup>27</sup> § 32:142. Incontestability as quieting title and validity of the mark, 6 McCarthy on Trademarks and Unfair Competition § 32:142 (5th ed.).

<sup>28</sup> See generally Application Requirements, TMEP §800

<sup>29</sup> Application Requirements, Drawing Must Show Only One Mark, TMEP §807.1

<sup>30</sup> Application Requirements, Color in the Mark, TMEP §807.07

<sup>31</sup> Application Requirements, Broken Lines to Show Placement, TMEP §807.08

<sup>32</sup> Initial Expert Report of Caroline de Baere at ¶ 31.

<sup>33</sup> § 19:58. Drawing of mark—Standard character and special format word mark registrations, 3 McCarthy on Trademarks and Unfair Competition § 19:58 (5th ed.).



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47. Broken or dotted lines in the drawing are necessary to adequately depict the commercial impression of the mark. Broken lines are used to indicate the placement or position of a mark and disclaim elements that are not part of the registered mark. Ms. de Baere does not properly consider the dotted lines in the claimed registrations, which explain the position of the marks. For example, Ms. de Baere states that the words “sole edge” are unclear to her; however, a review of either the drawing or specimen associated with the registrations clearly shows the position of the mark.<sup>34</sup>
48. From a trademark perspective the words, drawings, and specimens in AirWair’s applications and registrations are typical of what is described and very clear.<sup>35</sup> The relevant legal standard requires that the “drawing should show the mark in black on a white background.”<sup>36</sup> In addition, the drawing must be “clear” and “fairly represent the mark.”<sup>37</sup> Importantly, “[t]he main purpose of the drawing is to provide notice of the nature of the mark sought to be registered”<sup>38</sup> The purpose of the drawing (and trademark registration in general) is not to instruct or teach others how to make and use the design like a patent registration does. There is no requirement for trademark registration to plot out in specificity all the exact measurements, dimensions, or materials like a patent registration. It only needs to fairly and clearly represent the mark to provide notice of its nature.
49. Ms. de Baere continues to misconstrue the plain language of the registrations throughout her report. For example, when discussing her interpretation of the claimed element “sole edge with longitudinal ribbing” she pictures a “saw-tooth design” on the bottom of a sole that is clearly not what the registrations containing this element depict.

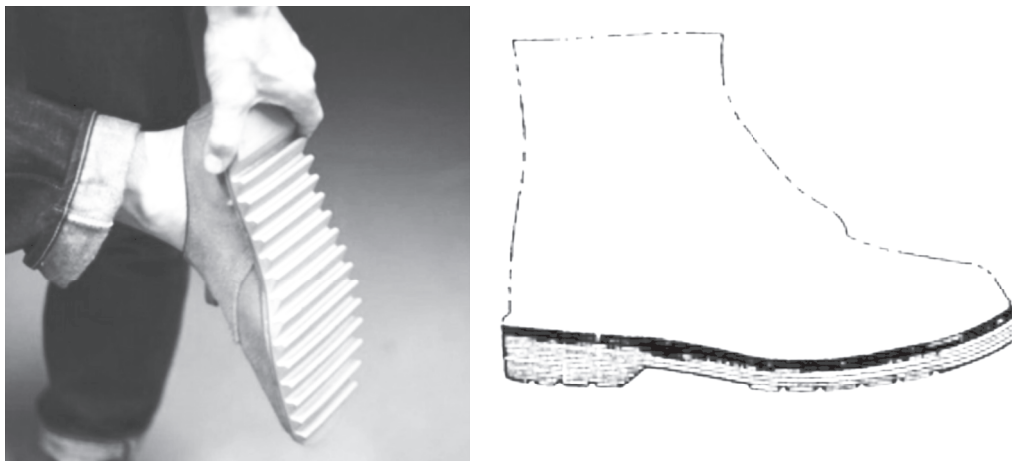


Figure 1: Image of Sole Edge – Saw-tooth Design from the Initial Expert Report of Caroline de Baere at ¶ 36 compared to the drawing from the '689 registration of the design of a sole edge including longitudinal ribbing and a dark color band over a light color. The phantom lining is not part of the mark, but merely indicates the position of the mark.

<sup>34</sup> Initial Expert Report of Caroline de Baere at ¶ 36.

<sup>35</sup> See e.g., *Converse, Inc. v. Int'l Trade Comm'n Skechers U.S.A., Inc.*, 909 F.3d 1110, 1114 (Fed. Cir. 2018) (single black and white drawing for shoe design elements sufficient for trade dress registration).

<sup>36</sup> 37 C.F.R. §2.52.

<sup>37</sup> Application Requirements, Drawing, TMEP §807.

<sup>38</sup> *Id.*

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50. Ms. de Baere’s analysis of “AirWair’s Trade Dress Claims” is premised on her opinion of what the AirWair trade dress might include based on her misreading of the words of the registrations and her failure to consider the drawings and specimens to supplement the words.<sup>39</sup> This is an improper analysis of the registrations and causes her to misapply the standards for secondary meaning and functionality later in her report.

**V(B). Ms. de Baere’s Utilitarian Functionality Analysis is Misplaced**

51. Ms. de Baere acknowledges that, despite individual elements of a trade dress being functional, the design as a whole can still be non-functional under the legal definition.<sup>40</sup> However, she nonetheless proceeds to analyze each element individually before arriving at the incorrect conclusion that the trade dress as a whole is functional.<sup>41</sup>

52. Ms. de Baere applies the incorrect standard of functionality—focusing on literal function instead of the legal definition of functionality as used in trademark law. The proper standard for functionality in trademark and trade dress law is whether the design features are “essential to the use or purpose of the article or if it affects the cost or quality of the article.”<sup>42</sup> It is not enough that the design has *some* utilitarian advantage or functionality.

