

UNITED STATES DISTRICT COURT  
SOUTHERN DISTRICT OF NEW YORK

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: ELEMENTS/JILL SCHWARTZ, INC., :  
: :  
: Plaintiff, : 01 CIV. 904 (DLC)  
: :  
: -v- : OPINION and ORDER  
: :  
: GLORIOSA COMPANY and GLORIA PACOSA, :  
: :  
: Defendants. :  
: :  
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DENISE COTE, District Judge:

Plaintiff Elements/Jill Schwartz, Inc. ("Elements"), a manufacturer of picture frames and a line of journals, photograph albums, and address books, filed this action against defendants Gloriosa Company ("Gloriosa") and Gloria Pacosa for willful copyright infringement under the Copyright Act of 1976, 17 U.S.C. § 101, et seq., trade dress infringement and dilution under the Lanham Act, 15 U.S.C. § 1125(a) and (c), unfair competition under the Lanham Act and the common law of New York, and for dilution under New York General Business Law § 360-1, et seq. On March 6, 2002, plaintiff's copyright infringement claim was dismissed with

prejudice. The defendants now move for summary judgment as to the remaining claims, each of which is based on plaintiff's assertion that it has a protectible trade dress. For the reasons that follow, the defendants' motion is granted.

#### **BACKGROUND**

The following facts, drawn from evidence submitted by the parties, are undisputed unless otherwise noted.

##### The Elements Products

Jill Schwartz ("Schwartz") started the company Elements in or about 1984, to sell her jewelry designs. In 1987, she expanded her designs beyond jewelry to frames and then to books in or about 1989. Elements creates books and frames appropriate for many occasions, including books in the "baby" and "wedding" categories. Elements copyrights some of its frame designs.

##### The Elements Trade Dress

Schwartz characterizes her book covers and frames as collages. Elements frames are composed from a variety of materials, including resin, paint, paper, ribbon, and findings. Findings are assorted pieces affixed to a surface -- in this case the Elements book covers and frames -- such as metal pieces, buttons, name plates, and ribbons. The Elements book covers are also composed of a variety of materials, including paper, fabric, ribbon, and findings.

In the Amended Complaint, the trade dress of the books and frames is described as "a distinctive selection and arrangement of elements including particular types of ribbon such as gingham,

decorative non-functional buttons and metal findings of a certain size, a background of numerous fine patterned handmade or designed fabrics and/or papers, and an asymmetrical coordination of such elements." In deposition testimony, Schwartz characterized the trade dress in the Elements frames and books as being composed of the following: (1) two or more paper, paint, or fabric surface patterns; (2) division of those two or more surface patterns by a ribbon or a finding; and (3) two or more different findings in a line. In a Declaration submitted in opposition to this motion, Schwartz modified her description of the third element of the trade dress, stating that three or more findings in a line, often with a nameplate or frame as one of the findings, are the third element of the trade dress. According to Schwartz, within this trade dress, there can be multiple lines of elements on the same frame or book cover, and some frames and books that display the elements of the trade dress may also include additional design elements.

Not every Elements frame or book includes the design elements and configuration described as the Elements trade dress. Pictures of Elements' books and frames that incorporate the trade dress are interspersed on the pages of the plaintiff's catalogs with pictures of books and frames that do not. Elements uses publicly available materials in its book and frame designs, discontinues certain frame and album models from year to year, and periodically adds new styles to its product lines.

One buyer of Elements products for retail stores has

described the aesthetic of the Elements frames and books as having a consistent visual impression, using a minimum of two special papers or fabrics, ribbon and trim often acting as a "visual bridge" between the two or more papers, and "findings or metals, bits of pieces and baubles" which follow the geometry of the layout of the papers as opposed to being scattered around the surface. Another buyer of Elements products for retail stores described the common configuration and characteristics of Elements books as follows:

They are always covered with paper, usually two different papers, sometimes three or four different papers. If you look at the front of the book, it's usually divided by a ribbon or some kind of textural line. Maybe about a third of the way down on the cover there are, they always have little doodads, elements, jewelry findings, little metal pieces, buttons, glued on the front of them, sometimes right across the ribbon, and the ribbon is usually horizontal and other times it is arranged in a different fashion.

