

UNITED STATES DISTRICT COURT
SOUTHERN DISTRICT OF NEW YORK

X

GEIGTECH EAST BAY LLC,

Plaintiff,

-against-

LUTRON ELECTRONICS CO., INC.,

Defendant.

18 Civ. 05290 (CM)
19 Civ. 04693 (CM)
20 Civ. 10195 (CM)

X

DECISION AND ORDER

I. Introduction

In the lead case (18 Civ. 05290) of three consolidated lawsuits filed by GeigTech East Bay (“GeigTech”) against Lutron Electronics (“Lutron”), the parties have submitted multiple motions to strike, motions to exclude the opinions and proposed testimony of multiple experts, and motions for summary judgment.

II. Background and Procedural History

The Court assumes the parties’ familiarity with the facts and the procedural history of the case. An extensive discussion of both is available in the Court’s August 12, 2021, Decision and Order Denying Plaintiff’s Motion for Preliminary Injunction and Staying the Remainder of the Case, (Dkt. No. 141), and May 5, 2022, Claim Construction Decision. (Dkt. No. 163).

I will decide the motions to strike and the *Daubert* motions before addressing the merits. Because “only admissible evidence need be considered by the trial court in ruling on a motion for summary judgment . . . it is appropriate for district courts to decide questions regarding the admissibility of evidence on summary judgment.” *Raskin v. Wyatt Co.*, 125 F.3d 55, 66 (2d Cir.

1997). “The resolution of evidentiary questions on summary judgment conserves the resources of the parties, the court, and the jury.” *Ibid.*

III. Lutron’s Motions to Strike Geigtech’s (1) “Second” Motion for Partial Summary Judgment, (2) GeigTech’s Motion to Exclude Testimony on Non-Infringing Alternatives, and (3) the Affidavits of Dr. Paul W. Thurman are Denied

Lutron moves to strike Geigtech’s “second” motion for partial summary judgment, (Dkt. No. 238), its “Motion to Exclude Testimony on Non-Infringing Alternatives,” (Dkt. No. 224), and two affidavits filed by Dr. Paul W. Thurman, (Dkt. Nos. 248-8 and 248-5). (*See* Motions to Strike, Dkt. Nos. 253 and 256). All motions are denied. However, GeigTech’s first motion for partial summary judgment is stricken, and any issues discussed in those motion papers but not in Geigtech’s second motion will be deemed abandoned.

A. Legal Standard

“Motions to strike are generally disfavored and will not be granted unless the matter asserted clearly has no bearing on the issue in dispute.” *Kehr ex rel. Kehr v. Yamaha Motor Corp., U.S.A.*, 596 F. Supp. 2d 821, 829 (S.D.N.Y. 2008) (internal quotation marks and citation omitted). Motions to strike will only be granted when “there is a strong reason for so doing.” *Hargett v. Metro. Transit Auth.*, F.Supp.2d 393, 404 (S.D.N.Y.2008).

B. “Second” Motion for Partial Summary Judgment

On November 8, 2019, this court held an initial pretrial conference in the related proceeding, Case No. 1:19-cv-4693-CM. During that conference, I set a scheduling order for this case. I also discussed with the parties how best to proceed with Lutron’s libel counterclaim. Geigtech’s counsel represented to the court that it intended to move for summary judgment on the claim, likely by January 2020. I told the parties that an early motion in this case would be acceptable, but I warned counsel that the parties will each only get “one bite at the apple,”

meaning that GeigTech would be allowed one summary judgment motion. As a result (or so I assume), GeigTech did not file that early motion for summary judgment.

On February 2, 2023 – three weeks before the deadline for filing summary judgment motions -- GeigTech filed a “Motion for Partial Summary Judgment,” supported by a 25-page memorandum of law. GeigTech sought summary judgment (1) dismissing Lutron’s defamation counterclaim; (2) dismissing all counterclaims and affirmative defenses that relied on Lutron’s theory that an architect named Matthew Taylor is an unnamed co-inventor of the patents-in-suit; and (3) dismissing Lutron’s claim that the ‘717 patent is invalid, on the ground that its failure to assert those arguments in connection with the patent’s Post Grant Review (PGR) estopped it from raising them in this lawsuit. (Dkt. Nos. 199-202). Lutron filed its opposition memorandum on February 23, 2023, (Dkt. Nos. 204-207), and GeigTech filed its reply memorandum on March 7, 2023. (Dkt. No. 260).

On February 24 – the day after Lutron filed its opposition papers in connection with the February 2 motion -- GeigTech filed a “Motion For Partial Summary Judgment Regarding J. Geiger’s Claim For Patent Infringement And Lutron’s Related Claims And Defense,” together with another 25-page supporting brief. In this motion, GeigTech renewed its request for summary judgment dismissing the defamation claim and Lutron’s invalidity arguments; it also sought summary judgment of liability on GeigTech’s claim that Lutron had infringed the ‘717 Patent. In connection therewith, GeigTech also sought summary judgment dismissing Lutron’s affirmative defenses asserting equitable intervening rights and inequitable conduct, as well as its defense concerning the availability of commercially acceptable non-infringing alternatives. (Dkt. Nos. 238-239, 249-250).

Second Circuit and Southern District law is clear that “it is improper for a party to file a successive motion for summary judgment which is not based upon new facts and which seeks to raise arguments it could have raised in its original motion.” *Purchase Partners, LLC v. Carver Fed. Sav. Bank*, 2013 WL 1499417, at *7 (S.D.N.Y. Apr. 10, 2013) (quoting *Campers’ World Int’l, Inc. v. Perry Ellis Int’l, Inc.*, 221 F.R.D. 409, 409 (S.D.N.Y. 2004)); see also *Brown v. City of Syracuse*, 673 F.3d 141, 147 n.2 (2d Cir. 2012); *Bryant v. Silverman*, 2018 WL 4357478, at *3 (S.D.N.Y. Sept. 12, 2018). The reason that courts in this Circuit disapprove of “piecemeal consideration of successive motions for summary judgment” is that “parties ought to be ‘held to the requirement that they present their strongest case for summary judgment when the matter is first raised.’” *Siemens Westinghouse Power Corp. v. Dick Corp.*, 219 F.R.D. 552, 554 (S.D.N.Y. 2004) (citations omitted).

GeigTech argues that it really only moved for summary judgment *once* “albeit by filing two motions and supporting memoranda.” (Dkt. No. 262 at 7). That argument is ludicrous on its face. GeigTech filed two motions, the second of which was partly duplicative of the first.

Moreover, the reason for GeigTech’s maneuver seems clear enough – to evade the court’s 25-page limit for memoranda of law filed in support of dispositive motions. GeigTech’s argument that it complied with the page limit by filing two 25-page briefs in support of its arguments, rather than one 50-page brief, is laughable.

GeigTech argues that it filed its “motion” for summary judgment in two parts because this court allegedly has a prior practice of allowing parties to file multiple summary judgment motions. I have no such practice. But I told the parties in this case they were only allowed one bite of the summary judgment apple – they could not make two motions – so whatever happened in some other case is of no moment. GeigTech offers no explanation for why it simply did not

seek permission to file a longer brief because of the number of issues that needed to be addressed; litigants make such requests all the time, and in appropriate cases I grant such permission.

I will only consider one of the two summary judgment motions that GeigTech has filed. The issue of which one was effectively decided some time ago, when Lutron first raised the double motion problem. At that time, I directed Lutron to respond to the second motion. That is the motion I will consider. It raises more issues, and so is more likely to help narrow the scope of issues for trial. The issues that were raised in the first motion but not the second motion will not be deemed abandoned and will not be discussed in this opinion.

If Lutron wants to seek sanctions in the form of recovering the cost of responding to the first motion — or, at least, to those portions of the first motion that are no longer under consideration — I am open to such an application. GeigTech’s counsel is cautioned not to engage in such practices again.

C. Geigtech’s Motion to Exclude Testimony on Non-Infringing Alternatives Is Denied

In support of its arguments for limiting any potential award of damages for GeigTech’s patent infringement claim, Lutron offers expert opinions about the availability of non-infringing alternatives to the patented devices at the time of a hypothetical licensing negotiation. GeigTech has moved to exclude these expert opinions about non-infringing alternatives; Lutron subsequently moved to strike that motion. Geigtech’s motion is denied; Lutron’s motion to strike is denied as moot.

Where a patentee alleges damages in the form of lost profits or a reasonable royalty, “[t]he burden of proving damages falls on the patentee.” *Lucent Techs., Inc. v. Gateway, Inc.*, 580 F.3d 1301, 1324 (Fed. Cir. 2009). In either case, the appropriate scope of damages is “the

difference between [the patentee’s] pecuniary condition after the infringement, and what his condition would have been if the infringement had not occurred.” *Aro Mfg. Co. v. Convertible Top Replacement Co.*, 377 U.S. 476, 507 (1964) (internal quotations omitted). “This formulation requires the patentee to reconstruct the market, by definition a hypothetical enterprise, to project economic results that did not occur.” *Riles v. Shell Expl. & Prod. Co.*, 298 F.3d 1302, 1311 (Fed. Cir. 2002). Because an economically rational defendant would presumably benefit from available non-infringing alternatives—rather than leaving the market altogether or paying a more expensive licensing fee—a patentee must consider whether such alternatives are indeed available when reconstructing the hypothetical market under a lost profit or reasonable royalty theory. *See id.*

Lutron asserts that GeigTech has abandoned damages in the form of lost profits, (Dkt. No. 272 at 29), an assertion that GeigTech does not dispute. (Dkt. No. 292 at 10). Accordingly, the existence of non-infringing alternatives is relevant only to limit damages in the form of a reasonable royalty.

Reasonable royalties are meant to provide a “floor” to patent damages by approximating the amount an infringer would reasonably have paid to the patentee. *Lucent Techs., Inc. v. Gateway, Inc.*, 580 F.3d 1301, 1324 (Fed. Cir. 2009). One way to calculate a reasonable royalty is through a hypothetical negotiation framework, which evaluates the fifteen factors laid out in *Georgia-Pacific Corp. v. U.S. Plywood Corp.*, 318 F. Supp. 1116, 1120 (S.D.N.Y. 1970). The availability of non-infringing design options is one of the considerations in the hypothetical arm's-length negotiation for a reasonable royalty. *Mars, Inc. v. Coin Acceptors, Inc.*, 527 F.3d 1359, 1373 (Fed. Cir. 2008), *modified on other grounds*, 557 F.3d 1377 (Fed. Cir. 2009). Non-infringing alternatives are relevant in two ways: first, they help value the invention, and second,

they may limit the infringer's willingness to pay in a hypothetical negotiation. *See AstraZeneca AB v. Apotex Corp.*, 782 F.3d 1324, 1334 (Fed. Cir. 2015).

During discovery, GeigTech served Lutron with several requests for production, interrogatories, and 30(b)(6) deposition topics on the issue of non-infringing alternatives to the Accused Products. (Dkt No. 225 at 7). In response, Lutron stated it was aware of three alternative designs. These designs were described by John Bull when GeigTech deposed him, as well as in a deposition exhibit. (Dkt No. 226-3 at 4).

In its opening report, GeigTech's infringement expert, Nancy Perkins, offered her opinion that the three designs identified by Bull, far from being non-infringing alternatives, actually infringed the '717 and '872 Patents. Perkins also argued that the "Bull designs," as they will be called, fail to provide the same or similar benefits as the inventions described in the aforementioned patents and so would not be commercially acceptable to customers. (Dkt. No. 265-4).

Lutron served two rebuttal expert reports in response to Perkins' testimony — one from its technical expert, Dr. Eric Maslen, and the other from its damages expert, Christine Meyer. Maslen critiques Perkins' opinions and explains why the Bull designs do not infringe the Asserted Claims of either the '717 or '872 Patent. (Dkt. No. 226-2 at 94-107). Meyer criticizes GeigTech's damages expert, Jeffrey Baliban, for not properly considering the Bull designs as non-infringing alternatives when calculating a potential reasonable royalty. (Dkt. No. 226-1 at 30). These are the opinions GeigTech seeks to preclude.

GeigTech argues that, because Lutron bears the burden of proving the existence of non-infringing alternatives, it should have disclosed the testimony of Maslen and Meyer in its opening expert reports, which were due on November 22, 2022 – not in rebuttal reports. (Dkt.

Nos. 224-226). It also asserts that the opinions should be stricken as unsupported by the record evidence. (*Ibid.*).

1. Lutron Did not Fail to Disclose Non-Infringing Alternatives During Discovery or File Untimely Expert Reports

GeigTech first argues that Lutron’s experts should be precluded from testifying on non-infringing alternatives because Lutron (1) did not disclose record evidence of purported non-infringing alternatives during discovery and (2) its experts offered their opinions on these alternatives in rebuttal expert reports, not opening expert reports, making the disclosure of the alternatives untimely. (Dkt. No. 225). GeigTech asserts that “When commercially acceptable non-infringing alternatives are left out of the accused infringer’s opening expert reports and introduced in their rebuttal reports, the resulting prejudice is substantial and warrants exclusion.” *See Ericsson Inc. v. TCL Comm’n Tech. Holdings, Ltd.*, 2017 WL 5137401, at *14 (E.D. Tex. Nov. 4, 2017), *rev’d on other grounds*, 955 F.3d 1317 (Fed. Cir. 2020).

Let me deal with the second issue first. The fact that these opinions were disclosed in a rebuttal report is not problematic. In fact, it makes perfect sense.

Lutron was under no obligation to provide expert opinions about non-infringing alternatives in prior to filing rebuttal reports. It is GeigTech’s burden to prove damages, including reasonable royalties. *ResQNet.com, Inc. v. Lansa, Inc.*, 594 F.3d 860, 872 (Fed. Cir. 2010). November 22, 2022 – the date on which GeigTech says Lutron should have filed the Maslen and Meyer reports — was the deadline for “expert report(s) of a party with the burden of proof. Lutron has no burden of proof with respect to damages.

Furthermore, the opinions offered in the Maslen’s and Meyer’s rebuttal reports are classic rebuttal testimony. Maslen’s opinions that the alternate designs were not infringing is proper rebuttal to Perkins’ opinions that they are. Likewise, Meyer’s opinions about the impact of the

non-infringing alternatives on the damages calculations is not, as Plaintiff claims, “criticizing Baliban for not considering opinions that Lutron had not yet offered.” (Dkt. No. 22 at 9). Her opinion criticizes Baliban for not considering potential NIAs and the impact of those NIAs on any calculation of reasonable royalties. In so opining, she was relying on evidence that was known to GeigTech — evidence to which Baliban had access but did not consider (Bull’s deposition testimony about non-infringing alternative designs and the accompanying deposition exhibits).

None of this testimony could have been given except in the form of rebuttal to the expert reports filed by GeigTech’s experts.

Nothing in GeigTech’s cited cases supports its theory that the burden was on Lutron to produce opening reports about the issue of non-fringing alternatives. In *Ericsson Inc. v. TCL Comm’n Tech. Holdings, Ltd.*, 2017 WL 5137401, at *13-14 (E.D. Tex. Nov. 4, 2017), the accused infringer did not properly disclose possible non-infringing alternatives during fact discovery *at all*. That is not the case here.

GeigTech’s reliance on *Smart Skins, LLC v. Microsoft Corp.*, 2016 WL 4148091, at *2 (W.D. Wash. July 1, 2016) is also misplaced. In *Smart Skins*, the testimony of the alleged infringer’s expert regarding NIAs was not true rebuttal, because it went beyond the scope of plaintiff’s expert’s report. Here, GeigTech’s expert Nancy Perkins affirmatively concluded that the three Bull designs infringed GeigTech’s patent. (Dkt. No. 265-4). It was perfectly appropriate for Maslen to address and rebut Perkins’ opinions in his report. Meyer’s rebuttal opinions about how NIAs impact the adequacy of Baliban’s calculation of a reasonable royalty and his analysis of the *Georgia-Pacific* factors are likewise appropriate.

Finally, in *SPEX Techs. v. Apricorn, Inc.*, 2020 WL 1289546, at *3 (C.D. Cal. Jan. 21, 2020), the defendant had failed to disclose the existence of NIAs until after the close of discovery and only ten days before the deadline for expert reports. In that case, the court found that Defendants had failed to meet its obligations under Rule 26, that these failures to disclose were not harmless and that its rebuttal report disclosures failed to cure those deficiencies, so it excluded the expert testimony on NIAs.

So let us turn to whether Lutron timely disclosed the existence of the alleged non-infringing alternatives.

Rule 26(a) requires the disclosure of expert testimony “at the times and in the sequence that the court orders.” Fed. R. Civ. P. 26(a)(2)(D). The operative Civil Case Management Plan directed the parties to file opening reports regarding issues as to which a party bears the burden, followed by rebuttal reports. (Dkt. No. 166). Rule 37(c)(1) of the Federal Rules of Civil Procedure provides that: “If a party fails to provide information ... as required by Rule 26(a) or (e), the party is not allowed to use that information ... to supply evidence on a motion, at a hearing, or at a trial, unless the failure was substantially justified or is harmless.” The purpose of Rule 37(c) is to prevent the practice of “sandbagging” an adversary with new evidence. *Ebewo v. Martinez*, 309 F.Supp.2d 600, 607 (S.D.N.Y. 2004). However, preclusion is a discretionary remedy, even if “the trial court finds that there is no substantial justification and the failure to disclose is not harmless.” *Design Strategy, Inc. v. Davis*, 469 F.3d 284, 297 (2d Cir. 2006). Further, as preclusion of evidence is a “harsh remedy,” it “should be imposed only in rare situations.” *Cates v. Trustees of Columbia Univ. in City of New York*, 2019 WL 1433709, at *3 (S.D.N.Y. Apr. 1, 2019) (citations omitted).

The burden is on the allegedly non-disclosing party to establish that its supposed failure to disclose was substantially justified or harmless. *Design Strategies, Inc. v. Davis*, 367 F. Supp. 2d 630, 634 (S.D.N.Y. 2005). The Second Circuit considers four factors in determining whether preclusion is an appropriate sanction: (1) the party's explanation for the failure to comply with the disclosure requirement; (2) the importance of the precluded witness's testimony; (3) the prejudice suffered by the opposing party in having to prepare to meet the new testimony; and (4) the possibility of a continuance. *Patterson v. Balsamico*, 440 F.3d 104, 117 (2d Cir. 2006).

The three "John Bull" NIAs relied on by Maslen and Meyer were disclosed during discovery in response to Interrogatory 13. GeigTech deposed John Bull about the Bull Designs, and its own expert, Perkins, evaluated them and reached the (disputed) conclusion that the Bull designs also infringed plaintiff's patent. (Dkt. No. 265-1 at 1-2; Dkt. No. 265-2 at 173:4-190:17; Dkt. No. 265-3; Dkt. No. 265-4 ¶¶ 351-372; Dkt. No. 265-5, ¶¶ 34-36, 60-62). GeigTech can hardly claim surprise when it addressed those very designs in its opening reports. Nor can it fault Lutron for responding to what its expert tendered (an opinion about infringement) by offering one of their own – or for criticizing GeigTech's expert for failing to take the existence of non-infringing alternatives into account in calculating plaintiff's damages. There was no surprise, no sandbagging – there was no failure to disclose that the Bull designs were potential non-infringing alternatives during discovery. As a result, the reasoning of cases like *SPEX* has no applicability here. It is entirely proper for a rebuttal expert to testify as to the availability of NIAs, in response to expert testimony that certain previously disclosed alternatives were either still infringing or not sufficient alternatives. *See, e.g., Biedermann Techs. GmbH & Co. KG v. K2M, Inc.*, 2020 WL 4720083, at *4 (E.D. Va. May 14, 2020) *PSN Ill. LLC v. Abbott Labs*, 2012 WL 5381278, at *2

(N.D. Ill. Oct. 31, 2012); *Medisim, Ltd. v. Best Med. LLC*, 861 F. Supp. 2d 158, 163 (S.D.N.Y. 2012); *Plumley v. Mockett*, 836 F. Supp. 2d 1053, 1065-66 (C.D. Cal. 2010).