53. Trade dress functionality in footwear has been examined by the courts, and it has been consistently held that functional benefit derived from the presence of features generally does not deem the design functional in the legal sense, and that numerous commercially viable alternatives exist.<sup>43</sup> Shoe sole patterns and shoe designs have repeatedly been upheld as non-functional trade dress features.<sup>44</sup>

54. Ms. de Baere’s analysis of functionality of the trade dress does not explain which of AirWair’s 5 registrations she believes are subject to the functionality defense. She does state that her analysis considered the “Common Elements” which she defines as the elements set out in the ‘692 registration.<sup>45</sup> Therefore, it appears that Ms. de Baere’s functionality analysis is limited to the ‘692 registration. Moreover, she does not discuss the yellow stitch described in the ‘750 or ‘751 registrations or the undersole design of the ‘468 registration, confirming that her functionality argument does not apply to those registrations.<sup>46</sup>

55. Ms. de Baere recognizes that yellow stitching separately or in combination with the two-tone grooved sole edge is not functional. She states, “For any conceivable function or

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<sup>39</sup> Initial Expert Report of Caroline de Baere at ¶30-44.

<sup>40</sup> *Id.* at ¶ 47-48.

<sup>41</sup> *Id.* at ¶ 49-55.

<sup>42</sup> *TrafFix Devices, Inc. v. Mktg. Displays, Inc.*, 532 U.S. 23, 32, 121 S. Ct. 1255, 1261, 149 L. Ed. 2d 164 (2001).

<sup>43</sup> *See, e.g., Converse, Inc. v. Int'l Trade Comm'n Skechers U.S.A., Inc.*, 909 F.3d 1110, 1124 (Fed. Cir. 2018) (“We find no error in the ITC’s determination that the mark is nonfunctional. Any functional benefit is derived from the presence of toe caps and bumpers generally, not the particular design of the ‘753 trademark, and there are numerous commercial alternatives to that design.”).

<sup>44</sup> *See, e.g.,* N.13-14 § 7:86. Features held nonfunctional, 1 McCarthy on Trademarks and Unfair Competition § 7:86 (5th ed.).

<sup>45</sup> Initial Expert Report of Caroline de Baere at ¶ 30, 45-58.

<sup>46</sup> *Id.*

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wardrobe matching objective, there are multiple color choices available for shoe makers to use on the welt stitch portion of footwear.”<sup>47</sup>

56. Ms. de Baere’s opinion that the “Common Elements” are functional is fatally flawed because it is based on her overly broad and incorrect interpretation of the AirWair trade dress, as discussed above.
57. Her opinion is also faulty because it relies on analyzing elements of the mark separately rather than in combination, as required under the law.
58. Even when considering the elements separately, Ms. De Baere does not take into account all of the required factors for functionality for each element. For example, with regard to the Two Tone Grooved Sole Edge, she considers only one of the factors for functionality: *whether alternative designs are available*. She does not address the three other important factors, including most critically whether the design yields a utilitarian advantage, whether advertising touts the utilitarian advantages of the design, and whether the particular design results from a comparatively simple or inexpensive method of manufacture. With regard to the heel tab and welt stitch elements of the mark, she applies only her unsupported view on utilitarian function of the features. Therefore, her analysis of functionality is erroneous and does not support an opinion on functionality of the AirWair trade dress.
59. The one example used to demonstrate that the combination of features she considers functional illustrates the problem with her analysis. The RockRooster boot that Ms. de Baere pictures is obviously different from the AirWair boot and the trade dress reflected in the RockRooster boot is plainly dissimilar from the Dr. Martens Two Grooved Sole Edge, welt stitch, and heel tab.<sup>48</sup> This obvious mistake, based on the incorrect interpretation of the trade dress, is repeated for each of the elements. See for example the Nike sneaker referenced to support the claim that a grooved sole edge is “common.”<sup>49</sup> Obviously, the pictured footwear does not contain the “two tone grooved sole edge” described in AirWair’s registrations.
60. Ms. de Baere’s analysis of the impact of AirWair’s marketing language is incorrect and misplaced.<sup>50</sup> The language that Ms. de Baere points to says nothing about any functional advantages of the trade dress. It actually makes the opposite point; the original work boot was transformed in the Dr. Martens brand into “one of the most culturally relevant brands of the modern era.”<sup>51</sup> “Rebellious Self-Expression” is the main theme of the video. A brief review of the recent popularity of the boot on celebrities, from musicians to pop culture figures to the nieces of Vice President Harris, attest to the fact that Dr. Martens are not “just a work boot.”<sup>52</sup>

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<sup>47</sup> *Id.* at ¶ 87.

<sup>48</sup> *Id.* at ¶ 56-57.

<sup>49</sup> *Id.* at ¶ 53-54.

<sup>50</sup> *Id.* at ¶ 58.

<sup>51</sup> *Id.* (caption in picture).