They have a lot of photographs. It could be a little photo in a metal frame centered on the album or sometimes just a word or wording and a little framed button kind of thing. Sometimes they have ribbons going on the side binding. Sometimes the paper could be broken up in like one on the bottom and two different papers divided across the top. But generally it's a top and bottom, a third, two-thirds. Usually the papers are different patterns.

Carol Sedestrom Ross, former president of American Craft Enterprises, the marketing division of the American Craft Council, and current director of craft marketing for George Little Management, the largest producer of consumer goods trade shows in the United States, describes the consistent characteristics of Elements' products as the colors used, the

patterning of either the fabric or the paper used, and the metal elements applied to the surfaces as decoration. Ms. Ross further notes that the Elements designs frequently employ two patterns of paper or fabric, usually divided where they meet by ribbon or ribbon with metal elements on it.

Since she began making books and frames with the design elements described above, Schwartz has objected to the use of designs by other manufacturers and designers that employ the same or similar design elements, by speaking directly with the designer or manufacturer, or referring the matter to her attorneys.

#### The Gloriosa Products

Gloria Pacosa ("Pacosa") has manufactured and sold her own crafts since 1984. She has made and sold a wide range of handmade craft items, including mixed media ceramic figurines, lamps, frames, and albums, and has exhibited such items in craft shows since 1986. For the last five or six years, she has used the business name and mark "Gloriosa & Co." Gloriosa & Co. is a sole proprietorship located in Ashfield, Massachusetts, and Pacosa is responsible for decision-making and design at the company.

Pacosa began to concentrate on frames and albums in 1995. The frames made by Gloriosa in or about 1996 included more than one fabric or paper only to the extent that their design included a fabric mat partially covered by another fabric, thus leaving a thin border of different fabric next to the photo window. The

design of Pacosa's albums always included two fabrics or papers and ribbons, and in 1999, she began adding ornaments such as buttons, metal findings and other three-dimensional objects. Thereafter, in about January 2001, she added these three-dimensional objects to her frame designs. The Gloriosa frames and albums encompass a broad range of designs, some of which include alone or in combination, multiple background surfaces, ribbons, metal pieces, and other three-dimensional objects. At the time Pacosa began using three-dimensional objects and ribbons in her album and frame designs, she was aware of companies using similar design elements, including the plaintiff. Pacosa uses publicly available materials in her book and frame designs, discontinues certain frame and album models from year to year, and adds new styles to the Gloriosa product lines.

#### Confusion Between the Products

Jill Schwartz has described instances of actual confusion between her products and the defendants' products. On the other hand, a "mall intercept" survey conducted by the defendants in which participants were shown six albums, including one each from the plaintiff and defendant, concluded that consumers are likely to think that albums that have raised (three-dimensional) metallic items on the cover are more or less equally likely to come from any maker or company using metallic items. More respondents connected the Elements album to a product of a third party than they did to the Gloriosa album and very few respondents connected the Elements album with the Gloriosa album

and nothing else. According to the study, respondents answered by simply reacting randomly to a general style involving raised metallic objects on the cover of an album, rather than to any particular form or design of those objects.

### **DISCUSSION**

Summary judgment may not be granted unless the submissions of the parties, taken together, "show that there is no genuine issue as to any material fact and that the moving party is entitled to a judgment as a matter of law." Rule 56(c), Fed. R. Civ. P. The substantive law governing the case will identify those issues that are material, and "only disputes over facts that might affect the outcome of the suit under the governing law will properly preclude the entry of summary judgment." Anderson v. Liberty Lobby, Inc., 477 U.S. 242, 248 (1987). "A dispute regarding a material fact is genuine 'if the evidence is such that a reasonable jury could return a verdict for the nonmoving party.'" Mount Vernon Fire Ins. Co. v. Belize NY, Inc., 277 F.3d 232, 236 (2d Cir. 2002) (quoting Anderson, 477 U.S. at 248). The moving party bears the burden of demonstrating the absence of a material factual question, and in making this determination, the Court must view all facts in the light most favorable to the nonmoving party. Abdu-Brisson v. Delta Airlines, Inc., 239 F.3d 456, 465 (2d Cir.), cert. denied, 122 S. Ct. 460 (2001). When the moving party has asserted facts showing that the nonmovant's claims cannot be sustained, the opposing party must "set forth specific facts showing that there is a genuine issue for trial,"

and cannot rest on the "mere allegations or denials" of his pleadings. Fed. R. Civ. P. 56(e); see also Goenaga v. March of Dimes Birth Defects Found., 51 F.3d 14, 18 (2d Cir. 1995). In deciding whether to grant summary judgment, this Court must, therefore, determine (1) whether a genuine factual dispute exists based on the evidence in the record and (2) whether the facts in dispute are material based on the substantive law at issue.