But the Bull designs are not the only NIAs mentioned in Meyer’s rebuttal to Baliban’s damages report. Meyer also identifies other Lutron products that she claims “could serve customers’ need for motorized shades” if the wired Palladiom shading system were not available. (*Ibid.*). To buttress this aspect of her opinion, Meyer cites an interview that she and her team conducted with John Bull. (Dkt. No. 226-1 at 17-18 n.75 & n.76). Lutron did not identify specifically identify these Lutron products as NIAs in response to GeigTech’s discovery requests (Dkt. No. 226-1 at 17-18) and Bull was not asked about them at his deposition.

GeigTech argues that it was deprived on an opportunity to depose fact witnesses about these products or to explore their feasibility, functionality, acceptability, and potential cost. *See, e.g., ICM Controls Corp., v. Honeywell Int’l Inc.*, 2021 WL 3403734, at *4 (N.D.N.Y. Aug. 4, 2021). It seeks to strike so much of Meyer’s report as relied on the alternative Lutron shading systems as NIAs.

Lutron counters that Meyer’s rebuttal report does not “rely” on these alternatives – that her critique of Baliban’s reasonable royalty calculation depends for its force only on the Bull Designs and does not assign any value to the other Lutron products. If that be so, then there is no reason for Meyer to testify about the Lutron products in her discussion of NIAs, and any mention of those products should be excised from her report and excluded from her testimony.

2. GeigTech’s Motion to Strike on the Ground that The Record Evidence Does Not Support Meyer’s Testimony Is Denied

Finally, GeigTech argues that Meyer should otherwise be precluded from offering any testimony about NIAs — even those that were timely disclosed in accordance with Rule 26 — because record evidence does not support her opinions that the disclosed NIAs would have

affected a hypothetical negotiation of reasonable royalties. Specifically, its motion argues that there is no evidence in the record that (1) Lutron's alternative designs were available at the time of the hypothetical negotiation, (2) they are commercially acceptable, (3) about their cost, or (4) the time it would take to implement these designs. (Dkt. No. 225 at 13-16).

Lutron challenges that this "motion to exclude" is not a proper *Daubert* motion. It claims that this motion is, in effect, a third motion for summary judgment, since it argues that the record evidence does not support Meyer's opinions, not her qualifications or methodology. (Dkt. No. 254 at 6-7)

Lutron is right. GeigTech's arguments for exclusion are disagreements with the conclusions reached by Meyer and the factual assumptions and considerations underlying those conclusions, not with her credentials or her methodology. To the extent GeigTech takes issue with the evidence that underlies Meyer's conclusions, it should vigorously cross-examine her. But that disagreement does not justify excluding her testimony. *Daubert*, 509 U.S. at 596.

D. Lutron's Motion to Strike the Affidavits of Dr. Paul W. Thurman Is Denied

On February 24, 2023 — the deadline for summary judgment motions and joint pretrial order submissions — Lutron served its motion for summary judgment on GeigTech's claims for trade dress infringement, unfair competition, and patent infringement. (Dkt. No. 228). In support of its argument that GeigTech's shading brackets have not acquired a secondary meaning in the market, Lutron produced the reports of two separate survey experts, Dr. Bruce Isaacson and David Franklyn, both of whom conducted separate consumer surveys showing that GeigTech's target audiences had "zero or virtually zero association of the appearance of GeigTech's shades with one source." (Dkt. No. 228 at 21). GeigTech produced no expert survey evidence during discovery. (*Ibid.*).

On that same day—more than 30 days after the close of all expert discovery—GeigTech served two affidavits of a new expert, Dr. Paul W. Thurman. Dr. Thurman was not tendered as a trial (or summary judgment) witness. Instead, GeigTech offers Dr. Thurman’s lengthy affidavits (40 and 50 pages long, respectively) – which critique the surveys conducted by Drs. Isaacson and Franklyn — in support of its *Daubert* motions seeking to exclude their testimony. (Dkt. Nos. 248-8 and 248-5).

Because Dr. Thurman’s affidavits do not suggest in the slightest that the consumer survey testimony of Isaacson and Franklyn should be excluded, I deny Lutron’s motion to strike Dr. Thurman’s affidavits. Instead I have considered them and (as will be seen below) I reject their reasoning.

Plaintiff states repeatedly that it does not intend to call Dr. Thurman at trial, and I will take GeigTech at its word, and not allow GeigTech to call Dr. Thurman at trial.

IV. *Daubert* Motions

A. Legal Standard

Under the standard set forth in *Daubert v. Merrell Dow Pharms., Inc.*, 509 U.S. 579 (1993) and Rule 702 of the Federal Rules of Evidence, the district court serves a “gatekeeping” function in determining whether an “expert” witness really qualifies as one. Rule 702 provides that:

A witness who is qualified as an expert by knowledge, skill, experience, training, or education may testify in the form of an opinion or otherwise if: (a) the expert’s scientific, technical, or other specialized knowledge will help the trier of fact to understand the evidence or to determine a fact in issue; (b) the testimony is based on sufficient facts or data; (c) the testimony is the product of reliable principles and methods; and (d) the expert has reliably applied the principles and methods to the facts of the case.

“The Second Circuit has ‘distilled Rule 702’s requirements into three broad criteria: (1) qualifications, (2) reliability, and (3) relevance and assistance to the trier of fact.’” *In re Aluminum Warehousing Antitrust Litig.*, 336 F.R.D. 5, 27 (S.D.N.Y. 2020) (quoting *In re LIBOR-Based Fin. Instruments Antitrust Litig.*, 299 F. Supp. 3d 430, 466 (S.D.N.Y. 2018)).

The party proffering the expert’s opinions “has the burden to establish the [Rule 702] admissibility requirements, with the district court acting as a ‘gatekeeper’ to ensure that the ‘expert’s testimony both rests on a reliable foundation and is relevant to the task at hand.’” *In re Pfizer Inc. Secs. Litig.*, 819 F.3d 642, 658 (2d Cir. 2016) (quoting *United States v. Williams*, 506 F.3d 151, 160 (2d Cir. 2017)). The court need not “admit opinion evidence that is connected to the 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). In its evaluation, “the district court must focus on the principles and methodology employed by the expert, without regard to the conclusions the expert has reached or the district court’s belief as to the correctness of those conclusions.” *Amorgianos v. Nat’l R.R. Passenger Corp.*, 303 F.3d 256, 266 (2d Cir. 2002).

Ultimately, the *Daubert* standard is a “flexible one,” *Daubert*, 509 U.S. at 594, “and will necessarily vary from case to case,” *Amorgianos*, 303 F.3d at 266. District courts have “broad discretion in the matter of the admission or exclusion of expert evidence.” *Boucher v. U.S. Suzuki Motor Corp.*, 73 F.3d 18, 21 (2d Cir. 1996) (quoting *Salem v. United States Lines Co.*, 370 U.S. 31, 35 (1962)). Even if an expert is qualified, the court must still consider whether the probative value of the testimony is “substantially outweighed by a danger of . . . unfair prejudice” or likelihood of confusing or misleading the jury. Fed. R. Evid. 403; *see also United States v. Dukagjini*, 326 F.3d 45, 55 (2d Cir. 2002).

A. Plaintiff's Motions to Exclude the Opinions of Bruce Isaacson and David Franklyn Are Denied

Lutron proffers the opinions of David Franklyn and Dr. Bruce Isaacson. These two individuals conducted surveys examining whether GeigTech's asserted trade dress has attained secondary meaning in the marketplace. GeigTech has moved to exclude their testimony in their entirety. As Plaintiff's arguments in support of striking these experts' testimony are essentially identical, I will consider them together.

Both motions are denied.

1. Background

David Franklyn was retained by Lutron to assess whether the trade dress claimed by GeigTech, specifically the trade dress of the end, jamb, and middle brackets of its J Geiger window shading systems, has acquired secondary meaning among likely purchasers of its products. (Dkt. No. 231-114 at 5). For purposes of the study, Franklyn defined the interested universe as consumers aged eighteen or older who either have purchased, or who are considering purchasing, high-end motorized roller window shades. (*Id.* at 7). He showed survey participants several pictures of GeigTech's motorized roller window blinds, which feature the asserted trade dress, and asked "whether they associate the displayed products with one company, more than one company, or no company at all." (*Ibid.*). The study included a separate control group in which respondents were shown modified versions of GeigTech's asserted trade dress, where the only modification was to eliminate the round or circular appearance of the brackets and asked the same set of questions. (*Ibid.*).

A total of 388 respondents participated in the double-blind survey, 194 in the test group and 194 in the control group. (*Id.* at 8, 26). 20% of test respondents associated the appearance of the motorized window shade products with one company. (*Id.* at 30). 18% of control respondents

associated the appearance of the shade products with one company (*Ibid.*). As a result, screening out the control, only 2% of the survey population identified the alleged GeigTech trade dress as a source indicator. *Ibid.*

Respondents who associated the window shades with one company were then asked to indicate with which company they associate them. (*Ibid.*). Of these, none identified GeigTech as the source of the shades, although one identified Savant, a GeigTech retailer, as the source. (*Id.* at 32). As a result, Franklyn concluded that the level of secondary meaning associated with GeigTech's asserted trade dress is less than 2% (*Ibid.*).

None of the respondents cited the asserted trade dress in the design as the reason for believing that the products came from one company. (*Ibid.*). For those respondents who identified "exposed hardware" as a feature they consider when purchasing window shades, the percentage who associated the window shades with one company was the same as for those who did not consider the feature. (*Id.* at 37).

Accordingly, Franklyn concluded that the survey found (1) zero to *de minimis* levels of secondary meaning associated with GeigTech's asserted trade dress and (2) that the design of GeigTech's shades does not function as a source identifier for any particular brand. (*Id.* at 8).

Dr. Bruce Isaacson was likewise retained by Lutron to conduct a survey measuring the level of secondary meaning associated with GeigTech's claimed trade dress for its jamb brackets, center brackets, and end brackets. (Dkt. No. 231-113 at 4-5). He designed his survey to measure the secondary meaning associated with the circular and U-shaped elements of the brackets as they appear when installed with roller shades. (*Id.* at 5). He interviewed consumers and professionals (including architects, general contractors, home builders, interior designers, and interior decorators), who, among other criteria, indicated that they:

“had purchased, selected, or recommended an exposed roller shade that is motorized, and/or were likely, in the next 12 months, to purchase, select, or recommend an exposed roller shade that is motorized; and are willing to consider purchasing, recommending, or selecting motorized roller shades priced at \$1,500 or more per shade.”

(Ibid.). The consumers or professionals were shown pictures of GeigTech jamb brackets, center brackets, or end brackets, as installed with roller shades, and then answered questions intended to measure secondary meaning. *(Id.* at 7). Certain participants were also shown “control brackets”—modified images of the test brackets—and similarly answered questions intended to measure secondary meaning. *(Id.* at 8). The use of the control questions was designed to remove the effect of inattentiveness, bias, or other external factors on respondent results. *(Ibid.)*.

A total of 929 respondents participated in the survey. *(Id.* at 226). The survey results showed that 20.4% of the consumers shown test brackets, and 14.9% of those shown the control brackets, answered that they associated their appearance with one company or brand. *(Id.* at 14). 12.6% of the professionals shown the test brackets and 13.9% of those shown the control brackets also associated their appearance with one company or brand. *(Ibid.)* Accounting for the influence of biases and external factors identified in the control group, the net percentage of respondents who associated the test brackets with one company was 5.5% for consumers (20.4%-14.9%) and -1.3% for professionals. (12.6%-13.9%). *(Ibid.)*.

Respondents were also asked what company they associated with the overall appearance of the test brackets. Only 0.3% of consumers—and 0% of professionals—shown the test brackets associated them with GeigTech. *(Ibid.)*

As a result, Isaacson concluded that both of these measures of association are well below the levels typically regarded as indicating that the asserted trade dress elements have attained secondary meaning in the marketplace. *(Ibid.)*.

2. Qualifications

Both David Franklyn and Bruce Isaacson are amply qualified to survey and assess whether GeigTech's claimed trade dress has acquired secondary meaning among likely purchasers of the product.

David Franklyn is a law professor at Arizona State University and the Executive Director of the McCarthy Institute for IP and Tech Law. (Dkt. No. 285-3 at 40). The McCarthy Institute is focused on scholarship and research in the areas of intellectual property law and cognate fields of academic research. He is also editor-in-chief and co-author of McCarthy's Desk Encyclopedia of Intellectual Property Law. (*Id.* at 42). He has published a significant amount of scholarship on consumer perception and trademark law and presents at symposiums and conferences concerning the same. (*Id.* at 41, 48-52). During a three decade career, Franklyn has consulted and/or qualified as an expert witness in multiple federal, state, and international litigations involving consumer perception and behavior issues and related damages issues. (*Id.* at 42-48).

Other courts have recognized Franklyn's expertise and permitted him to testify about consumer surveys like the one he conducted here. *See Kodiak Cakes, LLC v. JRM Nutrasciences, LLC*, 2022 WL 17340660 at *7-*8, *16, (D. Utah Nov. 30, 2022); *Emerson Radio Corp. v. Emerson Quiet Kool Co.*, 1:20-cv-01652, Dkt. 203 at 126-27 (D. Del. Oct. 22, 2021); *Rockwell Automation, Inc. v. Radwell Int'l, Inc.*, 1:15-cv-05246, Dkt. 767 at 1 (D.N.J. August 27, 2020); *Jaguar Land Rover Ltd. v. Bombardier Recreations Prods., Inc.*, Case No. 2:16-cv-13386, Dkt. No. 222 at 7 (E.D. Mich. Jan. 4, 2019).

Bruce Isaacson is similarly qualified to survey and opine on the level of secondary meaning that GeigTech's claimed trade dress has achieved in the marketplace. During his nearly 18 years as President of MMR Strategy Group, a marketing research firm, Dr. Isaacson has

provided testimony about surveys that he or others conducted in over 100 matters. (Dkt. No. 231-113 at 15). This includes testimony as a survey expert in a variety of venues, including federal courts, state courts, the Trademark Trial and Appeal Board (TTAB), the U.S. International Trade Commission, and the U.S. Court of Federal Claims. *Id.* In nearly two dozen matters, he was retained by federal agencies, including the U.S. Federal Trade Commission, the U.S. Department of Justice, and the U.S. Patent and Trademark Office. *Id.* Dr. Isaacson also routinely provides advice to large companies and other organizations on topics such as marketing. He has authored or co-authored multiple publications on trademarks. His Master of Business Administration and Doctor of Business Administration degrees—both from Harvard Business School—included coursework in marketing, research design, statistics, buyer behavior, strategy, and other topics. (*Id.* at 16).

In sum, there is no question that Franklyn and Isaacson are qualified to survey and opine on the extent to which GeigTech’s asserted trade dress has achieved secondary meaning among consumers in the marketplace. Given their education, skill, training, and experience in conducting surveys on consumer perception, their participation will “will likely assist the trier of fact in arriving at the truth.” *Johnson & Johnson Vision Care, Inc. v. CIBA Vision Corp.*, 2006 WL 2128785, at *5 (S.D.N.Y. July 28, 2006) (citation omitted).

To attack the testimony of these two eminently qualified experts, GeigTech offers the affidavits of Dr. Paul Thurman. Unlike Lutron’s experts, Thurman lacks the qualifications to opine on whether GeigTech’s trade dress has achieved secondary meaning in the marketplace.

Thurman claims to have provided expert testimony in several federal district courts on patent infringement, secondary meaning and trade dress via the use of survey and statistical analysis. (Dkt. No. 245-8 ¶ 8). But just five years ago, in a deposition in a case pending in the

Northern District of California, Thurman testified that he lacked any familiarity with the term “secondary meaning” and that he had no expertise in surveys measuring secondary meaning. (Dkt. No. 284 at 11). Nothing on his resume suggests how he might have acquired the expertise he was lacking in 2018 in the intervening five years. Furthermore, Dr. Thurman’s resume identifies only two occasions on which he has been qualified as expert witness -- once in the Supreme Court of New York in 2007 and once in the U.S. District Court for the Northern District of California in 2018 -- and both times he was qualified as an expert in the fields of general survey analysis, business valuation, and corporate finance, not secondary meaning. (Dkt. No. 248-8 at 46).

Thurman’s principal criticism of the surveys conducted by Lutron’s experts appears to be that they lack expertise in “shape perception science,” or modern Gestalt theory. (Dkt. No. 284 at 12). As far as I can tell, modern Gestalt theory as a way to evaluate consumer perception has passed *Daubert* muster in just one case in any federal court. *Delta T, LLC v. Dan’s Fan City, Inc.*, 2021 WL 458022 (M.D. Fla. Feb. 9, 2021). This court found a second such case in which the theory was employed by a proposed expert, but the court granted a *Daubert* motion and excluded the testimony for lack of reliability. *See Oralabs, Inc. v. Kind Grp. LLC*, 2015 WL 4694138, at *4 (D. Colo. Aug. 7, 2015). This track record does not inspire confidence in Dr. Thurman’s criticism.

Moreover, Thurman’s only identifiable qualification as an expert in evaluating surveys via gestalt theory stems from his co-authorship of a single paper validating a particular test of shape perception for use in patent infringement cases. But it is Thurman’s co-authors, not

Thurman, who appear to be the experts in the field.¹ Thurman’s own experience appears to be limited to his “use [of] this research in my business every day, especially when serving as a survey expert.” (Dkt. No. 245-8 at 11). He fails to cite a single case in any court in which he has previously been qualified as an expert in modern gestalt theory or used it as the basis of testimony he was permitted to offer.

I conclude that Franklyn and Isaacson are well-qualified to offer their opinions and to present the results of the surveys on which they are based. Nothing in Thurman’s affidavits attacking their credentials convinces me otherwise.

3. Admissibility

“[C]ourts have long held that consumer surveys are the most persuasive evidence of secondary meaning.” *LVL XIII Brands, Inc. v. Louis Vuitton Malletier S.A.*, 209 F. Supp. 3d 612, 638-39 (S.D.N.Y. 2016) (collecting cases), *aff’d sub nom. LVL XIII Brands, Inc. v. Louis Vuitton Malletier SA*, 720 F. App’x 24 (2d Cir. 2017). However, while they may be persuasive, they are not dispositive. Indeed, “any survey is of necessity an imperfect mirror of actual customer behavior under real life conditions.... It is notoriously easy for one survey expert to appear to tear apart the methodology of a survey taken by another.” 6 MCCARTHY ON TRADEMARKS § 32:184 at 32–380. There is “no such thing as a ‘perfect’ survey. The nature of the beast is that it is a sample, albeit a scientifically constructed one.” *Id.* at 32–380 to 32–381.

“To evaluate the validity and reliability of a survey, a court should consider whether: (1) the proper universe was examined and the representative sample was drawn from that universe;

¹ The primary and secondary authors on the paper, Charles Mauro and Christopher Morley, are the co-authors of a chapter on the influence of the scientific field of neuro-aesthetics on design law in the Research Handbook on Design Law. *See* Charles L. Mauro & Christopher D. Morley, *How different is different? Modern neuroscience and its impact on design law*, in RESEARCH HANDBOOK ON DESIGN LAW (Henning Hartwig ed., 2021).

(2) the survey's methodology and execution were in accordance with generally accepted standards of objective procedure and statistics in the field of such surveys; (3) the questions were leading or suggestive; (4) the data gathered were accurately reported; and (5) persons conducting the survey were recognized experts.” *Coty Inc. v. Excell Brands, LLC*, 277 F. Supp. 3d 425, 449-50 (S.D.N.Y. 2017) (quoting *Gucci Am., Inc. v. Guess?, Inc.*, 831 F. Supp. 2d 723, 738 (S.D.N.Y. 2011)).