<sup>52</sup> “Dr. Martens were originally a modest work-wear boot that was even sold as a gardening shoe at one stage. So, how did this utilitarian boot transform into one of the most culturally relevant brands of the modern era? It is an interesting and unique story.” *Id.*

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61. Ms. de Baere's opinion that Dr. Martens footwear is "generally functional" fails to apply the law to the defense of functionality.<sup>53</sup> The question is whether the trade dress used in the footwear is functional, not whether the footwear itself serves a function. Therefore, her opinion on functionality is without foundation and incorrect.<sup>54</sup>

### **V(C). Ms. de Baere Fails to Apply Aesthetic Functionality Properly**

62. Ms. de Baere's report at times suggests that the AirWair trade dress might also be aesthetically functional. This argument, which is never clearly distinguished from her general utilitarian functionality track, also fails because it does not properly analyze any "significant non-reputation-related competitive disadvantage."<sup>55</sup>

63. An aesthetically functional design must be so essential to competition that its exclusive use would put competitors at a significant non-reputation-related competitive disadvantage.<sup>56</sup> In other words, a "visually pleasing design can be protected as trade dress so long as effective alternative designs exist for competitors to use."<sup>57</sup> Ms. de Baere's report is replete with examples of alternative designs that can and have been used by competitors.<sup>58</sup> These examples of competitors using *different* designs on footwear establishes, contrary to her conclusion, that competitors have many alternatives to AirWair's combination of trade dress features.<sup>59</sup> Therefore, Ms. de Baere's suggestion that protection of individual elements of the AirWair trade dress would put competitors at a disadvantage is contradicted by the very examples she provides.

64. To the extent that Ms. de Baere is attempting to support an aesthetic functionality defense, her argument fails because it looks to a single element and compares it to a multi-element trade dress. In this way she repeats the same mistake of isolating individual elements of the trade dress and ignoring the whole.<sup>60</sup>

65. By supplying examples of alternative designs for a sole edge, for example, Ms. de Baere refutes her own argument that the trade dress is aesthetically functional. She shows that competitors have a range of alternative designs to choose from and have used those alternatives for many years, all without objection from AirWair.

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<sup>53</sup> *Id.* at ¶ 59.

<sup>54</sup> *Id.*

<sup>55</sup> *Au-Tomotive Gold, Inc. v. Volkswagen of Am., Inc.*, 457 F.3d 1062 (9th Cir. 2006) (In the case of a claim of aesthetic functionality, an alternative test inquires whether protection of the feature as a trademark would impose a significant non-reputation-related competitive disadvantage.

<sup>56</sup> § 7:80. Uneven use of the aesthetic functionality theory in the modern courts, 1 McCarthy on Trademarks and Unfair Competition § 7:80 (5th ed.).

<sup>57</sup> *Id.*

<sup>58</sup> Initial Expert Report of Caroline de Baere at ¶34 (comparison to Georgia Boot), ¶37 (comparison to Gianvito Rossie), ¶39 (comparison to Georgia Boot), ¶40 (comparison to Dunlop),

<sup>59</sup> *Id.* at ¶ 53 (comparison to Nike), ¶53 (comparison to Sorel), ¶55 (comparison to Caterpillar).

<sup>60</sup> See Section IV(A).

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**V(D). Ms. de Baere Does Not Analyze Secondary Meaning Correctly**

66. Ms. de Baere's secondary meaning analysis fails for multiple reasons.

- a. First, it proceeds from a fundamental misreading of the registrations as described above, including ignoring the incontestable status of three of the registrations.<sup>61</sup>
- b. Second, Ms. de Baere fails to apply all of the factors necessary to establish lack of secondary meaning.
- c. Third, the factors that Ms. de Baere does apply are admittedly through the lens of an experienced, professional footwear designer and not an ordinary consumer.

67. Even with regard to the two marks that are not yet incontestable ('689 and '692), the registrations are *prima facie* evidence of secondary meaning.<sup>62</sup> A party seeking to invalidate a registered mark in such a manner bears the burden of establishing sufficient and undisputed evidence of functionality or lack of secondary meaning.

68. Ms. de Baere's secondary meaning analysis is essentially that other products use elements of AirWair's registered trade dress. This argument fails to analyze the AirWair products at issue—instead diverting attention to the marketplace alternatives which actually work in AirWair's favor by showing the plethora of alternative feature combinations available.

69. Incontestable registration protects trade dress even further and precludes invalidation arguments based on lack of distinctiveness. A defendant faced with an incontestable registered mark cannot defend by claiming that the mark is invalid because it is descriptive and lacks secondary meaning.<sup>63</sup> Ms. de Baere fails to organize her analysis in a way that isolates the incontestable registrations.

70. Ms. de Baere's secondary meaning analysis also fails because she does not properly apply the factors that she acknowledges must be used. Her analysis focuses entirely on other products in the marketplace and their design choices, not on the relevant inquiry of whether *consumers* recognize the trade dress as an indicator of source of the footwear. Her analysis doesn't inquire into whether actual purchasers of the product associate the trade dress with AirWair, nor does she discuss the degree and manner of advertising that AirWair has undertaken or the length and manner of the use of the trade dress. Nor does her analysis inquire into the exclusive use of the trade dress.

71. Ms. de Baere acknowledges that, "In the footwear industry particularly, consumers have learned to recognize design aspects appearing on a shoe as source-identifying features associated with one particular brand."<sup>64</sup> She also acknowledges that she's been aware of Dr. Martens footwear since the 1980s. Nonetheless, she fails to employ any of the relevant tests

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<sup>61</sup> See Section V(A).

<sup>62</sup> Lanham Act § 33(a).

<sup>63</sup> § 15:35. Effect of federal registration—Incontestable registrations, 2 McCarthy on Trademarks and Unfair Competition § 15:35 (5th ed.).

<sup>64</sup> Initial Expert Report of Caroline de Baere at ¶ 62.