A. Trade Dress Infringement Claim

"To prevail on a Lanham Act infringement claim, a claimant must show that it has a valid mark entitled to protection and that the defendant's use of it is likely to cause confusion." Morningside Group Ltd. v. Morningside Capital Group, L.L.C., 182 F.3d 133, 137 (2d Cir. 1999) (citation omitted). While the distinctiveness of word marks, symbols, and even product packaging may be proven by showing either that the mark is inherently distinctive or that the mark has acquired secondary meaning, the "product design plaintiff . . . must always make the second, more difficult showing" of secondary meaning. Yurman Design, Inc. v. PAJ, Inc., 262 F.3d 101, 115 (2d Cir. 2001) (citing Wal-Mart Stores, Inc. v. Samara Bros., Inc., 529 U.S. 205, 213-14 (2000)); see also Knitwaves, Inc. v. Lollytoqs Ltd., 71 F.3d 996, 1008 (2d Cir. 1995). A trademark acquires secondary meaning when, "in the minds of the public, the primary significance of a mark is to identify the source of the product rather than the product itself." Wal-Mart Stores, 529 U.S. at 211 (citation omitted); see also L. & J.G. Stickley, Inc. v.

Canal Dover Furniture Co., 79 F.3d 258, 262 (2d Cir. 1996). Put differently, secondary meaning exists where "the public is moved in any degree to buy an article because of its source." Genesee Brewing Co. v. Stroh Brewing Co., 124 F.3d 137, 143 n.4 (2d Cir. 1997) (citation omitted).

A product's trade dress "encompasses the overall design and appearance that make the product identifiable to consumers." Nora Beverages, Inc. v. Perrier Group of Am., Inc., 269 F.3d 114, 118 (2d Cir. 2001); see also Yurman Design, 262 F.3d at 114; Fundamental Too, Ltd. v. Gemmy Indus. Corp., 111 F.3d 993, 999 (2d Cir. 1997). As the Supreme Court has recently observed:

The design or packaging of a product may acquire a distinctiveness which serves to identify the product with its manufacturer or source; and a design or package which acquires this secondary meaning, assuming other requisites are met, is a trade dress which may not be used in a manner likely to cause confusion as to the origin, sponsorship, or approval of the goods.

TraFFix Devices, Inc. v. Mktg. Displays, Inc., 532 U.S. 23, 28 (2001).

In extending protection to product designs, courts are to exercise "particular 'caution,'" Landscape Forms, Inc. v. Columbia Cascade Co., 113 F.3d 373, 380 (2d Cir. 1997) (quoting Jeffrey Milstein, Inc. v. Gregor, Lawlor, Roth, Inc., 58 F.3d 27, 32 (2d Cir. 1995)), for "almost invariably, even the most unusual of product designs -- such as a cocktail shaker shaped like a penguin -- is intended not to identify the source" of the product, "but to render the product itself more useful or more appealing." Wal-Mart Stores, 529 U.S. at 213; see Restatement

(Third) of Unfair Competition § 16 cmt. b at 159 (1995) ("Product designs are more likely to be seen merely as utilitarian or ornamental aspects of the goods."). In addition, trade dress claims "raise a potent risk that relief will impermissibly afford a level of protection that would hamper efforts to market competitive goods." Yurman Design, 262 F.3d at 115 (citation omitted). While most trademarks only create a monopoly in a word, phrase, or symbol, "granting trade dress protection to an ordinary product design would create a monopoly in the goods themselves." Landscape Forms, 113 F.3d at 380. In keeping with this concern, "just as copyright law does not protect ideas but only their concrete expression, neither does trade dress law protect an idea, a concept, or a generalized type of appearance." Yurman Design, 262 F.3d at 115 (citation omitted). A final hurdle is the congressionally-imposed requirement that a plaintiff prove that an unregistered trade dress is "not functional." 15 U.S.C. § 1125(a)(3) (West Supp. 2001); Nora Beverages, 269 F.3d at 118; see also TrafFix Devices, 532 U.S. at 29.

