


No. _____

IN THE
Supreme Court of the United States



BOBCAR MEDIA, LLC,

Petitioner,

—v.—

AARDVARK EVENT LOGISTICS, INC.,

Respondent.

ON PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES
COURT OF APPEALS FOR THE FEDERAL CIRCUIT

PETITION FOR WRIT OF CERTIORARI

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QUESTIONS PRESENTED

1. Whether the Court should resolve the circuit split under Federal Rule of Appellate Procedure 36 (wherein a minority of circuit courts issue judgments without any explanation of their decisions), and elucidate whether or not the use of one-word affirmances has constitutional and statutory boundaries.
2. Whether the Federal Circuit's extensive use of its Rule 36, to enter judgments which extinguish constitutional rights and private property rights without any explanation, violates constitutional and statutory protections, principles of right and justice, and this Court's supervisory authority.
3. Whether Federal Circuit Rule 36(a)(3) violates constitutional principles, such as the Seventh Amendment, Due Process, and Equal Protection, by authorizing panels to affirm summary judgment decisions denying jury trials, without any explanation whatsoever, and irrespective of the rules and rights in the circuit from which the case was appealed.

PARTIES TO THE PROCEEDINGS BELOW

All parties to the proceedings are listed on the cover page of this petition.

CORPORATE DISCLOSURE STATEMENT

Pursuant to Supreme Court Rule 29.6, Bobcar Media Group LLC (“Bobcar”) is a privately held corporation. More than 10% of its shares are owned by its parent corporation, AHA Ventures LLC (“AHA”), which is also a privately held corporation. None of Bobcar or AHA’s shares are held by a publicly traded company.

RELATED CASES STATEMENT

Bobcar Media LLC v. Aardvark Event Logistics, Inc., U.S. District Court for the Southern District of New York, No. 16-cv-885 (JPO). Order of Dismissal Entered April 6, 2020, 2020 U.S. Dist. LEXIS 60542 (S.D.N.Y. April, 6, 2020).

Bobcar Media LLC v. Aardvark Event Logistics, Inc., U.S. Court of Appeals for the Federal Circuit, No. 20-1847. Judgment Entered March 5, 2021. 839 Fed. Appx. 545 (Fed. Cir. 2021).

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<i>English vs. Emery Reimbold and Strick Limited</i> (2002) 1 WLR 2409	23
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<i>Schwendimann v. Arkwright Advanced Coating, Inc.</i> , 959 F.3d 1065 (Fed. Cir. 2020).....	42
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OTHER AUTHORITIES

Amy Coney Barrett, <i>The Supervisory Authority of the Supreme Court</i> , 106 Colum. L. Rev. 324 (2006)....	28
Andrew Hoffman, <i>The Federal Circuit’s Summary Affirmance Habit</i> , 2018 B.Y.U.L. Rev. 41913, 22,	25
Antonin Scalia, <i>The Rule of Law as a Law of Rules</i> , 56 U. Chi. L. Rev. 1175 (1989).....	12
Benjamin N. Cardozo, <i>Jurisdiction of the Court of Appeals</i> (2d ed. 1909).....	15
Clint Bolick, <i>The Case for Legal Textualism</i> , https://www.hoover.org/research/case-legal-textualism	11
Dennis Crouch, <i>Wrongly Affirmed Without Opinion</i> , Wake Forest L. Rev. 52 (2017), University of Missouri School of Law Legal Studies Research Paper No. 2017-02.....	15
Evan J. Wallach et al., <i>Federal Circuit Review of USPTO Inter Partes Review Decisions, by the Numbers: How the AIA Has Impacted the Caseload of the Federal Circuit</i> , 98 J. Pat. & Trademark Off. Soc’y 105 (2016).....	33
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Federalist 80	12

Jason D. Eisenberg, <i>CAFC Rule 36 Judgement: 24 Hour Affirmance with No Explanation</i> , <i>National Law Review</i> , Volume VIII, No. 52 (Feb. 21, 2018).....	35
Jason Rantanen, <i>Federal Circuit Now Receiving More Appeals Arising from the PTO than the District Courts</i> , <i>PatentlyO</i> (Mar. 2, 2016), https://patentlyo.com/patent/2016/06/circuit-appeals-decisions.html	33
John P. Stevens, <i>Address to the Illinois State Bar Association's Centennial Dinner</i> , 65 Ill. B.J. 508 (1977).....	14
Lea Brilmayer, <i>Carolene, Conflicts, and the Fate of the Inside-Outsider</i> , 134 Univ. Pa. L.R. 1291 (1986).....	14
Martha J. Dragich, <i>Will the Federal Courts of Appeals Perish if They Publish? Or Does the Declining Use of Opinions to Explain and Justify Judicial Decisions Pose a Greater Threat?</i> , 44 Am. U.L. Review 757 (1995).....	14
Martin Gardner, <i>A Gardner's Workout</i> (A K Peters/CRC Press, July 18, 2001).....	20
Mel Dickstein "Why judges write opinions," <i>MinnPost</i> (Oct. 7, 2014), https://www.minnpost.com/community-voices/2014/10/why-judges-write-opinions	11, 32

	PAGE(S)
Office of the Clerk, Practitioner’s Guide to the U.S. Court of Appeals for the Tenth Circuit, Section IX.A (2018).....	17
Office of the Clerk, Practitioner’s Guide to the U.S. Court of Appeals for the Tenth Circuit, Section IX.A (2021).....	17
Patricia M. Wald, <i>The Problem with the Courts: Black-Robed Bureaucracy or Collegiality Under Challenge?</i> , 42 Md. L. Rev. 766 (1983)	18
<i>Proceedings of the First Annual Jud. Conf. of the U.S. Ct. of App. For the Fed. Cir.</i> , 100 F.R.D. 499 (1983)	27
Shirley S. Abrahamson, <i>Judging In The Quiet Of The Storm</i> , 24 St. Mary’s L. J. 965 (1993).....	22
Topologia z czuba, http://prac.im.pwr.wroc.pl/~kwasnicki/pl/teaching/ archive/z_czuba_topologia_2007_I.html	19
Where the Arts Meet the Sciences, https://richbeveridge.wordpress.com/category/ math-history	20

OPINIONS BELOW

The district court dismissed Bobcar’s patent claims under Rule 12(b)(1) on January 19, 2019 (Appx.17a-20a). It dismissed Bobcar’s trade dress claim on summary judgment and excluded Bobcar’s expert on April 6, 2020 (Appx.21a-42a). The Federal Circuit issued a one-word affirmance on March 5, 2021 (Appx.43a).

JURISDICTION

Bobcar had 150 days to petition (until August 2, 2021), per this Court’s Order addressing COVID-19. This Court has jurisdiction to review cases from the court of appeals pursuant to 28 U.S.C. §1254(1).

PROVISIONS INVOLVED

Federal Rule of Appellate Procedure 36

(“Rule 36”)

Entry of Judgment; Notice

- (a) Entry. A judgment is entered when it is noted on the docket. The clerk must prepare, sign, and enter the judgment:
 - (1) after receiving the court’s opinion—but if settlement of the judgment’s form is required, after final settlement; or
 - (2) if a judgment is rendered without an opinion, as the court instructs.
- (b) Notice. On the date when judgment is entered, the clerk must serve on all parties a copy of the opinion—or the judgment, if no opinion was written—and a notice of the date when the judgment was entered.

Federal Circuit Rule 36 (“CAFC Rule 36”)

Entry of Judgment

(a) Judgment of Affirmance Without Opinion

The court may enter a judgment of affirmance without opinion, citing this rule, when it determines that any of the following conditions exist and an opinion would have no precedential value:

- (1) the judgment, decision, or order of the trial court appealed from is based on findings that are not clearly erroneous;
- (2) the evidence supporting the jury’s verdict is sufficient;
- (3) the record supports summary judgment, directed verdict, or judgment on the pleadings;
- (4) the decision of an administrative agency warrants affirmance under the standard of review in the statute authorizing the petition for review;
- (5) a judgment or decision has been entered without an error of law.

REASONS FOR GRANTING THE WRIT

The Federal Circuit’s Rule 36 practice has gotten out of hand, contravening the principles set forth by the Founders of the Constitution, and basic tenets of justice.

After Bobcar’s business was ruined, it sought redress at the Federal Circuit for multiple constitutional violations. For example, the district court dismissed Bobcar’s trade dress claims under a

theory first brought up in the dismissal order itself – a defense theory that the defendant never raised. The court never gave Bobcar prior notice of the theory, or an opportunity to respond, before dismissing. That violated Rule 56(f) and Due Process.

Aggrieved, Bobcar appealed. The Second Circuit has held that such dismissals are “almost always reversible error” (*infra*, Section VIII.A). However, Bobcar had to go to the Federal Circuit because its case includes patent claims. On appeal, Bobcar delineated explicit violations of Due Process and its Seventh Amendment rights. It also pointed to intervening law of the Federal Circuit and this Court contradicting the lower court’s approach on various issues.

The Federal Circuit disposed of all the violations using a one-word affirmance. It is impossible to surmise the justification for that disposition.

To be sure, whether Bobcar was right or wrong is beside the point. The larger issue is the deep flaw in the system itself. That goes beyond any one litigant – and affects all of them.

Unlike this Court, litigants have a statutory right of appeal to the Federal Circuit, and, in most instances, it is the court of last resort. Billion dollar technologies and industries often hang on its guidance. But, all too often, it says nothing.

Worse yet, it proved here that grievances about anything, including serious constitutional violations, can be injudiciously waved away without explanation. Why? “Because we said so.” That renders all constitutional guarantees worthless.

The Federal Circuit’s practice conflicts with nine other circuits. It conflicts with the framework set

forth by the Founders. It conflicts with the rule of law, and the common law system. It conflicts with principles of right and justice, including reason, truth, transparency, accountability, and uniformity – principles so universal that foreign law systems have rejected this type of practice. It violates principles of Equal Protection and Due Process. It eviscerates the very statutory right established by Congress to petition to this Court, because silent dispositions leave nothing to review.

Nor can the Executive Branch be expected to challenge the status quo. With a single word, the CAFC rubber stamps 60% of the Patent Office's IPR determinations (*infra*, fn.17).

The Federal Circuit's boundless habit of invoking Rule 36 has profoundly eroded public faith in the judicial system, and violated constitutional and judicial norms. As a result, exercise of this Court's supervisory authority is urgently necessary.

STATEMENT OF THE CASE

Bobcar Media LLC, the brainchild of two entrepreneurs from Brooklyn, was founded to popularize their new "Bobcar" vehicle. The Bobcar is a "mobile showroom" which interactively engages customers on the street, promoting products with an immediacy that passing advertisements do not have. Over ten patents have been issued to the Bobcar's design; and the company won an industry award for its innovative work.

A. The District Court Proceedings

Aardvark's "Aardy" vehicles came to Bobcar's attention in 2015 when they were used to lure away Bobcar's largest customers. T-Mobile, for example,

switched to the Aardy after noting its similarity to Bobcars that T-Mobile previously used. (Appx. 55a, ¶¶123-125). As a result, Bobcar filed an action in New York for infringement of three of its utility patents, three design patents, and its trade dress.

In discovery, Aardvark was bereft of any R&D evidence. The Aardy plans “coincidentally” appeared out of thin air mere months after the Bobcar’s successful debut. Ultimately, the Aardys ruined Bobcar’s whole business, forcing layoffs and ownsizing.

After discovery, the district court excluded Bobcar’s trademark expert (who had a 20 page resume in the relevant fields), and dismissed the trade dress claims, finding no secondary meaning (Appx.34a-41a). It also granted Aardvark’s motion to dismiss Bobcar’s patent claims for lack of standing under Rule 12(b)(1) (Appx.17a-20a), on grounds of lack of ownership of the patents (patents that the inventors and company all testified were owned by Bobcar).

B. The Federal Circuit Proceedings

Bobcar appealed the rulings as violating its constitutional rights, *viz.*, Due Process, and the Seventh Amendment.

As to Due Process, the lower court dismissed the trade dress claims under a theory that Aardvark never raised in years of litigation. The court raised the defense theory *sua sponte* in the dismissal order itself. In violation of Due Process and Rule 56,¹ it did

¹ See, Fed.R.Civ.P. 56(f)(2) (a court may grant summary judgment “on grounds not raised by a party” but only “[a]fter giving notice and a reasonable time to respond”); *ING Bank N.V. v. M/V Temara*, 892 F.3d 511, 523-24 (2d Cir. 2018).

not give Bobcar prior notice of the theory, or opportunity to respond, before it dismissed.

As to the Seventh Amendment, Bobcar had the right to a jury trial. Secondary meaning is a factual question. *Cartier, Inc. v. Sardell Jewelry, Inc.*, 294 F. App'x 615, 618 (2d Cir. 2008) (summary order).² Bobcar had extensive evidence, in dozens of exhibits, on five of six factors³ (Appx.48a-54a, 56a-58a). By law, “no ‘single factor is determinative,’ and every element need not be proved.” *Thompson Med. Co. v. Pfizer Inc.*, 753 F.2d 208, 217 (2d Cir. 1985). Also, all inferences should have been drawn in Bobcar’s favor. *Anderson v. Liberty Lobby, Inc.*, 477 U.S. 242, 255 (1986). Instead, the judge invaded the province of the jury and dismissed.

Bobcar also challenged the dismissal entered January 14, 2019 (Appx.17a-20a) under 12(b)(1) for lack of standing. Later superseding Federal Circuit cases in 2019 and 2020 acknowledged that such 12(b)(1) dismissals are inappropriate, as per this Court’s *Lexmark* decision. *Infra*, Section VIII.C.

Within 24 hours of oral argument, the CAFC issued a one-word affirmance. Faced with evidence that constitutional rights had been violated, and with intervening decisions contrary to the lower court’s approach, the CAFC summarily affirmed without explaining why.

² Second Circuit law governed since the claim did not arise under patent law. *Panduit Corp. v. All States Plastic Mfg. Co.*, 744 F.2d 1564, 1575 (Fed. Cir. 1984) (for non-patent issues “[w]e ... adjudicate ... in accordance with the applicable regional circuit law ... Where the regional circuit court has spoken on the subject, we must apply the law as stated”).

³ *Infra*, Section VIII.B, fn.21.

ARGUMENT

I. RULE 36 PRACTICE IS CONTRARY TO CONSTITUTIONAL PRINCIPLES

A. It is Contrary to the Framework of the Founders

The founders intended that the legitimacy of the judicial branch would be founded upon its adherence to principles of reason; not on the raw power characterizing the excesses of British rule. As they explained, “[t]he judiciary ... may truly be said to have neither FORCE nor WILL, but merely judgment.” Federalist 78.

Rule 36 eliminates that distinction. It authorizes the issuance of reason-free orders by fiat. The decision is “because we say so.”

This is the ultimate example of Force and Will but no Judgment. It turns the Constitutional framework on its head.

Under the Constitutional vision, “[t]he courts must declare the sense of the law; and if they should be disposed to exercise WILL instead of JUDGMENT, the consequence would equally be the substitution of their pleasure to that of the legislative body.” Federalist 78. But under Rule 36, there is no need to declare the sense of the law.

Constitutionally, appellate action was meant to inhere in an explication of the law applying to particular facts. “[W]hen a writ of error is brought from an inferior to a superior court of law in this State ... the latter ... cannot institute a new inquiry concerning the fact, but it takes cognizance of it as it appears upon the record, *and pronounces the law arising upon it.*” Federalist 81 (emphasis added).

“This word is composed of JUS and DICTIO, juris dictio or a speaking and pronouncing of the law.” *Id.* fn.3. That was to be the fundamental role of the appeals courts, i.e., to issue reasoned judgments, a “speaking and pronouncing of the law.” *Id.* Rule 36 eradicates that role.

The role, however, is essential to a free society. “To avoid an arbitrary discretion in the courts, it is indispensable that they should be bound down by strict rules and precedents, which serve to define and point out their duty in every particular case that comes before them.” Federalist 78. That constitutionally indispensable condition is meaningless if courts can rule without explanation. A court that does not have to explain the basis for its decisions is not truly bound by rules or precedents: it has no barrier to “an arbitrary discretion.” Rule 36 permits a law of judges, in place of a guarantee of judges of law.

B. The Constitution Was Meant to Protect Against Decisions in Secrecy

This concern was the basis for the constitutional system in the first place – its *raison d’être* was to escape from the whims of the monarchy. “Before they declared their independence in the colonies ... star chamber proceedings were of common occurrence, and it was to abolish and forbid secret or star chamber trials that called forth the provisions of the federal and state Constitutions requiring public trials.” *Keddington v. State*, 19 Ariz. 457, 459 (1918).

“The court of star chamber was an efficient, somewhat arbitrary arm of royal power. ... Star chamber stood for swiftness and power; it was not a competitor of the common law so much as a limitation on it.” *Faretta v. California*, 422 U.S. 806, 821 fn.17 (1975) (internal citation omitted). Unfortunately, the

same goes for Rule 36: “it is not a competitor of the common law,” but supplants its past and future. *See, infra*, Section II.B.

From this early history arose “this nation’s historic distrust of secret proceedings.” *In re Oliver*, 333 U.S. 257, 273 (1948). “Arbitrary and secret deprivation of life, liberty, and property were no longer to be tolerated. The rule of open administration of justice was thereafter to be followed.” *Keddington*, 19 Ariz. at 459. As a result of these concerns, the need for written explanation has been upheld in multiple contexts.