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to measure *consumer* recognition of the claimed trade dress, relying instead on her personal view that they are “simply work boots.”

72. The only evidence adduced by Ms. de Baere in support of her secondary meaning argument is a series of pictures of “work boots” that allegedly contain the “common elements.” First, by plain inspection the comparison appears faulty, supported only by the misinterpretation of the AirWair trade dress discussed above. Second, there is no evidence that consumers view those boots as similar to Dr. Martens, nor that they were sold in the US or to consumers of Dr. Martens footwear. In short, these boots prove nothing that undercuts secondary meaning of the AirWair trade dress.<sup>65</sup>
73. Demonstrating common use of individual features of a combined mark, even if her report contained such evidence of actual substantial and significant use (which it does not), is not sufficient to establish a lack of secondary meaning in a combination of features, nor would it be sufficient without consideration of the other important elements which relate to AirWair’s use of the mark.

#### **V(E). Ms. de Baere’s Likelihood of Confusion Analysis is Improper**

74. Ms. de Baere is not qualified as a confusion expert. She has not proffered any of the generally accepted confusion analysis materials such as a market survey, current consumer research, consumer interviews, or other direct evidence. Her entire likelihood of confusion analysis is based on her own unsupported speculation as a designer.
75. Reflecting the lack of qualification, Ms. de Baere’s likelihood of confusion analysis is flawed and misapplies the key test factors. Her analysis is mistaken because it isolates individual elements, focusing on minor differences that only an expert footwear designer would (if at all) immediately notice, to the exclusion of the total, overall impression of similarity, in concluding that no confusion exists on an element-by-element basis. The proper inquiry is whether the similarity in the overall trade dress of the products “without a detailed or extended analysis” is likely to confuse an ordinary consumer.<sup>66</sup>
76. Analysis of likelihood of confusion should proceed from the standpoint of an ordinary consumer. Ms. de Baere argues that the design interpretations in question are “important to footwear professionals”<sup>67</sup> or “designers” but does not undertake the analysis from the perspective of an ordinary consumer.<sup>68</sup> Given Ms. de Baere’s experience in the footwear business she is hardly an ordinary consumer and cannot, without doing empirical research,

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<sup>65</sup> Not only are the pictured boots obviously dissimilar from Dr. Martens but there is no evidence that they are sold in the same market to the same consumers or at all. For example, the Solovair cited as the only example with “all” of the common elements is pictured from a UK retailer website, British Boot Company without any evidence that the boot has been sold in the US in any quantities or at all.

<sup>66</sup> § 4:11. Infringement of trade dress, 1 Federal Unfair Competition: Lanham Act 43(a) § 4:11 (“[T]he touchstone under section 43(a) is the similarity in the overall trade dress of the products without a detailed or extended analysis. If the overall impression is that the competing product is likely to cause confusion in the mind of the public, a violation is made out.”).

<sup>67</sup> Initial Expert Report of Caroline de Baere at ¶ 34, 98.

<sup>68</sup> Initial Expert Report of Caroline de Baere at ¶ 31, 32, 37, 39, 41, 52, 53, 74, 77, 79, 83, and 101.

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opine on whether an *ordinary consumer* in the marketplace is likely to be confused by the challenged footwear.

77. Furthermore, the few instances in which Ms. de Baere considers the ordinary consumer are cursory, generic, and internally inconsistent. For instance, Ms. de Baere argues that consumers associate work boots with uniformity, making no reference or analysis to the specific AirWair registrations and designs.<sup>69</sup> But her report also shows a multitude of work boot designs that are anything but uniform and encompass a plethora of different features and element variations.<sup>70</sup>

## V. Conclusion

78. In conclusion, as set out in detail above, it is my opinion that the Initial Expert Report of Caroline de Baere is not supported by the governing trademark law, misinterprets the relevant trade dress, fails to apply the well-established tests applicable to her analysis, and is based on conjecture rather than evidence. As a footwear designer, her opinion with regard to secondary meaning or likelihood of confusion is not relevant and nothing in the report supports her conclusions on these subjects.



**Dated: February 12, 2021**

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**David J. Franklyn**

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<sup>69</sup> Initial Expert Report of Caroline de Baere at ¶ 69.

<sup>70</sup> Initial Expert Report of Caroline de Baere at ¶ 53-57.

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**EXHIBIT A**



Expert Report of David J. Franklyn  
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**School of Law**, August 2018-present  
Professor of Intellectual Property Law, July 2018-present

##### **Golden Gate University, Edward S. Ageno School of Business**

Professor of Business, Marketing and Advertising, July 2018-present

##### **Golden Gate University School of Law and Edward S. Ageno School of Business**

Director, McCarthy Institute, July 2018-present  
Director, Center for Empirical Study of Consumer Perceptions, July 2018-present

##### **University of San Francisco School of Law**

Professor of Intellectual Property Law, 2000 – June 2018  
Subjects Taught: Trademark Law; Copyright Law; Right of Publicity; International IP Law; IP Survey; IP Theory Seminar; Moral Philosophy Seminar  
Director, J. Thomas McCarthy Institute for IP & Technology Law  
Director, Center for Empirical Study of Trademark Law (CEST)  
Director, Domestic and International LL.M. Program in IP Law

##### **University of California, Hastings College of Law**

Visiting Professor of Law, January 2006 – May 2006; January 2007 – June 2007

##### **Salmon P. Chase College of Law, Northern Kentucky University**

Associate Professor of Law, 1999 – 2000  
Assistant Professor of Law, 1996 – 2000  
*Lukowsky Award for Outstanding Professor of the Year*, 1999