The Second Circuit has held that "a plaintiff asserting that a trade dress protects an entire line of different products must articulate the specific common elements sought to be protected." Yurman Design, 262 F.3d at 118. While trade dress is concerned broadly with the overall look of a product, that does not permit a plaintiff to "dispense with an articulation of the specific elements which comprise its distinct dress." Landscape Forms,

113 F.3d at 381. “[A] plaintiff’s inability to explain to a court exactly which aspects of its product design(s) merit protection 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.” Id.; see also Jeffrey Milstein, 58 F.3d at 33. In addition to specifying the elements of its trade dress, a plaintiff seeking trade dress protection for an entire product line must establish that the “overall look in each separate product is consistent.” Yurman Design, 262 F.3d at 116 (citation omitted). Where protection for an entire line of products is sought, the concern for protecting competition is “particularly acute.” Id. (citing Landscape Forms, 113 F.3d at 380).

The plaintiff’s inability to articulate a trade dress for its books and frames with sufficient particularity, as well as plaintiff’s failure consistently to use even its generally described trade dress means that its trade dress claims must fail. Despite some inconsistencies noted above, Schwartz describes the trade dress in both her frames and books as being composed of three elements: (1) two or more paper, paint, or fabric surface patterns; (2) the division of those two or more surface patterns by a ribbon or a finding; and (3) three or more different findings in a line.<sup>1</sup> The Elements frames and albums do

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<sup>1</sup> Although the plaintiff adds that the findings “often” include a nameplate or frame, since the plaintiff does not assert that these findings are always present, they are not essential elements of its trade dress.

not employ these trade dress elements in a particular, uniform configuration. Not all of the Elements frames and books incorporate this trade dress. Some of the frames and books that do contain these elements also include other significant design elements.

Starting with the plaintiff's frames, some of the background patterns of the rectangular and square frames are divided horizontally, others vertically, and still others employ one principal background pattern, with accents at the frame's outer corners, or on alternate panels. Some of the circular frames consist of multiple background patterns arranged around the circle, others employ a single background design trimmed with a different pattern. On the Elements frames, findings are arranged in lines, rings, and square patterns, often around the rim of the photo window or even scattered on the frame surface. In some of the Elements frames, the background papers or patterns are divided by ribbons or bands of differently-patterned material, but in others, different background designs are not divided by any such element. Moreover, some of the Elements frames do not appear to employ any ribbon or banding at all. While the elements described by Schwartz as composing the trade dress are notable in varying arrangements on the majority of frames in the Elements line, the way in which these elements are employed in the frame designs is not consistent and varies from frame to frame.

The Elements books similarly vary in their incorporation of

the trade dress elements and in their configuration. Background patterns are arranged horizontally, vertically, in thirds, and in quadrants. For some of the horizontally or vertically arranged books, the different background designs take up equal portions of the surface; for others, one background covers more surface area. The placement of ribbons or trim on the book covers ranges from ribbons that separate different background patterns to ribbons that accent the binding of the book. Some background pattern interfaces, particularly on those books employing three or more background patterns, are not set off by ribbons or trim. The findings on the book covers are most often arranged in a line or a cross, but the findings on some of the Elements books are arranged in a ring or arch shape. Several of the Elements books contain accents of different background patterns at their

linear arrangements of findings, means that the plaintiff seeks protection for the idea of ornamenting frames and books with multiple paper and fabric backgrounds, accented with various ribbons and trim as well as three-dimensional findings, as opposed to any particular design configuration employing these elements. The fact that many producers of frames, albums, and journals use identical or similar elements in their designs, is evidence that plaintiff's purported trade dress "is no more than a concept or idea to be applied to particular products." Jeffrey Milstein, 58 F.3d at 33. While the plaintiff contends that none of these other designers and manufacturers use all three of the trade dress elements together "in the arrangement defined" by the Elements trade dress, the variability of the Elements designs belies any contention that there is an "arrangement" stable enough to warrant trade dress protection.