This Court, for example, has criticized unexplained agency action. “There are no findings and no analysis here to justify the choice made, no indication of the basis on which the Commission exercised its expert discretion. We are not prepared to and the Administrative Procedure Act will not permit us to accept such adjudicatory practice.” *Burlington Truck Lines v. United States*, 371 U.S. 156, 167-68 (1962). Though Article III appeals courts are not agencies, the same reasoning applies. Without a requirement for written reasoned explanations, they “can become a monster which rules with no practical limits on its discretion.” *Id.* *See also, Amerijet Int’l Inc. v. Pistole*, 753 F.3d 1343, 1350 (D.C. Cir. 2014) (failure to set forth reasons “constitutes arbitrary and capricious agency action.”); *McHenry v. Bond*, 668 F.2d 1185, 1192 (11th Cir. 1982) (“The fundamental principle of reasoned explanation ... serves at least three interrelated purposes: enabling the court to give proper review to the administrative determination; helping to keep the administrative agency within proper authority and discretion, as well as helping to avoid and prevent arbitrary, discriminatory, and irrational action by the agency; and informing the

aggrieved person of the grounds of the administrative action so that he can plan his course of action including the seeking of judicial review.”).

II. IT UNDERMINES THE INTEGRITY OF THE JUDICIAL SYSTEM

A. It is Inconsistent with the Rule of Law

The rule of law requires an adherence by judges to collective principle, rather than personal policy. As a judge of the Arizona Supreme Court put it, “Personal policy preferences must yield to the rule of law or we have no rule of law.” *See*, Clint Bolick, *The Case for Legal Textualism*, <https://www.hoover.org/research/case-legal-textualism>.

Without written decisions, no yielding is necessary.

As Judge Dickstein explained, “[i]magine how terrifying our system of justice would be if judges made decisions without explanation. We wouldn’t stand for such a system because we want to know that decisions are fairly reached.”⁴

As noted, such a system is also contrary to the Constitutional intent. *Supra*, Section I.A (“[t]o avoid an arbitrary discretion in the courts it is indispensable” to bind judges “to strict rules and precedents”). “The mere necessity of uniformity in the interpretation of the national laws, decides the question.” Federalist 80.

If circuits can indulge in rules that eliminate the obligation to interpret the national laws uniformly, the promise of the Constitution is vitiated. If they

⁴ Mel Dickstein “Why judges write opinions,” MinnPost (Oct. 7, 2014), <https://www.minnpost.com/community-voices/2014/10/why-judges-write-opinions>

can eliminate the obligation to justify their decisions, the promise of a just and fair system is empty.

The line between the rule of law and law without rules is effectively erased.

B. It is Inconsistent with the Common Law System

As Justice Scalia has stated, the common law system is one which grows through fact-specific pronouncements. Antonin Scalia, *The Rule of Law as a Law of Rules*, 56 U. Chi. L. Rev. 1175, 1177 (1989). The law, however, cannot grow from single word rulings – rulings lacking even the ambiguity of Delphic pronouncements.

“Opinions are what courts do They are the substance of judicial action Written opinions are key to the operation of our system of stare decisis, and without them, the state of the law would be in confusion.” Andrew Hoffman, *The Federal Circuit’s Summary Affirmance Habit*, 2018 B.Y.U.L. Rev. 419, 432 (internal citations and quotations omitted). Decisions that are opinion-free render the common law system a dead letter in a wide swath of cases: there is no assurance of fidelity to the past, and no foundation for consistency in the future.

Moreover, the notion that a case does not warrant a written decision does a great disservice. Litigants, commentators, and the public are often left scratching their heads as to why seemingly sound arguments were rejected. As a Federal Circuit judge once stated, “I write separately because I am of the view that a petitioner to this court seeking reversal of a decision is entitled to an explanation of why the arguments on which he relied for his appeal did not

prevail.” *In re Packard*, 751 F.3d 1307, 1314 (CAFC 2014) (Plager, J., concurring.).

Furthermore, the true importance of a decision often remains to be seen. As Judge Holloway stated, “when we make our *ad hoc* determination that a ruling is not significant enough for publication, we are not in as informed a position as we might believe. Future developments may well reveal that the ruling is significant indeed.” *In re Rules of United States Court of Appeals etc.*, 955 F.2d 36, 38 (10th Cir. 1986) (Holloway, J., dissenting). Likewise, Justice Stevens maintained that this practice “rests on a false premise” which “assumes that an author is a reliable judge of the quality and importance of his own work product.”⁵

As this Court’s jurisprudence has shown, even footnotes have had occasion to later take center stage. *Carolene Products*’ footnote 4 is a prime example. *United States v. Carolene Products Co.*, 304 U.S. 144, 152 fn.4 (1938). As Professor Brilmayer noted, it is “so venerable as to have achieved almost axiomatic status in a world where virtually every other proposition of constitutional law is best considered controversial. It is, in Justice Powell’s words, ‘the most celebrated footnote in constitutional law.’” Lea Brilmayer, *Carolene, Conflicts, and the Fate of the Inside-Outsider*, 134 Univ. Pa. L.R. 1291 (1986) (citation omitted). In contrast, there is no telling how

⁵ Martha J. Dragich, *Will the Federal Courts of Appeals Perish if They Publish? Or Does the Declining Use of Opinions to Explain and Justify Judicial Decisions Pose a Greater Threat?*, 44 Am. U.L. Review 757, 790 fn.204 (1995), quoting John P. Stevens, *Address to the Illinois State Bar Association’s Centennial Dinner*, 65 Ill. B.J. 508 (1977).

many impactful judicial statements have been lost because a case was silently decided under Rule 36.

The central function of the courts of appeal to render justice, not just dispose of cases. As Justice Cardozo explained, there is a long appellate tradition of explaining decisions – of not just “declaring justice between man and man, but of settling the law.”⁶ Rule 36 runs squarely counter to that tradition.

III. THE CAFC’S RULE 36 PRACTICE CONFLICTS WITH NINE CIRCUITS

A. The Majority of Circuits Issue Explanations

The legitimacy of one-word affirmances is also the subject of a significant circuit split.

Nine circuits provide an explanation when rendering a decision; namely, the First, Second, Third, Fourth, Sixth, Seventh, Ninth, Eleventh, and D.C. Circuits. They do under internal rule or established practice.⁷

⁶ Benjamin N. Cardozo, *Jurisdiction of the Court of Appeals* (2d ed. 1909) § 6, quoted in Dennis Crouch, *Wrongly Affirmed Without Opinion*, Wake Forest L. Rev. 52 (2017), University of Missouri School of Law Legal Studies Research Paper No. 2017-02.

⁷ 1st Cir. R. 36(a) provides for an opinion or summary explanation. 2nd Cir. Internal Operating Procedure 32.1.1, permits summary orders, which contain explanations. The Third Circuit allows affirmance by reference to the lower decision (3rd Cir. I.O.P. 6.3.2); but, in practice, has not issued a one-word affirmance in almost thirty years. *See, Birth v. United States*, 958 F.2d 362 (3d Cir. 1992). 4th Cir. R. 36.3 requires reasoning in any summary opinion. The Sixth Circuit has no rule authorizing a one-word written affirmance. The Seventh Circuit also does not have a rule; and, in practice, explains the

In contrast, the Federal Circuit joins a minority of circuits which use one-word affirmances, namely, the Fifth, Eighth, and Tenth Circuits.⁸

B. The Circuits' Rules are Subject to the Review of This Court

Of course, each circuit may “make and amend rules governing its practice.” Fed. R. App. P. 47(a)(1). However, the “discretion in promulgating local rules is not ... without limits. This Court may exercise its inherent supervisory power to ensure that these local rules are consistent with the principles of right and justice.” *Frazier v. Heebe*, 482 U.S. 641, 645 (1987)

panel’s rationale at least briefly. *See e.g., Thomas v. WGN News*, 637 F. App’x 222, 223 (7th Cir. 2016). In the Ninth Circuit, the shortest judgment is a memorandum disposition, which is “a concise explanation of the Court’s decision” that recites “such information crucial to the result.” 9th Cir. General Order. 4.3.a. The Eleventh Circuit previously permitted affirmances without opinion (*see*, 11th Cir. R. 36-1, prior to Aug. 1, 2006), but rescinded that rule in 2006. D.C. Circuit R.36(d) provides for an abbreviated disposition “containing a notation of precedents or accompanied by a brief memorandum” and that a “statement explaining the basis for this court’s action” “will be retained as part of the case file ... and be publicly available there on the same basis as any published opinion” (*id.*, 36(e)).

⁸ *See*, Fed. Cir. R. 36(a) (providing five conditions under which “[t]he Court may enter a judgment of affirmance without opinion”); with no explanation other than citing its own rule; 5th Cir. R. 47.6 (mirroring the Federal Circuit rule); Eight Circuit R. 47B (allowing one-word affirmances under four conditions); and Tenth Circuit R. 36 (“The court may dispose of an appeal or petition without written opinion.”). As to the latter, the Tenth Circuit guidebook previously indicated that “[t]he court ... may ... use a terse judgment such as the one word ‘affirmed.’”). Office of the Clerk, Practitioner’s Guide to the U.S. Court of Appeals for the Tenth Circuit, Section IX.A (2018). However, since 2019, the sentence has curiously been changed to instead say that it “may ... issue a shorter decision.” *Id.* (2021).

(citations and quotations omitted).⁹ The use of CAFC Rule 36 is inconsistent with such principles.

IV. IT IS CONTRARY TO “PRINCIPLES OF RIGHT AND JUSTICE”

A. Reason and Truth

For example, two core principles are that justice must be founded on reason and truth. It should be rooted on thoughtful, logical analyses; on sound principles and true facts. Written decisions nurture these values. Rule 36 does not.

As Judge Wald of the D.C. Circuit put it, “My own guiding principle is that virtually every appellate decision requires some statement of reasons. The discipline of writing even a few sentences or paragraphs explaining the basis for the judgment insures a level of thought and scrutiny by the court that a bare signal of affirmance, dismissal, or reversal does not.” Patricia M. Wald, *The Problem with the Courts: Black-Robed Bureaucracy or Collegiality Under Challenge?*, 42 Md. L. Rev. 766, 782 (1983).

Likewise, Justice Stevens referred to the “decision not to publish the opinion or to permit it to be cited” as akin to “a body of secret law” constituting “decisionmaking without the discipline and accountability that the preparation of opinions requires.” *Cty. of Los Angeles v. Kling*, 474 U.S. 936, 940 (1985) (Stevens, J., dissenting). A written reasoned opinion fosters the truth-finding process far more than a cursory one-word decision.

⁹ See also, 28 U.S.C. §2072 (“[t]he Supreme Court shall have the power to prescribe general rules of practice and procedure ... for cases in the ... courts of appeals”).

Moreover, *only* a written ruling allows one to prove when the grounds for decision are wrong. “Certain principles have remained relatively immutable in our jurisprudence. One of these is that ... the Government’s case must be disclosed to the individual so that he has an opportunity to show that it is untrue.” *Greene v. McElroy*, 360 U.S. 474, 496 (1959). No judicial value is more fundamental than the ability to prove that something is false. By removing the government’s obligation to disclose the basis for its decision, Rule 36 removes the opportunity to show its basis is untrue.

A good decision is like a mathematical proof, setting forth its premises, axioms, and reasoning, taking the reader from beginning to conclusion. “It’s worth recalling the story of the very famous mathematician G.H. Hardy, who in a lecture said about some detail in a proof: “This is obvious.” After a pause, he went on: “Hmm, is it really obvious?” After another pause he left the room to consider the point, returning 20 minutes later with the verdict: “Yes, I was right, it is obvious.”¹⁰

Similarly, in Princeton’s Fine Hall, “someone once posted a ‘Scale of Obviousness’:

If Wedderburn says it’s obvious, everybody in the room has seen it ten minutes ago.

If Bohnenblust says it’s obvious, it’s obvious.

If Bochner says it’s obvious, you can figure it out in half an hour.

If von Neumann says it’s obvious, you can prove it in three months if you’re a genius.

¹⁰ Topologia z czuba, http://prac.im.pwr.wroc.pl/~kwasnicki/pl/teaching/archive/z_czuba_topologia_2007_I.html, quoting Jonathan (“J.R.”) Partington.

If Lefschetz says it's obvious, it's wrong.¹¹

These anecdotes hold more than a grain of truth. It is impossible to warrant the reliability of a decision when the underlying premises, axioms, facts, and reasoning are all invisible. In nearly all federal cases, the courts of appeals are the last stop. Justice is too important to leave everyone in the dark whether the final decision was reached via the reasoning of a Wedderburn or a Lefschetz.

B. Transparency

Another core principle is transparency. Our Constitution meant to avoid secrecy, not to embrace it. *Supra*, Section I.B. As Judge Stein put it, we have a “powerful idea that there is a strong presumption of openness to our judicial proceedings. ... To the extent that we allow the exceptions to become bigger and bigger, then we start to look like the Star Chamber, or lettres de cachet or similar items that really should not find their way into our system of justice.” *Secrecy and the Courts: The Judges’ Perspective*, 9 J.L. & Pol’y 169, 191 (2000). Indeed, secret proceedings “symbolized a menace to liberty.” *Oliver*, 333 U.S. at 269.

Though commonly expressed in the context of secret trials, the principle cannot be cabined so narrowly. Publishing the underlying basis for judicial decision-making is equally, *if not more*, important – it is an essential check in the democratic system. As Justice Black explained, quoting Bentham: “Without publicity, all other checks are insufficient: in comparison of publicity, all other

¹¹ <https://richbeveridge.wordpress.com/category/math-history> quoting, Martin Gardner, *A Gardner’s Workout* (A K Peters/CRC Press, July 18, 2001).

checks are of small account. Recordation, appeal, whatever other institutions might present themselves in the character of checks, would be found to operate rather as cloaks than checks; as cloaks in reality, as checks only in appearance.” *Id.* at 271.

Rule 36 one-word decisions are a check “only in appearance”; and “a cloak in reality.”

C. Accountability

Another core principle is accountability. “Professor Llewellyn wrote that judges and the decision-making process are kept in check by ... ‘steadying factors.’ A key ‘steadying factor’ is the requirement that an appellate judge write an opinion explaining the outcome ... The writing process imposes a profound constraint on judicial discretion.” Shirley S. Abrahamson, *Judging In The Quiet Of The Storm*, 24 St. Mary’s L. J. 965, 987 (1993). “The act of stating reasons that can be judged and evaluated, combined with the doctrine of stare decisis, can control judicial arbitrariness.” *Id.* at 987-988.

In a democracy, judges must be accountable to the law, to the public, and to each other. Written decisions foster a conscious or unconscious constraint on the whims and caprices of the decision-maker. One-word decisions do not.

D. Uniformity

Another core principle is uniformity. Like cases must be treated alike. “Publishing opinions is a key function of appellate courts inasmuch [as] the federal courts of appeals are ‘needed to announce, clarify, and harmonize the rules of decision employed by the legal system in which they serve.’ This function is particularly important in an age in which the Supreme Court hears a mere fraction of appellate

court cases.”¹² Without written decisions, there is no basis for uniformity.

“If there are such things as political axioms, the propriety of the judicial power of a government being coextensive with its legislative, may be ranked among the number. *The mere necessity of uniformity in the interpretation of the national laws, decides the question.*” Federalist 80 (emphasis added). One-word decisions contravene the constitutional goal of uniformity, rather than promoting it.

E. Foreign Law Is Also Instructive

It is no surprise that these principles are reflected in the Constitution. Given their universal nature, it is also no surprise that foreign courts have rejected unexplained dispositions as repugnant to justice.

The Supreme Court of India, for example, has held that “[t]he practice of recording a decision without reasons in support cannot but be severely deprecated.” *Commissioner Of Income-Tax v. M/S. Walchand & Co. (Pvt.) Ltd.*, 1967 AIR 1435, 1967 SCR (3) 214 (17 March 1967).

The English courts have likewise held that “justice will not be done if it is not apparent to the parties why one has won and the other has lost.” Articlesonlaw.in/writing-reasoned-orders, citing *English vs. Emery Reimbold and Strick Limited* (2002) 1 WLR 2409. Similarly, “The House of Lords in *Cullen vs. Chief Constable of the Royal Ulster Constabulary*, (2003) 1 WLR 1763 ... on the requirement of reason held, ‘First, they impose a discipline ... which may contribute to such decisions being considered with care. Secondly, reasons encourage transparency ...

¹² Hoffman, 2018 B.Y.U.L. Rev. at 432 (citation omitted).

Thirdly, they assist the Courts in performing their supervisory function if judicial review proceedings are launched.” *Id.*, citing para 7, page 1769.

In fact, “[s]ince the requirement to record reasons emanates from the broad doctrine of fairness in decision making, [it] ... is now virtually a component of human rights and was considered part of Strasbourg Jurisprudence.” *Id.* (citing *Ruiz Torija v Spain* (1995) 19 EHRR 553, at 562 para. 29, and *Anya vs. University of Oxford*, 2001 EWCA Civ 405, “wherein the Court referred to Article 6 of European Convention of Human Rights which requires, ‘adequate and intelligent reasons must be given for judicial decisions’”).

The United States should be a judicial vanguard in protecting these principles, as the Constitution intended. But Rule 36 makes it seem that the U.S. is struggling to catch up in the rear.