##### **University of Cincinnati College of Law**

Visiting Assistant Professor of Law, August 1999 – December 1999

##### **Pater Noster High School, Los Angeles**

Teacher & Dean of Students, 1984-87

#### **Education and State Bar Admissions**

Admitted to practice in California and Illinois  
University of Michigan Law School, J.D., 1990, *cum laude*, Order of the Coif  
Evangel College, B.A., 1983, *magna cum laude*, History, Philosophy, Religion; Outstanding Philosophy Graduate; Baccalaureate Speaker, 1983

#### **Publications/Research**

*Revisiting Consumer Perceptions of Google Search Results as Google Shifts Labeling Practices* (in progress) (multinational empirical analysis of Google presentation of paid search in antitrust regulatory framework)  
*Can Online Consumers tell the Difference between Real News and Paid Commercial or Political Advertorials Masquerading as News?*  
*Going Native: Can Consumers Recognize Advertising?* 19 YALE JOURNAL OF LAW & TECHNOLOGY 77

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(2017) (with David Hyman and Calla Yee)  
*The Problem of Mop Heads in the Era of Apps: Toward More Rigorous Standards of Value Apportionment in Contemporary Patent Law*, 98 JOURNAL OF THE PATENT AND TRADEMARK OFFICE SOCIETY (2016) (with Adam Kuhn) (2016 Rossman Award winning article for most significant contribution to IP scholarship)  
*Trademark Surveys: An Undulating Path*, 92 TEXAS LAW REVIEW 2117 (2014) (with Shari Diamond)  
*Owning Oneself in a World of Others — Towards a Paid-For First Amendment*, 49 WAKE FOREST LAW REVIEW 977 (2014) (with Adam H. Kuhn)  
*Trademarks as Keywords: Who Buys Them*, 92 TEXAS LAW REVIEW 2019 (2014) (with David A. Hyman)  
*Trademarks as Search Engine Keywords: Much Ado About Something?* 26 HARVARD JOURNAL OF LAW & TECHNOLOGY 481 (2013) (with David A. Hyman)  
*Trademark Surveys and Icebergs — It's What's Under the Water* \_\_\_\_ TRADEMARK REPORTER \_\_\_\_ (forthcoming) (with Shari Diamond)  
*Search Bias and the Limits of Antitrust: An Empirical Perspective on Remedies*, ILLINOIS PROGRAM IN LAW, BEHAVIOR, AND SOCIAL SCIENCE (2015) (with David A. Hyman)  
*The European Court of Justice Rules on Keyword Ads and Trademark Rights*, 14 INTELLECTUAL PROPERTY LAW BULLETIN 89 (2010)  
*The New Federal Anti-Dilution Act: Reinstating the Myth of 'Likely' Dilutive Harm as a Mask for Anti-Free-Rider Liability*, 11 INTELLECTUAL PROPERTY LAW BULLETIN 199 (2007)  
MCCARTHY'S DESK ENCYCLOPEDIA OF INTELLECTUAL PROPERTY LAW, editor-in-chief and coauthor with J. Thomas McCarthy and Roger Schechter (3d ed. 2005)  
*Debunking Dilution Doctrine: Justifying the Anti-Free-Rider Principle in American Trademark Law*, 56 HASTINGS LAW JOURNAL 117 (2004)  
*Owning Words in Cyberspace: The Accidental Trademark Regime*, 2001 WISCONSIN LAW REVIEW 1251 (2001) *The Apparent Manufacturer Doctrine, Trademark Licensors & the Third Restatement of Torts*, 49 CASE WESTERN RESERVE LAW REVIEW 762 (1999)  
*The Third Restatement of Torts: Symposium Introduction*, 26 NORTHERN KENTUCKY LAW REVIEW 531 (1999)  
*Toward A Coherent Theory of Strict Tort Liability for Trademark Licensors*, 72 SOUTHERN CALIFORNIA LAW REVIEW 1 (1998)  
*A Property Theory of Trademark Law* (in progress)  
*The First Amendment as a Market Allocation Device in Right of Publicity Cases: Towards a Comprehensive Theory of Add-On Value, Collateral Rights and Free Riding in Intellectual Property Law* (in progress)  
*An Empirical Analysis of Google's Antitrust Settlement in the EU* (forthcoming) (with David A. Hyman)

**Professional Consulting Experience**

I have written expert reports, been deposed, drafted briefs, designed, conducted and analyzed trademark and other consumer perception surveys, counseled clients on USPTO matters, drafted license agreements, drafted settlement agreements, prepared counsel for oral argument and offered counsel on litigation strategy in a wide variety of intellectual property matters.

**Keystone Strategy LLC**, San Francisco and New York, December 2013 – present

Function as a trademark and empirical survey expert and IP consultant in a number of trademark and patent matters.