A “survey suffer[ing] from substantial methodological flaws ... will be excluded under both Rule 403 and Rule 702.” *Malletier v. Dooney & Bourke, Inc.*, 525 F. Supp. 2d 558, 581 (S.D.N.Y. 2007). Plaintiff offers the testimony of Dr. Thurman to support its argument that the Franklyn and Isaacson survey are substantially methodologically flawed, and so should be excluded.²

“In cases arising under the Lanham Act, the Court's gatekeeper function is of heightened importance because the pivotal legal question virtually demands expert survey research on issues such as consumer perception.” *Id.* at 562 (cleaned up). Grouping GeigTech’s objections under the relevant *Coty* factors, I address each in turn.

a. The surveys’ representative samples draw from the proper universe

Both experts’ representative samples draw from the proper universes for their respective secondary meaning surveys. The universe for a secondary meaning study “should focus on the typical group(s) of consumers to whom the mark is directed” because the issue is “determined by consumer perception of the mark.” *Diamond & Swann, Trademark and Deceptive Advertising*

² As noted above, GeigTech insists that it is only relying on Dr. Thurman at the *Daubert* stage and disclaims any intention to call him at trial – a decision I will not allow Plaintiff to revisit. It is not at all clear how Plaintiff plans to attack the surveys at trial (since, as will be seen below, there is no reason to exclude them, and I am not doing so). Dr. Thurman may well lack expertise in secondary meaning surveys, but he does have expertise in survey research more generally, and I will consider his criticisms of the Lutron experts’ surveys in deciding the *Daubert* motions.

Surveys at 42 (2d ed. 2022) (“*Trademark Surveys*”). For such “surveys to be probative and meaningful, they must rely on potential consumers of the product in question.” *Tri-Star Pictures, Inc. v. Unger*, 14 F. Supp. 2d 339, 350 (S.D.N.Y. 1998) (internal quotations omitted). A secondary meaning survey is of “dubious value” where its universe is not keyed to the relevant market. *Centaur Commc'ns, Ltd. v. A/S/M Commc'ns, Inc.*, 652 F. Supp. 1105, 1110-11 (S.D.N.Y. 1987), *aff'd*, 830 F.2d 1217 (2d Cir. 1987), overruled on other grounds, *Paddington Corp. v. Attiki Importers & Distribs., Inc.*, 996 F.2d 577, 585 (2d Cir. 1993). To avoid being overinclusive, such a survey should “encompass only the potential buyers of the products at issue.” *Lon Tai Shing Co. v. Koch+Lowy*, 1992 WL 18806, at *3 (S.D.N.Y. Jan. 28, 1992). To avoid being underinclusive, it must not “defin[e] a group narrower than the ideal universe, thus leaving out a group of persons whose perception is relevant.” 6 J. Thomas McCarthy, MCCARTHY ON TRADEMARKS § 32:161 (5th ed. 2022) (collecting cases).

Plaintiff, buttressed by Dr. Thurman, argues that Franklyn’s survey did not define the proper universe both because it excluded relevant consumers of GeigTech’s products and because the universe it did survey was overly broad. (Dkt. No. 244 at 16).

Specifically, it asserts that Franklyn excluded relevant consumers such as architects, A/V installers, interior designers, contractors, and home builders, who are the primary purchasers of shades, rather than homeowners themselves. (*Id.* at 17). It also asserts that the population surveyed was overly broad because the target group—consumers 18 or older, unaffiliated with window shade or related industries, with a willingness to pay \$1000 or more for a single window shade—is not representative of past or potential GeigTech customers, who can only purchase GeigTech products through its showrooms and authorized dealers. (*Id.* at 18). Plaintiff further argues that Franklyn’s universe is flawed because he (1) did not screen out respondents who

wanted a motorized roller shade with a fascia, (2) may have included respondents who are brand agnostic, and (3) failed to use information provided by GeigTech about its target demographics to narrow the universe. (*Id.* at 19).

These arguments go to weight, not admissibility.

As the Second Circuit has long held, “[t]o be probative and meaningful ... surveys ... must rely upon potential consumers of the products in question.” *Universal City Studios, Inc. v. Nintendo Co.*, 746 F.2d 112, 118 (2d Cir. 1984) (citations omitted). But while designers and decorators may be deeply involved in a client’s purchasing decision – and may sometimes even make selections without client input — homeowners are the ultimate customers where window treatments are concerned. Franklyn’s choice of survey population is certainly not immune to criticism; his failure to include design professionals as part of the survey response group offers wonderful fodder for cross, or from testimony given by an industry witness (including one from GeigTech) who can undermine the weight to be accorded Franklyn’s testimony by explaining to the jurors who is in the usual customer base for the products in suit. But no one has suggested that ultimate consumers are never involved in such decisions and so should not be targeted when conducting a survey of the sort under consideration here. Franklyn’s failure to include design professionals goes to the weight to be accorded his evidence, not its admissibility. *THOIP v. Walt Disney Co.*, 690 F. Supp. 2d 218, 231 (S.D.N.Y. 2010).

Plaintiff’s argument that the group selected is overinclusive is undermined by GeigTech’s assertion that it has a nationwide market and that it has spent millions of dollars to advertise its products throughout the country. (Dkt. No. 169 ¶ 16). GeigTech’s witnesses have testified that GeigTech sells its products nationwide through its showrooms; according to its CEO and former CEO, it reaches far-flung areas through a widespread network of dealers. (Dkt. No. 285-2 at

144:25-145:9, 148:21-25, 165:16-22; Dkt. No. 285-1 at 48:18-21, 41:4-8; Dkt. No. 285-8 at 52:2-7, 149:21-23). Plaintiff has similarly claimed that its advertising — which it contends has helped its trade dress attain secondary meaning in the marketplace — is disseminated nationwide. (Dkt. No. 169 ¶ 25; Dkt. No. 285-1 at 148:2-19; Dkt. No. 285-8 at 50:17-51:4; Dkt. No. 285-9 at GT_0163499). By conducting a nationwide survey of consumers who are willing to pay \$1000 or more for a single window shade, Franklyn selected what appears to be a relevant consumer group of wealthy individuals with an interest in high-end shading solutions. GeigTech is perfectly free to argue to the trier of fact that Franklyn’s survey should have focused more closely on consumers located in the immediate vicinity of its showrooms; but its broad assertions of a national business are fatal to any effort to exclude the survey altogether. Criticisms of his sample, whether as over or under inclusive, go to the weight a trier of fact should accord his testimony. *Cf. Lon Tai Shing Co. v. Koch+Lowy*, 1992 WL 18806, at *3 (S.D.N.Y. Jan. 28, 1992).

The remaining purported “flaws” in Franklyn’s survey identified by Thurman and GeigTech do not warrant its exclusion, either. While GeigTech insists that customers who want a motorized roller shade with a fascia are not GeigTech customers, it fails to offer any evidence that purchasers of motorized rollers shades with a fascia are a group “that differs in its responses” from potential purchasers of GeigTech’s products. *See Friesland Brands, B.V. v. Vietnam Nat’l Milk Co.*, 221 F. Supp. 2d 457, 461 (S.D.N.Y. 2002). The appropriate universe for a customer survey is the universe of potential customers, not just those consumers who are specifically interested in the precise product offered by plaintiff.

Nor does the inclusion of brand-agnostic customers undermine the survey’s admissibility. The one case cited by GeigTech for the proposition that brand-agnostic customers should be

excluded, *Syndicate Sales, Inc. v. Hampshire Paper Corp.*, 192 F.3d 633, 636 (7th Cir. 1999), merely holds that customers who are indifferent to brands should not be included in surveys that measure consumer confusion because, for a customer “to be deceived, [she] must be looking for something [i.e., a particular brand].” *Spangler Candy Co. v. Crystal Pure Candy Co.*, 235 F. Supp. 18, 27 (N.D. Ill. 1964), *aff’d*, 353 F.2d 641 (7th Cir. 1965). Franklyn is not measuring consumer confusion in his survey, and GeigTech cites no authority suggesting that brand-agnostic customers should not be included in surveys about whether asserted trade dress is source-identifying. As a matter of logic, even a customer who is brand-indifferent when making a purchase can associate trade dress with a particular brand. There are undoubtedly people who are brand-indifferent when buying cola, but it would be hard to find someone who does not recognize the unique shape of the classic Coca-Cola bottle – its trade dress. Thus, including brand-agnostic customers in the survey population does not automatically render the survey unreliable. Again, this factor goes to weight.

Finally, Franklyn’s decision to not use GeigTech’s own target demographic data to narrow the universe does not render the survey so overinclusive as to warrant its exclusion. GeigTech conflates the customers it targets with potential customers for its products. It makes perfect sense that GeigTech would want to sell its products to customers with home values of more than a million dollars (one of its target demographics); a million dollar home likely requires many window shades and is being purchased by someone who is more likely amenable to paying top dollar for interior decoration.³ But that does not mean that customers whose homes cost less are not potential customers for GeigTech products. GeigTech has certainly not indicated

³ Since a \$1 million house in New York City is far different than a \$1 million house in St. Louis – and the purchaser of a \$1 million property in New York City is probably different than the purchaser of a \$1 million house in St. Louis as well – it is not clear to me that GeigTech’s selected demographic is not just as subject to attack as Franklyn’s would be. No doubt that will be explored at trial.

that it would refuse to sell its products to a customer whose home cost only \$750,000. The relevant criterion for including customers in the universe is whether they are potential customers. Franklyn chose to measure that potential by including people who were willing to pay a high price for an individual window shade (\$1000 or more). (Dkt. No. 285-2 at 143:24-144:1). To exclude some of these customers might actually render the survey underinclusive, by “leaving out a group of persons whose perception is relevant.” MCCARTHY § 32:161. Accordingly, I will not exclude Franklyn’s survey because he selected a proper universe for his responsive group. Again, this is a criticism of Franklyn’s methodology that goes to its weight.

Plaintiff similarly argues that Isaacson’s survey did not define the proper universe. Obviously, he cannot make exactly the same argument since, in contrast to Franklyn, Isaacson *did* survey consumers and professionals — the very professionals Plaintiff believes Franklyn should have included (architects, general contractors, home builders, interior designers and interior decorators). (Dkt. No. 247 at 9). Nonetheless, Plaintiff argues that Isaacson’s survey universe is too broad. Specifically, GeigTech asserts that Isaacson’s universe of consumers and professionals who were “willing to consider purchasing . . . motorized roller shades priced at \$1500 or more per shade,” is too broad because GeigTech’s target audience can only purchase GeigTech products through its showrooms and authorized dealers. (*Id.* at 16). Plaintiff also asserts, as it did with Franklyn, that the universe is flawed because Isaacson did not screen out respondents who intended to purchase shades “off the shelf” or install them themselves, as well as those who are brand-agnostic. Its final criticism is that Isaacson, like Franklyn, failed to rely on information provided by GeigTech about its target demographic. (*Id.* at 17).

These arguments are no more persuasive in Isaacson’s case than they were in Franklyn’s. Isaacson’s selection criteria are properly keyed to potential customers for GeigTech’s product;

GeigTech's own witness testified that the average per-window cost of a GeigTech shading system is \$1500. (Dkt. No. 285-2 at 143:24-144:1). By selecting consumers willing to pay \$1500 or more for a single window shade, Isaacson surveyed a relevant consumer base of individuals with an interest in high-end shading solutions. *Cf. Lon Tai Shing Co. v. Koch+Lowy*, 1992 WL 18806, at *3 (S.D.N.Y. Jan. 28, 1992). And as discussed above, the fact that GeigTech advertises and sells nationwide means any criticism of Isaacson's use of a customer base not focused on the immediate vicinity of its showrooms goes to the weight, not the admissibility, of his survey. The same is true of the remaining methodological "flaws" identified by GeigTech: the inclusion of brand agnostic customers and the failure to use GeigTech's target demographic data. *Supra* at pgs. 26-28.

The most potentially convincing of GeigTech's arguments is that Isaacson's decision not to screen out respondents who intended to purchase their shades off the shelf or install them themselves undermines the reliability of the survey, because GeigTech's products cannot be purchased "off the shelf." Unquestionably this fact can be used to attack the persuasiveness of Isaacson's testimony. However, as noted above, GeigTech fails to offer any evidence that self-installers are a group "that differs in its responses" from potential purchasers of GeigTech's products. *See Friesland Brands, B.V. v. Vietnam Nat'l Milk Co.*, 221 F. Supp. 2d 457, 461 (S.D.N.Y. 2002).

Moreover, GeigTech's argument overlooks the fact that off-the-shelf purchasers and self-installers may actually have been screened out by Isaacson's requirement that the survey respondent be a customer willing to pay \$1500 or more for a single window shade. Common sense suggests that someone who is willing to pay \$1500 or more for a single window shade is not someone who is going to install his own shades. In fact, I would hazard a guess that there are

few if any self-installable motorized window shades costing \$1500 or more that are available off the shelf. If I am wrong about that, I am sure it will be brought out on cross examination.

For both surveys, plaintiff argues that *Leelanau Wine Cellars, Ltd. v. Black & Red, Inc.*, 452 F. Supp. 2d 772, 782 (W.D. Mich. 2006), aff'd, 502 F.3d 504 (6th Cir. 2007), an out-of-circuit case, supports its arguments that the survey universes are geographically over-inclusive. There, the survey proponent “defined the universe as Michigan consumers over 21 years of age who had either purchased a bottle of wine in the \$5 to \$14 price range in the last three months or who expected to purchase a bottle of wine in that price range in the three months following the interview.” *Id.* The court found this universe was “significantly overbroad” because the products embodying the trade dress were “available primarily only through their [wine] tasting rooms on the Leelanau Peninsula and in Frankenmuth and through their website.” *Id.* That being so, the court found that “only a tiny percentage of the consumers in the universe chosen . . . would be potential purchasers.” *Id.*

GeigTech argues that the same is true here because its products are only sold through GeigTech and authorized dealer showrooms, so any survey should only have targeted customers who live close to those showrooms. (Dkt. No. 244 at 18; Dkt No. 247 at 17).

Leelanau is factually inapposite to this case. In *Leelanau*, the winemaker’s potential consumers consisted primarily of individuals who lived in close proximity to the tiny Michigan towns of Leelanau and Frankenmuth, individuals who visited those towns as tourists, and the limited number of Michigan residents who buy their wine online. That relatively tiny population was a drop in the bucket compared to the selected universe of all Michigan adults who bought wine in the \$5 to \$14 range (potentially millions of customers).

Here, both survey experts tailored their consumer universes to the limited number of individuals willing to shell out thousands of dollars on motorized window shades. GeigTech advertises its shades throughout the United States, and it has showrooms or dealerships in many locations throughout the United States. That the actual sale of the shades must occur in showrooms run by GeigTech or its authorized dealers is of no moment; evidence in the record illustrates a GeigTech sales consultant servicing a potential customer in the small town of Rockport, Maine, which as far as I can tell is far from the nearest showroom or authorized dealer. (Dkt. No. 226 at 29 n. 148). There is simply no evidence that consumers who do not live in the immediate vicinity of an authorized GeigTech dealer are unable to buy Plaintiff's products, or that GeigTech would refuse to sell to them. While such consumers may be less likely to select GeigTech products, this goes to the weight that should be afforded the survey, not its admissibility. *THOIP v. Walt Disney Co.*, 690 F. Supp. 2d 218, 219 (S.D.N.Y. 2010).

b. The surveys were designed and executed in accordance with generally accepted standards of objective procedure and statistics in the field

Plaintiff argues that the control stimuli used by Franklyn and Isaacson, which were meant to remove the effect of respondent biases and external factors, were too similar to the test stimuli to assess secondary meaning accurately. (Dkt. No. 244 at 19-20; Dkt. No. 247 at 19). Specifically, both experts altered the smooth, rounded end shapes of the brackets to give them multiple edges (resulting in an appearance similar to a trapezoid); but they did not otherwise modify the length, height, or thickness of the bracket shapes, leaving in place key elements that are assessed by consumers. (Dkt. No. 244 at 20; Dkt. No. 247 at 19). Plaintiff further argues that the surveyors' methodologies were inherently flawed, again because they should have been based on "modern Gestalt theory" and "shape perception theory and practice." (Dkt. No. 244 at

13; Dkt. No. 247 at 13). Finally, Plaintiff argues that Franklyn’s and Isaacson’s methods were otherwise defective because the experts did not use “assisted surveys,” they did not conduct pilot surveys prior to conducting the actual surveys, and they did not undertake a proper statistical analysis using appropriate sample sizes to power the studies. (Dkt. No. 244 at 23-24; Dkt. No. 247 at 21-22).

All these arguments fail.

First, the experts’ control stimuli were appropriate for the survey. “To fulfill its function, a control should share as many characteristics with the experimental stimulus as possible, with the key exception of the characteristic whose influence is being assessed.” *THOIP v. Walt Disney Co.*, 690 F. Supp. 2d 218, 240 (S.D.N.Y. 2010) (internal quotation marks omitted). Plaintiff’s purported bracket trade dress is for:

“The jamb bracket [] described as a clean circular element that is integral and seamless with both the shade and the wall.” ([*Compl.*] ¶ 45.) The center bracket [] described as “a clean, U-shaped element, where the U-Shaped element fits seamlessly between two shade ends that abut the same, effectively creating a ‘shade sandwich’ with the U-shaped element in the middle.” (*Id.* ¶ 49.) The end bracket [] described as “a clean U-shaped element that stands alone in its ornamental connection of the end of the shade to a wall, where the outward face side of the U-shaped element is unencumbered with any of the normally ‘ugly’ mechanisms required to attach the element to the wall.” (*Id.* ¶ 53.)

Dkt. 65 at 9 (citing Dkt. No. 1). The control stimuli were identical to the GeigTech brackets, except that the prominent circular or U-shaped elements on each respective bracket was modified to not be rounded. While Plaintiff argues the length, height, and thickness should have been modified, these are not asserted elements of GeigTech’s trade dress.

It is true that neither expert changed the bracket so as not to be “integral and seamless” with the wall. However, to do so likely would have caused the control stimulus to be too dissimilar to the experimental stimuli. “[A] control stimulus should not be less attractive than the

experimental stimulus if the survey is designed to measure how familiar the experimental stimulus is to respondents, because attractiveness may affect perceived familiarity.” 1 MOD. SCI. EVIDENCE § 7:21 (2023 Ed.). By selecting “a control stimulus that had little in common with the [brackets] at issue in this case,” the experts would have more likely caused an “underreporting of background ‘noise.’” *Malletier v. Dooney & Bourke, Inc.*, 525 F. Supp. 2d 558, 595 (S.D.N.Y. 2007). Even if the failures to alter these characteristics created imperfect control stimuli, “a survey with an imperfect control [stimulus] generally provides better information than a survey with no control group at all . . .” Shari Seidman Diamond, Reference Guide on Survey Research, in MANUAL ON SCIENTIFIC EVIDENCE 2d at 258 (Federal Judicial Center 2000). Any issues with the control stimuli thus go only to weight but do not merit exclusion.

Second, Franklyn and Isaacson did not need to base their surveys on modern Gestalt theory and shape perception science. As already mentioned, this theoretical framework does not appear to have widespread acceptance in cases of this type, having been the subject of just two *Daubert* decisions, one of which concluded that testimony based thereon was not scientifically grounded and should be excluded. (Dkt. No. 284 at 12). GeigTech offers no evidence that modern gestalt theory and shape perception science is a generally accepted method for evaluating consumer perceptions of secondary meaning – aside, of course, from the opinion of Dr. Paul W. Thurman. But I have already concluded that Dr. Thurman is not sufficiently expert in modern Gestalt theory and shape perception science to testify about such matters, at least where trade dress and secondary meaning (about which he claimed to know nothing five years ago) are concerned. Franklyn and Isaacson executed their surveys in accordance with reasoned methodologies that have been employed in dozens of cases; Plaintiff does not identify how the application of gestalt and shape perception theory would have changed the results they obtained.