V. RULE 36 PRECLUDES MEANINGFUL APPELLATE REVIEW

A. It Eviscerates the Statutory Right to Petition for Certiorari

While each circuit may “make and amend rules governing its practice” (Fed. R. App. P. 47(a)(1)), such rules “must be consistent with ... Acts of Congress” (*id.*). Congress, in turn, intended that the final judgments of the courts of appeal are to be subject to review on a writ of certiorari. 28 U.S.C. §2350(a).

The promise of §2350(a), however, is illusory when a circuit panel withholds its reasoning, effectively circumventing review. Indeed, some commentators have suggested that the Federal Circuit and other

courts use Rule 36 on occasion for precisely this purpose – to “cert-proof” some decisions.¹³

Ironically, the courts of appeal have themselves long viewed lower court decisions without explanation as being an abuse of discretion. *See e.g., In re Lloyd’s Register N. Am., Inc.*, 780 F.3d 283, 290 (5th Cir. 2015) (“It is an abuse of discretion for a district court to grant or deny a motion to dismiss without written or oral explanation”); *Rose v. Hartford Underwriters Ins. Co.*, 203 F.3d 417, 419 (6th Cir. 2000) (“the district court’s denial of the motion to amend without explanation qualifies as an abuse of discretion”). Justice at the courts of appeal should not be subject to a laxer standard than at the district court.

The Federal Circuit has itself complained for years when the proverbial shoe was on the other foot.¹⁴ Likewise, in several recent cases it granted the extraordinary writ of mandamus, and ordered a stay until the district court issues a ruling providing a

¹³ Hoffman, 2018 B.Y.U.L. Rev. at 442 fns.148-150 (2018) (collecting cites).

¹⁴ *See e.g., Oakley, Inc. v. Int’l Tropic-Cal Inc.*, 923 F.2d 167, 168 (Fed. Cir. 1991) (“the court’s findings ... are so limited and conclusory that meaningful appellate review is not possible”); *Whitserve, LLC v. Comput. Packages, Inc.*, 694 F.3d 10, 36 (Fed. Cir. 2012) (“a trial court’s failure to explain the basis for its ongoing royalty rate precludes this court from reviewing the decision for an abuse of discretion”); *Ultratec Inc. v. CaptionCall, LLC*, 872 F.3d 1267, 1274 (Fed. Cir. 2017) (“the Board’s procedures impede meaningful appellate review ... For judicial review to be meaningfully achieved ... the agency ... must present a full and reasoned explanation of its decision ... The agency does not have unfettered discretion ... and we cannot affirm ... where the agency fails to provide a reasoned basis for its decision”).

basis for its decision *capable of meaningful appellate review*. *In re SK Hynix, Inc.*, 835 Fed. Appx. 600, 601 (Fed. Cir. 2021); *In re Tracfone Wireless, Inc.*, 2021 U.S. App. LEXIS 6689, *5 (Fed. Cir. 2021). Faced with a judge dragging his feet on transferring cases out of his court, six Federal Circuit judges viewed his failure to issue an explanation as an abuse of discretion. *See e.g., SK Hynix*, 835 Fed. Appx. at 600-601.

Moreover, the Federal Circuit contradicts its origin story. When it was created, it required opinions in all cases. *See*, Fed. Cir. R. 18 (1982) (“Disposition of appeals shall be with a published opinion or an unpublished opinion”). Chief Judge Markey promised that the court would *always* issue its reasoning. “It is tradition. It is a requirement of the courts of this land, thank G-d. We do not issue fiats. We do not just render a one-worded decision and go away. We explain our decisions. It is one of the great keys of the American judicial system.”¹⁵

B. It Nullifies this Court’s Constitutional and Supervisory Authority

The Constitution provides that “the judicial power of the United States shall be vested in one Supreme Court, and in such inferior courts as the Congress may from time to time ordain and establish.” Constitution, Article III, Section I. As the *Supreme* Court of the land, this Court was invested with final authority over all matters brought within the inferior courts.

¹⁵ *Proceedings of the First Annual Jud. Conf. of the U.S. Ct. of App. For the Fed. Cir.*, 100 F.R.D. 499, 511 (1983) (Markey, C.J.).

Similarly, as to rules of procedure, “[t]he law in this area is clear. This Court has supervisory authority over the federal courts.” *Dickerson v. United States*, 530 U.S. 428, 437 (2000). That authority was first asserted in *McNabb*. See, Amy Coney Barrett, *The Supervisory Authority of the Supreme Court*, 106 Colum. L. Rev. 324, 328 fn.9 (2006), citing *McNabb v. United States*, 318 U.S. 332 (1943).

The Court’s rules likewise provide that it has the prerogative to assess whether a “court of appeals ... has so far departed from the accepted and usual course of judicial proceedings, or sanctioned such a departure by a lower court, as to call for an exercise of this Court’s supervisory power.” S.Ct.R.10(a).

The CAFC, however, has used CAFC Rule 36 to nullify this constitutional and supervisory authority. In a large proportion of cases,¹⁶ its panels appropriate the final say. This Court cannot review unwritten decisions. For all these cases, the CAFC sets itself up as “supreme,” contrary to the Constitution.

VI. IT UNDERMINES BASIC CONSTITUTIONAL RIGHTS

A. It Violates Equal Protection and Due Process

“When an appeal is afforded ... it cannot be granted to some litigants and capriciously or arbitrarily denied to others without violating the Equal Protection Clause.” *Lindsey v. Normet*, 405 U.S. 56, 77 (1972). Rule 36, however, allows a panel to decide which litigants will have further rights of appeal, and which will not. There is nothing stopping them from

¹⁶ *Infra*, fn.17.

arbitrarily or capriciously denying some litigants the further review afforded to others.

As such, Rule 36 has created a tale of two litigants. There are now two disparate classes. The first is granted reasoned justification for its appellate decisions, which are then subject to petitions for rehearing, *en banc* review, and petitions for *certiorari*. The litigants, public, and courts can review those decisions for potential error. The second is granted silence, precluding further review.

This is a serious flaw in the rules, allowing discrimination between those who have further access to justice and those who do not. Yet, “at all stages of the proceedings the Due Process and Equal Protection Clauses protect persons like petitioners from invidious discriminations.” *Griffin v. Illinois*, 351 U.S. 12, 18 (1956).

As this Court aptly explained, “[i]t is essential that the judge provide a reasonably specific explanation ... Unless such an explanation is given, adequate appellate review is not feasible, and without such review, widely disparate awards may be made, and awards may be influenced (or at least, may appear to be influenced) by a judge’s subjective opinion regarding particular attorneys or the importance of the case.” *Perdue v. Kenny A.*, 559 U.S. 542, 558-59 (2010). Without a reasoned decision, there is no Equal Protection.

Equal Protection is also a concern because the Federal Circuit has exclusive jurisdiction of an entire appeal when it involves any patent law. A party with patent and non-patent claims, residing in a majority circuit which issues its reasoning, loses its “home court” right to a reasoned decision when forced to

appeal to the CAFC. That very scenario occurred here. *Infra*, Section VIII.D.

Laying open the grounds for decision-making is also essential to preserve Due Process. As one judge noted in the criminal context, the “right to see and comment on the evidence ... is essential ... if we are to honor our due process commitment to truth seeking in the administration of the law. ... Such adversary comment provides a crucial check on official findings and conclusions which will be relied upon by the decision maker, but which cannot be assumed to be infallibly valid.” *United States v. Dockery*, 447 F.2d 1178, 1191 (D.C. Cir. 1971) (Wright, J., dissenting). When a panel keeps its decision-making to itself, it improperly attains infallibility.

B. Reasoned Decisions are Needed to Protect Fundamental Rights

The necessity of explicating a court’s reasoning is similarly critical to protect *all* fundamental rights. Without reasoned decisions justifying the particulars of judicial action (or inaction), the protections guaranteed by the Bill of Rights are of no moment.

Here, for example, numerous constitutional violations were implicated. *Infra*, Section VIII. How the Federal Circuit could affirm in the face of those violations is anyone’s guess, because its one-word affirmance shrouded its decision in mystery.

VII. RULE 36 HAS UNDERMINED PUBLIC FAITH IN THE JUDICIAL SYSTEM

A. It Provides a Semblance of Injustice Which Tarnishes the Courts

It is a long-cherished tradition that the courts must not just avoid impropriety – they must also avoid the appearance of impropriety. Justice Blackmun said it well. “Important in this regard ... is the appearance of justice. ‘Secret hearings – though they be scrupulously fair in reality – are suspect by nature. Public confidence cannot long be maintained where important judicial decisions are made behind closed doors and then announced in conclusive terms to the public, with the record supporting the court’s decision sealed from public view.’” *Gannett Co. v. DePasquale*, 443 U.S. 368, 429 (1979) (Blackmun J., dissenting), quoting *United States v. Cianfrani*, 573 F.2d 835, 851 (CA3 1978).

As Judge Dickstein elucidated:

“What I think is so wonderful about our system is that we come to a clear understanding of the law when opinions are well written and clearly expressed. A reader, following the arc of the decisions in this case, knows how the ultimate decision was made – what arguments were considered and accepted or rejected. It leads to a respect for the law, whether or not you agree with it. That’s how our law develops, and one way we assure respect for the process – it’s the reason we write legal decisions; sometimes very long ones.”

Mel Dickstein, *op. cit.*

The ability to review the “arc” of a decision preserves the integrity of the judicial system, and fosters respect for the law. The inability to review it does the opposite. The ability to scrutinize for judicial overreach, personal preferences, or misunderstandings of the record, is essential to trust in the system.

All judges are human and can make errors. But their esteem as stewards of justice is lost when their decision-making is covered up. By hiding a decision’s bases, Rule 36 creates an invidious perception, which has fomented a public distrust of the judiciary.

B. It Has Engendered Widespread Public Distrust

That distrust is copious when it comes to the Federal Circuit. By its own admission, it employs one-word affirmances in an astounding percentage of decisions.¹⁷ It is no wonder that the frequent use of CAFC Rule 36 has resulted in a profound loss of confidence in the court. *See e.g.*, Dennis Crouch, *Wrongly Affirmed Without Opinion*, 52 Wake Forest L. Rev. 561 (2017); Rebecca A. Lindhorst, *Because I Said So: The Federal Circuit, the PTAB, and the Problem With Rule 36 Affirmances*, 69 Case W. Res.

¹⁷ As CAFC Judge Wallach observed, **60%** of all *Inter Partes Reviews* (IPRs) by 2016 were affirmed under CAFC Rule 36. Evan J. Wallach et al., *Federal Circuit Review of USPTO Inter Partes Review Decisions, by the Numbers: How the AIA Has Impacted the Caseload of the Federal Circuit*, 98 J. Pat. & Trademark Off. Soc’y 105, 113 (2016). Likewise, from 2008-2016, the rate of disposal of appeals from the district courts rose from 21% to 43%. Jason Rantanen, *Federal Circuit Now Receiving More Appeals Arising from the PTO than the District Courts*, PatentlyO (Mar. 2, 2016), <https://patentlyo.com/patent/2016/06/circuit-appeals-decisions.html>.

L. Rev. 247 (2018); Andrew Hoffman, *The Federal Circuit's Summary Affirmance Habit*, 2018 B.Y.U.L. Rev. 419 (2018). *See also*, Martha J. Dragich, *op. cit.*

As some experienced commentators put it:

“The Supreme Court recognized that there are some rare instances where the outcome of the case is so clear a full opinion wouldn’t be necessary. It seems doubtful, however, that the Supreme Court envisioned Rule 36 decisions, which are all of one short sentence, would be used in close to half of all cases brought to a Circuit Court. But that is precisely what is happening at the United States Court of Appeals for the Federal Circuit. America’s innovators feel as if they are under siege, and by any honest objective review that feeling is based on substantial fact. ... None of the so-called Regional Circuits use Rule 36 as extensively as does the Federal Circuit, particularly with respect to novel and controversial issues.”

Peter Harter & Gene Quinn, *Rule 36: Unprecedented Abuse at the Federal Circuit*, https://www.ipwatchdog.com/2017/01/12/rule-36-abuse-federal_circuit/id=6971.

Another reflected the prevalent frustration:

“Many in the patent bar feel that the taking of a patent representing substantial commercial success, millions in R&D, and years of development, not to mention millions in litigation costs, should never end in a summary affirmance by the Federal Circuit. They argue the Federal Circuit

should not be able to “punt” on a difficult case with complex legal and factual issues.

In the end, no matter whether you are a Patent Owner or Petitioner, after a long fought legal battle and the millions spent on litigation, the parties are owed more than a single sentence.”

Jason D. Eisenberg, *CAFC Rule 36 Judgement: 24 Hour Affirmance with No Explanation*, National Law Review, Volume VIII, No. 52 (Feb. 21, 2018).

This wisdom of the crowd reflects a long-simmering dissatisfaction that nobody is immune from the potential injustice that Rule 36 can mask. The CAFC’s pervasive Rule 36 practice has served “to sap the foundations of public and private confidence” in the judiciary. Federalist 78. This can only be corrected by this Court’s intervention.

VIII. THIS CASE IS AN EXCELLENT VEHICLE TO ADDRESS THESE ISSUES

This case squarely presents the legal and policy issues above, and arises out of an inequitable use of CAFC Rule 36 which implicated issues of Due Process, the Seventh Amendment, and Article III standing. That the Federal Circuit could silently gloss over constitutional and private property rights illustrates the need for review.

A. Bobcar Received No Response to Its Due Process Concerns

Bobcar suffered a Due Process violation wherein its claim was dismissed under a *sua sponte* argument, without prior notice, or a chance to respond. That alone called for reversal.

“The Supreme Court has emphasized that prior notice is a prerequisite to a *sua sponte* grant of summary judgment.” *ING Bank*, 892 F.3d at 523-24 (2d Cir. 2018), citing *Celotex Corp. v. Catrett*, 477 U.S. 317, 326 (1986). “A district court’s failure to provide adequate notice *is almost always reversible error.*” *Id.* at 524 (emphasis added).

And yet, the Federal Circuit did not reverse. The Second Circuit’s *ING Bank* decision was binding,¹⁸ but the CAFC jettisoned it.

Nor is this a minor matter. The district court violated one of the most ancient principles of justice: *audi alteram partem*, “listen to the other side.”¹⁹ It created a theory of dismissal, and failed to let Bobcar’s side be heard.

For example, it *sua sponte* stated that secondary meaning must be assessed “before the infringement began” (Appx.36a). It then assessed it for only one infringement, even though there were *thirteen separate* infringements.

But as this Court explained, events that occur after a first claim “often give rise to new material operative facts that in themselves, or taken in conjunction with the antecedent facts, create a new claim to relief.” *Lucky Brand Dungarees, Inc. v. Marcel Fashions Grp., Inc.*, 140 S.Ct. 1589 (2020) (cleaned up). “This principle takes on particular force in the trademark context, where the enforceability of a mark and likelihood of confusion between marks often turns on

¹⁸ *TechSearch L.L.C. v. Intel Corp.*, 286 F.3d 1360, 1377 (Fed. Cir. 2002) (regional circuit law applies to procedural issues that are not issues of substantive patent law).

¹⁹ Rule 56(f) embodies this principle, but the rule and principle were disregarded.

extrinsic facts that change over time.” *Id.* Indeed, “*liability for trademark infringement turns on marketplace realities that can change dramatically from year to year.*” *Id.* (emphasis added). This Court’s intervening approach dictated that each of the 13 infringements should have been assessed on its own as to whether secondary meaning existed at the time of that new infringement.

Furthermore, the district court even got the date of first infringement wrong – assessing it as of 2008 (Appx.38a). That was clearly erroneous since Bobcar and Aardvark *both* agreed that the date of the first accused infringement was in 2009. The court left out a year of secondary meaning evidence.

That the district court created a new argument for Aardvark was also unfair. “In our adversarial system of adjudication, we follow the principle of party presentation ... in the first instance and on appeal ... we rely on the parties to frame the issues for decision and assign to courts the role of neutral arbiter of matters the parties present.” *United States v. Sineneng-Smith*, 140 S.Ct. 1575, 1579 (2020) (citations and quotations omitted). “[O]ur system is designed around the premise that parties represented by competent counsel know what is best for them, and are responsible for advancing the facts and argument entitling them to relief. ... courts are essentially passive instruments of government ... They do not, or should not, sally forth each day looking for wrongs to right. They wait for cases to come to them, and when cases arise, courts normally decide only questions presented by the parties.” *Id.* (cleaned up).

As such, Bobcar was also deprived of Due Process by dismissal under a theory that Aardvark and its

expert – the former head of the Trademark Office – never raised in years of litigation. Had Bobcar been given notice, it could, at worst, have narrowed itself to its strongest claims and most important infringements, *viz.*, the Aardys in 2015-2016 for T-Mobile and Samsung. It had eight years of evidence at that point, rather than the single year the court considered. Under the district court’s wrongful process, Bobcar never had a chance.

Bobcar raised important issues of Due Process. But the CAFC silently affirmed without explanation.