**Franklyn IP Consulting**, San Francisco, 2000–present

I have served as an independent consultant and expert witness in numerous IP cases (including patent, trade secret, antitrust, copyright, trademark, and right of publicity) on behalf of individuals and corporations, including, among others:

**Representative Clients and Matters**

ROGUE FITNESS SPLUNK CHANEL TOYOTA  
SCRUM ALLIANCE  
EMERSON RADIO  
VANS  
RIGHTSTYLE CVS  
FLORA-BAMA V. VIACOM INC. OVERHEAD GARAGE DOOR INC. OTIS MCCALLISTER  
NEWMARK REALTY CAPITAL BOBCAT  
YETI

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DEFENDER  
ICANN MAHINDRA (v. Jeep)  
APPLE  
AMAZON  
THE COCA-COLA COMPANY THE BUFFALO BILLS  
ORACLE  
FREEFLY SYSTEMS (MOVI) ROCKWELL AUTOMATION CROCS  
DIRECTV  
GREWAL  
MERIT MEDICAL SYSTEMS NOVADAQ  
NUSENDA  
POLO RALPH LAUREN REINSDORF  
SERVICE NOW  
SPOTIFY  
THE THINK GROUP  
JOIN  
KIMBERLY-CLARK  
AMAZON  
DIAGEO BRANDS  
PALM RESTAURANTS  
INTERNATIONAL OLYMPIC COMMITTEE (consultation for 2016 Olympics re: trademarks and copyrights)  
FAIRSEARCH.org (conducted consumer perception surveys in UK) FACEBOOK  
3-FORM CHROMA (3-D trademark)  
POM WONDERFUL  
BUGATTI (international trademark issues)  
RAYTHEON (filed affidavits in 10 foreign countries re: PAVEWAY mark)  
FORAY TECHNOLOGIES  
FLOWIL, INTERNATIONAL (SYLVANIA – international mark analysis)  
HERBALIFE ALLERGEN (BOTOX) MAUI PINEAPPLE CONVERSE  
BELVEDERE VODKA MOET HENNESEY MICROSOFT  
SONIA DAKAR COSMETICS KING OF THAI NOODLES LSI INDUSTRIES  
PIZZA MAN GoGo SPORTS LEVI STRAUSS NIKE  
NISSAN (dealership franchises and co-branding analysis) VOLKSWAGEN USA  
ION MEDIA NETWORKS  
PURITY COSMETICS  
ESTATE OF SIR ARTHUR CONNAN DOYLE (protecting SHERLOCK HOLMES) ESTATE OF WILLIAM  
CASTE (producer of Rosemary's Baby)  
HARD ROCK CAFÉ (international licensing issues)  
ING FERTILITY  
FIRST NIAGRA INSURANCE  
CRISTOFF (against TASTERS CHOICE (owned by NESTLE))  
DIOPTI CS MEDICAL PRODUCTS WINDOW WORLD  
BAD BOY INC (filed affidavits in several foreign countries) SILVERS (GOOGLE children's books) DUFF (against  
True Religion Jeans) SUNDBERG  
ISABELA'S KITCHEN  
BIG ISLAND CANDIES  
BLUE SHIELD OF CALIFORNIA IGB ENERGY GROUP  
HOOD RIVER DISTILLERIES  
THE ROLL GROUP/Paramount Citrus (CUTIES brand oranges) GERAWAN FARMS (PRIMA brand fruit)  
GLIDEWELL Labs (BruxZir dental crown mark)  
ROCKWELL INDUSTRIES  
BOMBARDIER RECREATIONAL PRODUCTS  
MAHINDRA  
ALCON  
HUBERT HANSEN FAMILY TRUST  
SEAPORT HOTELS  
FIX-IT AUTO

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KITCHEN CAFÉ  
FLORABAMA  
LENS.COM  
HYBRID ATHLETICS  
HEARTLAND FOODS (SPLENDA)  
EMERSON RADIO  
BONDURANT HIGH PERFORMANCE DRIVING SCHOOL

**Deposition, Court or Arbitration Testimony in the Past Ten Years**

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OGD Equip Co. v. Overhead Door Corp., Eastern District of Texas, November 2019, No. 4:17-cv-0898-ALM-KPJ (Deposition)  
Fix Auto USA v. Mondofix Inc., Montreal Arbitration, October 2019 (Arbitration Testimony)  
FCA v. Mahindra, Eastern District of Michigan, June 2019, No. 2:2018cv12645, (Trial Testimony - ITC Matter; Deposition in both matters)  
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Singh Management Co., v. Singh Building et al., Eastern District of Michigan, 2016, No: 2:2015cv11478 (Deposition and Arbitration Testimony)  
Polo Ralph Lauren USA Holdings v. United States Polo Association, Southern District of New York, 2016, No. 1:2013cv07147 (Deposition)  
Pom Wonderful v. Pur Pom, Federal Court Case in Central District of California, May 2016, CASE NO. CV 13-06917 MMM (CWx) (Deposition)  
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Gerawan v. Townsend, Townsend & Crew, Superior Court of the State of California – Fresno, 10cecg03427, December 2015, (Deposition)  
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Major Brands v. Diageo, Missouri State Court, St. Louis, September 2014, No. 1322-CC00534 (Deposition) Amazon v. IRS, Federal Tax Court, Seattle, November 2014, No. 17-72922 (Trial Testimony and Deposition) Rembrandt v. Facebook, Eastern District of Virginia, July 2013, 1:13-CV-158 (Deposition)  
Glidewell Labs v Keating, Southern District of California, 2012, SACV 11-1309-DOC ANX (Deposition)  
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Sun Pacific Group v. Paramount Group, American Arbitration Association Commercial Arbitration Tribunal, 2012, 72/180/y/01187-11, (Deposition and Arbitration Testimony)  
Millennium v. Reed Smith, New York State Court, New York City, November 2012 (Deposition) Milton Okun v. Peter Morton, California Superior Court, Los Angeles, 2010, BC369660 (Deposition)  
PWI v. Horizonte, US District Court, Southern District of Florida, 2009, 08-20738CIV-jordan\mcALLIEY (Deposition)