Third, Franklyn and Isaacson were not required to use “assisted surveys” or pilot surveys, or to compute appropriate sample sizes to “power” their studies. Plaintiff offers no authority, other than Thurman (who by his own admission lacks expertise in the field of secondary meaning), for the assertion that it is generally accepted that a secondary meaning survey should give respondents a list of possible responses. (Dkt. No. 244 at 23; Dkt. No. 247 at 21). In fact, secondary meaning is appropriately measured by close-ended questions. *See, e.g., MCCARTHY* §§ 32:190-91. Second, the experts were not required to pilot test or pre-test the surveys. “While a pre-test or pilot test is a common precursor in many surveys, there is no requirement that a pilot test must be used to ensure reliability.” *MCCARTHY* § 32:163.50; *see also Capri Sun GmbH v. American Beverage Corporation*, 595 F. Supp. 3d 83, 127 (S.D.N.Y. 2022). Moreover, Plaintiff overlooks the fact that Isaacson did pre-test his survey. (Dkt. No. 231-113 ¶ 2).

Statistical analysis and computation of appropriate sample sizes to “power” studies are not required for market surveys. As long as it makes the existence of a fact “more or less probable,” Fed. R. Evid. 401, non-projectable survey evidence is sufficiently reliable for Lanham Act litigation. *Schieffelin & Co. v. Jack Co. of Boca*, 850 F. Supp. 232, 247 (S.D.N.Y. 1994) The court is satisfied that the results from the survey are not compromised by the size of the sample. Accordingly, none of these purported “flaws” supports exclusion.

Finally, Plaintiff asserts that the surveys are unreliable because they must replicate real world marketplace conditions.

It is true that “the closer the survey methods mirror the situation in which the ordinary person would encounter the trademark, the greater the evidentiary weight of the survey results.” *THOIP v. Walt Disney Co.*, 690 F. Supp. 2d 218, 231 (S.D.N.Y. 2010) (quoting *MCCARTHY* §

32:163 at 32–333).⁴ However, while it might be preferable to recreate market conditions for a market survey, reliability must, at times, give way to practicality. As Judge Wyszynski observed in the famous *Zippo* lighter case, “While it may be that in general the store is the best place to measure the state of mind [of a consumer] at the time of purchase, it would be virtually impossible to obtain a representative national sample if stores were used.” *Zippo Mfg. Co. v. Rogers Imports, Inc.*, 216 F. Supp. 670, 685 (S.D.N.Y. 1963).

In this case, recreating real world marketplace conditions would presumably require defendant’s experts to replicate a window shade showroom and march in hundreds of consumers to review the test and control stimuli. Such an effort would be totally infeasible, not least because it would be highly improbable to convince enough people to participate in the survey. The reality is that viewing the images on a computer, as was done here, recreates the manner in which many of GeigTech’s customers undoubtedly have their first encounter with its trade dress – by looking at its products in a catalogue or on the company’s website.⁵ I am satisfied that the surveys are not undermined by the conditions of the survey, and any “flaws of [the] surveys [] go to evidentiary weight and do not warrant exclusion. *THOIP*, 690 F. Supp. 2d at 219.

Accordingly, the Court finds that the Franklyn and Isaacson’s “survey[] methodology[ies] and execution were in accordance with generally accepted standards of

⁴ However, the case law does not specify whether real world conditions are needed for secondary meaning surveys, since the only authorities cited are cases involving confusion surveys. *See, e.g., Mattel, Inc. v. Azrak-Hamway Int’l, Inc.*, 724 F.2d 357, 361 (2d Cir. 1983).

⁵ Plaintiff also asserts additional arguments that respondents were not given enough time to view the images of the test and control brackets, and that the images were too small to see the asserted trade dress. (Dkt. No. 244 at 14-16; Dkt No. 247 at 14-15). This seems to arise from Plaintiff’s misunderstanding of Defendant’s experts’ deposition testimony. (Dkt. No. 284 at 24-25; Dkt No. 288 at 24). These matters can be the subject of cross examination; there is no reason to exclude on the basis of such criticisms.

objective procedure and statistics in the field of such surveys.” *Coty Inc.*, 277 F. Supp. 3d at 449-50.

c. The persons conducting the survey are recognized experts

As discussed above, Franklyn and Isaacson are amply qualified to conduct the described survey.

The Court accordingly denies GeigTech’s *Daubert* motions to exclude Franklyn and Isaacson’s opinions and the surveys on which they are based.

B. Defendant’s Motion to exclude the opinions of Nancy Perkins is Granted in Part and Denied in Part

In support of its claims for patent infringement, trade dress infringement and unfair competition, Plaintiff plans to offer at trial the opinions of its expert Nancy Perkins, who has submitted a total of four expert reports: on (1) patent infringement, (2) trade dress infringement and unfair competition, (3) secondary considerations of non-obviousness for patent infringement and (4) validity of the asserted patent.

Nancy Perkins is the founder and president of Perkins Design Ltd., an industrial design consultancy and expert witness business. (Dkt. No. 220-1 ¶ 4). She earned a B.F.A. in Industrial Design from the University of Illinois at Urbana-Champaign in 1972. (*Id.* ¶ 5). She is the Chicago Chapter Chair, Midwest District VP and National Secretary/Treasurer of the Industrial Designers Society of America (“IDSA) and was certified by IDSA as an Expert Witness in Design Patent Litigation in 2015 (*Id.* ¶ 9, at 113). Over the course of fifty years, she has served as a designer and design consultant for a number of firms and companies including: Peterson Bednar Associates, Deschamps Mills Associates, Cameo Container Corporation, Sears Roebuck & Company, and Jarden Consumer Solutions. (*Id.* at 113). Her experience in shade design

includes window fascia concept development for the Carey McFall/Bali Window Blinds brand and design development for Springs Window Fashions. (*Id.* ¶ 11).

Relevant to her testimony on secondary meaning and the trade dress similarity, Perkins claims to have expertise in “how ordinary observers visually perceive and evaluate various types of products” based on her “experience in observing consumers as they make purchase decisions . . .” (*Id.* ¶ 12). Specifically, “During my years with Sears, more than a million people a day shopped in our stores. I conducted and observed research into how ordinary observers evaluate and compare ornamental product designs. I studied and learned the habits and customs of ordinary observers in the retail environment, including the approximate length of time and degree of attention a typical customer spends comparing various similar ornamental product designs.” (*Ibid.*).

Plaintiff intends to have Perkins offer five opinions at trial: “(1) The J Geiger trade dress is non-functional; (2) The J Geiger trade dress has achieved secondary meaning in the market; (3) The J Geiger trade dress is substantially similar to the Palladiom Shading System and there is a likelihood of confusion; (4) The end and center brackets of the Palladiom Shading System infringe the Asserted Claims of U.S. Patent No. 10,294,717 (the “’717 Patent”); and (5) The ’717 Patent is valid and enforceable.” (Dkt. No. 290 at 8).

All other opinions contained in Perkins’ reports are deemed abandoned and may not be the subject of testimony at trial.

Lutron seeks to exclude Perkins’ proffered opinions on multiple grounds.

1. Opinions Relating to the Functionality of the Asserted Trade Dress

Lutron seeks to exclude Perkins’ testimony that GeigTech’s trade dress is non-functional on the ground that it includes improper opinions on ultimate issues of fact and law.

The Lanham Act requires that “the person who asserts trade dress protection has the burden of proving that the matter sought to be protected is not functional.” 15 U.S.C. § 1125(a)(3). A product feature is utilitarian functional if, *inter alia*, “if it is (1) essential to the use or purpose of the article or if it (2) affects the cost or quality of the article.” *Sulzer Mixpac AG v. A&N Trading Co.*, 988 F.3d 174, 182 (2d Cir. 2021), cert. denied, 212 L. Ed. 2d 321, 142 S. Ct. 1359 (2022) (quoting *Christian Louboutin S.A. v. Yves Saint Laurent Am. Holdings, Inc.*, 696 F.3d 206, 219 (2d Cir. 2012)). A product feature may also be aesthetically functional if monopolization of the claimed feature would “limit[] the range of adequate alternative designs,” *Christian Louboutin S.A. v. Yves Saint Laurent Am. Holdings, Inc.*, 696 F.3d 206, 222 (2d Cir. 2012).

“Although an expert may opine on an issue of fact within the jury’s province, he may not give testimony stating ultimate legal conclusions based on those facts.” *United States v. Bilzerian*, 926 F.2d 1285, 1294 (2d Cir. 1991). “Expert testimony may not usurp the province of the judge to instruct on the law.” *In re Puda Coal Sec. Inc., Litig.*, 30 F. Supp. 3d 230, 251 (S.D.N.Y. 2014), *aff’d sub nom. Querub v. Hong Kong*, 649 F. App’x 55 (2d Cir. 2016) (quoting *Bilzerian*, 926 F.2d at 1294). Courts must “distinguish between factual conclusions that may be included in an expert’s testimony—though they embrace an ultimate issue to be decided by the jury—and opinions embodying legal conclusions that encroach upon the court’s duty to instruct on the law.” *Bilzerian*, 926 F.2d at 1294.

Perkins is unquestionably qualified to offer certain opinions that would help a jury evaluate the functionality of GeigTech’s asserted trade dress. Perkins’ experience in industrial design and window fascia design equips her to opine that the visual elements of the jamb bracket trade dress do not affect the cost or quality of the mounting bracket because “whether the end

bracket is a circular or square shape would have no impact on the cost or quality of the overall shade system.” (Dkt. No. 220-1 ¶ 63). Similarly, Perkins’ experience in architectural hardware design, and her understanding of consumer preferences for architectural hardware equips her to offer her opinion that the number of other designs for exposed shading system brackets offer alternatives to the asserted trade dress that compete with the asserted trade dress in the same market. (Dkt. No. 220-1 ¶¶ 73-83).

Most important, Perkins can opine that specific aspects of the trade dress do not perform any function in terms of fastening the shade or holding it up but are in fact purely ornamental. Offering an opinion about technical aspects of features — and whether those features do anything, as opposed to look pretty — does not usurp the jury’s role. If in fact those features perform some function, Lutron is in a position to point out that fact, leaving it to the jury to decide who is correct. If Lutron is unable to raise a genuine issue of fact on this score, the mere fact that evidence concerning the functionality of various features comes from an expert does not mean it cannot be introduced.

To the extent Lutron believes the opinions Perkins offers are incomplete because she fails to consider certain evidence or fails to address certain issues—such as whether (1) aspects of Plaintiff’s trade dress is claimed or disclosed by the patents; (2) whether the “seamless” and “integral” elements of the trade dress provide performance benefits; or (3) “the effect of the claimed design on light gaps,” (Dkt. No. 219 at 15-17)—those “gaps or inconsistencies in the reasoning leading to [the expert’s] opinion” go only to the weight of her testimony. *See Campbell ex rel. Campbell v. Metro. Prop. & Cas. Ins. Co.*, 239 F.3d 179, 186 (2d Cir. 2001). As will be discussed below, Defendant intends to offer the rebuttal opinions of Joel Delman on this

point, so the experts can both testify about their difference of opinions. Perkins can also be cross examined about these issues. *Daubert*, 509 U.S. at 596 (citations and quotations omitted).

2. Opinions Relating to Secondary Meaning

GeigTech offers Perkins' opinion that its trade dress has attained secondary meaning in the marketplace.

Perkins is not qualified to offer an expert opinion concerning secondary meaning. She has no experience empirically measuring consumer association or prior involvement in the advertising and sales of consumer products. Her proposed testimony about secondary meaning simply parrots the conclusions reached by others. Therefore, her testimony on this issue is excluded (with one exception). For our immediate purposes, this means that it cannot be relied on to raise any genuine issue of material fact.

Secondary meaning exists 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, Inc. v. Samara Bros.*, 529 U.S. 205, 211 (2000) (emphasis added) (quoting *Inwood Labs., Inc. v. Ives Labs., Inc.*, 456 U.S. 844, 851 n.11 (1982)). “Because the primary element of secondary meaning is ‘a mental association in buyer[s] minds between the alleged mark and a single source of the product,’ the determination whether a mark or dress has acquired secondary meaning is primarily an empirical inquiry.” *Sunbeam Products, Inc. v. W. Bend Co.*, 123 F.3d 246, 253 (5th Cir.1997) (citation omitted) (emphasis in original). Accordingly, courts have long held that consumer surveys are the most persuasive evidence of whether a product has acquired secondary meaning. *See, e.g., Sports Traveler, Inc. v. Advance Magazine Publishers, Inc.* (“*Sports Traveler II*”), 25 F.Supp.2d 154, 164 (S.D.N.Y.1998).

Of course, consumer surveys are not the only form of evidence relevant to deciding whether a product has acquired secondary meaning. *Centaur Commc'ns, Ltd. v. A/S/M Commc'ns, Inc.* (“*Centaur II*”), 830 F.2d 1217, 1223 (2d Cir.1987). The Second Circuit has identified five other potentially relevant factors: (1) advertising expenditures, (2) unsolicited media coverage of the product, (3) sales success, (4) attempts to plagiarize the mark, and (5) length and exclusivity of the mark's use. *Centaur II*, 830 F.2d at 1222.

Nevertheless, the ultimate determination of whether a particular trademark or trade dress has acquired secondary meaning remains an “empirical question of consumer association.” *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 770-71, 112 S.Ct. 2753, 120 L.Ed.2d 615 (1992) (internal quotation marks and citation omitted). In other words, the essential aspect of secondary meaning is proof that consumers associate the trade dress with a particular manufacturer.

Perkins proposes to testify about GeigTech’s advertising expenditures and sales success, as well as attempts to plagiarize the mark, and the length and exclusivity of the trade dress’ use. After reviewing her proposed testimony, I conclude that it is simply *ipse dixit*, and that it principally summarizes, under the veneer of her expertise, conclusions reached by others who are far more qualified than she to address the empirical question of consumer association. Her testimony should, therefore, be excluded.

It is well established that 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.” *Id.* at 638 (quoting *Nimely v. City of New York*, 414 F.3d 381, 399 n.13 (2d Cir. 2005)). Since the acquisition of secondary meaning is ultimately an empirical question, the expertise most relevant to determining to such a determination involves training or experience performing empirical analyses. *LVL XIII Brands, Inc. v. Louis Vuitton Malletier S.A.*,

209 F. Supp. 3d 612, 639 (S.D.N.Y. 2016), *aff'd sub nom. LVL XIII Brands, Inc. v. Louis Vuitton Malletier SA*, 720 F. App'x 24 (2d Cir. 2017).

Perkins' expertise about consumer association allegedly derives from her observation of consumers at Sears, where she worked for many years as an industrial design consultant. (Dkt. No. 220-1 at 113). But Perkins does not explain how watching customers making decisions qualifies her to opine that a particular product has attained secondary meaning in their minds. "Observing customers" is not a methodology, and Perkins describes no reproduceable or testable way of assessing, from consumer behavior, whether a product has acquired secondary meaning. *Gen. Elec. Co. v. Joiner*, 522 U.S. 136, 146 (1997); *Bobcar Media, LLC v. Aardvark Event Logistics, Inc.*, 554 F.Supp.3d 606, 612-613 (S.D.N.Y. 2020), *aff'd*, 839 F. App'x 545 (Fed. Cir. 2021).

The lack of any perceptible method to Perkins' madness is understandable, since her experience in design and her study of consumer perception relates minimally, if at all, to measuring the acquisition of secondary meaning or opine on the *Centaur* factors. While "it is well-settled that, to be an expert, a person need not hold a particular degree or license," *Emig v. Electrolux Home Prods. Inc.*, 2008 WL 4200988, at *5 (S.D.N.Y. Sept. 11, 2008), and that, "Courts within the Second Circuit have liberally construed expert qualification requirements when determining if a witness can be considered an expert." *Lickteig v. Cerberus Cap. Mgmt., L.P.*, 589 F. Supp. 3d 302, 328 (S.D.N.Y. 2022) (internal quotations omitted), Perkins' qualifications do not suggest that she has any background in empirical analysis of consumer behavior. (Dkt. No. 220-1 ¶¶ 4-16). Nor does her resume indicate that she has relevant experience with product marketing or sales, as opposed to industrial design. (Dkt. No. 220-1 at 113-123). While Perkins claims to have experience assessing how ordinary customers evaluate

products based on her employment at Sears, she was employed by Sears as an industrial design consultant and does not purport to have had any involvement in Sears' advertising or sales strategies for the products she helped design. (Dkt. No. 220-1 at 7, 113).

Moreover, the opinions she offers on the factors amount to little more than a colorful narrative of the testimony that will be given by other witnesses, the additive effect of which provides no particular assistance to the jury. "Expert testimony is inadmissible when it addresses 'lay matters which a jury is capable of understanding and deciding without the expert's help.'" *Highland Capital Mgmt. L.P. v. Schneider*, 379 F. Supp. 2d 461, 468 (S.D.N.Y. 2005) (citation omitted). Perkins' opinions about secondary meaning simply rehash the record evidence with an air of authority. For example, Perkins' opines, based on her review of GeigTech's marketing expenditures, that GeigTech's advertising expenditures were "significant." (Dkt. No. 220-1 ¶¶ 113, 121). In so concluding she does nothing more than repeat the views expressed by James Geiger (the head of GeigTech) as well as Plaintiff's other expert, Paul Goldberger. (Dkt. No. 220-1 ¶¶ 105-121). Perkins' "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 evidence from the face of the documents that [she] cites." *Bobcar Media, LLC*, 554 F. Supp. 3d at 614. Perkins serves only "imbue [GeigTech's] arguments with an impermissible gloss of correctness." *Pearlstein v. Blackberry Ltd.*, 2021 WL 4131646, at *4 (S.D.N.Y. Sept. 10, 2021).

Similarly, Perkins does not perform any empirical analysis about whether third parties have attempted to plagiarize GeigTech's designs, or whether its asserted trade dress was exclusive. Her opinions focus entirely on Lutron, which she accuses of plagiarizing GeigTech's trade dress; and her testimony simply narrates the contents of Lutron emails, which will be

introduced into evidence and can be summarized by counsel in closing argument. The “contemporary research” she conducted in order to undergird her opinion about the exclusivity of GeigTech’s trade dress consists of visiting a Lowe’s store, searching for similar products online, reviewing product information from competitor shade companies, attending a webinar hosted by Hunter Douglas (another shade company), and reviewing information produced by GeigTech and Lutron during discovery. (Dkt. No. 220-1 ¶ 131). But research into whether other brands currently offer products with similar trade dress *in 2022* will not help the jury decide whether there were other, similar exposed shading systems on the market *between 2012 and 2017* (the relevant time period for evaluating whether GeigTech’s design attained secondary meaning prior to the introduction of the Palladiom shading system).

In short, much of Perkins’ proposed “testimony” about secondary meaning is more properly delivered by GeigTech’s counsel in closing argument.

However, there is one opinion that Perkins is well-suited to offer based on her significant design experience. Perkins opines that the other shade brackets identified by Lutron as “alternatives” to GeigTech’s system do not look like the GeigTech bracket. While she cannot reach that ultimate conclusion for the jury – she cannot say “this” does not look like “that” – she has relevant expertise in industrial design that qualifies her to explain the differences between the dress of the GeigTech bracket and the supposed “alternatives” identified by Lutron. She is just the sort of person who can opine about distinctions among seemingly similar products, and about how those distinctions appear to professionals in the field (who are customers of these products). The jury is free to reject her testimony based on its own side by side comparison of the various products, but I cannot say that Perkins will not help the jury make that side by side comparison.

3. Opinions Relating to Trade Dress Similarity and Likelihood of Confusion

To establish a likelihood of confusion about the source of the product bearing allegedly infringing trade dress, a plaintiff must show that “numerous ordinary prudent purchasers are likely to be misled or confused as to the source of the product in question because of the entrance in the marketplace of the defendant's mark,” *Gruner + Jahr Printing & Publ'g Co. v. Meredith Corp.*, 991 F.2d 1072, 1077 (2d Cir.1993), “or that there may be confusion as to [the] plaintiff's sponsorship or endorsement of the [defendant's] mark,” *Hormel Foods Corp. v. Jim Henson Prods., Inc.*, 73 F.3d 497, 502 (2d Cir.1996).