B. It Lost Its Seventh Amendment Rights

The lower court ruling also violated the Seventh Amendment right to a jury trial. Under governing precedent,²⁰ whether the Bobcar had secondary meaning was a heavily factual question, requiring analysis of six factors. *Cartier*, 294 F. App’x at 618 (summary order).²¹ After Bobcar opposed dismissal with dozens of factual exhibits (Appx.48a-54a, 56a-58a), the district judge decided the question himself (Appx.34a-41a). That ran counter to black-letter constitutional law that “issues of law are to be resolved by the court, and issues of fact are to be determined by the jury under appropriate instructions by the court.” *Baltimore & Carolina Line, Inc. v. Redman*, 295 U.S. 654, 657 (1934). As this Court stated, “neither we nor the Court of Appeals can redetermine facts found by the jury *any*

²⁰ Second Circuit precedent governed the trade dress issue. *Supra*, fn.2.

²¹ The six factors are: “(1) advertising expenditures, (2) consumer studies linking the mark to a source, (3) unsolicited media coverage of the product, (4) sales success, (5) attempts to plagiarize the mark, and (6) length and exclusivity of the mark’s use.” *Id.*

more than the District Court can predetermine them.” Atlantic & Gulf Stevedores, Inc. v. Ellerman Lines, Ltd., 369 U.S. 355, 358-359 (1962) (emphasis added).

Bobcar’s extensive evidence encompassed five of six factors. Relying on another district court case, the court gave great weight to the absent factor, a survey, calling it “most persuasive” (Appx.37a). But surveys are not required under binding Second Circuit law.²² Likewise, their limited probative value has been noted by at least two members of this Court. *U.S.P.T.O. et al., v. Booking.com B.V.*, 140 S.Ct. 2298, 2309 (2020) (Sotomayor, J., concurring) (“flaws in a specific survey design, or weaknesses inherent in consumer surveys generally, may limit the probative value of surveys ... I do not read the Court’s opinion to suggest that surveys are the be-all and end-all”) (emphasis added); *id.* at 2313 (Breyer, J., dissenting) (criticizing the value of surveys). Even Aardvark’s own expert, the former Assistant Commissioner of Trademarks, admitted that surveys do little good.²³

As another example, the court gave no weight to advertising beyond dollars paid (Appx.36a-37a). It is beyond peradventure that social media (e.g., Facebook, Twitter, etc.), can engender millions of

²² *Thompson*, 753 F.2d at 217; *LeSportsac, Inc. v. K Mart Corp.*, 754 F.2d 71, 78 (2d Cir. 1985) (sufficient evidence of secondary meaning even without a survey).

²³ Aardvark’s expert, Philip Hampton, headed the Trademark Office from 1994-1998, and is now a trademark litigator. He testified that he could not recall a single case in which he ever used a survey. (Appx.49a-50a, ¶¶78-80.) “[T]hey’re expensive. And even though courts claim they want them, they seem like they knock them out as much as they accept them. And, you know, a quarter million dollars to have your survey knocked out is not a way to ingratiate yourself with your client.” *Id.*

views. But the court gave that impact no weight as to brand awareness (secondary meaning), because the posts are free. That was completely disassociated from marketplace realities. *Compare, Booking.com v. Matal*, 278 F. Supp. 3d 891, 922 (E.D. Va. 2017) (social media following is indicative of the number of consumers who are familiar with a brand), *aff'd*, 915 F.3d 171 (2019), *aff'd*, 140 S. Ct. 2298 (2020); *Classic Liquor Imps., Ltd. v. Spirits Int'l B.V.*, 201 F. Supp. 3d 428, 446 (S.D.N.Y. 2016) (social media a factor in finding disputed facts as to secondary meaning, calling for a trial); *Nordstrom, Inc. v. Nomorerack Retail Grp., Inc.*, 2013 U.S. Dist. LEXIS 41810, *28 (W.D. Wash. Mar. 25, 2013) (social media a factor in determination that mark is famous). It likewise disregarded advertising of Bobcar's website.

All in all, the weighing of the evidence presented fertile ground for a jury. But the judge refused to empanel one. Perhaps he was influenced by his heavy caseload – he complained he had 400 civil cases pending, and 75 motions for summary judgment fully briefed (Appx.46a).

Whatever the reason, the Seventh Amendment cannot simply be disregarded. But the CAFC silently affirmed without explanation.

C. Its Standing Under Lexmark Was Not Addressed

After the district court's ruling, the Federal Circuit issued two decisions recognizing that its prior approach to standing had to be changed²⁴ per this

²⁴ *Lone Star Silicon Innovations LLC v. Nanya Tech. Corp.*, 925 F.3d 1225, 1235-36 (Fed. Cir. 2019) (“motions to dismiss based on ‘statutory standing’ defects are properly brought under Rule 12(b)(6) rather than Rule 12(b)(1) in recognition of the fact

Court's ruling in *Lexmark*.²⁵ Under *Lexmark*, and the CAFC's new precedents, the district court's 12(b)(1) dismissal was wrong. *Id.* But the CAFC silently affirmed without explanation.

D. Equal Protection Issues Are Involved

The affirmance also implicates issues of Equal Protection. Bobcar had to appeal to the CAFC because its case included patent claims. The CAFC then addressed the trade dress claim contrary to governing Second Circuit precedent that the district court's actions were reversible error. *ING Bank*, 892 F.3d at 524. Bobcar lost the benefit of a reversal per its rights in the Second Circuit because it was forced to proceed before the CAFC.

Furthermore, the Second Circuit's rules provide for reasoned summary orders, at a minimum. However, Bobcar was deprived of a written decision. The Federal Circuit applied CAFC Rule 36, and ignored the approach of the circuit where the case originated.

A litigant should expect equal protection regardless of circuit. Instead, there was a stark disparity of treatment, as shown by the Second and Federal Circuits' contrasting rights and rules.

that such defects are not jurisdictional"); *Schwendimann v. Arkwright Advanced Coating, Inc.*, 959 F.3d 1065, 1071 (Fed. Cir. May 5, 2020) ("As long as a plaintiff alleges facts that support an arguable case or controversy under the Patent Act, the court has both the statutory and constitutional authority to adjudicate the matter").

²⁵ *Lone Star*, 925 F.3d at 1235-36 ("the Supreme Court has recently clarified that so-called 'statutory standing' defects do not implicate a court's subject-matter jurisdiction ... *Lexmark* is irreconcilable with our earlier authority treating §281 as a jurisdictional requirement. ... We therefore firmly bring ourselves into accord with *Lexmark*").

**E. All of Which Illustrate the Serious
Risks of Rule 36 Practice**

Ultimately, this petition does not rise or fall on whether the lower courts were right or wrong. The far greater concern is how Bobcar's appeal was addressed. Serious issues were swept under the rug with a single word. If such appellate action is acceptable, no rights are truly safe.

Minutes after the Constitution was ratified, Benjamin Franklin famously said that we have "A republic, if you can keep it." Constitutional principles can only sustain the republic if they are protected. If they can be brushed off, without explanation, then there is no protection at all.

We may have a Constitution in theory.

But we cannot keep it.

CONCLUSION

For the foregoing reasons, this Court should grant this petition for certiorari.

Dated: August 2, 2021

Respectfully submitted,

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APPENDIX

1a

Appendix A

UNITED STATES DISTRICT COURT
FOR THE SECOND CIRCUIT

OPINION AND ORDER

16-CV-885 (JPO)

BOBCAR MEDIA, LLC,

Plaintiff,

—v.—

AARDVARK EVENT LOGISTICS, INC.,

Defendant.

J. PAUL OETKEN, District Judge:

Plaintiff Bobcar Media, LLC (“Bobcar”) initiated this action on February 4, 2016, against Defendant Aardvark Event Logistics, Inc. (“Aardvark”). (Dkt. No. 1.) In the operative Second Amended Complaint, filed April 20, 2016, Bobcar alleges patent infringement under 35 U.S.C. § 271, trademark infringement and unfair competition under the Lanham Act, 15 U.S.C. § 1125(a), and unfair competition under New York law. (Dkt. No. 12 (“SAC”) ¶¶ 93–131.) Aardvark has also asserted counterclaims against Bobcar, seeking a declaratory judgment that the six patents on which Bobcar bases its suit are invalid, that

Aardvark did not infringe Bobcar's patents or trade dress, and that Aardvark did not engage in unfair competition. (Dkt. No. 22 at 22–31.)

On September 7, 2018, Aardvark moved to dismiss the patent infringement claims in the Second Amended Complaint for lack of standing.¹ (Dkt. No. 101.) Specifically, Aardvark argues that Bobcar did not own the patents at issue at the time it filed suit, and that Bobcar thus cannot sue for patent infringement. (Dkt. No. 102 at 1.)

Based on the evidence submitted by the parties, the Court agrees that Bobcar has not sufficiently demonstrated that it possessed standing to initiate this action. Therefore, at this point in time, the Court is inclined to grant Aardvark's motion. However, the Court will delay ruling on the motion to dismiss for ten days, to give Bobcar the opportunity to either file a sur-reply to the motion to dismiss, or move to add the original inventors, David Hazan and Benjamin Cohen, as plaintiffs pursuant to Rule 21.

¹ Aardvark invokes Federal Rule of Civil Procedure 12(b)(1) as the basis for its motion. Because Aardvark has already filed an Answer (Dkt. No. 22), though, the Court construes this as a motion for judgment on the pleadings under Rule 12(c), premised on a lack of subject-matter jurisdiction. *See Goodwin v. Solil Mgmt. LLC*, No. 10 Civ. 5546, 2012 WL 1883473, at *1 (S.D.N.Y. May 22, 2012). Ultimately this is a distinction without a difference, however, because “[w]here a Rule 12(c) motion asserts that a court lacks subject matter jurisdiction, the motion is governed by the same standard that applies to a Rule 12(b)(1) motion.” *Xu v. City of New York*, No. 08 Civ. 11339, 2010 WL 3060815, at *2 n.2 (S.D.N.Y. Aug. 3, 2010).

I. Background

A. Procedural History

Bobcar filed the operative Second Amended Complaint in this action on April 20, 2016. (Dkt. No. 12.) Aardvark moved to dismiss the Second Amended Complaint under Rule 12(b)(6), and the Court denied the motion on January 4, 2017. (Dkt. Nos. 13 & 21.) Aardvark subsequently filed its Answer, which asserted counterclaims seeking a declaratory judgment in Aardvark's favor on each of Bobcar's claims. (Dkt. No. 22 at 22–31.)² Fact discovery in this action closed on August 17, 2018. (Dkt. No. 99.) The instant motion to dismiss was filed on September 7, 2018. (Dkt. No. 101.) On November 14, 2018, the parties completed their claim construction briefing (Dkt. Nos. 104, 107–108, 110), and a *Markman* hearing before the Court is scheduled for December 19, 2018 (Dkt. No. 109).

B. Factual Background

The following facts are taken from the operative Complaint and the parties' submissions regarding the motion to dismiss. (*See* SAC; Dkt. Nos. 101–103, 105–106.) Familiarity with the matter, as set forth in the Court's prior opinion in this case, is presumed. *See Bobcar Media, LLC v. Aardvark Event Logistics, Inc.*, No. 16 Civ. 885, 2017 WL 74729, at *1–3 (S.D.N.Y. Jan. 4, 2017).

The patent infringement claims in this case involve three utility patents and three design patents relating to Bobcar's promotional vehicles: U.S. Patent Nos. 7,942,461 (“the ‘461 patent”); 8,220,854 (“the

² On May 8, 2018, Aardvark moved for sanctions against Bobcar under Rule 11; that motion is pending before the Court. (Dkt. No. 64.)

‘854 patent”); 8,690,215 (“the ‘215 patent”); D652,353 (“the ‘353 patent”); D678,823 (“the ‘823 patent”); D736,675 (“the ‘675 patent”). (SAC ¶¶ 9–14.) The first of these, the ‘461 patent, was issued on May 17, 2011, and lists the inventors as Benjamin Cohen and David Hazan, and the assignee as Bobcar Media, LLC. (Dkt. No. 12-1 at 1.) The other five patents were issued between January 2012 and August 2015, list Cohen and Hazan as the inventors and Bobcar as the assignee, and are related to the ‘461 patent through a chain of patent applications that are continuations and continuations in part of the ‘461 patent. (*See* Dkt. Nos. 2-2 through 12-6.)

During fact discovery in this matter, Bobcar did not produce any documents constituting the written assignment of the patents at issue from the inventors (the putative assignors) to the putative assignee, Bobcar. (Dkt. No. 102 at 2; Dkt. No. 103-3 at 26; Dkt. No. 105 at 3.) Counsel for Bobcar, Morris Cohen, represented at a February 14, 2018 telephonic conference before the Court that he “believe[s] there was an assignment document” when the patent applications were filed, and that if a copy of the original written assignment document “still exists” it would have been produced; but counsel was unsure whether “there are still copies of those documents.” (Dkt. No. 103-3 at 27.)

David Hazan—inventor of the patents and Bobcar’s designated Rule 30(b)(6) witness—was asked about the existence of an assignment document at his Rule 30(b)(6) deposition:

Q. Is there any other document [other than the face of the patents] that evidences BobCar’s ownership of the patents?

...

A. Is there any other document? There could be one.

Q. I can't get into this "could be."

A. I know. I am just saying again I can't pull one out of my pocket for you, but it is possible that we produced one for you.

...

Q. Is there a written document from the inventors assigning any right, title and interest to BobCar?

MR. COHEN: Objection. Asked and answered.

A. I told you I don't have a document at my fingertips, but I am 100 percent sure that we assigned the patents to BobCar Media, LLC.

Q. Have you ever seen a document?

A. If there is a document, I have seen it, and I signed it, so I am telling you that I believe that there is a document. I just don't have one at my fingertips to show you a document.

...

Q. Topic 10 [in the 30(b)(6) notice] requires the identification of any assignment document. You have not identified anything to me, so apparently there is no assignment document.

MR. COHEN: Objection, mischaracterizes testimony. You should go back and read his testimony.

Q. Can you identify this document for me?

MR. COHEN: Objection. Asked and answered.

A. I answered it. I will answer it again. I can't identify the document for you at the moment.

Q. This is the moment.

MR. COHEN: Objection.

A. I don't have the document.

Q. Is there any verbal agreement between the inventors of BobCar as to the ownership of this patent?

...

A. Yes.

Q. There's a verbal agreement?

A. Yes. There was definitely a verbal agreement.

(Dkt. No. 103-4 at 210–11, 227–28; Dkt. No. 105-1 at 218–19.)

In addition, accompanying its opposition to the motion to dismiss, Bobcar submitted a declaration from Benjamin Cohen—the other inventor on the patents and the current President of Bobcar (Dkt. No. 105-12 ¶ 1)—regarding the alleged assignment. Cohen avers:

David Hazan and I both executed a document many years ago assigning to Bobcar all of our rights in the patent applications that we filed, i.e. all our rights to the patents-in-suit. . . . Both of us agreed that our company Bobcar would be the owner of our rights to the patents-in-suit, and we

executed that document for the purpose of transferring to Bobcar any and all our rights to the patents-in-suit. . . . There is no question in my mind that our written transfer of our rights to Bobcar was executed many years before the February 2016 filing of suit in this action.

(Dkt. No. 105-12 ¶¶ 4, 6–7.) Bobcar has also submitted “confirmations of assignment” from both Cohen and Hazan, which confirm that the inventors assigned to Bobcar all rights in the patents at issue, and that the “original written assignment” of the patents occurred “prior to April 5, 2011.” (Dkt. Nos. 105-9 & 105-10.)

II. Legal Standard

Article III’s case-or-controversy requirement mandates that “the party invoking federal jurisdiction have *standing*—the personal interest that must exist at the commencement of the litigation.” *Haley v. Teachers Ins. & Annuity Ass’n of Am.*, No. 17 Civ. 855, 2018 WL 1585673, at *2 (S.D.N.Y. Mar. 28, 2018) (quoting *Carter v. HealthPort Techs., LLC*, 822 F.3d 47, 55 (2d Cir. 2016)). If a plaintiff cannot demonstrate standing, a court lacks subject-matter jurisdiction over the plaintiff’s claims and must dismiss them.

“On a motion to dismiss under Rule 12(b)(1), where evidence relevant to the jurisdictional question is before the court, the court ‘may refer to [that] evidence.’” *MMA Consultants 1, Inc. v. Republic of Peru*, 245 F. Supp. 3d 486, 499 (S.D.N.Y. 2017) (alteration in original) (quoting *Makarova v. United States*, 201 F.3d 110, 113 (2d Cir. 2000)). “This evidence may include affidavits, exhibits and

declarations, all subject to the familiar standards of admissibility found in [Federal Rule of Civil Procedure] 56.” *Id.* The plaintiff bears the ultimate burden of “prov[ing] subject-matter jurisdiction by a preponderance of the evidence.” *Kurzon v. Democratic Nat’l Comm.*, No. 16 Civ. 4114, 2017 WL 2414834, at *1 (S.D.N.Y. June 2, 2017) (quoting *Morrow v. Ann Inc.*, No. 16 Civ. 3340, 2017 WL 363001, at *2 (S.D.N.Y. Jan. 24, 2017)).

III. Discussion

Aardvark moves to dismiss the patent claims in the Second Amended Complaint, contending that Bobcar lacks standing to claim patent infringement because it did not own the patents at issue when it commenced this action. (Dkt. No. 102 at 1.) Bobcar responds that although it lost the assignment document, it nonetheless possesses standing to assert patent infringement because it can sufficiently demonstrate that an assignment of the patents at issue in fact occurred. (Dkt. No. 105 at 3.)