**Law Firm Experience**

**Mayer Brown**, *Litigation Attorney*, Chicago, IL, 1991-1996  
**United States District Court for the Eastern District of Michigan**, *Law Clerk to the Honorable John Feikens*, 1990 -1991  
**Sonnenschein, Nath & Rosenthal**, *Summer Associate*, Chicago, IL, 1990 **O'Melveny & Myers**, *Summer Associate*, Los Angeles, CA, 1989  
**Mayer Brown**, *Summer Associate*, Chicago, IL, 1988

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The McCarthy Institute Presents with the SFIPLA: Trademark Law and its Challenges in 2020—Legal updates in the EU and US (September 2020), *available at* <https://sfippla.com/events/hot-topics-in-uk-eu-and-us-trademark-law-live-via-zoom-september-2nd>

The McCarthy Institute in Conversation with Uber: Brand Values that Move Us (September 2020), *available at* <https://www.youtube.com/watch?v=J6O1z07N-9s>

The McCarthy Institute Presents with Debevoise & Plimpton: A Deep Dive into Booking.com (August 2020), *available at* [https://www.youtube.com/watch?v=G\\_rWFmsLI4](https://www.youtube.com/watch?v=G_rWFmsLI4)

The McCarthy Institute Presents with Banner & Witcoff: Patenting Vaccines re: COVID and Equal Access Issues (August 2020), *available at* <https://www.youtube.com/watch?v=rlyc2OUOxmE>

The McCarthy Institute Presents with Orrick: A deep-dive into Romag Fasteners in the United States Supreme Court (June 2020), *available at* [https://www.youtube.com/watch?v=kHL4ks\\_FMXA](https://www.youtube.com/watch?v=kHL4ks_FMXA)

### Presentations, Symposiums, Conferences

*The McCarthy Institute Goes to Oracle in the Silicon Valley* (Organizing live event for Fall 2021).

*The McCarthy Institute Goes to the EUIPO* (planned, organized, moderated, and presented at 500 person, 2-day IP conference): *Non-traditional Trademarks in the United States* (September 2019).

*The McCarthy Institute Goes to the USPTO: Forum on Brand Protection and Anti-counterfeiting Strategies* (June 2019).

*The McCarthy Institute Goes to NYU: Trademark Law and its Challenges in 2019*. Planned, organized, presented and hosted annual conference on trademark law (February 2019).

*Tutorial on the Use of Empirical Surveys in United States Trademark Registration and Litigation*. Presented to Judges and staff of the European Union Intellectual Property Office in Alicante, Spain (May 2018).

*The McCarthy Institute Goes to Google: Trademark Law and its Challenges in 2018*. Planned, organized, presented and hosted annual conference on trademark law (February 2018).

*Northern Kentucky University Law Review Symposium*. Presented published research findings on native advertising and consumer perceptions (March 2017).

*The McCarthy Institute Goes to Seattle: Trademark Law and its Challenges in 2017*. Planned, organized, spoke, and presented at trademark conference co-hosted by Microsoft & INTA and held at Amazon Corporate Conference Center (February 17, 2017).

*The McCarthy Institute Goes to San Francisco: Trademark Law and its Challenges in 2015*. Planned, organized, spoke, and presented at trademark conference co-hosted by Microsoft & INTA and held at The University of San Francisco (September 26, 2015).

*Trademark Year in Review*, Los Angeles IP Lawyers Assoc. (January 2015). *New Paradigms in Patent Monetization and Damages*, Hanson & Bridget (2015).

*The McCarthy Institute Goes to London: Trademark Law and its Challenges in 2014*. Planned, organized, spoke, and presented empirical research on Internet search regulation at conference co-hosted by Microsoft and Oxford held at the British Library in London and at Oxford University (March 13-14, 2014).

*The Use of Surveys in Trademark Litigation*, University of Texas Law Review Symposium (January 2014).

*The Purchase of Trademarks as Keywords*, University of Texas Law Review Symposium (January 2014).

*Trademarks as Keywords: Much Ado About Something?* Oxford/NYU Empirical Trademark Conference, USPTO, Washington, D.C. (September 26, 2013).

*Patent Trolls*, Keynote Speaker, ABA IP Section Lunch, San Francisco (August 2013). *Trademarks as Keywords, Much Ado About Something?* Association of Law and Economics Annual Conference, Vanderbilt Law School (May 9, 2013).

*The McCarthy Institute Goes to L.A.: Trademark Law and its Challenges in 2013* Planned, organized, and spoke at conference co-hosted by Fox and Microsoft held at Fox Entertainment in Los Angeles (February 28, 2013).

*Presented Empirical scholarship on Internet search algorithms*, Stanford Law School (November, 2012).

Expert Report of David J. Franklyn  
*AirWair Int'l v. ITX USA LLC*, 3:19-cv-07641 (N.D. Cal)

*The McCarthy Institute Goes to New York City: Trademark Law and its Challenges in 2012*. Planned, organized, spoke, and presented on topics covering gTLDs, DMCA, and SOPA/PIPA legislation at conference co-hosted by Time Warner and Microsoft in New York (February 2012).

*The McCarthy Institute Goes to Redmond: Trademark Law and its Challenges in 2011*. Planned, sponsored, moderated, and presented empirical research on keyword advertising, trademarks, and consumer perceptions of the online advertising environment at conference co-hosted by Microsoft held at Microsoft in Redmond, Washington. Organized panels on dilution; keyword advertising; Chinese trademark law; ICANN's planned roll-out of new gTLDs; keynote address by J. Thomas McCarthy; Horacio Gutierrez (Head of Global IP, Microsoft); and Judge Kong (Chief Judge, Chinese Supreme Court for IP) (February 2011).