In assessing the likelihood of confusion, courts in this Circuit consider the “*Polaroid* factors” articulated by Judge Friendly in *Polaroid Corp. v. Polarad Elecs. Corp.*, 287 F.2d 492 (2d Cir. 1961). Those are: (1) the strength of the plaintiff's mark; (2) the degree of similarity between the plaintiff's and defendant's marks; (3) the competitive proximity of the products sold under the marks; (4) the likelihood that the plaintiff will bridge the gap; (5) actual confusion; (6) the defendant's good faith, or lack thereof, in adopting its mark; (7) the quality of the defendant's product; and (8) the sophistication of the plaintiff's customers. *Time, Inc.*, 173 F.3d at 117; see also *Polaroid*, 287 F.2d at 495.

GeigTech asked Perkins to offer her opinions on each of these factors as they relate to its asserted trade dress. Although consumer surveys are not necessary to prove a likelihood of confusion, in general, a court should not permit testimony about this issue based on “subjective belief or unsupported speculation,” *Wet Seal*, 179 F.Supp.2d at 302 (quoting *Daubert*, 509 U.S. at 590, 113 S.Ct. 2786), and should exclude the sort of lay comparison of products that the average trier of facts can perform without the assistance of an expert witness. *Id.* at 302-303.

With two exceptions, Perkins' opinions relating to trade dress similarity and likelihood of confusion lack any connection to her expertise.

First, Perkins opines that GeigTech's trade dress is strong because she believes it has achieved secondary meaning in the market. (Dkt. No. 220-1 ¶ 145). As discussed above, *supra* at pgs. 40-44, Perkins lacks the expertise to opine on whether GeigTech's trade dress has attained secondary meaning the marketplace, because she fails to undertake any empirical analysis of consumer association with the asserted trade dress, merely summarizes conclusions reached by others and lacks any experience in advertising or sales that might qualify her to opine on GeigTech's advertising expenditures or the sales success of the J Geiger system. Moreover, under the *Polaroid* test, the strength of a mark is determined by its "inherent distinctiveness" or its "tendency to uniquely identify the source of [a] product." *Star Indus., Inc. v. Bacardi & Co. Ltd.*, 412 F.3d 373, 384 (2d Cir. 2005). Whether GeigTech's trade dress has acquired secondary meaning does not, alone, tend to show that it is inherently distinctive in the marketplace. As a result, Perkins' opinion poses a significant risk of confusing the jury about the standard for showing the strength of Plaintiff's trade dress in the marketplace (i.e., that the dress should be considered strong if it has attained secondary meaning).

Second, Perkins opines that "it appears" that GeigTech and Palladiom are direct competitors in the marketplace. (Dkt. No. 220-1 ¶ 179). The fact that the two companies are competitors is an undisputed fact and has been since the outset of this lawsuit, and Perkins is perfectly free to comment on that fact (which is probably necessary background to aspects of her testimony). Perkins does not need to say that "Lutron's own documents confirm that J Geiger is a direct competitor," (*Id.* ¶ 180-183) or to summarize internal Lutron documents that mention J Geiger as a competitor. (*Id.* ¶¶ 181). This is the sort of narrative testimony that is manifestly

unhelpful to a jury. *Bobcar Media, LLC*, 554 F. Supp. 3d at 614. But I will not bar her from observing that the two companies are competitors – if they were not, we would not have spent the past five years litigating.

Third, Perkins opines that Lutron intentionally copied GeigTech’s trade dress when it created the Palladiom system. Inferences about the intent or motive of parties or others lie outside the bounds of expert testimony” because those are “classic jury question[s].” *In re Rezulin Prods. Liab. Litg.*, 309 F. Supp. 2d 531, 547 (S.D.N.Y. 2004); *see also Scott v. Chipotle Mexican Grill, Inc.*, 315 F.R.D. 33, 34 (S.D.N.Y. 2016). Perkins’ testimony on this score consists of conclusory statements such as, “I understand Lutron began taking notice of J Geiger’s novel products and commercial success almost since the inception of the J Geiger Shading System,” and, “It appears that Lutron responded to the customer demand shown above by copying the trade dress for J Geiger’s jamb, end, and center brackets.” (Dkt No. 220-1 ¶¶ 94, 96). This is not appropriate expert testimony. Again, it is summation masquerading as expert testimony.

Fourth, Perkins opines that the record contains evidence demonstrating actual confusion among market participants about the source of the Palladiom shading system. But all she does to support this supposedly expert opinion is regurgitate the contents of images of online social media posts in which individuals comment on the similarities between the two shading systems. Her assertion that “individuals expressed confusion about who originated the design” (*Id.* ¶¶ 187-88) is either apparent from the face of the documents or it is not. It is the province of GeigTech’s lawyers, not its expert, to discuss that evidence and its implications with the jury. The same is true of internal Lutron emails in which shade installation representatives and Lutron dealers comment on the similarities between the Palladiom shading system and the J Geiger shading system (*Id.* ¶¶ 189-91) – grist for the summation mill, with no need for any “expert”

intermediation. Additionally, discussions about the similarities between the two shading systems does not equate with customer confusion between them; Perkins herself admits that, by speaking about the similarities between the two systems, the speakers (who may or may not be actual consumers) tend to indicate that they know exactly who is the source of which product. (Dkt. No. 220-4 at 389:18).

Finally, based on a conversation with Plaintiff's other expert, Paul Goldberger, Perkins opines that actual confusion may be difficult to measure because customers are often brand-agnostic. The fact that actual confusion may be difficult to measure does not mean that actual confusion exists in the marketplace. Indeed, in cases like this one there is frequently evidence of actual confusion – customers who bought, or want to buy, one company's product contacting the other with questions, for example.

In short Perkins adds nothing to the discussion of actual confusion, so her testimony on this point is excluded.

Fifth, Perkins opines that the purchasers in the relevant market are architects, designers, builders, AV integrators, and wealthy homeowners. But the only source for her opinion is her conversations with Paul Goldberger. (*Id.* ¶ 194). We do not need Perkins to tell us what Goldberger said (or is going to say); and her expertise does not cause her to reach this conclusion.

Perkins may, however, testify about two of the *Polaroid* factors: the degree of similarity between the plaintiff's and defendant's dress and the quality of the defendant's product. She is particular well qualified to discuss these issues with the trier of fact.

Perkins is a design consultant with significant experience with the design of window shading products. She is the sort of person who can opine about similarities and differences

between competing products and about how those distinctions appear to professionals in the field (who purchase or recommend these products). While Lutron claims that Perkins does not use any specific methodology to reach her opinions, they are clearly grounded in her long career as a design consultant. This experience amply qualifies her to testify based on his personal, specialized experiences and observations. *See* Fed. R. Evid. 702(a). To the extent Lutron wants to challenge the sufficiency of her experience with shading solutions, it can cross examine her.

While Lutron argues that jurors do not need an expert to tell them whether parties' brackets appear similar to the average consumer, Perkins offers her opinions about the differences from the perspective of a designer (which are, again, a niche group that is a significant customer segment for these products). This is not a perspective that the jurors will necessarily possess. Particularly as GeigTech has consistently insisted that its customer base consists primarily of professionals in the fields of architecture and design, Perkins' can provide the trier of fact with useful testimony. The jury is free to reject her testimony if it conflicts with the jurors' own side by side comparison of the various products.

4. Opinions Relating to the Alleged Infringement of the '717 Patent by the Palladiom End and Center Brackets

GeigTech offers Perkins' opinions about whether the Palladiom end and center brackets infringe the '717 patent. Lutron asserts her opinions should be excluded because Perkins (i) ignores the Court's claim construction of "obscure," (ii) ignores the '717 Patent claims' express requirement that "the bracket" perform the obscuring function and (iii) improperly relies on the doctrine of equivalents as to the "first recess" term. (Dkt. No. 219 at 27).

We can quickly dispatch the third point: GeigTech concedes that it will not offer at trial Perkins' opinion that the recess limitation violates the patent under the doctrine of equivalents.

(Dkt. No. 290 at 29). Accordingly, that testimony cannot be relied on to raise any genuine issue of fact on the summary judgment motions.

Claims 1 and 8 of the '717 Patent (the only independent claims now asserted) both require:

“wherein *the bracket is configured to obscure the electrical wiring* when the bracket is coupled to the support surface and supports the roller window shade assembly”

(Dkt. No. 220-10 at 10:36-41, 12:18-23) (emphases added). During claim construction, this court construed the claim term “configured to obscure the electrical wiring,” to give it its plain and ordinary meaning, which is that “the bracket is configured to hide [the wiring].” (Dkt. 163 at 21). The terms do not, as I stated, include the specific language that only “a view” need be concealed, as was the case with the disallowed claim 15: “Wherein the mounting bracket obscures *a view* of the electrical wiring.” (*Id.* at 18) (internal quotations omitted). As a result, for the purposes of claims 1 and 8, “Wiring that can be seen—from any view—is not ‘obscured’ by the bracket. It is perhaps ‘partly obscured,’ but it is not ‘obscured.’ Therefore, if the wiring can be seen from certain vantage points, it does not fall within the claim language used in claims 1 . . . [and] 8 . . . of the '717 Patent” (Dkt. 163 at 19). Indeed, “complete concealment is embodied in the description of the invention and in every single figure illustrating the detailed description—most especially in Figure 21...” (*Id.* at 21)

Lutron cites several statements made by Perkins at her deposition that it believes shows that she has an erroneous understanding of the claim. (Dkt. No 219 at 28-29). It argues that the court construed the limitation to require the bracket to accomplish the concealment of the wiring, while Perkins’ construction allows for the concealment to be accomplished through a combination of the roller shade and bracket. GeigTech counters that Perkins is applying the

court's construction and that Lutron is now trying to narrow the court's claim construction decision. (Dkt. No. 290 at 27). It argues that Lutron's construction—that the bracket must entirely conceal the wire—contradicts the clear language in the claims stating that the wiring is obscured when “the bracket is coupled to the support surface and *supports the roller window shade assembly*.” (Emphasis added). GeigTech claims that the inclusion of the phrase “supports the roller window shade assembly” means that the claims are practiced when the bracket and roller, in combination, conceal any wiring. As a result, even if the bracket is configured to hide the wiring “on the side of the bracket that is typically not viewable,” the bracket practices the claims. (Dkt. No. 290).

It is GeigTech, not Lutron, that seeks to change the meaning of my claim construction decision. The court was very clear that “if the wiring can be seen from certain vantage points, it does not fall within the claim language,” and that the “complete concealment” of the wires is accomplished “because the bracket is configured to hide them,” not because the roller shade plays any role in the concealment. (Dkt. 163 at 19, 21). This contrasts with claims 9 and 15 of the '821 Patent, in which the “window tube shade” must obscure the fastener— “wherein, when holding a window tube shade, the outer circumferences of each disk-shaped mounting bracket is visible and the fastener *is obscured by the window tube shade . . .*” (Dkt. No. 220-9 at 9:18-19; 10:34-35) (emphasis added). While GeigTech argues that this construction would exclude the embodiment of the claim in Figure 21, I have held previously that Figure 21 illustrates a bracket configured to accept an electrical wire and obscure it through “complete concealment.” (Dkt. No. 163 at 21). The court specifically rejected the interpretation GeigTech now asserts, where the wiring is still visible, albeit from a viewpoint that is not typically seen; I held that “adding the

words ‘from at least one viewpoint’ to the claim language goes well beyond anything claimed by the inventor in the claims here under construction.” (*Ibid.*).

“Where expert testimony is in fact inconsistent with a court's claim construction, it should be excluded under the *Daubert* standard as unreliable, irrelevant, unhelpful, and confusing to the jury.” *Kewazinga Corp. v. Microsoft Corp.*, 2021 WL 4066597, at *3 (S.D.N.Y. Sept. 1, 2021). Here, Perkins repeatedly testifies to an erroneous construction of the limitation. In her deposition, she testified multiple times that a product will practice claims 1 and 8 of the ‘717 where the roller window shade assembly and not the bracket obscures the wires, and where the wire may still be visible from certain angles:

Q: So you believe that a wire that can be seen even when the shade is mounted is still obscured from view under the court’s claim construction?

A: If I am understanding correctly, yes.

Q. That is the understanding that you used when you prepared your reports, correct?

A. Yes, the patent claims talk about obscuring the wire, and this also obscures the wire in a passage.

Q. But it obscures it from some views and not all views, right?

A. Yes.

Q. For the analysis you did that is good enough, correct?

A. Yes.

(Dkt. No. 220-5 at 20:9-22:1) (objections omitted). And again, later in her deposition, she states:

Q: So the next to last limitation it says "wherein the bracket is configured to obscure the electrical wiring when the bracket is coupled to the support surface and supports the roller window shade assembly." You see that right?

A. Yes.

Q. Do you agree with me or not that this claim requires that the bracket be the thing that obscures the electrical wiring?

A. The bracket must do that and when it is -- when the roller shade assembly is in place that must also obscure.

Q. The roller window shade assembly needs to do the obscuring according to this claim?

A. Yes.

(Dkt. No. 220-5 at 111:11-112:2). Perkins’ “understanding” of the court’s claim construction is clearly wrong because it (1) allows for the wires to be visible from certain angles and (2)

assumes the concealment of the wires can be accomplished by the bracket in combination with the roller shade, not simply by the configuration of the bracket. Perkins further testified that she relied on this erroneous understanding in forming her opinions about Lutron's alleged infringement. (Dkt. No. 220-5 at 112:3-6).

Perkins' impermissible construction poses a significant risk of confusing the jury about the requirements of the asserted claims. Accordingly, Perkins' infringement opinions relating to this limitation are excluded.

However, Perkins may offer her opinion that the Palladiom shading system infringes the other limitations of claims 1 and 8 of the '717 Patent. For example, she may testify that the system's end and center brackets comprises a bracket "configured to be coupled to a support surface and configured to support a roller window shade assembly . . ." or have "a second surface extending substantially perpendicular to the first surface, wherein the second surface is configured to extend adjacent an end of the roller window shade assembly . . ." (Dkt. No. 249-6 at 59, 126)

5. Opinions Relating to the Validity and Enforceability of the '717 Patent

Finally, GeigTech offers Perkins' opinions about the validity and enforceability of the '717 Patent. Lutron challenges the admission of opinions on the validity of the patent based on secondary considerations, because Perkins (1) selectively cites certain documents provided to her by counsel, (2) provides improper characterization of this material, and (3) draws conclusions based solely on the provided documents. (Dkt. No. 219 at 10).

Perkins concedes that she only reviewed the discovery provided by Lutron that was given to her by GeigTech's counsel. (Dkt. No. 220-4 at 235:7-11). But Lutron does not identify what

other documents, if any, it believes that Perkins should have considered before reaching her conclusions.

In any case, “Courts have long recognized that the existence of alternative factual scenarios that an expert has not considered in rendering an opinion goes only to the weight and credibility of the expert’s testimony, not its admissibility.” *Media Glow Digital, LLC v. Panasonic Corp. of N. Am.*, No. 16 CIV. 7907 (HBP), 2019 WL 1055527, at *5 (S.D.N.Y. Mar. 6, 2019). Perkins should certainly be cross-examined on her failure to review certain relevant documents (if they exist), but this does not merit exclusion of her testimony. *Daubert*, 509 U.S. at 596.

C. Defendant’s Motion to exclude the opinions of Paul Goldberger is Denied

Plaintiff also offers the opinions of its expert Paul Goldberger in support of its trade dress infringement and unfair competition claims. In his expert report, Goldberger offers his “analysis regarding the relevant market for the J Geiger and Palladiom Shading System[s] and certain relevant factors that concern J Geiger’s claim for trade dress infringement, which also apply to J Geiger’s claim of unfair competition.” (Dkt. No. 210-1 ¶ 3).

Paul Goldberger, a Yale-educated architectural historian, is the former Dean and current Joseph Urban Chair of Design and Architecture at The New School’s Parsons School of Design. (Dkt. No. 210-1 ¶¶ 4-5). As Dean, he oversaw the renowned Product Design Department at Parsons. (Dkt. No. 210-1 at 10:22-11:16). Mr. Goldberger often works as an architecture and design consultant on various projects like the LaGuardia Airport redesign, Tiffany & Co.’s flagship store on Fifth Avenue, and the New York Public Library. (Dkt. No. 210-1 ¶¶ 6, 8). He is hired for his expertise by many organizations like the Barack Obama Foundation and the Lincoln Center. (*Id.* at 100). He has written extensively on design, architecture, and formerly wrote a

monthly column on industrial and product design. (*Id.* at ¶ 9). He was for many years the Chief Architecture Critic for The New York Times; he won a Pulitzer Prize for criticism in 1984.

In response to Lutron’s motion to exclude, GeigTech stipulates that Goldberger will testify only about some of the opinions contained in his report. GeigTech asserts that Goldberger “did not and does not intend to offer an opinion on attempts to plagiarize, sales success, likelihood of confusion, or functionality.” (Dkt. No. 281 at 25). To the extent Lutron seeks to exclude Goldberger’s testimony on those points, its motion is denied as moot.

GeigTech does propose to offer Goldberger’s opinions that (1) GeigTech’s advertising targeted customers in the high-end, exposed shade market; (2) GeigTech was the only participant in that market until Lutron introduced the Palladiom; and (3) surveying that high-end market is not practicable. (Dkt. No. 281 at 7).

Lutron’s motion to exclude that testimony is denied.

1. Opinion that GeigTech’s Advertising Targeted the High-End Market

As already discussed above, one factor considered in determining whether asserted trade dress has acquired secondary meaning in the marketplace is the amount of plaintiff’s advertising expenditures and whether that advertising is directed consumers to the trade dress. After considering the evidence on GeigTech’s efforts to advertise its trade dress and evidence in Lutron’s documents, Goldberger offers two opinions.

The first is that GeigTech’s advertising was addressed to “the key participants in this new market for the new high-end exposed shade market that J Geiger had created: architects, designers, builders, AV integrators, and wealthy homeowners.” (Dkt. No. 210-1 ¶63). The second is that GeigTech’s showrooms are in “cities or regions [that] are all notable for their large percentages of high-income residents, most of whom are highly sophisticated about design. They

are also places in which many influential architects and designers live, and in which a significant number of wealthy clients whose tastes lean particularly toward minimalism and clean-lined modernism reside. In short, these areas are the target market for J Geiger shades.” (Id. ¶¶64-65). Relatedly, Mr. Goldberger notes GeigTech’s focus on conferences and trade shows, events that “draw influential architects, designers, builders, and AV integrators, [shows that they are] the key demographic for J Geiger’s high-ed exposed shading system.” (Id. ¶67).

Lutron argues that, while Goldberger might be an expert on certain design subjects, he lacks the expertise to offer an assessment on GeigTech’s advertising efforts. It further argues that his opinions amount to little more than summary testimony of record evidence. Its arguments are absurd.

Goldberger is an architect, designer and architectural critic of significant note. He has every reason to be familiar with the buying patterns of architects and designers and their clients, because he has long studied and reported on such matters. The opinions Goldberger offers about how GeigTech targets certain types of customers, whether through the placement of advertisements or the location of its showrooms, are exactly the sort of opinions that one would expect from a person with extensive design and architectural experience. And this information is not necessarily within the ken of the lay juror. Therefore, Goldberger’s opinions about the targeting of GeigTech’s advertising, “will likely assist the trier of fact in arriving at the truth” about the efficacy of GeigTech’s advertising expenditures. *Johnson & Johnson Vision Care, Inc. v. CIBA Vision Corp.*, 2006 WL 2128785, at *5 (S.D.N.Y. July 28, 2006) (citation omitted).