A. Standing to Assert Patent Infringement Claims

“Standing to sue for patent infringement derives from the Patent Act, which provides that “[a] patentee shall have remedy by civil action for infringement of his patent.” *Au New Haven, LLC v. YKK Corp.*, 210 F. Supp. 3d 549, 553 (S.D.N.Y. 2016) (alteration in original) (quoting *Keranos, LLC v. Silicon Storage Tech., Inc.*, 797 F.3d 1025, 1031 (Fed. Cir. 2015) (quoting 35 U.S.C. § 281)). An entity that is not the original recipient of a patent is also considered a “patentee” with statutory standing to sue for infringement in its own right if it is the “assignee[]” and current owner of the patent, or an “exclusive

licensee[] who w[as] given all substantial rights to the patent.” *My First Shades v. Baby Blanket SunCare*, 914 F. Supp. 2d 339, 345 (E.D.N.Y. 2012). Bobcar asserts that it has standing to sue here because it is the assignee of the patents at issue. (Dkt. No. 105 at 1.)³

It is well established that a patent in an invention is generally issued to and initially owned by the inventor, who may then transfer ownership through an assignment. *See Bd. of Trs. of Leland Stanford Junior Univ. v. Roche Molecular Sys., Inc.*, 563 U.S. 776, 785 (2011); *Beech Aircraft Corp. v. EDO Corp.*, 990 F.2d 1237, 1248 (Fed. Cir. 1993). Equally well established, and particularly important in this case, is that “[p]atent ownership cannot be assigned without a ‘written instrument documenting the transfer of proprietary rights in the patents.’” *Picture Patents, LLC v. Aeropostale, Inc.*, 788 F. Supp. 2d

³ In the alternative, Bobcar claims that it is at least an “exclusive licensee” of the patents, and has standing to sue in that capacity. (Dkt. No. 105 at 8–9.) Bobcar is correct that “courts permit exclusive licensees to bring suit in their own name, without joining the patent owner, if the exclusive licensee holds ‘all substantial rights’ in the patent.” *Telebrands Corp. v. Del Labs., Inc.*, 719 F. Supp. 2d 283, 290 (S.D.N.Y. 2010). But Bobcar ignores the fact that such “virtual assignments’ (i.e., exclusive license agreements that convey all substantial rights) must [also] be in writing for a party to have standing to sue in its own name.” *Aspex Eyewear, Inc. v. Altair Eyewear, Inc.*, 288 F. App’x 697, 705 (Fed. Cir. 2008); *see also Vapor Point LLC v. Moorhead*, 832 F.3d 1343, 1351–52 (Fed. Cir. 2016) (O’Malley, J., concurring); *Blumenthal Distrib., Inc. v. Exec. Chair, Inc.*, No. 10 Civ. 1280, 2010 WL 5980151, at *4 (E.D.N.Y. Nov. 9, 2010). This argument in the alternative thus does not relieve Bobcar of the burden of demonstrating that a *written* transfer of ownership in the patents occurred.

127, 137 (S.D.N.Y. 2011) (quoting *Speedplay, Inc. v. Bebob, Inc.*, 211 F.3d 1245, 1250 (Fed. Cir. 2000)).

During discovery, Bobcar was unable to produce a written assignment document that transferred ownership in the patents from the inventors—Hazan and Cohen—to their company. (Dkt. No. 106 at 1.) From this evidentiary gap, Aardvark infers that a written assignment was never executed and Bobcar was not the true owner of the patents when it brought this case. (Dkt. No. 102 at 7–8.) Bobcar responds that although it has lost the assignment document, it can prove that an assignment occurred through the testimony of the two inventors and *nunc pro tunc* assignments, corroborated by the patent applications. (Dkt. No. 105 at 4–8). Aardvark contends that this evidence is insufficient.⁴ (Dkt. No. 106 at 2–3.)

In resolving Aardvark’s motion to dismiss, the ultimate question for the Court is whether Bobcar has shown, by a preponderance of the evidence, that there was in fact a written assignment of the patents at issue. Aardvark asserts that Bobcar cannot meet its burden, because the evidence on which Bobcar attempts to rely is (1) “inadmissible” and (2) otherwise “deficient,” and because (3) even if the Court accepts the evidence Bobcar has put forward, that evidence is insufficient to show that each of the six patents at issue was assigned in writing. (Dkt. No. 106 at 2–4.) The Court agrees that the evidence on which Bobcar relies is inadmissible to prove the

⁴ Aardvark also briefly contends that Bobcar’s inability to produce a written assignment document “alone is dispositive” here. (Dkt. No. 106 at 2.) The Court disagrees. The existence and contents of a document can be proven through secondary evidence. *See* Fed. R. Evid. 1004.

contents of the alleged original written assignment; therefore, at this point in time, Bobcar has not proven that a written assignment was executed.

In resolving a motion to dismiss for lack of subject-matter jurisdiction, courts can rely on evidence outside the pleadings only if such evidence would be admissible on summary judgment. *See MMA Consultants*, 245 F. Supp. 3d at 499. Aardvark contends that the evidence relied on by Bobcar should be “deemed inadmissible,” because Bobcar has not “offered any evidence that the purported assignment existed, much less was lost.” (Dkt. No. 106 at 3.) The basis for this argument is the “best evidence” rule.⁵ (Dkt. No. 106 at 2–3 & n.3 (citing *Seiler v. Lucasfilm, Ltd.*, 808 F.2d 1316, 1320 (9th Cir. 1986); *Allergia, Inc. v. Bouboulis*, No. 14 Civ. 1566, 2017 WL 2547225, at *8–9 (S.D. Cal. June 13, 2017); *Archie Comic Publ’ns, Inc. v. DeCarlo*, 258 F. Supp. 2d 315, 329–31 (S.D.N.Y. 2003)).)

“The ‘best evidence’ rule is codified at Rules 1002 through 1004 of the Federal Rules of Evidence.” *Bandler v. BPCM NYC, Ltd.*, No. 12 Civ. 3512, 2014 WL 5038407, at *7 (S.D.N.Y. Sept. 29, 2014) (brackets omitted) (quoting *Burt Rigid Box, Inc. v. Travelers Prop. Cas. Corp.*, 302 F.3d 83, 91 (2d Cir. 2002)). The rule establishes the presumption that “[a]n original writing . . . is required in order to prove its content.” Fed. R. Evid. 1002. But it provides that “[a]n original is not required and other evidence of the content of a writing . . . is admissible” under certain conditions, including where “all the originals

⁵ Although Aardvark does not expressly invoke the “best evidence” rule by name or citation, the content of its argument and case citations indicate that this is clearly the rule of evidentiary admissibility on which Aardvark seeks to rely.

are lost or destroyed, and not by the proponent acting in bad faith.” Fed. R. Evid. 1004(a). “To satisfy Rule 1004, [t]he party seeking to prove the contents of the writing must establish a proper excuse for the non-production of the document and that the original did exist.” *Crawford v. Franklin Credit Mgmt. Corp.*, No. 08 Civ. 6293, 2015 WL 1378882, at *4 (S.D.N.Y. Mar. 26, 2015) (alteration in original) (quoting *Bandler*, 2014 WL 5038407 at *8). And the proponent “must meet this burden by a preponderance of the evidence.” *Id.*

Because Bobcar seeks to prove the contents of a written document that it claims was once executed—and, in particular, seeks to prove that the document contained an assignment of all six of the patents here at issue—it would ordinarily need to do so by producing the document itself. Here, though, Bobcar contends that it cannot produce the original assignment document because “the document was lost.” (Dkt. No. 105 at 4.) Bobcar’s opposition brief states that “[t]he document may still exist somewhere, or it may be lost. With Bobcar’s prior move of offices, it has not been found to date.” (*Id.* at 4 n.1.) Counsel for Bobcar made similar claims at a teleconference before the Court, stating, “If it still exists, we produced it. . . . I’m just saying that now we haven’t gotten any further copies of it.” (Dkt. No. 103-3 at 27.)

The loss of a document can clearly be a proper excuse for its non-production. *See Crawford v. Tribeca Lending Corp.*, 815 F.3d 121, 127 (2d Cir. 2016) (per curiam). But whether Bobcar lost the assignment document—and did so in good faith—is a “factual predicate[]” which it “must prove by a preponderance of the evidence.” *Id.* Statements of counsel at conference or in a brief, of course, are not

evidence. *See Dimond v. Darden Rests., Inc.*, No. 13 Civ. 5244, 2014 WL 3377105, at *12 (S.D.N.Y. July 9, 2014). And nothing in the declaration, deposition testimony, or confirmation documents on which Bobcar relies addresses what happened to the original assignment document, if it ever existed at all. The Court is left with no evidence on which to conclude that an original assignment document was actually lost.⁶

As such, the “factual predicates” for invoking the Rule 1004 exception are not satisfied here, and the evidence offered by Bobcar is inadmissible to prove the contents of the alleged original assignment document. And because Bobcar has adduced no admissible evidence to prove the contents of the document, it has not proven by a preponderance that it owned the patents at issue and had statutory standing to sue when the case was filed. Therefore, based on the evidence before the Court at this point in time, the Court is inclined to conclude that it lacks subject-matter jurisdiction.

The Court will postpone ruling on Aardvark’s motion to dismiss for ten days, however, to give Bobcar the opportunity to file further submissions responding to Aardvark’s reply brief (Dkt. No. 106 at 2–3) and addressing issues under the “best evidence” rule.

⁶ Because the Court concludes that Bobcar has not satisfied the “excuse” predicate of Rule 1004(a), it does not decide whether Bobcar has proven by a preponderance of the evidence another factual predicate: that “the original did exist.” *Crawford*, 2015 WL 1378882, at *4 (quoting *Bandler*, 2014 WL 5038407, at *8).

B. Adding New Plaintiffs Under Rule 21

Bobcar's opposition to the motion to dismiss does not address the possibility of adding the inventors of the patents as plaintiffs, in the event that Bobcar is unable to demonstrate standing to initiate the action on its own. However, in support of its motion to dismiss, Aardvark asserts that Bobcar cannot cure any "standing defect by joining the actual owners of the Asserted Patents to this suit." (Dkt. No. 102 at 11.) The Court disagrees.

As discussed above, "[p]atent owners, including assignees and exclusive licensees who were given all substantial rights to the patent, may sue alone in their own right." *My First Shades*, 914 F. Supp. 2d at 345. By contrast, "[e]xclusive licensees, with less than all substantial rights to the patent, may sue only if the owner of the patent is joined as a necessary party in the litigation." *Id.* And importantly, such "an exclusive license need not be in writing for the licensee to have standing if the patentee or assignee is also joined." *Id.* at 350 (quoting *Aspex Eyewear, Inc. v. Altair Eyewear, Inc.*, 288 F. App'x 697, 706 (Fed. Cir. 2008)).

Although Bobcar has not proven the content of the alleged *written* assignment on the evidence adduced, it has proven the existence of a *verbal* agreement. (See Dkt. No. 103-4 at 228.) From the representations of the inventors, corroborated by the patent applications, the Court concludes that the inventors at a minimum verbally agreed to transfer all rights in the patents to Bobcar. Such an agreement—an assignment in all but memorialization-by-writing—is the equivalent of an implied exclusive license. As such, Bobcar would have statutory standing to sue for

patent infringement if the inventors of the patents were also joined as plaintiffs.

Under Federal Circuit precedent, “an exclusive licensee with less than all substantial rights in the patent [that] did not have the right to sue under the Patent Act at the inception of the lawsuit,” can “cure the defect by filing a motion to join the patentee as a plaintiff.” *Paradise Creations, Inc. v. UV Sales, Inc.*, 315 F.3d 1304, 1310 (Fed. Cir. 2003). Indeed, the Federal Circuit has a “practice of endorsing joinder of patent owners, under Rule 21 of the Federal Rules of Civil Procedure, in order to avoid dismissal for lack of standing.” *Alps S., LLC v. Ohio Willow Wood Co.*, 787 F.3d 1379, 1385 (Fed. Cir. 2015).

This practice does not run afoul of Article III limits on subject-matter jurisdiction because such an exclusive licensee, with “the right to exclude others from making, using, and selling an invention described in the claims of a patent is constitutionally injured by another entity that makes, uses, or sells the invention’ and therefore has constitutional standing.” *My First Shades*, 914 F. Supp. 2d at 345 (quoting *Intellectual Prop. Dev., Inc. v. TCI Cablevision of Cal., Inc.*, 248 F.3d 1333, 1346 (Fed. Cir. 2001)). Exclusive licensees are “required to join the title holder” only as a matter of prudential standing, in order “to prevent multiple litigations regarding the same patent.” *Id.* But “[i]t is sufficient for [prudential] standing purposes that the title holder is eventually added to the suit, even if the title holder was not in the suit originally, because the exclusive licensee meets constitutional standing requirements.” *Id.* at 346.

Adding the inventors—David Hazan and Benjamin Cohen—as plaintiffs in this action would thus cure

any deficiency in Bobcar's statutory standing at the time it filed the suit.

Accordingly, the Court will delay granting Aardvark's motion to dismiss for ten days, in which time Bobcar can move, if it so chooses, to add Hazan and Cohen as parties under Rule 21.

IV. Conclusion

For the foregoing reasons, the Court will defer ruling on Aardvark's motion to dismiss for ten days. On or before December 17, 2018, Bobcar may choose to file either additional submissions responding to Aardvark's reply brief, or a motion to add additional plaintiffs under Rule 21. If Bobcar does not act to cure its standing deficiency within that time, the patent infringement claims in the Second Amended Complaint will be dismissed without prejudice. In the event that Bobcar files additional submissions, Aardvark will have until December 21, 2018 to respond.

SO ORDERED.

Dated: December 7, 2018
New York, New York

/s/ J. Paul Oetken
J. PAUL OETKEN
United States District Judge

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Appendix B

UNITED STATES DISTRICT COURT
FOR THE SECOND CIRCUIT

16-CV-885 (JPO)

ORDER

BOBCAR MEDIA, LLC,

Plaintiff,

—v.—

AARDVARK EVENT LOGISTICS, INC.,

Defendant.

J. PAUL OETKEN, District Judge:

On December 7, 2018, the Court concluded that Plaintiff Bobcar Media LLC had not adequately demonstrated that it possessed statutory standing to assert patent infringement claims against Defendant Aardvark Event Logistics, Inc. when this case was filed. (Dkt. No. 111.) The Court deferred ruling on Aardvark's Rule 12(b)(1) motion to dismiss for ten days to give Bobcar the opportunity to cure its

standing deficiency.¹ By the end of that period, the Court directed Bobcar to do one of two things to establish standing: either (1) provide “additional submissions responding to Aardvark’s reply brief”—specifically to “address[] issues under the ‘best evidence’ rule”—or (2) file “a motion to add additional plaintiffs under Rule 21” of the Federal Rules of Civil Procedure. (Dkt. No. 111 at 10, 12.)

Bobcar chose to do neither. Instead, in its sur-reply Bobcar essentially moves for reconsideration by rehashing arguments made in its opposition brief, asserting that it possesses standing as an exclusive licensee of the patents at issue. (*Compare* Dkt. No. 115 at 2, *with* Dkt. No. 105 at 9.) Not only was this approach *not* one of the ways in which the Court permitted Bobcar to respond to the December 7, 2018 Opinion, but Bobcar’s argument had already been squarely rejected by the Court.

As the Opinion explained, in order for an exclusive licensee to have standing to bring a patent infringement action on its own, the exclusive license must be in writing. (Dkt. No. 111 at 6–7 n.3.) “[B]oth assignments and ‘virtual assignments’ (i.e., exclusive license agreements that convey all substantial rights) must be in writing for a party to have standing to sue in its own name.” *Aspex Eyewear, Inc. v. Altair Eyewear, Inc.*, 288 F. App’x 697, 705 (Fed. Cir. 2008) (citing *Enzo APA & Son, Inc. v. Geapag A.G.*, 134 F.3d 1090, 1093 (Fed. Cir. 1998)). For the reasons stated in the December 7, 2018 Opinion, Bobcar has not adduced sufficient admissible evidence to demonstrate that the inventors executed an original

¹ The Court later granted Bobcar’s request for an extension, providing an additional ten days to comply with the Court’s December 7, 2018 Opinion. (Dkt. No. 114.)

written assignment covering the patents at issue. (Dkt. No. 111 at 8–10.) Nor has Bobcar attempted to prove the existence or contents of a written exclusive license agreement. Therefore, Bobcar has not demonstrated that it possessed statutory standing to sue as an exclusive licensee without the inventors as co-plaintiffs when this action was filed.

In its sur-reply, Bobcar requested that its ability to file a motion to add the inventors as co-plaintiffs under Rule 21 be reserved until the Court ruled on its response to the December 7, 2018 Opinion. (Dkt. No. 115 at 3.) This request is denied. The Court afforded Bobcar the opportunity to attempt to establish standing by filing a Rule 21 motion on or before December 27, 2018. (*See* Dkt. Nos. 111 & 114.) Bobcar elected not to pursue this course of action, and the Court is not inclined to defer its ruling on Aardvark’s motion to dismiss any longer.

The Court observes that Bobcar would face a heavy burden in attempting to add the inventors as co-plaintiffs at this point in the litigation, for the reasons identified in Aardvark’s sur-reply. (Dkt. No. 116 at 7–8.) The case has been pending for nearly three years, and Bobcar has had notice of Aardvark’s concerns about its standing since February 2018. (*See* Dkt. No. 54 at 24–25.) Furthermore, the ability of a Rule 21 motion to establish standing hinges on Bobcar’s acknowledging its status as a licensee of the patent, marking a significant departure from the position Bobcar has maintained over the first two years of this litigation. Ultimately, however, the likelihood of success of any Rule 21 motion is inapposite. The Court declines to exercise its discretion to allow the filing of a Rule 21 motion at this stage, after Bobcar failed to take the opportunity to do so in the time allotted.