Moreover, because the specific elements of the trade dress listed by the plaintiff are not present in all of the Elements frames and books, trade dress protection for these two lines of products is not appropriate. See, e.g., Landscape Forms, 113 F.3d at 382. While minor variations may not prevent trade dress protection, the variability in the Elements designs is significant.

Citing to Coach, Inc. v. We Care Trading Co., No. 99 Civ. 11672 (DLC), 2001 WL 812126 (S.D.N.Y. July 18, 2001), Elements explains that it is "not necessarily seeking trade dress protection . . . for every product it makes." In Coach, a jury

found a protectible trade dress in Coach's "classic collection" of leather handbags. The elements comprising the trade dress of this collection were glove-tanned leather, bound edges, heavy brass or nickel-plated brass hardware, and a hangtag with a beaded chain. Id. at \*1. These elements were present consistently on each handbag in the classic collection, which was distinct from other handbag collections produced and marketed by Coach.

Elements has submitted no evidence that its frames and books are divided into separate lines, with some collections incorporating the elements of the trade dress while others do not. The Elements catalogs describe the Elements picture frames as follows:

Hand painted frames with an eclectic [sic] yet timeless feel. The beautifully painted surfaces are adorned with findings, buttons, ribbons and elements of collage.

All of the frames are pictured together, with no demarcations as to style, line, or collection, and with frames incorporating the trade dress elements depicted alongside those that do not. The Elements books are described in the catalogs as part of the Cornelia Collection, which includes "all of [the Elements] paper products: blank journals, scrap books (photo albums), and address books." As with the frames, the books are displayed together, with no categorization as to style, line, or sub-collection.

Because the plaintiff has not described the elements of its trade dress at a sufficient level of specificity for a jury to

find a protectible trade dress, and because plaintiff has not presented sufficient evidence from which a jury could find that the plaintiff used its broadly defined trade dress consistently in either of the lines of products for which it seeks trade dress protection, the defendants' motion for summary judgment on plaintiff's claim of trade dress infringement is granted.

Finding no trade dress to warrant protection under the Lanham Act, the plaintiff's claim of trade dress dilution under the Lanham Act must also fail.

B. State Law Claims

To establish a claim for dilution under New York law, plaintiff must prove (1) ownership of a distinctive mark, and (2) likelihood of dilution. N.Y. Gen. Bus. Law § 360-1 (McKinney 1996); New York Stock Exchange, Inc. v. New York, New York Hotel, LLC, 62 U.S.P.Q.2d 1260, 2002 WL 483528, at \*7 (2d Cir. Apr. 1, 2002); Federal Express Corp. v. Federal Espresso, Inc., 201 F.3d 168, 175 (2d Cir. 2000). The plaintiff having failed to articulate a protectible trade dress in the design of its frames and books, and thus having failed to demonstrate its ownership of a distinctive mark, its state law dilution claim must also fail.

The plaintiff's state law unfair competition claim fails for the same reason. "Under Federal or State law, the gravamen of a claim of unfair competition is the bad faith misappropriation of a commercial advantage belonging to another by infringement or dilution of a trademark or trade name or by exploitation of proprietary information or trade secrets." Eagle Comtronics,

Inc. v. Pico Prod., Inc., 682 N.Y.S.2d 505, 506 (4th Dep't 1998) (emphasis supplied). A common law unfair competition claim "must be grounded in either deception or appropriation of the exclusive property of the plaintiff." H.L. Hayden Co. v. Siemens Med. Sys., Inc., 879 F.2d 1005, 1025 (2d Cir. 1989) (citation omitted). There being no trade dress that qualifies for protection and thus no trade dress in which the plaintiff has a proprietary right, the plaintiff cannot make out a claim for unfair competition based on the bad faith infringement of that trade dress. See Yurman Design, 262 F.3d at 118 (reversing judgment on unfair competition claim because judgment on trade dress infringement claim was reversed); Genesee Brewing, 124 F.3d at 149; cf. Nadel v. Play-By-Play Toys & Novelties, Inc., 208 F.3d 368, 378 (2d Cir. 2000) ("the law of property does not protect against the misappropriation or theft of that which is free and available to all").

**CONCLUSION**

The defendants' motion for summary judgment is granted with respect to all of plaintiff's remaining claims. The Clerk of Court shall close the case.

SO ORDERED:

Dated: New York, New York  
July 15, 2002

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DENISE COTE  
United States District Judge