This is true even though Goldberger readily admits, “I am not an advertising expert ... I have never worked in the advertising world. It is a subject that interests me, but I claim no professional background in it.” (Dkt. No. 210-2 at 110:19-25, 119:3-6, 186:3-14). But Goldberg

does not purport to offer opinions that require expertise about marketing in general or about the financial aspects of marketing and advertising expenditures. He is explaining how the advertising choices GeigTech made were designed to reach certain consumers — of whom he is one, and whose work he has studied extensively. I will allow the testimony.

2. GeigTech Was the Only Participant in the High-End Market until the Introduction of the Palladiom

Another factor considered in determining whether asserted trade dress has acquired secondary meaning is the length and exclusivity of the trade dress's use. After recounting the history of roller shades and the market landscape before and at the time GeigTech's shading system was introduced, Goldberger concludes that from "2012 to 2017, J Geiger was the only company to offer its unique design for jamb, center, and end brackets." (Dkt. No. 210-1 ¶74). Goldberger also looks at the products that Lutron points to "as having a similar appearance as the trade dress asserted for the J Geiger end bracket" and explains why they do not reflect J Geiger's distinctive trade dress. (*Id.* ¶82.) Specifically, he says, "In my opinion, none of the alternative end brackets cited by Lutron have the same look or feel of the J Geiger brackets. They are comparable only in superficial ways, and the sophisticated designers and clients at whom the J Geiger and Palladiom products are aimed would surely recognize that they are not comparable. There simply was no other product that truly replicated the look and aesthetic as the J Geiger Shading System until the release of Palladiom by Lutron in 2017." (*Id.* ¶82).

Lutron's argument that Goldberger lacks the expertise to offer such opinions is utterly unpersuasive. Indeed, Goldberger is precisely the sort of person who can opine about subtle distinctions among ostensibly similar products and about how those distinctions are perceived by architects and designers and their customers (who are generally influenced by their architects and designers). Goldberger is a design historian and critic. He frequently consults on design projects.

He has deep knowledge of products and a discerning eye for identifying the unique aspects of trade dress, as well as the similarities and differences in the trade dress of different products.

Moreover, his extensive experience as an architectural and design critic means he looks at products in the way that these trained professionals do. His historical explanation of developments in the market for window treatments can provide helpful framing for the jury as they seek to understand why GeigTech's trade dress was purportedly novel when introduced.

While Lutron claims that Goldberger does not use any specific methodology to reach his opinions, that is of no moment in connection with the specific opinions he will offer. They are grounded in his long career as an architectural and design consultant and his observations, as both participant and critic, of developments in the interior design world. This experience amply qualifies him to testify based on his personal, specialized experiences and observations. *See Fed. R. Evid. 702(a)*. To the extent Lutron wants to challenge the sufficiency of Goldberger's experience with shading solutions, it can cross examine him.

Lutron fares no better with its second argument, which is that lay jurors do not need an expert to tell them whether brackets manufactured by third parties do or do not appear similar to GeigTech's brackets. Goldberger will testify about the differences between GeigTech's trade dress and that of competing products from the perspective of an expert in high end design — who is, not incidentally, an intended consumer of such products. While the jury is perfectly free to reject his testimony based on its own side by side comparison of the various products, Goldberger's testimony offers the trier of fact the view from the perspective of the architect/designer, which is not a perspective that the jurors possess. Particularly as GeigTech has consistently insisted that its customer base is primarily professionals in the fields of architecture and design, Goldberger can provide useful testimony.

3. Opinion that Surveying the High-End Market is Not Practicable

Finally, Goldberger contends that it is not practicable to survey the relevant market for GeigTech shades because the “relevant market is too new and too small.” (Dkt. No. 210-1 ¶139). He opines that “the participants most knowledgeable in this market are typically high-end architects, interior designers, or AV integrators who work on projects that often have budgets of more than \$1-million, and often reach to multiples millions of dollars” are unlikely to participate in an online survey. (*Id.* ¶140. Further, he comments that the end customer for GeigTech shading is often brand agnostic, so end customers are not reliable survey respondents. (*Id.* ¶141).

Again, Lutron argues that Goldberger lacks the expertise to offer any criticisms as to the feasibility of conducting survey. In support of this point, it cites Goldberger’s own testimony that he lacks any expertise in survey research or knowledge about the standards for surveys in a trade dress case, and that his statements are based on anecdotal information. (Dkt. No. 210-2 at 110:19-25, 119:3-6, 144:12-19, 186:3-14). It also argues that Goldberger’s testimony lacks credibility because he did not try to conduct a survey to demonstrate his point that one is not practicable.

These arguments are unpersuasive. Based on his knowledge and expertise of GeigTech’s potential customer base, as a professional in the field, Goldberger can offer his opinions about why the participants are unlikely to participate in consumer surveys of the sort used in trade secret litigation. This evidence is relevant to GeigTech’s argument that Franklyn’s and Isaacson’s surveys should not be relied on by the trier of fact. To the extent Lutron questions Goldberger’s assumptions and the conclusions he draws from the evidence he considers, that goes to the weight of his testimony, but it does not mandate its exclusion.

D. Plaintiff’s Motion to exclude the opinions of Dr. Eric Maslen is Granted in Part and Denied in Part

In opposition to GeigTech’s claim of patent infringement, Lutron offers the opinions of its expert, Dr. Eric Maslen. In his two expert reports on non-infringement and invalidity, Maslen opines that (1) Elements 1[a], 1[d] and 1[e]; and Elements 8[c], 8[d], and 8[e] of the ‘717 Patent are not infringed by the Palladiom shading system; and that (2) the asserted claims of the ‘717 Patent are invalid as anticipated or obvious in view of (i) Cid Quintas alone or combined with Fraczek or Nichols, (ii) Kirsch alone or combined with Fraczek, Quill, or Nichols, and (iii) Colson alone or combined with Fraczek, Nichols, or Cid Quintas. (Dkt. No. 218-2 ¶¶177, 202; Dkt. No. 218-1 ¶¶ 21-23).

Lutron seeks to exclude Maslen’s opinions on multiple grounds.

1. Qualifications as Person of Ordinary Skill in the Art

GeigTech first argues that Maslen is not qualified to opine on noninfringement or invalidity because he fails to qualify as a person of ordinary skill in the art (“POSITA”) using his own definition of that term.

“To offer expert testimony from the perspective of a skilled artisan in a patent case—like for claim construction, validity, or infringement—a witness must at least have ordinary skill in the art. Without that skill, the witness' opinions are neither relevant nor reliable. The opinions would not be based on any specialized knowledge, training, or experience that would be helpful to the factfinder.” *Kyocera*, 22 F.4th at 1376-77.

“In determining this skill level, the court may consider various factors including ‘type of problems encountered in the art; prior art solutions to those problems; rapidity with which innovations are made; sophistication of the technology; and educational level of active workers in the field.’” *In re GPAC Inc.*, 57 F.3d 1573, 1579 (Fed. Cir. 1995) (citation omitted). “In a

given case, every factor may not be present, and one or more factors may predominate.” *Ibid.* The level of ordinary skill in the art at the time of the invention is a factual issue. *Id.* at 1577.

Dr. Eric Maslen has been involved in the field of mechanical engineering for more than 40 years. He received a Ph.D. in Mechanical and Aerospace Engineering from the University of Virginia in 1991, has authored hundreds of peer-reviewed articles and numerous book chapters, and has been awarded seven United States patents. (Dkt. No. 218-1 at 281-305). He has been a mechanical engineering professor for decades and has worked in and consulted for industry, including years of work designing machinery. (*Id.*). He has also served as an expert witness in six cases, of which at least two involved patent infringement claims. (*Id.* at 301); *see also Baby Jogger, LLC v. Britax Child Safety, Inc.*, 27 F. Supp. 3d 654, 658 (E.D. Va. 2013); *Pregis Corp. v. Doll*, 2010 WL 11437351, at *1 (E.D. Va. Aug. 10, 2010).

This court has not previously decided who should be considered a POSITA. Both sides propose definitions, and those definitions are similar. GeigTech’s expert, Nancy Perkins, opines in her reports that a POSITA “in the technical field of the ’717 Patent at the relevant time would typically have had (1) 1-2 years of electro-mechanical consumer products [practical experience]; and/or (2) at least an associate’s degree in mechanical engineering, industrial design, or related fields,” but that “more practical experience could also qualify one not having the aforementioned education as a person of ordinary skill in the art while, conversely, a higher level of education could offset a lesser amount of experience.” (Dkt. No. 278-1 ¶¶ 43-44). Meanwhile Maslen’s reports adopt the definition used by the Patent Trial and Appeal Board (“PTAB”) during the patent’s Post-Grant Review (“PGR”), stating that a POSITA “would typically have had 1-2 years of experience designing or installing powered roller blinds or 3-4 years of designing electro-

mechanical consumer products; and at least an associate degree in mechanical engineering, industrial design, or related fields.” (Dkt. No. 218-1 ¶ 75).

When questioned at his deposition about whether he met the qualifications to be considered a POSITA by the PTAB, Maslen clarified that his definition only meant *typically* and that his “rather large — large additional background” and 3-4 years of experience in designing electro-mechanical products would qualify him as a POSITA. (Dkt. No. 218-3 at 22:2-23:5).

It is true that Maslen states that a POSITA would have 1-2 years of experience designing or installing powered roller blinds or 3-4 years of designing electro-mechanical consumer products. Under that strict definition, Maslen does not qualify as a POSITA.

However, Maslen has significant additional qualifications, including advanced degrees in mechanical engineering and experience offering expert testimony for patent infringement suits. Maslen also specifically testified to having five years of experience in industrial design, designing machinery for a private company, the Koppers Corporation. (*Id.* at 15:6-12). While GeigTech claims that Maslen does not qualify as a POSITA because he lacks the minimum level of experience in designing electro-mechanical consumer products or interior architecture, the invention of the asserted patent is a bracket — a bracket configured to obscure electrical wiring for a consumer A/V system, but a bracket, nonetheless. I am satisfied that, notwithstanding his lack of specific experience with roller blinds or electro-mechanical consumer products or interior architecture, there is a sufficient relationship between Maslen’s significant relevant technical expertise and the technology of the claimed bracket for him to offer his opinions as a POSITA. *Mytee Prod., Inc. v. Harris Rsch., Inc.*, 439 F. App’x 882, 887 (Fed. Cir. 2011) (citing *SEB S.A. v. Montgomery Ward & Co.*, 594 F.3d 1360, 1373 (Fed. Cir. 2010)).

2. Construction of “Obscure” Limitation

GeigTech next argues that Maslen’s opinions should be excluded because he fails to apply the court’s construction of the “obscure” limitation for his opinions regarding noninfringement of the ‘717 Patent. This objection is predicated on GeigTech’s erroneous reading of the court’s previously announced construction of the “obscure” limitation in Claims 1 and 8 of the ‘717 Patent — the very erroneous reading that caused the court to strike Nancy Perkins’ testimony about the “obscure” limitation. Since Maslen offers his opinions on noninfringement as rebuttal to Perkins’ infringement opinions, and since those opinions will not be coming in, his testimony on the “obscure” limitation has become unnecessary. *Fin. Guar. Ins. Co. v. Putnam Advisory Co., LLC*, 2020 WL 3582029, at *2 (S.D.N.Y. July 1, 2020); *Luitpold Pharms., Inc. v. Ed. Geistlich Sohne A.G. Fur Chemische Industrie*, 2015 WL 5459662, at *9 (S.D.N.Y. Sept. 16, 2015).⁶

3. Constructions of “Adjacent” and “Extends Away” Limitations

GeigTech also argues that Maslen’s infringement opinions should be excluded because he does not apply the court’s constructions of the “adjacent” and “extends away” limitations in his noninfringement report.

In his noninfringement report, Maslen argues that element 8[c] is not infringed because the Palladiom shading system’s “‘second end’ does not touch or adjoin the identified ‘second surface.’” (Dkt. No. 218-2 ¶197). The claim element describes, “an opening extending through the bracket, the opening having a first end *adjacent* the first surface and a second end *adjacent* the second surface . . .” (emphasis added). Maslen explains that, for the purpose of his

⁶ However, I note for the record that Maslen’s testimony would not otherwise be excluded, because it relies on a correct interpretation of the court’s claim construction. I do not exclude his testimony about the “obscure” limitation on that basis.

infringement analysis, “I understand the ordinary meaning of ‘adjacent’ may imply touching or adjoining, or it could mean something more subjective such as being near to. . . . I understand ‘adjacent’ in this context to mean adjoining.” (Dkt. No. 218-2 ¶197). Maslen argues, in effect, that adjacent cannot mean “near” because it would render the claim meaningless. (*Id.*). Assuming adjacent to mean “adjoining or touching,” he finds that the “second end” does not touch or adjoin the second surface. (*Id.*).

GeigTech asserts that Maslen improperly construes the term “adjacent” — a term for which Lutron did not seek claim construction from the court. (Dkt. No. 216 at 25). Lutron counters that GeigTech also improperly construes the term because, while GeigTech does not state its definition for “adjacent,” its expert, Nancy Perkins, testified that for the purpose of her infringement analysis that “adjacent” merely means “nearby.” (Dkt. No. 277 at 17).

GeigTech also claims that Lutron has forfeited this noninfringement argument because, *inter alia*, it did not disclose it in its interrogatory response on noninfringement. However, the interrogatory response clearly states, “Subject to claim construction . . . Lutron further identifies . . . at least the following claim elements that Plaintiff has failed to support adequately in its infringement contentions... ‘an opening extending through the bracket, the opening having a first end adjacent the first surface and a second end adjacent the second surface...’” (Dkt. No. 218-5 at 5). As a result, Lutron does not assert a new noninfringement argument through a rebuttal expert report on the “eve of trial.”

While GeigTech is correct that there is no reason Lutron could not have raised these claim construction issues earlier, it seems clear to me that neither side understood that the other was interpreting the term “adjacent” differently. “A determination that a claim term ‘needs no construction’ or has the ‘plain and ordinary meaning’ may be inadequate when a term has more

than one ‘ordinary’ meaning or when reliance on a term’s ‘ordinary’ meaning does not resolve the parties’ dispute.” *O2 Micro Int’l Ltd. v. Beyond Innovation Tech. Co.*, 521 F.3d 1351, 1361 (Fed. Cir. 2008). Nor can this court leave this dispute unresolved. “When the parties present a fundamental dispute regarding the scope of a claim term, it is the court’s duty to resolve it.” *O2 Micro Int’l Ltd. v. Beyond Innovation Tech. Co.*, 521 F.3d 1351, 1362 (Fed. Cir. 2008).

The question then is whether “adjacent” truly has more than one ordinary meaning or whether one expert is operating with an erroneous understanding of the term’s meaning. Upon review, it is apparent that the term “adjacent” has more than one ordinary meaning. It can mean adjoining or abutting, or it can mean close to, without necessarily touching.⁷ The question is what the term means in the context of this patent. That requires claim construction.

In his noninfringement report, Maslen also argues that Lutron does not infringe because the Palladiom bracket has a foot, so “[o]nly a portion of the bracket extends away from the support surface.” (Dkt. No. 218-2 ¶¶145-151). The claim language describes “a side configured to bear against the support surface such that *the bracket extends away* from the support surface and is adjacent an end of the roller window shade assembly” (Emphasis added). During claim construction neither party disputed the meaning of the term “extends away;” but they clearly now disagree about what the term means. Again, the now-contested term must be construed.

TNS Media Rsch., LLC v. Tivo Rsch. & Analytics, Inc., 629 F. App’x 916, 938 (Fed. Cir. 2015), is instructive here. In *TNS*, the parties had initially agreed to construe the term “purchase

⁷ “Lying near or close to, but not necessarily touching.” *ADJACENT*, Black’s Law Dictionary (11th ed. 2019); “1a: not distant or far off ...: nearby but not touching . . . b: relatively near and having nothing of the same kind intervening: having a common border: *ABUTTING*, *TOUCHING*: living nearby or sitting or standing relatively near or close together ... c: immediately preceding or following with nothing of the same kind intervening.” *Adjacent*, Webster’s Third New International Dictionary (2002) (cleaned up); “Lying near or close (to); adjoining; contiguous, bordering. (Not necessarily touching, though this is by no means precluded.)” *Adjacent*, Oxford English Dictionary (Second Edition 1991).

data” as “data describing the purchase of a particular product at a given time...” *Id.* However, at the summary judgment stage, the parties disagreed about how the phrase “at a given time” should be construed. *Id.* The district court construed the stipulated construction to resolve the pending summary judgment motion without further input from the parties. *Id.* The Federal Circuit found this procedure improper because the parties were not afforded the opportunity to present their own claim construction arguments before the district court sua sponte decided the claim construction issue.

The parties are directed submit claim construction briefs and supporting materials that will allow the court to construe the meaning of the contested terms “adjacent” and “extends away.” Those briefs are due by close of business on October 5.

Since we are on the eve of trial in this very old case, I will not follow my usual rule that claim construction arguments be limited to intrinsic evidence in the first instance. However, the parties should first argue that intrinsic evidence supports their proposed construction, and then argue that extrinsic evidence (which may include testimony from persons skilled in the art concerning the meaning commonly applied to the word “adjacent” by such persons) does so. I will rule based on intrinsic evidence if I can, and resort to consideration of extrinsic evidence only if I cannot. There will be no additional discovery taken on this matter; cross examining witnesses at trial about matters not previously the subject of questioning can be fun as well as instructive.

When I issue an opinion on claim construction, I will make a final ruling on whether any of the proposed expert testimony about “adjacency” or “extending away” will be allowed or excluded.

Finally, GeigTech asserts that Maslen improperly uses different constructions of the “obscures,” “extends away,” “recess,” and “adjacent” limitations in his invalidity and noninfringement reports. Since claim terms must be “construed the same way for both invalidity and infringement,” *Amgen Inc. v. Hoechst Marion Roussel, Inc.*, 314 F.3d 1313, 1330 (Fed. Cir. 2003), it argues that all his opinions must be excluded.

Lutron concedes that the constructions Maslen uses in his invalidity report differ from those used in his infringement report. However, it asserts that, in assessing invalidity, Maslen used what he understands to be GeigTech’s interpretation of the claim scope to analyze whether prior arts anticipate the asserted claims of the ‘717 Patent — a form of analysis endorsed by the Federal Circuit in *01 Communique Lab., Inc. v. Citrix Sys., Inc.*, 889 F.3d 735, 741-43 (Fed. Cir. 2018). (Dkt. No. 277 at 10-13).

In *Communique*, the defendant argued at trial that the patentee had “relied upon an ‘overbroad application’ of its claims to ensnare” defendant’s design. *Id.* at 743. However, it argued that under this “overbroad application” the patent was invalid, because “the asserted claims would also cover [the prior art].” *Ibid.* The plaintiff appealed the jury verdict of noninfringement, arguing that the trial court had improperly permitted the Defendant to raise a “practicing the prior art defense” to its infringement claim. *Id.* at 741. A practicing the prior art defense entails “compar[ing] the accused infringing behavior to the prior art in an attempt to prove that its conduct is either noninfringing or the patent is invalid as anticipated because the accused conduct is simply ‘practicing the prior art.’” *Cordance Corp. v. Amazon.com, Inc.*, 658 F.3d 1330, 1337 (Fed. Cir. 2011).

While the Federal Circuit agreed that it has long held that “there is no ‘practicing the prior art’ defense to literal infringement,” it clarified that a defendant is not precluded “from

arguing that if a claim term must be broadly interpreted to read on an accused device, then this same broad construction will read on the prior art.” *Communique*, 889 F.3d at 742. Accordingly, the Federal Circuit held that the Defendant’s argument was proper and “correctly recognized that claim terms must be ‘construed the same way for both invalidity and infringement.’” *Id.* at 743.