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For the reasons stated in the Opinion of December 7, 2018, Bobcar did not have statutory standing to assert the patent infringement claims in the Second Amended Complaint when filed. (Dkt. No. 12 (Count I).) Accordingly, the patent infringement claims in Bobcar's Second Amended Complaint are hereby DISMISSED WITHOUT PREJUDICE.

The Clerk of Court is directed to close the motion at Docket Number 101.

SO ORDERED.

Dated: January 14, 2019
New York, New York

 /s/ J. Paul Oetken
J. PAUL OETKEN
United States District Judge

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Appendix C

UNITED STATES DISTRICT COURT
FOR THE SECOND CIRCUIT

16-CV-885 (JPO)

OPINION AND ORDER

BOBCAR MEDIA, LLC,

Plaintiff,

—v.—

AARDVARK EVENT LOGISTICS, INC.,

Defendant.

J. PAUL OETKEN, District Judge:

Plaintiff Bobcar Media, LLC (“Bobcar”) initiated this action on February 4, 2016, against Defendant Aardvark Event Logistics, Inc. (“Aardvark”). (Dkt. No. 1.) In the operative Second Amended Complaint, filed April 20, 2016, Bobcar alleged patent infringement under 35 U.S.C. § 271, trademark infringement and unfair competition under the Lanham Act, 15 U.S.C. § 1125(a), and unfair competition under New York law. (Dkt. No. 12 (“SAC”) ¶¶ 93–131.) Aardvark asserted counterclaims against Bobcar, seeking a declaratory judgment that the six patents on which Bobcar bases its suit are invalid, that Aardvark did

not infringe Bobcar’s patents or trade dress, and that Aardvark did not engage in unfair competition. (Dkt. No. 22 at 22–31.) On January 14, 2019, this Court dismissed all patent infringement claims for lack of statutory standing. (Dkt. No. 117.) Aardvark has now moved to exclude the expert testimony of James A. Roberts, Ph.D. (Dkt. No. 141), and for summary judgment on all remaining claims (Dkt. No. 142). Bobcar has cross-moved for summary judgment. (Dkt. No. 147.) For the reasons that follow, Aardvark’s motion to exclude is granted, Aardvark’s motion for summary judgment is granted, and Bobcar’s cross-motion for summary judgment is denied.

I. Background

Bobcar is a company that owns technology and designs for promotional vehicles. (SAC ¶¶ 8–9.) Created in 2007, Bobcar vehicles “are mobile marketing vehicles used in connection with mobile marketing programs conducted on behalf of brands and/or advertising agencies representing brands.” (Aardvark SOF¹ ¶¶ 8–10.) The vehicle has panels that open and close to reveal products promoted in a showroom. (See Dkt. No. 148 (“Bobcar SOF”) ¶¶ 60–64.) Bobcar has used its vehicles in dozens of campaigns. (Aardvark SOF ¶ 15.) While Bobcar holds four utility and four design patents in connection

¹ Aardvark’s Rule 56.1 Statement of Facts, referred to herein as “Aardvark SOF,” was filed under seal in its entirety. Where the Court relies on documents that have been filed under seal, the Court has concluded that the parties’ interests in continued sealing of the portions referenced in this Opinion and Order are insufficient to overcome the presumption of public access to judicial documents. See *Lugosch v. Pyramid Co. of Onondaga*, 435 F.3d 110, 119–20 (2d Cir. 2006).

with the Bobcar, it never registered the trade dress it asserts in this action. (Aardvark SOF ¶¶ 57, 78.)

“Aardvark is an experimental and event mobile marketing firm . . . that provides promotional vehicles.” (Aardvark SOF ¶ 42.) Aardvark offers promotional vehicles under the name “Aardy.” (Aardvark SOF ¶ 43.) A version of the Aardy was introduced into the marketplace in 2008. (Aardvark CSOF² ¶ 131.) The Aardy has also been used in several campaigns. (Aardvark SOF ¶¶ 44–56.) Bobcar asserts that the Aardy is confusingly similar to the Bobcar vehicle, and that it infringes upon its trade dress. (*See* SAC.) On February 4, 2016, Bobcar filed this action. (Dkt. No. 1.)

II. Motion to Exclude

A. Legal Standard

The admissibility of expert testimony is governed by Federal Rule of Evidence 702, which provides that an expert who is “qualified . . . by knowledge, skill, experience, training, or education may testify” if the testimony would be helpful to the trier of fact, is “based on sufficient facts or data,” and is “the product of reliable principles and methods,” reliably applied to the facts of the case. Fed. R. Evid. 702. And these factors, in turn, largely have their origins in *Daubert*, in which the Supreme Court held that the district court bears a critical gatekeeping function in assessing the admissibility of expert testimony. *Daubert v. Merrell Dow Pharm., Inc.*, 509 U.S. 579, 589–95 (1993).

² Aardvark’s response to Bobcar’s Statement of Facts, referred to herein as “Aardvark CSOF,” was filed under seal in its entirety. To the extent this Court relies upon it, it is hereby unsealed. *See supra* note 1.

“[T]he proponent of expert testimony has the burden of establishing by a preponderance of the evidence that the admissibility requirements of Rule 702 are satisfied” *United States v. Williams*, 506 F.3d 151, 160 (2d Cir. 2007). Although Rule 702 requires courts to serve an initial gatekeeping function to keep out “junk science,” *Davis v. Carroll*, 937 F. Supp. 2d 390, 412 (S.D.N.Y. 2013), it is nonetheless “a well-accepted principle that Rule 702 embodies a liberal standard of admissibility for expert opinions,” *Nimely v. City of New York*, 414 F.3d 381, 395 (2d Cir. 2005). However, “nothing in either *Daubert* or the Federal Rules of Evidence requires a district court to admit opinion evidence that is connected to existing data only by the *ipse dixit* of the expert. A court may conclude that there is simply too great an analytical gap between the data and the opinion proffered.” *Gen. Elec. Co. v. Joiner*, 522 U.S. 136, 146 (1997).

B. Discussion

Bobcar offers Dr. James A. Roberts as a “consumer behavior expert” to opine “on issues relating to [Bobcar’s] trade dress and relating to [Aardvark’s] infringement thereof by its Aardvark promotional vehicles, and its federal and state unfair competition[, including] likelihood of confusion . . . , secondary meaning, and functionality.” (Dkt. No. 141-3 (“Roberts Rep.”) ¶ 1.) Aardvark moves to exclude Roberts’s expert report on the grounds (1) that Roberts is not qualified to render an expert opinion, (2) that he offers improper legal opinions that go to the ultimate issue in the case, and (3) that his opinions are not based on any recognized or reliable methodology.

Daubert presents a two-step inquiry for deciding whether to admit expert testimony. The first question a court poses in conducting the *Daubert* inquiry is “whether the expert has sufficient qualifications to testify.” *Davis*, 937 F. Supp. 2d at 412 (citation omitted). If so, the “next question is ‘whether the proffered testimony has a sufficiently reliable foundation.’” *Id.* (quoting *Amorgianos v. Nat’l R.R. Passenger Corp.*, 303 F.3d 256, 265 (2d Cir. 2002)). “The ultimate determination the Court must make on a *Daubert* motion is that the expert ‘employs in the courtroom the same level of intellectual rigor that characterizes the practice of an expert in the relevant field.’” *Fort Worth Emps.’ Ret. Fund v. J.P. Morgan Chase & Co.*, 301 F.R.D. 116, 127 (S.D.N.Y. 2014) (quoting *Kumho Tire Co. v. Carmichael*, 526 U.S. 137, 152 (1999)).

As an initial matter, Aardvark does not dispute that Roberts is qualified as a consumer behavior expert — instead, it argues that he is not qualified to render the specific opinions that he offers in his expert report. “Even if ‘a witness qualifies as an expert with respect to certain matters or areas of knowledge, it by no means follows that he or she is qualified to express expert opinions as to other fields.’” *LVL XIII Brands v. Louis Vuitton Malletier S.A.*, 209 F. Supp. 3d 612, 638 (S.D.N.Y. 2016) (quoting *Nimely v. City of New York*, 414 F.3d 381, 399 n.13 (2d Cir. 2005)). Roberts was retained to address issues including “likelihood of confusion . . . , secondary meaning, and functionality.” (Roberts Rep. ¶ 1.) Aardvark argues that because these concepts require an understanding of legal concepts that Roberts does not possess, he is unqualified to opine on those issues. However, an expert does not need to be well-versed in the legal terrain to be sufficiently

qualified to testify as an expert witness. A consumer behavioral expert is not so irrelevant as to be unqualified to testify to help the jury determine whether there exists likelihood of confusion, secondary meaning, or functionality. And because Roberts has extensive experience as a consumer behavior expert (*see* Roberts Rep. at 37–56), this Court will not exclude Roberts’s testimony for lack of qualifications.

However, it is clear that the proffered expert report offers both impermissible legal conclusions and opinions that are not based on any reliable methodology. While an expert opinion “is not objectionable just because it embraces an ultimate issue,” Fed. R. Evid. 704(a), it remains impermissible for experts “to offer opinions embodying legal conclusions.” *Floyd v. City of New York*, 861 F. Supp. 2d 274, 287 (S.D.N.Y. 2012) (quoting *United States v. Scop*, 846 F.2d 135, 139 (2d Cir. 1988)). Further, it is axiomatic that proffered expert testimony must be “more than subjective belief or unsupported speculation.” *Daubert*, 509 U.S. at 589–90. Opinions are inadmissible when they are “connected to existing data only by the *ipse dixit* of the expert,” or when there is “simply too great an analytical gap between the data and the opinion proffered.” *Gen. Elec. Co.*, 522 U.S. at 146. As discussed below, because each section of the report ultimately draws legal conclusions based on evidence that is seemingly not analyzed in any meaningful way, Roberts’s expert report is excluded.

1. Trade Dress Opinion

Roberts opines that Bobcar has clearly identified its trade dress, that the claimed trade dress is distinctive, and that Bobcar was the exclusive user of

the claimed trade dress when Bobcar introduced its first vehicle in 2007. (*See* Roberts Rep. ¶¶ 25–33). He based these opinions on the pleadings, exhibits attached thereto, this Court’s January 4, 2017 Opinion and Order, deposition testimony, and produced documents. (*See id.*)

To the extent that Roberts relies on the pleadings or this Court’s prior Opinion and Order, that reliance is misplaced. Neither the pleadings nor this Court’s 2017 Opinion and Order are admissible evidence. It is true that “[i]f experts in the particular field would reasonably rely on those kinds of facts or data in forming an opinion on the subject, they need not be admissible for the opinion to be admitted.” Fed. R. Evid. 703. However it is unlikely, to say the least, that consumer behavior experts reasonably rely on legal documents to come to their conclusions.³ On that basis alone, all conclusions based on that evidence is excluded.

However, even excluding the opinions that rest on an impermissible basis, the rest of the trade dress section would not assist the jury. Because in his expert opinion Roberts simply “rehash[es] otherwise admissible evidence about which he has no personal

³ Roberts’s reliance on this Court’s Opinion and Order is particularly problematic due to Roberts’s misunderstanding of this Court’s ruling. At the early motion to dismiss stage, this Court assessed whether Bobcar had, *in its complaint*, alleged enough facts to state a claim under the Lanham Act and New York state law. (*See* Dkt. No. 21.) This Court has not yet adjudicated the critical questions in this case, as Roberts seems to erroneously suggest throughout the report. (*See, e.g.*, Roberts Rep. ¶ 44 (claiming that this Court “previously held” that Bobcar’s “design features are not essential to the purpose of Bobcar’s promotional vehicles” (second quoting Dkt. No. 21 at 14)).)

knowledge,” those observations are inadmissible. *See Highland Capital Mgmt., L.P. v. Schneider*, 379 F. Supp. 2d 461, 468–69 (S.D.N.Y. 2005). Roberts offers no analysis beyond highlighting aspects of the record that he finds important and demonstrating how it satisfies the legal standards he sets out. Because the jury would be engaging in the same process when assessing Bobcar’s claims, this is impermissible *ipse dixit* testimony. *See Gen. Elec. Co.*, 522 U.S. at 146. Accordingly, the trade dress portion of the expert report is excluded.

2. Non-Functionality Opinion

Roberts assesses the non-functionality of Bobcar’s promotional vehicles with the use of the same categories of materials discussed in Section II.B.1, *supra*, with the addition of a Google search. (Roberts Rep. ¶¶ 34–44.) Roberts notes that “[a] Google search for on-vehicle advertising provides a nearly overwhelming number of alternatives for on-vehicle promotion” and thus concludes that “the Bobcar promotional vehicles are only one of many ways a vehicle can be used as an advertising medium.” (Roberts Rep. ¶ 36.) However, it is not beyond the understanding of the average juror that on-vehicle advertising such as “car rooftop advertising,” “car and truck decals and stickers,” or “bumper stickers” exist. (*See id.*) Therefore, while a Google search itself may be unwieldy to present to the jury, surely the information that there are numerous ways that vehicles can be used to advertise can be effectively conveyed by way of the direct and cross examination of fact witnesses.

And for the same reasons discussed in Section II.B.1, *supra*, Roberts’s review of the other evidence is unhelpful to the jury because it contains no analysis

beyond that which can be done by the average juror. Accordingly, the non-functionality portion of the expert report is excluded.

3. Secondary Meaning Opinion

Roberts assesses whether Bobcar's trade dress has acquired secondary meaning with the use of the same categories of materials discussed in Section II.B.1. (See Roberts Rep. ¶¶ 45–83.) And for the same reasons discussed in that section, Roberts's review of the evidence is not more sophisticated than that to be performed by the average juror. The extent of advertising expenditures, positive press, and sales revenues is evident from the face of the documents that Roberts cites. (See, e.g., Roberts Rep. ¶ 54 (“The statements indicate millions of dollars of expenditures on the Bobcar vehicles and their campaigns.”).)

Indeed, the only statement that goes beyond the mere application of facts to the law is Roberts's opinion that:

[Bobcar's] direct engagement is far more effective than simple advertisements or advertising which can more easily be ignored by a consumer or at the periphery of a consumers' [sic] consciousness. The use of the brand ambassador brings the consumer into direct contact with the BobCar[and] brings the BobCar into the forefront of the consumer's consciousness.

(Roberts Rep. ¶ 57.) However, while this analysis could conceivably be within the realm of knowledge of a consumer behavior expert, Roberts does not provide any support for this opinion. Because Roberts has failed to bridge the “analytical gap” between the evidence and his opinion, it does not pass muster. See *Gen. Elec. Co.*, 522 U.S. at 146. Accordingly, the

secondary meaning portion of Roberts’s opinion is excluded.

4. Likelihood of Confusion Opinion

Roberts assesses the likelihood of confusion with the use of the same categories of materials discussed in Section II.B.1. (See Roberts Rep. ¶¶ 84–152.) And for same reasons discussed there, Roberts’s review of the evidence is not more sophisticated than the analysis of which a lay juror is capable. For example, Roberts notes that after reviewing “hundreds of images from the Aardvark and Bobcar websites” as well as “depositions and exhibits,” he came to the conclusion that “[i]t is evident that in the eye of the ordinary consumer, [the] products are extremely similar.” (Roberts Rep. ¶ 92.) He offers no analysis other than the fact that he reviewed those materials — materials that presumably jurors would be able to review themselves at trial. (See *id.*) Accordingly, statements like these are inadmissible.

In fact, the only statement in this section that conceivably goes beyond mere application of facts to law in this section is the following: “I am not aware of any documentation of extensive development and design work by Aardvark . . . as one would expect from development of a new promotional vehicle. This further provides a strong inference of copying and bad faith.” (Roberts Rep. ¶ 117.) However, like the statement discussed in Section II.B.3, *supra*, no support is provided for this opinion. Accordingly, the likelihood of confusion portion of the report is inadmissible.

* * *

In sum, because every section of Roberts’s expert report is pervaded with impermissible legal

conclusions and his opinions are not based on any evident reliable methodology, the report must be excluded in its entirety.

III. Motions for Summary Judgment

A. Legal Standard

Summary judgment under Rule 56 is appropriate where “there is no genuine dispute as to any material fact and the movant is entitled to judgment as a matter of law.” Fed. R. Civ. P. 56(a). A fact is material if it “might affect the outcome of the suit under the governing law.” *Anderson v. Liberty Lobby, Inc.*, 477 U.S. 242, 248 (1986). A dispute is genuine if, considering the record as a whole, a rational jury could find in favor of the non-moving party. *See Ricci v. DeStefano*, 557 U.S. 557, 586 (2009).