*IP in the Cloud with Horacio Gutierrez* (Head of IP-Global; Microsoft) USF School of Law (October 2010).

*Keywords, Trademarks and Consumer Perceptions: What do Consumers Really Want When They Use Trademark as Keyword Search Terms?* USF School of Law Presentation with McCarthy Institute Academic Affiliates, Professors David Hyman (University of Illinois School of Law) and Ben Edelman (Harvard Business School) (November 2010).

*The Right of Publicity in Film*, co-presenter with top in-house IP attorneys for PIXAR and LUCAS FILM at ABA meeting, San Francisco (August 2010).

*The Effect on Trademark Owners of ICANN's planned roll-out of new top-level generic domain names (gTLDs)*, sponsored by the Center for Domain Name Abuse (CADA), San Francisco (June 2, 2010).

*Trademark Year in Review 2010*, Los Angeles Intellectual Property Lawyer's Meeting, Las Vegas (May 2010).

*Trademark Year in Review 2010*, San Francisco Intellectual Property Lawyer's Meeting, Napa (May 2010).

*Trademark Year in Review 2009*, California Bar Association IP Section Annual Meeting, San Diego (November 14, 2009).

*The Brand as Property: Trademark Law and its Challenges in the New Era*, organizer, moderator, and speaker; international trademark law symposium co-sponsored by McCarthy Institute, Microsoft, WIPO and Unitalen (a prominent Chinese IP law firm) (November 4, 2009).

*Trademark Use, Wonder Doctrine or Wrong Turn?* Vail Colorado IP Lawyers Association Retreat (January 2009).

*INTA Conference*, Panelist on Trademark and Internet Blogging, Seattle (May 2009).

*Symposium on Derivative Works and Fair Use in Copyright Law*, Speaker, moderator, and organizer, McCarthy Institute for IP & Technology Law, USF School of Law (November 1, 2008).

*International Trademark and Copyright Law*, guest lecturer, St. Charles University, Prague (July 2008).

Speaker, California Bar Association Meeting, Intellectual Property Section, (November 2008).

Speaker, International Association of Trademark Lawyers, Meeting in Aspen Colorado (January 2009). *Trademark Year in Review*, California Intellectual Property Lawyer's Association, Santa Barbara (May 2008). *Network Neutrality—What is It?* Producer and moderator, USF School of Law (January 2008).

*Trademark Year in Review 2007*, San Francisco Intellectual Property Lawyers Association, Napa (May 2007). *Trademark Year in Review 2006*, Silicon Valley IPLA, Palo Alto (November 2006).

*Trademark Trends*, California Intellectual Property Lawyers Conference, Santa Barbara (November 2006).

*The Google Library Project: Fair Use or Misappropriation?* USF School of Law (October 2006).

*International IP: Who Should be Responsible for Top-Level Domain Name Governance*, Speaker and Panel Moderator, Bay Area High Tech Conference, Stanford Law School (April 2005).

*Trademark and Copyright Update 2005*, Andrews IP Conference, San Francisco (October 2005).

*Trends in Trademark Law*, Northern and Southern California Associations of Intellectual Property Attorneys, Palm Springs (June 2005).

*Trademark Year in Review 2005*, Cooley, Gottlieb, San Francisco (June 2005).

*The Right of Publicity and First Amendment*, panelist with Judge Alex Kozinski; Northern California Chapter of the Copyright Society of America (May 2005).

*The Anti-Free-Rider Impulse in Intellectual Property Law*, Katz-Kiley Distinguished IP Lecturer, University of Houston Law School (November 2004).

*Trademark Update: 2004 Year in Review*, San Francisco IPLA Annual Meeting, Lake Tahoe (June 2004). *Toward a New Understanding of Dilution and the Anti-Free Rider Impulse*, Silicon Valley Intellectual Property Lawyer's Association (October 2003).

*Exploring the Anti-Free-Rider Impulse in American Dilution Law*, Salmon P. Chase College of Law Lecture Series (September 2003).

*Symposium on Comparative Analysis of Business Method and Software Patenting in the European Union and the United States*, moderator and organizer; co-sponsored by the McCarthy Institute and Kilburn & Strode, a London IP firm (June 2003).

*Symposium on Biotech Patent Issues*, moderator and organizer; co-sponsored by the McCarthy Institute and Morrison Foerster (March 2003).

*Victoria's Secret and Dastar: Remaking Trademark Law*, Los Angeles Association of IP Attorneys (June 2003).

Expert Report of David J. Franklyn

*AirWair Int'l v. ITX USA LLC*, 3:19-cv-07641 (N.D. Cal)

*The Right of Publicity and the First Amendment*, GGU IP Symposium, San Francisco (October 2002).

*First Amendment Limits on the Right of Publicity*, ABA Intellectual Property Section Annual Meeting, Philadelphia (June 2002).

*The Boundaries of Language Commodification On-Line*, Northern Kentucky Law Review Symposium on Trademark and Cyberlaw Issues (February 2001).

*Symposium on Intellectual Property Law*, moderator, Northern Kentucky Law Review (February 2000).

*Symposium on the Third Restatement of Torts*, moderator, Northern Kentucky Law Review (February 1999).

*Symposium on the Regulation of Media Violence & the First Amendment*, moderator and coordinator, Northern Kentucky Law Review (November 1999).

*Trends in Mass Tort Litigation*, Panel on Mass Tort Litigation Joint Meeting of ABA Products Liability and Litigation Sections, Dallas (April 1999).