Maslen uses *Communique*-style analysis of whether prior arts anticipate the ‘717 patent “extends away,” “recess,” and “adjacent” limitations as asserted by GeigTech. For example, in explaining the assumptions underlying his analysis of the prior art Cid Quintas, he opines:

In reaching this conclusion, I assume that J Geiger’s apparent infringement contentions carry at least two relevant implications: 1) that “bracket” (under J Geiger’s apparent interpretation of the term in its infringement contentions) may include associated covers; and 2) that, under J Geiger’s apparent interpretation of the claim language, the wire need not be obscured by the bracket alone but, according to J Geiger’s infringement contentions, this obscuring may be accomplished by the combination of bracket and installed roller window shade assembly.

(*Id.* at 110-11).

In essence, Lutron’s first defense is that the accused product does not infringe the claims of the ‘717 patent. However, it asserts that GeigTech has expanded the scope of its patent claims in its infringement contentions to cover the features of the Accused Products. So it argues in the alternative that, under the broader applications, the patent is invalid in light of prior art. There is nothing improper about these arguments; it was exactly the approach approved in *Communique* to allow an accused infringer to counter a patentee’s efforts to twist a patent “like a nose of wax . . . one way to avoid anticipation and another to find infringement.” *See Amazon.com, Inc. v. Barnesandnoble.com, Inc.*, 239 F.3d 1343, 1351 (Fed. Cir. 2001).⁸

⁸ While *Communique* allows this invalidity argument, the Federal Circuit also distinguished this argument from the “practicing the prior art” defense to infringement. *Communique*, 889 F.3d at 742. The Federal Circuit emphasized this distinction because it was concerned defendants would “skirt evidentiary hurdles and conflate the infringement and invalidity inquiries.” *Id.* The Court cautions Lutron to avoid conflating invalidity and infringement when arguing and eliciting evidence about the J Geiger system.

4. Disclosure of Opinions in Expert Report and Disclosure of Elements in Prior Art References

Finally, GeigTech argues that Maslen’s invalidity report fails to include a complete statement of all opinions he will express, and his invalidity opinions fail to detail how each claim element is disclosed in the prior art references.

In his invalidity report, Maslen opines that the asserted claims of the ‘717 Patent are invalid as anticipated or obvious in view of Cid Quintas. In support of this position, he adopted the interpretation that “that the support structure identified as “bracket (12)” as well as any attached accessories such as “decorative outer cap (13)”, “enclosing housing or casing (14)”, and “prismatic cross-shaped nipple (15)” collectively comprise the “bracket” as the term is used in J Geiger’s infringement contentions.” (Dkt. No. 218-1 ¶ 254). GeigTech argues that, because he fails to include support (26) as part of his “bracket,” he may not offer testimony that it is part of the bracket at trial.

However, as already discussed, preclusion is a discretionary remedy for non-disclosure. And in determining whether preclusion is appropriate, a court is directed to consider: (1) the party's explanation for the failure to disclose; (2) the importance of the evidence to be precluded; (3) the prejudice suffered by the opposing party if the evidence were not precluded; and (4) the possibility of a continuance. *See Patterson v. Balsamico*, 440 F.3d 104, 117 (2d Cir. 2006).

Maslen explains that he did not include support (26) explicitly within his report because he intended for it to be captured by the phrase “any attached accessories,” since it, like the “cross-shaped nipple” (15), is a structural element without which the bracket would not be functional. (Dkt. No. 218-1, ¶ 254; Dkt. 218-3, 78:3-11; 83:13-21). Maslen’s use of the phrase “such as” means that he was not necessarily mentioning all “attached accessories,” but rather providing examples of “attached accessories.”

GeigTech does not agree that support (26) qualifies as an “attached accessory,” because support (26) attaches to the roller shade, not the bracket. But that difference of opinion does not justify preclusion.

Neither does Maslen’s failure to disclose everything that, in his opinion, was an “attached accessory.” I would of course preclude if GeigTech had been prejudiced by any failure to disclose, but it has not been prejudiced. In fact, GeigTech actually deposed Maslen on this very subject and asked him, *inter alia*, whether (26) was a component of his “bracket” (which he confirmed) and how he understands the wire to interact with support (26) and run through the bracket . (Dkt. 218-3 at 78:3-11, 79:22-80:5, 82:19-22, 83:13-21, 91:5-7, 92:2-5). There is, therefore, no basis to preclude Maslen’s opinion.

GeigTech also argues that several of Maslen’s opinions on the prior art references amount to little more than conclusory statements based on undisclosed assumptions. For example, Maslen states that Cid Quintas anticipates the “passage limitation,” explaining that the wire leaves the motor and enters the area [he] identified as the ‘passage.’” (Dkt No. 218-1 ¶266; Dkt. No. 218- 3 at 93:10-94:17. However, at his deposition, Maslen admits that “Cid Quintas just shows the wire coming out of the motor, yes, and doesn’t explicitly show how it gets through the bracket” and that “Cid Quintas doesn’t say that the wire has to go through the bracket.” (Dkt. No. 218-3 at 74:25-75:8) He also makes certain assumptions, such as “[t]he wire exits the end of the roller ... so I assume it folds up between 260 and the end of the roller shade.” (*Id.* at 80:24-82:22).

“[A] prior art reference may anticipate without disclosing a feature of the claimed invention if that missing characteristic is necessarily present, or inherent, in the single anticipating reference.” *Schering Corp. v. Geneva Pharms.*, 339 F.3d 1373, 1377 (Fed. Cir.

2003). Maslen provides substantial detailed analysis about the “passage” in the Quintas’ bracket. (Dkt. No. 218-1 ¶¶ 261-267). To the extent Quintas does not expressly disclose the routing of wiring through the bracket, Maslen argues that a POSITA would recognize that the routing would naturally follow from the design. Maslen’s opinions and testimony have sufficient factual foundation; any disagreement GeigTech has with the underlying factual assumptions and conclusions reached by Maslen goes to weight, not admissibility. *ActiveVideo*, 694 F.3d at 1333.

While GeigTech asserts it is prejudiced by this failure to disclose because it did not have reasonable opportunity to prepare for effective cross-examination and its expert could not respond to these aspects, GeigTech made no motion to amend its expert’s report and it did not seek an additional opportunity to depose the witness in light of these allegedly new disclosures.

GeigTech also claims that inherency cannot save Maslen’s opinions because Maslen was clear he was not relying on inherency, and in fact didn’t know what inherency even is. (Dkt. No. 218-4 at 385:9-13; 386:11-24). Indeed, when questioned about how he interpreted claim language, Maslen agreed that he testified based on how a POSITA would understand those terms. (*Id.*) But Maslen does not need to know that he is relying on inherency (a legal concept) for him identify a feature as inherent from the perspective of a POSITA. Accordingly, preclusion on this basis is not warranted.

With one exception, the rest of GeigTech’s arguments for why opinions of Maslen ought to be excluded go to the weight to be accorded his testimony and are fair game for cross examination. The one bit of Maslen’s proposed testimony that should be excluded is his opinion that Colson’s bracket “obscures” the wire because element 228, “probably has a vertical groove the wire lays into in order to be able to allow the wire to make it up to the receptable” (Dkt. No.218-3 at 172:1-173:19). Maslen did not rely on element 228 in any way in his report. And at

his deposition, Maslen admitted that Colson does not actually disclose that element 228 has a vertical groove. (*Id.*). Instead, he arrived at his conclusion that 228 could obscure in his deposition. An expert cannot offer a new opinion based on previously undisclosed assumptions for the first time in a deposition. Accordingly, Maslen's opinions that Colson's bracket obscures the wire must be excluded.

Finally, GeigTech argues that Maslen's obviousness analysis is conclusory and fails to identify a motivation to combine. It contends that Maslen relies on an assumed market urge to provide the motivation to combine the prior art references and that he never explains how he would modify the prior art references to arrive at the patented inventions.

Obviousness is shown when "a skilled artisan would have been motivated to combine the teachings of the prior art references to achieve the claimed invention, and that the skilled artisan would have had a reasonable expectation of success in doing so." *Procter & Gamble Co. v. Teva Pharmaceuticals USA, Inc.*, 566 F.3d 989, 994 (Fed. Cir. 2009). "Though less common, in appropriate circumstances, a patent can be obvious in light of a single prior art reference if it would have been obvious to modify that reference to arrive at the patented invention." *Arendi S.A.R.L. v. Apple Inc.*, 832 F.3d 1355, 1361 (Fed. Cir. 2016) (citations omitted). As the Federal Circuit has explained, "knowledge of a problem and motivation to solve it are entirely different from motivation to combine particular references." *TQ Delta, LLC v. CISCO Sys., Inc.*, 942 F.3d 1352, 1360 (Fed. Cir. 2019) (internal quotations and citations omitted).

Maslen notes throughout his report how common it was at the time of the alleged invention to route the electrical wiring of consumer electronics in a manner that hides it from view. (Dkt. No. 218-1 ¶¶ 112-18). Moreover, there was ample patent literature available to a POSITA, such as Mitsuhiro, to accomplish the concealment of wiring by routing it through a

stamped metal bracket. (*Id.* ¶¶ 329-30). “The interrelated teachings of multiple patents; the effects of demands known to the design community or present in the marketplace; and the background knowledge possessed by a person having ordinary skill in the art . . . [can show] there was an apparent reason to combine the known elements in the fashion claimed by the patent at issue.” *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 418 (2007). Between the existing market demand for wire-concealment in consumer electronics, and the existing literature at the time, Maslen provides a sufficient factual basis for opining that a POSITA would have reason to combine the known elements in the fashion claimed by the patent at issue.

While GeigTech contends that Maslen never identifies how he modifies the reference to arrive at the patented invention, the only example for this “conclusory” discussion, his discussion of the asserted passage in Quintas, clearly includes analysis of how a POSITA might be inclined to modify the prior art. Specifically, he opines that:

“[I]t would be obvious to a POSA that, if it were desired to have two or more window shade roller assemblies installed along the same axis with minimal space between adjacent assemblies, brackets (12) and covers (14) . . . could be installed back-to-back to achieve this A POSA would understand this configuration to be a simple solution that would require little experimentation yet yield predictable results. In other words, it would be a minor step for a POSA to realize that this back-to-back combination of brackets could be merged into a single double sided bracket were this arrangement to be deemed preferable.”

(Dkt. No. 218-1 ¶ 286). I am satisfied Maslen states with sufficient specificity how the prior art could be modified to arrive at the patented invention. As ever, arguments that the expert's assumptions “are unfounded go to the weight, not the admissibility, of the testimony.” *Robinson v. Suffolk Cnty. Police Dep't*, 544 F. App'x 29, 32 (2d Cir. 2013) (quoting *Boucher v. U.S. Suzuki Motor Corp.*, 73 F.3d 18, 21 (2d Cir.1996)) (internal quotation marks omitted).

E. Plaintiff's Motion to exclude the opinions of Joel Delman is Granted in Part and Denied in Part

To support its claim of trade dress infringement, GeigTech offers the opinions of both Paul Goldberger and Nancy Perkins. To counter those opinions, Lutron offers the rebuttal opinions of its own trade dress expert, Joel Delman. (Dkt. No. 237-2).

Delman has over 28 years of experience in product and brand development as an industrial designer, design strategist, consultant, and inventor. (Dkt. No. 237-2 ¶ 7). He is a named inventor of over 40 issued or applied-for utility and design patents. (*Id.* ¶ 17). He has served as an expert in over 20 cases related to design patents and product configuration trade dress and has testified in eleven cases at the time of his report, four of which related to trade dress (*Id.* ¶ 20; Dkt. No. 280-10).

In his report, Delman provides his opinions about (1) the inconsistent and selective definition of GeigTech's alleged trade dress; (2) the functionality of GeigTech's trade dress; (3) his critiques of GeigTech's experts' opinions on various secondary meaning factors; and (4) his critiques of the GeigTech's experts' opinions on various factors related to likelihood of confusion and trade dress similarity.

1. Opinions Relating to GeigTech's Trade Dress Definition

Delman opines that the Plaintiff's trade dress definition is invalid because it fails to identify or describe its elements with sufficient specificity. To reach this conclusion, he first provides a list of twelve attributes that he "distills" from the trade dress description in Plaintiff's amended complaint. (Dk. No. 237-2 ¶ 72). His analysis then consists primarily of statements describing what it is about the attribute or the component of the trade dress definition that he believes is vague or undefined. (*Id.* ¶¶ 73-92).

An expert opinion that “is connected to existing data only by the ipse dixit of the expert” need not be admitted. *Gen. Elec. Co. v. Joiner*, 522 U.S. 136, 144 (1997). There must be a “sufficiently rigorous analytical connection” between an expert’s methodology and conclusions. *Nimely v. City of New York*, 414 F.3d 381, 396 (2d Cir. 2005). An expert who offers “no analysis beyond highlighting aspects of the record that he finds important and demonstrating how it satisfies the legal standards he sets out” must be excluded “[b]ecause the jury would be engaging in the same process when assessing [the] claims, [which] is impermissible ipse dixit testimony.” *Bobcar Media, LLC v. Aardvark Event Logistics, Inc.*, 554 F.Supp.3d 606, 612-613 (S.D.N.Y. 2020), *aff’d*, 839 F. App’x 545 (Fed. Cir. 2021).

“[A]n expert basing his opinion solely on his experience must do more than aver conclusorily [sic] that his experience led to his opinion: ‘[i]f the witness is relying solely or primarily on experience, then the witness must explain how that experience leads to the conclusion reached, why that experience is a sufficient basis for the opinion, and how that experience is reliably applied to the facts.’” *523 IP LLC v. CureMD.Com*, 48 F. Supp. 3d 600, 643 (S.D.N.Y. 2014) (internal citations and quotations omitted).

Delman’s conclusion that Plaintiff’s trade dress definition is insufficiently specific lacks a connection to any methodology. While rebuttal experts, “have a less demanding task because they have no burden to produce models or methods of their own; they need only attack those of plaintiff[s] expert,” *In re Digital Music Antitrust Litig.*, 321 F.R.D. 64, 78 (S.D.N.Y. 2017), Delman’s commentary still must be rooted in some sort of analysis or expertise. Delman’s purported analysis amounts to little more than lay criticisms that the definitions of certain trade dress elements are vague or ambiguous.

For example, Delman observes that part of GeigTech’s asserted trade dress for its center and end brackets is a “U-shaped element.” (Dkt. No. 237-2 ¶ 77). He opines that this element is insufficiently specific because:

“A “U-shaped element” is even less descriptive of an ornamental appearance, and describes an even broader range of potential appearances, than the “circular element” discussed above. How long is the “U”? Is it open at the top, like a letter? Solid throughout? Merely a thin, metal outline of the outer edge? What if both sides of the U are not parallel?”

(*Ibid.*). Delman’s commentary bears no connection to his purported expertise in industrial design but consists of the sort of basic parsing of trade dress language that is expected of the jury, not an expert. Delman offers no explanation of how his expertise “leads to the conclusion reached.” 523 *IP LLC*, 48 F. Supp. 3d at 643.

Expert testimony is inadmissible when it addresses ‘lay matters which a jury is capable of understanding and deciding without the expert’s help.’” *Highland Capital Mgmt. L.P. v. Schneider*, 379 F. Supp. 2d 461, 468 (S.D.N.Y. 2005) (citation omitted). The jury is perfectly capable of evaluating the language of the asserted trade dress and evaluating whether it is sufficiently specific or descriptive without Delman’s assistance. Indeed, Delman’s expert testimony has been excluded in other cases for this very reason. *Lanard Toys Ltd. v. Anker Play Prod., LLC*, 2020 WL 6873647, at *4 (C.D. Cal. Nov. 12, 2020).

Accordingly, Delman’s opinions that Plaintiff’s definition of its trade dress lacks sufficient specificity are excluded in their entirety.

2. Opinions Relating to the Functionality of GeigTech’s Trade Dress

Delman also offers his opinion that— based on his review of GeigTech’s utility patents, third-party utility patents, Plaintiff’s litigation before the PTAB, and Nancy Perkins’ expert report—the alleged trade dress is essential to the use and purpose of the GeigTech’s shade

brackets. (Dkt. No. 237-2 ¶ 40). He also opines that the definition of the alleged trade dress describes a general appearance that is common and generic in the marketplace, such that granting Plaintiff “exclusive use [] would significantly limit the range of alternative designs that could be offered by competitors.” (*Ibid.*).

GeigTech argues that Delman’s opinions on trade dress functionality lack any analysis or showing of an analytical method. (Dkt. No. 236 at 26). It further argues that his opinions are unreliable because he relies on an erroneous understanding of the law regarding functionality of trade dress. Specifically, Delman opines that, “Counsel also explained to me that the Supreme Court has held that when evidence includes a utility patent that claims product features also claimed by trade dress, it is unnecessary to consider evidence relating to the availability of alternative designs.” (Dkt No. 237-2 at ¶ 101). GeigTech contends this understanding is at odds with the Supreme Court’s opinion in *TrafFix Devices, Inc. v. Mktg. Displays, Inc.*, 532 U.S. 23, 33-34 (2001), which states that a party seeking trade dress protections for features found in utility patents could “prove that those aspects do not serve a purpose within the terms of the utility patent.”

While I agree that defense counsel’s explanation of the Supreme Court’s holding in *TrafFix* is wrong,⁹ I do not find GeigTech’s arguments for excluding Delman’s testimony on functionality any more persuasive than I found Lutron’s arguments for excluding Perkins’ testimony on the same subject. In particular, Delman’s description of how the “alleged trade dress is essential to the use and purpose of GeigTech’s shades or affects the cost or quality of the

⁹ The case actually holds that even if there has been no previous utility patent for a product, the party asserting trade dress infringement still has the burden to show the nonfunctionality of the alleged trade dress features of the product. *TrafFix Devices, Inc. v. Marketing Displays, Inc.*, 532 U.S. 23, 32 (2001).

products,” is classic expert testimony concerning functionality. Delman offers opinions on how each element of the claimed trade dress provides utilitarian benefits in that they help minimize light gaps, permit the window shade to work better, prevent damage to the shade, and allow for greater mounting flexibility, amongst other benefits (*Id.* ¶¶ 188-208). These opinions are perfectly appropriate rebuttal opinions to Perkins’ opposing view that certain trade dress elements provide no utilitarian function. While GeigTech claims these opinions lack a clear methodology, Delman clearly relies on his experience to arrive at his opinions — exactly the “methodology” used by Perkins. *Emig*, 2008 WL 4200988, at *8. Delman can most certainly offer his opinions on the utilitarian functionality of certain trade dress elements.

Additionally, as to aesthetic functionality, Delman addresses the widespread third-party use of rounded and U-shaped elements and the desirability of clean, minimalist, unobtrusive, and exposed hardware in interior design. (Dkt. No. 237 ¶¶ 209-43, 249-51). Drawing upon his experience as a product designer, Delman opines that the GeigTech’s asserted trade dress effectively seeks to monopolize minimalist window shade design. (*Id.* ¶ 219).

“The scope of a rebuttal is limited to the same subject matter encompassed in the opposing party’s expert report, but district courts have been reluctant to narrowly construe the phrase ‘same subject matter.’” *Capri Sun GmbH v. Am. Beverage Corp.*, 595 F. Supp. 3d 83, 138-39 (S.D.N.Y. 2022) (quoting *Scott v. Chipotle Mexican Grill, Inc.*, 315 F.R.D. 33, 44 (S.D.N.Y. 2016)). Delman offers relevant opinions on the aesthetic functionality of the asserted trade dress. To the extent that his opinions do not respond to specific opinions of Plaintiffs’ experts, they reasonably respond to the same subject matter discussed by Plaintiffs’ experts.

GeigTech’s other specific objections to aspects of Delman’s proposed testimony — notably to his opinions relating to utility patents — can be the subject of cross examination.