“On summary judgment, the party bearing the burden of proof at trial must provide evidence on each element of its claim or defense.” *Cohen Lans LLP v. Naseman*, No. 14 Civ. 4045, 2017 WL 477775, at *3 (S.D.N.Y. Feb. 3, 2017) (citing *Celotex Corp. v. Catrett*, 477 U.S. 317, 322–23 (1986)). “If the party with the burden of proof makes the requisite initial showing, the burden shifts to the opposing party to identify specific facts demonstrating a genuine issue for trial, *i.e.*, that reasonable jurors could differ about the evidence.” *Clopay Plastic Prods. Co. v. Excelsior Packaging Grp., Inc.*, No. 12 Civ. 5262, 2014 WL 4652548, at *3 (S.D.N.Y. Sept. 18, 2014). The court views all “evidence in the light most favorable to the non-moving party,” and summary judgment may be granted only if “no reasonable trier of fact could find in favor of the nonmoving party.” *Allen v. Coughlin*, 64 F.3d 77, 79 (2d Cir. 1995) (internal quotation

marks omitted) (second quoting *Lunds, Inc. v. Chem. Bank*, 870 F.2d 840, 844 (2d Cir. 1989)).

B. Discussion

Aardvark and Bobcar each move for summary judgment on all of Bobcar's trade dress infringement and unfair competition claims. As an initial matter, a plaintiff must offer "a precise expression of the character and scope of the claimed trade dress." *Landscape Forms, Inc. v. Columbia Cascade Co.*, 113 F.3d 373, 381 (2d Cir. 1997). And to succeed on a claim for trade dress infringement involving the appearance of a product, Bobcar must show that "(1) the claimed trade dress is non-functional; (2) the claimed trade dress has secondary meaning; and (3) there is a likelihood of confusion between the plaintiff's good and the defendant's." *Sherwood 48 Assocs. v. Sony Corp. of Am.*, 76 F. App'x. 389, 391 (2d Cir. 2003) (summary order). Aardvark argues that Bobcar has met none of the elements to sustain its trade dress infringement claim, and therefore the federal- and state-law unfair competition claims must fall as well. Bobcar argues that it has met each element of its trade dress infringement claim and has additionally proved its unfair competition claims. This Court first considers whether the elements of the trade dress infringement claim are met, then addresses the unfair competition claims.

1. Trade Dress Description

Aardvark argues that Bobcar's description of its trade dress is improperly broad as a matter of law, and therefore its trade dress infringement claim must fail. In the Second Circuit, a plaintiff must articulate the specific elements that comprise its alleged trade dress. *See Yurman Design, Inc. v. PAJ, Inc.*, 262 F.3d 101, 118 (2d Cir. 2001). Further, a plaintiff must

make clear “how they are distinctive.” *Nat’l Lighting Co. v. Bridge Metal Indus., LLC*, 601 F. Supp. 2d 556, 562 (S.D.N.Y. 2009). Failure to do so “may indicate that its claim is pitched at an improper level of generality, i.e., the claimant seeks protection for an unprotectable style, theme, or idea.” *Landscape Forms, Inc.*, 113 F.3d at 381.

The Court remains unpersuaded that Bobcar’s description of its trade dress is not particularized enough to be protected. Bobcar’s identification of its trade dress is as follows:

[A] promotional vehicle having a compact cab in the front, and a compact showroom in back, the showroom having substantially rectangular or square panels on the left and right sides and rear in the closed position, the vehicle having a configuration in which those panels are raised above the showroom and above the height of the front cab in an open position, the showroom being open to the public on three sides when the panels are in the open position, providing an open air showroom which is used to promote goods or services displayed in the showroom, wherein the promotional vehicle includes a colorful front cab and colorful back, including a colorful coordinated theme extending the entire length of the vehicle from front to back and corresponding to the brand or type of goods or services in the showroom, and with the vehicle having advertising or promotional materials on the panels visible in the open and closed positions and corresponding to the brand or type of goods or services in the showroom.

(Aardvark SOF ¶ 76 (alteration in original).) While Aardvark argues that the definition “improperly

covers an inordinate number of vehicles with a limitless number of features too numerous to mention” (Dkt. No. 142-1 at 7), any trade dress description can be dissected in that manner and will therefore be at least somewhat susceptible to that issue. Far from being “pitched at an improper level of generality,” *Landscape Forms, Inc.*, 113 F.3d at 381, Bobcar’s description is quite detailed. Accordingly, this Court concludes that Bobcar has identified a protectable trade dress.

2. Secondary Meaning

Aardvark argues that Bobcar has not shown that its trade dress has acquired secondary meaning, and therefore its trade dress infringement claim fails as a matter of law. “The trade dress of a product attains secondary meaning when the purchasing public associates its design with a single producer or source rather than simply with the product itself.” *Coach Leatherware Co. v. AnnTaylor, Inc.*, 933 F.2d 162, 168 (2d Cir. 1991) (internal quotation marks and citations omitted). However, “[t]rade dress generally falls into one of two categories: product packaging or product design.” *Pure Power Boot Camp, Inc. v. Warrior Fitness Boot Camp, LLC*, 813 F. Supp. 2d 489, 537 (S.D.N.Y. 2011). While secondary meaning must be shown for product-design trade dress, it need not be shown for product-packaging trade dress. *See Wal-Mart Stores, Inc. v. Samara Bros, Inc.*, 529 U.S. 205, 215 (2000). Bobcar argues that because its trade dress falls into the product packaging category, it does not need to show secondary meaning to prove its trade dress infringement claim. (*See* Dkt. No. 147 at 11–12.) The Court rejects this argument. The reason that product packaging does not typically require a showing of secondary meaning is because its

“predominant function remains source identification.”
Wal-Mart Stores, Inc., 529 U.S. at 212.

This is not the function of the Bobcar. By way of example, the Supreme Court has noted that a Coca-Cola bottle

may constitute packaging for those consumers who drink the Coke and then discard the bottle, but may constitute the product itself for those consumers who are bottle collectors, or part of the product itself for those consumers who buy Coke in the classic glass bottle, rather than a can, because they think it more stylish to drink from the former.

Wal-Mart Stores, Inc., 529 U.S. at 215. Here, the Bobcar is the product. Critically, its customers are not those who might see the Bobcar vehicle on the street, but rather the brands and advertising agencies that secure the use of the Bobcar vehicle for promotional purposes. Those brands and advertising agencies are not interested in purchasing the product that the Bobcar is promoting, unlike the consumer who drinks Coke and discards the bottle. Bobcar’s customers are interested in the Bobcar vehicle itself, which makes it unequivocally the product. And even if there is some ambiguity about into which category the trade dress falls, the Supreme Court has held that “courts should err on the side of caution and classify ambiguous trade dress as product design, thereby requiring secondary meaning.” *Id.* Therefore, this Court holds that the trade dress that Bobcar seeks to protect is of the product design variety, and thus it is not exempted from the necessary showing of secondary meaning.

To assess whether a trade dress has acquired secondary meaning, courts consider the following

factors: (1) advertising expenditures, (2) consumer studies, (3) unsolicited media coverage of the product, (4) sales success, (5) attempts to plagiarize the mark, and (6) length and exclusivity of use. *Coach Leatherware Co.*, 933 F.2d at 169. Bobcar bears the burden to show secondary meaning, and “[p]roof of secondary meaning entails vigorous evidentiary requirements.” *Thompson Med. Co. v. Pfizer Inc.*, 753 F.2d 208, 217 (2d Cir. 1985) (citation omitted). Critically, Bobcar must show that its product acquired secondary meaning “before the infringement began.” *Braun Inc. v. Dynamics Corp. of Am.*, 975 F.2d 815, 826 (Fed. Cir. 1992) (citing *Saratoga Vichy Spring Co. v. Lehman*, 625 F.2d 1037, 1043 (2d Cir. 1980)).

i. Advertising Expenditures

Advertising expenditures are “indirect evidence of the possible effect that advertising might have on consumers’ association of the trade dress with the source of the product.” *LVL XIII Brands*, 209 F. Supp. 3d at 654–55 (citation omitted). And it is important to keep in mind that advertising expenditures are of “limited probative value” if the advertising has not “effectively created secondary meaning.” *Braun Inc.*, 975 F.3d at 826–27. Bobcar argues that it has spent millions of dollars on its promotional campaigns. (Dkt. No. 147 at 13 (citing Dkt. No. 147-19).) However, this represents its costs in carrying out the Bobcar vehicle promotional campaigns purchased by its customers. The fact that Bobcar lists its website on its vehicles (*see* Dkt. No. 147-49), cannot convert its core functions into advertisements. And while Bobcar offers evidence that it utilizes brand ambassadors, has sponsored at least one event, has issued press releases, advertises on its website and on social media, and has purchased print

advertisements, it offers no evidence showing how much money has been spent on these advertising activities. Accordingly, this factor weighs against Bobcar.

ii. Consumer Studies

Bobcar has failed to produce any consumer studies to support secondary meaning. (Aardvark SOF ¶ 90.) A consumer survey is not strictly required in this Circuit. *See LeSportsac, Inc. v. K mart Corp.*, 754 F.2d 71, 78 (2d Cir. 1985). However, “[a] consumer survey is the most persuasive element in demonstrating secondary meaning, because such a survey provides direct evidence.” *Ergotron, Inc. v. Hergo Ergonomic Support Sys., Inc.*, No. 94 Civ. 2732, 1996 WL 143903, at *8 (S.D.N.Y. Mar. 29, 1996). Bobcar curiously argues that Aardvark could have procured a consumer survey, and thus Aardvark’s failure to do so “lead[s] to an inference that it believed a survey would have been unfavorable.” (Dkt. No. 147 at 16.) However, it is black-letter law that the *plaintiff* bears the burden of demonstrating secondary meaning. *See Thompson Med. Co.*, 753 F.2d at 217. It was Bobcar’s responsibility to procure and marshal any and all evidence to support its trade dress infringement claim. It cannot shift the evidentiary burden of proof onto Aardvark in order to escape its own failure to provide consumer-study evidence. Accordingly, this factor weighs against Bobcar.

iii. Unsolicited Media Coverage

As evidence of unsolicited media coverage, Bobcar offers ten articles written about the Bobcar vehicle. (See Dkt. Nos. 147-25, 147-28 to -36.) The Court cannot evaluate the sufficiency of two of the articles, because Bobcar offers only a photograph of the article

rather than the article itself — and the photograph is taken from too far a distance for the words of the article to be readable. (*See* Dkt. Nos. 147-31, 147-33.) Accordingly, these two articles must be excluded from consideration. Three of the articles are about the Pentax campaign’s use of the Bobcar vehicle. (*See* Dkt. Nos. 147-25, 147-30, 147-36.) However, the articles that Bobcar offers do not make it clear that *Bobcar* is the source of the vehicle — indeed they read as if *Pentax* created the vehicle itself. (*See, e.g.*, Dkt. No. 147-25 (“Two Pentax BobCars are scooting around a 15 mile radius in New York City I’m happy to see [Pentax] trying something innovative to get the word out about their products.”).) One article is even entitled “Takin’ It to the People – The Pentax Bobcar.” (*Id.*) Because this media coverage does not refer to Bobcar as the company that created the vehicle, it cannot support a finding of secondary meaning. *See LVL XIII Brands*, 209 F. Supp. 3d at 658–59.

The remaining five articles offered do discuss Bobcar as the source of the vehicle. (*See* Dkt. Nos. 147-28, 147-29, 147-32, 147-34, 147-35.) Aardvark argues that Bobcar has not shown that this media coverage was unsolicited. *Cf. Nat’l Distillers Prods. Co. v. Refreshment Brands, Inc.*, 198 F. Supp. 2d 474, 481 (S.D.N.Y. 2002) (evidence of media coverage did not favor plaintiff where solicited). And while Aardvark does not offer any evidence that the coverage was not solicited, it is Bobcar’s burden to show that it was. It has not done so. And even if it had, none of these articles are from the relevant time period — before the Aardy came onto the market in 2008. *See Sports Traveler, Inc. v. Advance Magazine Publishers, Inc.*, 25 F. Supp. 2d 154, 164 (S.D.N.Y. 1998) (holding that unsolicited media accrued after

the date the infringement began “is irrelevant because that is the date upon which [Plaintiff]’s trade dress must have attained secondary meaning”) Accordingly, this factor weighs against Bobcar.

iv. Sales Success

Bobcar has earned millions of dollars in revenue from Bobcar vehicle campaigns. (*See* Dkt. No. 147-19.) And while all of that revenue was not accrued by the time that the Aardy went onto the market, campaigns that ultimately brought in over \$1 million had begun by 2008. (*Id.*) The volume of sales success here is robust enough such that this factor weighs in favor of Bobcar.

v. Attempts to Plagiarize the Mark

“Evidence that a mark has been widely copied is persuasive evidence of secondary meaning because it demonstrates that the mark has become a strong source identifier in the eyes of the purchasing public.” *Lopez v. Gap, Inc.*, 883 F. Supp. 2d 400, 428 (S.D.N.Y. 2012) (internal quotation marks and citation omitted). Here, Bobcar presents no evidence of any third-party copying. That alone may be enough for this factor to weigh against Bobcar. *See Metrokane, Inc. v. The Wine Enthusiast*, 160 F. Supp. 2d 633, 637 (S.D.N.Y. 2001) (“[S]ave for the copying alleged here, there have been no attempts to plagiarize the . . . trade dress.”)

Regarding Aardvark’s conduct, the relevant question is whether Aardvark’s alleged “copying was done deliberately, so as to benefit from [Bobcar’s] name and good will.” *Cartier, Inc. v. Four Star Jewelry Creations, Inc.*, 348 F. Supp. 2d 217, 243 (S.D.N.Y. 2004). Bobcar argues that there is sufficient evidence that Aardvark acted in bad faith

and copied the Bobcar, based on (1) the lack of documentation of any research and development on the part of Aardvark; (2) the fact that the Aardy was named after Aardvark, in the same way that the Bobcar vehicle was named after Bobcar the company; (3) evidence that Aardy originally had false “patent pending” designations; and (4) the fact that no intellectual property due diligence was conducted regarding the Aardy. (*See* Dkt. No. 147 at 25–27.) On this record, there is some evidence that Aardvark acted in bad faith. However, this somewhat limited evidence of Aardvark’s bad faith, coupled with the absence of evidence that any third party intentionally copied the Bobcar vehicle, does not sufficiently “demonstrate[] that the mark has become a strong source identifier in the eyes of the purchasing public.” *Lopez*, 883 F. Supp. 2d at 428 (citation omitted). Accordingly, this factor also weighs against Bobcar.

vi. Length and Exclusivity of Use

Bobcar argues that its trade dress has been exclusive from July 2007 to present, and therefore the use of its trade dress has been exclusive for over twelve years. (Dkt. No. 147 at 18.) However, the relevant question is the length and exclusivity of the use as of the date that Aardvark entered the market. *See Sports Traveler, Inc.*, 25 F. Supp. 2d at 166. The record is unclear on exactly what date in 2008 the Aardy entered the market. At best, however, the Bobcar enjoyed exclusive use of its trade dress for a year and a half. This is insufficient to constitute evidence of secondary meaning. *See Cicena Ltd. v. Columbia Telecomms. Grp.*, 900 F.2d 1546, 1552 (Fed. Cir. 1990) (holding that use of eighteen months is “evidence point[ing] strongly away from a finding of secondary meaning”). Accordingly, this factor too weighs against Bobcar.

The only secondary meaning factor weighing in favor of Bobcar is its sales success. And “sales success alone cannot establish secondary meaning.” *GeigTech E. Bay LLC v. Lutron Elecs. Co.*, 352 F. Supp. 3d 265, 284 (S.D.N.Y. 2018) (citation omitted). Therefore, as a matter of law, Bobcar has not produced sufficient evidence that its product acquired secondary meaning “before the infringement began.” *Braun Inc.*, 975 F.2d at 826 (citation omitted). Accordingly, Bobcar’s trade dress infringement claim must be dismissed.

3. Unfair Competition Claims

Bobcar asserts both federal- and state-law unfair competition claims based on the same facts on which its trade dress infringement claim is based. An unfair competition claim under the Lanham Act requires a showing (1) of a valid trademark entitled to protection under the Act, and (2) that Defendant’s actions are likely to cause confusion. *Int’l Diamond Importers, Inc. v. Oriental Gemco (N.Y.), Inc.*, 64 F. Supp. 3d 494, 524 (S.D.N.Y. 2014) (citation omitted). And under New York law, an unfair competition claim “is subject to the same analysis as [a] Lanham Act claim, except for the additional requirement of bad faith.” *Id.* at 525. Because this Court has already held that Bobcar’s trade dress is not protectable as a matter of law, its federal- and state-law unfair competition claims are dismissed as well. *See Maharishi Hardy Blechman Ltd. v. Abercrombie & Fitch Co.*, 292 F. Supp. 2d 535, 552 (S.D.N.Y. 2003).

IV. Conclusion

For the foregoing reasons, Defendant’s motion to exclude expert testimony is GRANTED. Defendant’s motion for summary judgment is GRANTED.

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Plaintiff's cross motion for summary judgment is DENIED.

The Clerk of Court is directed to close the motions at Docket Numbers 141 and 142, to enter judgment on behalf of Defendant, and to close the case.

SO ORDERED.

Dated: April 6, 2020
New York, New York

/s/ J. Paul Oetken
J. PAUL OETKEN
United States District Judge

Appendix D

NOTE: This disposition is nonprecedential.

UNITED STATES COURT OF APPEALS
FOR THE FEDERAL CIRCUIT

BOBCAR MEDIA, LLC,

Plaintiff-Appellant

—v.—

AARDVARK EVENT LOGISTICS, INC.,

Defendant-Appellee

2020-1847

Appeal from the United States District Court for
the Southern District of New York in No. 1:16-cv-
00885-JPO, Judge J. Paul Oetken.

JUDGMENT

MORRIS E. COHEN, Goldberg Cohen LLP, New
York, NY, argued for plaintiff-appellant.

PETER STEVEN WEISSMAN, Blank Rome LLP,
Washington, DC, for defendant-appellee. Also repre-
sented by EVAN H. LECHTMAN, Philadelphia, PA.

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THIS CAUSE having been heard and considered, it is ORDERED and ADJUDGED:

PER CURIAM (MOORE, SCHALL, and TARANTO, *Circuit Judges*).

AFFIRMED. See Fed. Cir. R. 36.

ENTERED BY ORDER OF THE COURT

March 5, 2021
Date

/s/ Peter R. Marksteiner
Peter R. Marksteiner
Clerk of Court

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Appendix E

UNITED STATES DISTRICT COURT
SOUTHERN DISTRICT OF NEW YORK

BOBCAR MEDIA, LLC,

Plaintiff,

—v.—

AARDVARK EVENT LOGISTICS, INC.,

Defendant.

16-CV-885 (JPO)

Telephone Conference

New York, NY
April 23, 2019
11:30 a.m.

Before:

HON. J. PAUL OETKEN

District Judge

APPEARANCES

GOLDBERG COHEN LLP
Attorneys for Plaintiff
BY: MORRIS E. COHEN

BLANK ROME LLP
Attorneys for Defendant
BY: EVAN LECHTMAN
PETER S. WEISSMAN

Transcript Page 13, Lines 1-25

MR. LECHTMAN: Yes.

MR. COHEN: Yes. Thank you.

THE COURT: Great. The next question is the Daubert stuff. Do you want to put that on the same schedule?

MR. LECHTMAN: As far as Daubert, at least as we appreciate our Daubert motion as to the liability expert offered by Bobcar, I can't speak to what they want to do, but we were planning on getting that on file in short order, two weeks, with two weeks to respond. But however your Honor wants to do it.

Is your Honor envisioning that we would do Daubert at the same time as summary judgment? I think the rules on Daubert may impact, may narrow things from our perspective on summary judgment for sure if there is no liability expert and that's gone and the like. So it may make our summary judgment brief look a little different than if there was a liability expert who could be relied on.

THE COURT: I understand. The problem is I have 400 civil cases. I have 75 motions for summary judgment fully briefed. I'm not going to get to a Daubert motion this summer. It's just not possible. There is a chance if I find that I look at it and it is something I can bang out in five pages, but it is just not reasonable given my workload. I wish things were easier, but they are not. You can file it whenever you want. I just can't guarantee that I would get to it before

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Appendix F

UNITED STATES DISTRICT COURT
SOUTHERN DISTRICT OF NEW YORK

BOBCAR MEDIA, LLC,

Plaintiff,

—v.—

AARDVARK EVENT LOGISTICS, INC.,

Defendant.

Civil Action No. 1:16-cv-00885-JPO

(JURY TRIAL DEMANDED)

**BOBCAR'S RULE 56.1 STATEMENT
OF MATERIAL UNDISPUTED FACTS
IN SUPPORT OF BOBCAR'S MOTION
FOR SUMMARY JUDGMENT**

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59. Aardvark claims it is competing better without the trade dress. *Id.*

V. BOBCAR'S TRADE DRESS IS AKIN TO PRODUCT PACKAGING

60. The Bobcar Mobile Showroom holds product inside. Exhibit 1; Dkt. 12-7.
61. The Bobcar Mobile Showroom holds products within the showroom. Exhibit 1; Dkt. 12-7.
62. The Bobcar Mobile Showroom can be opened to access the product inside, or closed to bar access to the product. Exhibit 1; Dkt. 12-7.
63. The showroom in the Bobcar Mobile Showroom can be opened and closed by moving the panels. Exhibit 1; Dkt. 12-7.
64. The products promoted by the Bobcar are separate from the Bobcar in that they are put inside and can be removed from the Bobcar, such as digital cameras. Exhibit 1; Dkt. 12-7.

VI. BOBCAR'S TRADE DRESS HAS SECONDARY MEANING

A. Bobcar Has Expended Extensively on Advertising

65. Bobcar expended millions of dollars on promotional campaigns using its vehicle. Ex. 19, including profit and loss statements from campaigns for Clear Wireless, T-Mobile, Olympus, Adorama, Pentax, and Sprint.
66. Bobcar lists its website on its vehicles, i.e. bobcarmedia.com. Ex. 49 and B. Cohen Dec. ¶ 4.

67. Bobcar's brand ambassadors are individuals who work with the vehicles to engage customers. Ex. 3 ¶ 55-56.
68. Bobcar has sponsored events such as the Fashion Group International luncheon. Exhibit 20.
69. The sponsorship of the event served as advertising for Bobcar. Exhibit 20.
70. Bobcar has issued press releases to advertise and promote its "unique new medium," i.e., its trade dress. Exhibit 21.
71. The press releases in Exhibit 21 advertises the Bobcar vehicles.
72. Bobcar's customers have also issued press releases about "the unique approach" of the BobCar Showrooms, i.e. the trade dress. Exhibit 22 (Pentax press release).
73. The press release in Exhibit 22 advertises the Bobcar vehicles.
74. Bobcar advertises via its website. Exhibit 23.
75. The website in Exhibit 23 advertises the Bobcar vehicles.
76. Bobcar also advertises via social media. Exhibit 24. Bobcar also advertises via videos posted on sites such as Vimeo. Exhibit 23 at 8.
77. Bobcar also advertises in print ads. Exhibit 27.

B. Consumer Studies Are Not Required or Useful

78. Aardvark's liability expert Mr. Hampton testified that he rarely uses surveys. Ex. 9 at 251:9-252:4.

79. He could not recall a single case in which he had ever used a survey. *Id.* 252:6-15.
80. Based on years of experience as a trademark lawyer, Mr. Hampton testified regarding surveys that “they’re expensive. And even though courts claim they want them, they seem like they knock them out as much as they accept them. And, you know, a quarter million dollars to have your survey knocked out is not a way to ingratiate yourself with your client.” *Id.* at 251:23-252:4.

C. Bobcar Has Had Substantial Unsolicited Media Coverage

81. In October 2007, an article in “The Digital Story” introduced readers to the Bobcars. Ex. 25.
82. This was unsolicited media coverage. Ex. 26, D. Story Tx. at 43:9-23, 48:1-22.
83. In a deposition, the author Derrick Story confirmed under oath that he is not affiliated with Bobcar or any other any company that makes marketing vehicles. Ex. 26, D. Story Tx. at 43:9-23, 48:1-22.
84. He testified that his article was unsolicited. *Id.* at 51:5-13.
85. He further testified that he wrote it because he thought that the Bobcar was unique, interesting, and innovative. *Id.* at 51:14-52:25.
86. The Digital Story article calls the Bobcar vehicle “innovative.” *See*, Ex. 25.
87. The Digital Story article shows an image of the Bobcar vehicle. *See e.g.*, Ex. 25.
88. The Bobcar vehicle in Exhibit 25 embodies all the features of Bobcar’s trade dress described in

Bobcar's Second Amended Complaint. Exhibit 25 and Dkt. 12 at ¶ 15.

89. There was also unsolicited media coverage about the Bobcar in Ladylux. Ex. 28.
90. There was also unsolicited media coverage about the Bobcar in the Robin Report. Ex. 29
91. There was also unsolicited media coverage about the Bobcar in TechCrunch. Ex. 30.
92. There was also unsolicited media coverage about the Bobcar in Beauty Store Business Magazine. Ex. 31.
93. There was also unsolicited media coverage about the Bobcar in Media Bistro. Ex. 32.
94. There was also unsolicited media coverage about the Bobcar in Media Life Magazine. Ex. 33.
95. There was also unsolicited media coverage about the Bobcar in Newslite. Ex. 34.
96. There was also unsolicited media coverage about the Bobcar in Wireless Week. Ex. 35.
97. There was also unsolicited media coverage about the Bobcar in EMBuzz. Ex. 36.

D. Bobcar Has Had Substantial Sales Success

98. Bobcar has generated millions of dollars of revenue from vehicles using its trade dress. *See*, Exhibit 19.
99. Bobcar was chosen for marketing programs by major companies and industry leaders, including, Samsung, T-Mobile, Verizon, Clear, Pentax, Olympus, and Sprint. *See e.g.*, Exhibit 19.

100. Bobcar has received testimonials in writing from customers.
101. John Legere, the CEO of T-Mobile, provided a video testimonial calling the Bobcar product “Unreal, guerrilla marketing at its finest ... creating havoc around New York City and everywhere else.” *See*, Exhibit 37 (BOBCAR 4874).
102. John Rarrick, an executive at T-Mobile, praised Bobcar’s success, stating that “it is very seldom that a program delivers 100% of the results we forecast. But it’s even rarer when you get positive results that you didn’t even plan for. Well that’s exactly what we got with Bobcar’s mobile showroom program here in the Northeast.” *See*, Exhibit 38 (BOBCAR 4875). *See also*, Deposition of John Rarrick at 23:24-32:12.

E. Aardvark’s Bad Faith

(*See*, Likelihood of Confusion Section Below)

F. The Length and Exclusivity of Use of Bobcar’s Trade Dress is Undisputed

103. Aardvark’s expert Mr. Hampton could not identify any use of Bobcar’s trade dress by a third party from July 2007. *See*, Ex. 9, 164:2-11 (“Q: Are you aware of any evidence any third party that uses the asserted trade dress in this case or has used it from July 2007 on? ... A: I’m not aware.”) (emphasis added).
104. The “Bookmobile” that Aardvark cites is not a promotional vehicle. *See*, 142-13, pg. 2 et seq.
105. The Bookmobile has no panels opening on three sides. *See*, 142-13, pg. 2 et seq.

106. The Bookmobile does not promote goods or services for sale. See, 142-13, pg. 2 et seq.
107. The Bookmobile does not have a colorful front cab and colorful back. See, 142-13, pg. 2 et seq.
108. The Bookmobile does not have advertising or promotional materials on the panels visible in the open and closed positions corresponding to a brand and type of the goods or services in the showroom. See, 142-13, pg. 2 et seq.
109. Aardvark has not produced any evidence in fact discovery that the 100 year old “Bookmobile” has been in use at any time from July 2004 to the present. *See e.g.*, Ex. 5, Rog. Response 6, pgs. 9-10.
110. Aardvark has not produced any evidence in fact discovery of dates of actual use in commerce of the vehicle shown in Dkt. 142-38. *See e.g.*, Ex. 5, Rog. Response 6, pgs. 9-10.
111. Aardvark has not produced any evidence in fact discovery of dates of actual use in commerce of the vehicle shown in Dkt. 142-45. *See e.g.*, Ex. 5, Rog. Response 6, pgs. 9-10.
112. Aardvark has not produced any evidence in fact discovery of dates of actual use in commerce of the vehicle shown in Dkt. 142-46. *See e.g.*, Ex. 5, Rog. Response 6, pgs. 9-10.
113. Aardvark has not produced any evidence in fact discovery of dates of actual use in commerce of the vehicle shown in Dkt. 142-47. *See e.g.*, Ex. 5, Rog. Response 6, pgs. 9-10.
114. Aardvark has not produced any evidence in fact discovery of dates of actual use in commerce of

the vehicle shown in Dkt. 142-40. *See e.g.*, Ex. 5, Rog. Response 6, pgs. 9-10.

115. Aardvark has not produced any evidence in fact discovery of any dates of actual use in commerce of the vehicle shown in Dkt. 142-41, before July 2007. *See e.g.*, Ex. 5, Rog. Response 6, pgs. 9-10.
116. Aardvark has not produced any evidence in fact discovery of any dates of actual use in commerce of the vehicle shown in Dkt. 142-42, before July 2007. *See e.g.*, Ex. 5, Rog. Response 6, pgs. 9-10.
117. Aardvark has not produced any evidence in fact discovery of dates of actual use in commerce of the vehicles shown in Dkt. 142-43 at any time from July 2004 – the present. *See e.g.*, Ex. 5, Rog. Response 6, pgs. 9-10.
118. Aardvark has not produced any evidence in fact discovery of dates of actual use in commerce of the vehicles shown in Dkt. 142-44 at any time from July 2004 – the present. *See e.g.*, Ex. 5, Rog. Response 6, pgs. 9-10.

G. Bobcar Provided Yet Further Evidence of Secondary Meaning

119. During discovery, Bobcar also provided data that Bobcar vehicles generate thousands of conversations, hundreds of thousands of primary impressions, and eleven million roadside impressions

VII. THE AARDY CREATES A LIKELIHOOD OF CONFUSION

A. Both Parties' Experts Were Confused

120. Aardvark's damages expert testified that he saw a mobile marketing vehicle on the street that

looked like an Aardy, but he couldn't tell whether it was an Aardy or a Bobcar. Exhibit 7, Urbanchuk Transcript at 256:1-16.

121. Aardvark's damages expert Mr. Urbanchuk also testified that he spent about 90 hours on his expert report (Ex. 7. at 41:14-21), and then spent 16-20 hours preparing for his deposition (*id.*, at 11:14-12:10).

B. Bobcar's Trade Dress is Strong

122. Bobcar is both the name of the Plaintiff's company and the name of its mobile showroom vehicle. *See e.g.*, Exhibit 23.

C. The Accused Aardy is Extremely Similar to Bobcar's Trade Dress

123. Molly Kennedy, an agency executive for T-Mobile, stated in email correspondence that the Aardy is "a close rendition of the Bobcar." Ex. 39.
124. Stanley Wisniewski of T-Mobile stated in email correspondence that Aardvark has a vehicle "very similar to what we used recently." Ex. 39
125. Molly Kennedy, an agency executive for T-Mobile, provided a recap of a conference in which she referred to Aardvark stating "Very comparable to the Bobcar." Ex. 40.

D. The Parties' Products are Proximate and There is No Gap to Bridge

126. Aardvark's expert stated that Bobcar and Aardvark "often compete for the same clients and utilize similar marketing strategies." Exhibit 8, Hampton Report at p. 5 ¶17.

E. There Has Been Actual Consumer Confusion

127. Bobcar's President has stated, in statements made under penalty of perjury, that he has repeatedly encountered actual confusion between the Bobcar and the Aardy. *See*, Exhibit 48, B. Cohen Dep. at 108:12 - 109:9; 193:18 - 195:16; 209:13 - 212:13; 213:24 - 215:8; 221:17 - 222:5; 226:12 - 227:4; B. Cohen Dec. ¶ 7; Dkt. 142-9 at 17, Rog Response 20.

F. Aardvark Adopted Bobcar's Trade Dress in Bad Faith

128. Aardvark's CEO testified that he has built thousands of promotional vehicles. Ex. 10 at 53:11-12 & 54:4-7.
129. Aardvark has not produced images in discovery of any promotional vehicles used in commerce by Aardvark before July 2007 and bearing the Bobcar's trade dress.
130. Aardvark contends it came up with the Aardy in 2008.
131. Aardvark has not provided documentation of any research and development by Aardvark with respect to the Aardy when the Aardy was allegedly created in 2008.
132. Larry Borden, the CEO of Aardvark sent out an email dated August 19, 2015, with the subject "BobCar" to Jasun Romain and Chris Makos of his company. Ex. 41.
133. In the email, he circulated images of a car that Turtle Transit was building for Bobcar. Ex. 41.
134. In the email, Mr. Borden stated: "Check this out. Apparently Turtle Transit is building

BobCar vehicles on the backs of some sort of car this is actually a good idea we might want to jump on something like this quickly.” Ex. 41.

135. Aardvark has represented that its Aardy is “patent pending.” Exhibit 42 (footer of each page and body of last page).
136. Those “patent pending” designations were all false. *See*, Ex. 10, Borden Dep. at 137:10-20.
137. Aardvark never filed a single patent application to the Aardy. *Id.*
138. When asked about these false statements, Mr. Borden claimed he never saw them before they went out, and would have taken them off if he had. Ex. 10, Borden Deposition at 137:21-138:6.
139. However, the false information was in an email from his own email account. *See*, Ex. 43, Ex. 10, L. Borden deposition at 140:16 - 142:17.
140. Mr. Borden claimed he didn’t know who wrote that email. *Id.*
141. He also alleged that he immediately put an end to the false statements. *Id.* at. 151:9-19.
142. But, in fact, a further email was sent from his account a few months later again with the same false statements. Ex. 44.
143. When asked why the false statements continued to go out from his email account he had no answer. Ex. 10, L. Borden Deposition at 161:23-163:7.
144. A May 22, 2018 deposition was conducted of Aardvark’s Account Director Chris Makos.

145. Mr. Makos was shown the promotional material with the false statements and was asked who created it. Ex. 11.
146. He testified that the material was created by Mr. Borden, and solely by Mr. Borden. Ex. 11, C. Makos Deposition at 115:10 – 116:12.
147. He also testified that all such materials have to go through Mr. Borden. *Id.*
148. The Bobcar was patent-pending in 2008 and has since been the subject of multiple issued patents. *See e.g.*, Dkt. 12-1, 12-2, 12-3, 12-4, 12-5, 12-6.
149. Aardvark arranged to place Aardys in locations the day before the Bobcars would be appearing there. Exhibit 45.
150. Mr. Borden did not conduct any intellectual property due diligence regarding the Aardy. *See*, Ex. 10, Borden Dep. at 345:19-21, 346:20 - 347:5, 347:6-15, 349:11-14.