3. Opinions Critiquing GeigTech’s experts’ opinions on factors related to secondary meaning and likelihood of confusion.

Delman also critiques Nancy Perkins’ and Paul Goldberger’s opinions on factors related to secondary meaning and likelihood of confusion. This court has excluded certain opinions of Nancy Perkins relating to secondary meaning and likelihood of confusion. However, it has allowed her to offer certain opinions relating to product similarity. It has also allowed GeigTech’s expert Goldberger to offer certain opinions as to the likelihood of confusion. Accordingly, Delman may offer his rebuttal opinions on these subjects. While GeigTech argues that Delman’s discussion of third-party brackets is not proper rebuttal because it does not respond to the exact opinions of Plaintiff’s experts, it reasonably responds to the same subject matter and is proper rebuttal. *Capri Sun GmbH v. Am. Beverage Corp.*, 595 F. Supp. 3d 83, 138-39 (S.D.N.Y. 2022) (quoting *Scott v. Chipotle Mexican Grill, Inc.*, 315 F.R.D. 33, 44 (S.D.N.Y. 2016)).

F. Defendant’s Motion to exclude the opinions of Jeffrey Baliban is Denied

In his expert report, GeigTech’s damages expert, Jeffrey L. Baliban, calculates a reasonable royalty that would compensate GeigTech for Lutron’s alleged infringement of the Patents-in-Suit and the amount of profits that should be disgorged from Lutron to compensate GeigTech for Lutron’s alleged infringement of its trade dress and its unfair competition. He “conclude[s] that, with regard to Lutron’s past infringement of the Patents-in-Suit, J Geiger is entitled to damages in the form of a reasonable royalty in the amount of \$2,786,864, representing a royalty rate of 14.86 percent” and “with regard to Lutron’s infringement of J Geiger’s trade dress as well as for Lutron’s unfair competition, J Geiger is entitled to disgorgement of Lutron’s profits on Palladiom Shading System revenue of \$35,004,803, generated from August 2017

through October 2022” (total, for both the wired and wire-free versions of the Palladiom Shading System).

Lutron seeks to exclude Baliban’s opinions relating to a reasonable royalty for the alleged patent infringement, but it does not move to exclude his opinions on the disgorgement of profits for the alleged trade dress and unfair competition claims. Lutron seeks to exclude Baliban’s reasonable royalty opinions on multiple grounds. All of them go to the weight; none persuasively suggests preclusion. Therefore, Lutron’s motion to preclude any of Baliban’s testimony is denied.

G. Plaintiff’s Motion to exclude the opinions of Daniel P. Werner is Denied

For its claim of trade dress infringement, GeigTech seeks disgorgement of Lutron’s profits from sales of the Palladiom shading system. At trial, GeigTech plans to offer the opinions of its damages expert Jeffrey L. Baliban, on (1) the amount of Lutron’s profits attributable to sales of the Palladiom Shading System and (2) the categories of expenses and costs that Lutron should not be allowed to deduct from the disgorgement calculations.

In opposition, Lutron offers the rebuttal opinions of its own damages expert, Dr. Daniel P. Werner. (Dkt. No. 223-1). In his report, Werner provides his opinions about (1) the portion of the Palladiom Shading System profits attributable to the alleged trade dress and (2) the expenses that should be deducted from Lutron’s Palladiom Shading System revenue and his opinions. GeigTech seeks to exclude some of those opinions.

GeigTech argues that Werner improperly opines (1) that GeigTech bears the burden of proving the portion of Palladiom profits attributable to the alleged trade dress and (2) that Baliban’s testimony is flawed because it instead assumes that Lutron bears the burden of apportionment. (Dkt. No. 222 at 7-12). But Lutron does not dispute that it bears the burden of

apportionment, (Dkt. No. 275 at 12), and Werner claims that he did not intend to opine otherwise. (Dkt. No. 223-2 at 12:15-25; 14:3-15:9; 17:7-23; 22:16-23:2). This argument thus drops from consideration.

GeigTech also asserts that Werner uses an unreliable methodology and data to calculate what portion of Palladiom shading system revenue is attributable to GeigTech's alleged trade dress. Specifically, it contends (1) that Werner's analysis fails to establish that GeigTech's trade dress was not a substantial factor in purchaser decisions, (2), that Werner improperly relies on unreliable cost and pricing data provided by Lutron to inform his analysis and (3) that his "price-based" analysis for apportionment does not provide any basis for concluding that Lutron would have sold Palladiom shading systems without the presence of GeigTech's infringing trade dress. It does not dispute Werner's selected costs that he deducts from the apportioned revenue (namely, the cost of goods sold, engineering and development expenses, and marketing, sales and commission expenses).

All of this goes to the weight of Werner's testimony and should be the subject of cross examination.

First, Lutron is not required to show that trade dress was not a substantial factor in purchaser decisions to argue that certain profits should not be disgorged. As GeigTech concedes, neither the Supreme Court nor the Second Circuit has ever set out any test or standard for apportionment. (Dkt. No. 300 at 7). As long as Werner offers a reasoned methodology for the attribution of profits — and he does — he can opine that a certain portion of the profits should not be disgorged.

Second, Lutron's internal data is sufficiently reliable to serve as the basis for Werner's calculations. Dr. Werner relied on data generated by Lutron in the ordinary course of its business

and exported from its ERP system. GeigTech's argument that it is not sufficiently reliable is meritless. GeigTech's own expert, Jeffrey Baliban, relies on this data for his analysis, and GeigTech assumes the data's reliability for that purpose. (*See* Dkt. No. 276-2 at 7 (citing LUT-GT0063095-97); Dkt. No. 276-3 at 11 (citing LUT-GT0063095-97); Dkt. No. 276- 8 at 195:11-14, 196:14-197:5). The ERP data came from the company's records and created in the ordinary course of business. It is also the same data used by the accounting team for its audited financial statements. (Dkt. No. 223-1 ¶ 61 n. 168). Courts in this circuit have consistently allowed the testimony of experts relying on internal company data, on the ground that any issues with the underlying data goes only to the weight that should be afforded their testimony but not its reliability. *See e.g., Car Freshner Corp. v. Am. Covers, LLC*, 2021 WL 4502281, at *9 (N.D.N.Y. Sept. 30, 2021); *Lee Valley Tools, Ltd. v. Indus. Blade Co.*, 288 F.R.D. 254, 267 (W.D.N.Y. 2013). Whether Werner's factual assumptions support his conclusion is appropriate fodder for cross-examination but is not a ground for exclusion. *Discover Fin. Servs. v. Visa U.S.A., Inc.*, 582 F. Supp. 2d 501, 507 (S.D.N.Y. 2008).

Third, Werner's methodology for calculating the profits attributable to the sale of the offending brackets is sufficiently reliable. The Palladiom shading system is a custom and configurable system. (Dkt. No. 223-1 ¶ 44 n.116). It comes in custom sizes and a range of fabrics and finishes. (*Ibid.*) One of the many selections a customer can make is the type of bracket, meaning the customer chooses whether his custom shading system includes the infringing trade dress. (*Id.* ¶ 44 n.115). Since the shades are a configured product, the price is also configured, meaning the different finishes or fabrics command different prices. (*Ibid.*) Lutron keeps track of all of these price components and can break down the price of a configured

product into the constituent parts—i.e., which parts of the price are attributable to which parts of the shade. (*Id.* ¶ 44)

Dr. Werner summed the “revenues attributable to the brackets-at-issue when sold individually and as part of the Palladiom Shading System,” in the ERP data and determined that \$6.1 million of Palladiom sales revenue is attributable to the alleged infringement of the asserted trade dress. (*Id.* ¶¶ 44, 46). To confirm the reasonableness of this figure, he also compared the sales and profits from the Palladiom system to the sales and profits from the non-infringing Sivoia shades. (*Id.* ¶ 47). Since Baliban calculated the average price of the Palladiom wired shade assembly was \$905 and the average price of the Sivoia shades was \$700, Werner calculates that the maximum value of the trade dress attributable to the accused products is \$205 per shade assembly, or 22.7% of the average Palladiom window shade revenue. As a result, the maximum total revenue attributable to the infringement could not exceed \$8.6 million (far below Baliban’s calculation of \$35 million of revenue attributable to the alleged trade dress).¹⁰ He then subtracted the COGS and other incremental costs attributable to these revenues and determined that Lutron’s profits attributable to the alleged trade dress infringement would not exceed \$518,416. (*Id.* ¶ 77).

GeigTech spills a lot of ink over the fact that Dr. Werner is not familiar with the details of the formula in Lutron’s internal system for calculating the revenue attributed to the brackets. However, GeigTech misses the point. Werner’s report repeatedly cites to Glenn Lavery’s deposition transcript, in which he explains how the pricing formula works. (*See, e.g.*, Dkt. No. 223-1 ¶ 44 ns.114-15). Lavery states explicitly that the “shades are a configured product, which

¹⁰ 22.7% * (\$33.4 million total revenues from wired and wire-free Palladiom Shade Assemblies + \$1.2 million total revenues from Sales Kits) + \$0.7 million total revenues from brackets sold individually = \$8.6 million.

means that pricing for the shade is also configured, and so there's basically a formula that sets what that -- that price would be depending on the options that customer has selected.” (Dkt. No. 276-6 249:3-7). It does not matter whether Werner knows why the individual components are priced a certain way; he knows what portion of the price for a custom shading system is attributable to the accused components, so he can calculate the revenue attributed to the sale of the brackets as a part of the custom shading system. If selecting the accused brackets adds \$114 to the price of the custom shading system, the revenue from the sale attributed to the accused brackets is \$114.

Put another way, if I go to an ice cream shop and order a sundae, I have a lot of options for toppings. The sundae with a cherry costs \$10 and the sundae without a cherry costs \$8. Why the shop would charge so much for a little cherry is unclear. But it is perfectly clear that the ice cream shop brings in \$2 for every cherry that a customer adds to a sundae.

The real disagreement over the methodology is Werner’s underlying assumption about why customers buy the Palladiom shading system. Werner’s \$6.1 million estimate assumes that consumers are purchasing the shading system for reasons other than the brackets (e.g., fabric choice, metal finish, etc.), and that selection of the offending brackets only offers some additional revenue over a different option. In essence, if the customer didn’t pick the offending brackets for her custom shading system, or if it wasn’t available, she would just pick another kind of brackets — but she would still purchase the Palladiom system.

GeigTech counters that this ignores that consumers might be choosing the Palladiom shading system specifically for the offending brackets. Under this assumption, all the other options are largely irrelevant to the consumer’s choice. If the offending brackets were not available, the customer would not purchase the Palladiom system (indeed, it would likely argue

that the customer might purchase the J Geiger system), so Werner’s opinions are purely speculative.

However, Werner does not assume consumer demand without support. Werner came to his conclusion about why consumers choose the Palladiom system by examining, among other things, (i) the “abundant academic research . . . noting that consumers will consider many different factors when choosing between products with multiple features,” (ii) dealers’ marketing and advertising of the Palladiom Shading System, (iii) documents produced in the case that “indicate[d] that consumers value the Palladiom Shading System for reasons other than the appearance of the brackets at issue,” (iv) trade publications that demonstrated “a portion of customer demand and product sales is due to compatibility, convenience, and/or bundling,” (v) deposition testimony from GeigTech’s CEO that compatibility with other systems in a household “might be the most important thing to some customers,” (vi) testimony from Lutron employees, and (vii) Lutron’s own internal documents (Dkt. No. 223-1 ¶¶ 33, 34, 35, 37, 39, 40), all of which “[c]ollectively . . . demonstrates that . . . [t]he Palladiom Shading System includes many features that drive sales and are unrelated to the allegedly infringing trade dress.” (*Id.* ¶ 42.). These are precisely the sort of factors that should undergird an expert’s opinion about what factors drive particular consumer decisions. Whether Werner is right or wrong in his analysis of those factors is a proper topic for cross examination — for example, if he has ignored survey evidence tending to show that people who buy Palladiom shades overwhelmingly do so because of the bracket, he can be questioned about that fact, and then counsel can argue that his methodology overlooked significant countervailing evidence. *Daubert*, 509 U.S. at 596 (citations and quotations omitted). Disagreement with the underlying factual assumptions and conclusions

reached by Werner goes only to weight, not admissibility. *Discover Fin. Servs. v. Visa U.S.A., Inc.*, 582 F. Supp. 2d 501, 507 (S.D.N.Y. 2008).

Werner's calculation is certainly a rough calculation. But an accused infringer need only show that certain profits are not attributable to the infringing activity by a "rough calculation." *See Troublé v. Wet Seal, Inc.*, 179 F. Supp. 2d 291, 304 (S.D.N.Y. 2001). I am satisfied that his calculation is sufficiently reliable.

Accordingly, Plaintiff's motion to exclude the opinions of Werner is denied.

V. Motions for Summary Judgment

A. Legal Standard

Summary judgment must be granted when there is "no genuine dispute as to any material fact and the movant[s] [are] entitled to judgment as a matter of law." Fed. R. Civ. P. 56(a); *accord Anderson v. Liberty Lobby, Inc.*, 477 U.S. 242, 247–48 (1986). A genuine dispute of material fact exists "if the evidence is such that a reasonable jury could return a verdict for the nonmoving party." *Anderson*, 477 U.S. at 248. At summary judgment, the movants bear the initial burden of demonstrating the absence of a genuine issue of material fact. *Celotex Corp. v. Catrett*, 477 U.S. 317, 323 (1986); *Feingold v. New York*, 366 F.3d 138, 148 (2d Cir. 2004).

Once the movants meet that burden, the non-movants may defeat summary judgment only by producing evidence of specific facts that raise a genuine issue for trial. *See* Fed. R. Civ. P. 56(c); *Anderson*, 477 U.S. at 248; *Davis v. New York*, 316 F.3d 93, 100 (2d Cir. 2002). To survive summary judgment, the non-movants must present concrete evidence and rely on more than conclusory or speculative claims. *Quinn v. Syracuse Model Neighborhood Corp.*, 613 F.2d 438, 445 (2d Cir. 1980). In assessing the record to determine whether genuine issues of material

fact are in dispute, a court must resolve all ambiguities and draw all reasonable factual inferences in favor of the non-moving party. *See Parkinson v. Cozzolino*, 238 F.3d 145, 150 (2d Cir.2001).

B. Plaintiff's Motion for Summary Judgment is Granted in Part and Denied in Part and Defendant's Motion for Summary Judgment is Denied

Plaintiff moves for partial summary judgment on (1) its claim for infringement of the '717 Patent, (2) Defendant's affirmative defenses of "equitable intervening adverse rights" and infectious unenforceability of the '717 Patent, (3) Defendant's affirmative defenses based on Post-Grant Review ("PGR") estoppel, (4) Lutron's defamation counterclaim, and (5) the factual issue of whether there are commercially available non-infringing alternatives to the accused products. (Dkt. No. 238). Defendant moves for summary judgment on Plaintiff's trade dress infringement and unfair competition claims, as well as its affirmative defense of "equitable intervening adverse rights." (Dkt. No. 227).

As my rulings on the various *Daubert* motions make clear, there are genuine issues of material fact relating to nearly every aspect of the case. Accordingly, with one exception, I deny both motions in their entirety. However, for the reasons set forth below, Plaintiff's motion for summary judgment dismissing Defendant's affirmative defense of "equitable intervening rights" is granted. Before I address that decision, the denial of Plaintiff's motion for summary judgment as to Defendant's affirmative defenses based on PGR estoppel requires some additional explanation.

In Plaintiff's first motion for summary judgment (now stricken), it moved for summary judgment on all of Defendant's affirmative defenses based on patent invalidity, because these prior art arguments could have been raised during the PGR. (Dkt. No. 200 at 14). In its second motion for summary judgment, it purports to incorporate these arguments "by reference," and

reasserts that Defendant is estopped from raising invalidity defenses that it could have raised during the PGR in front of the PTAB. (Dkt. No. 239 at 28). No dice. Plaintiff's first motion for summary judgment has been stricken and all arguments contained within have been forfeited, including its argument that Defendant is estopped from affirmative defenses based on invalidity.

I turn now to Defendant's affirmative defense of "equitable intervening adverse rights." While I am denying summary judgment for both parties on almost all issues, Plaintiff's motion for summary judgment as to Defendant's affirmative defense is granted (and Defendant's cross-motion for summary judgment as to this defense is denied) because Defendant improperly asserts an equitable defense that is not available against a claim for infringement of a continuation patent.

In its amended answer, Defendant asserts the affirmative defense of "equitable intervening rights." Defendant moves for summary judgment as to — what it now calls — its affirmative "equitable defense" of "intervening adverse rights." It claims that under the "general equitable doctrine" of "intervening adverse rights" it is entitled to dismissal of Plaintiff's patent infringement claim because Plaintiff unreasonably delayed in the prosecution of its continuation application. (Dkt. No. 228 at 32). GeigTech cross-moves for summary judgment on this affirmative defense, on the ground that intervening adverse rights is not a defense to infringement of the '717 Patent, because the '717 Patent is a continuation patent and the affirmative defense of intervening adverse rights is only available against infringement claims for reexamined or reissued patents (codified in the reexamination and reissue statutes, at 35 U.S.C. §§ 252, 307(b) and 316(b)). (Dkt. No. 239 at 24).

Intervening rights commonly arises as a statutory defense to claims asserting infringement of reexamined or reissued patents or as a necessary element to assert the equitable

defense of prosecution laches. To provide the necessary context for Lutron's argument, some explanation of both defenses is needed.

The doctrine of intervening rights was developed by courts to remedy the potential injustice "where a third party, having already begun to make, use, or sell a given article, finds its previously lawful activities rendered newly infringing under a modified patent." *Marine Polymer Techs., Inc. v. HemCon, Inc.*, 672 F.3d 1350, 1361 (Fed. Cir. 2012) (en banc). In such situations, the accused infringer should be deemed to have "acquired at least a right to continue to use the [articles] as if it held a license therefor under the reissued patent." *Id.* (quoting *Sontag Chain Stores Co. v. Nat'l Nut Co.*, 310 U.S. 281, 294-95 (1940)). The statutory basis for intervening rights can be found at 35 U.S.C. § 252, which provides for: "(1) intervening rights that abrogate liability for infringing claims added to or modified from the original patent if the accused products were made or used before the reissue, often referred to as absolute intervening rights; and (2) intervening rights that apply as a matter of judicial discretion to mitigate liability for infringing such claims even as to products made or used after the reissue if the accused infringer made substantial preparations for the infringing activities prior to reissue, often referred to as *equitable intervening rights*." *Marine Polymer*, 672 F.3d at 1361-62 (citing 35 U.S.C. § 252) (emphasis added).

Meanwhile, prosecution laches is an equitable defense to a charge of patent infringement that "may render a patent unenforceable when it has issued only after an unreasonable and unexplained delay in prosecution" that constitutes an egregious misuse of the statutory patent system under the totality of the circumstances. *Symbol Techs., Inc. v. Lemelson Med., Educ. & Rsch. Found.*, 422 F.3d 1378, 1385-86 (Fed. Cir.) ("*Symbol II*"), amended on reh'g in part sub nom. *Symbol Techs., Inc. v. Lemelson Med., Educ. & Rsch. Found.*, LP, 429 F.3d 1051 (Fed. Cir.

2005). “Prosecution laches requires proving two elements: (1) the patentee’s delay in prosecution must be unreasonable and inexcusable under the totality of circumstances and (2) the accused infringer must have suffered prejudice attributable to the delay.” *Personalized Media Commc'ns, LLC v. Apple Inc.*, 57 F.4th 1346, 1354 (Fed. Cir. 2023). Whether an applicant's delay is unreasonable requires “an examination of the totality of the circumstances, including the prosecution history of all of a series of related patents and overall delay in issuing claims” *Hyatt v. Hirshfeld*, 998 F.3d 1347, 1362 (Fed. Cir. 2021) (quoting *Symbol II*, 422 F.3d at 1385-86). “To establish prejudice, . . . an accused infringer must show evidence of *intervening rights*, that is, that the accused infringer or others “invested in, worked on, or used the claimed technology during the period of delay.” *Cancer Research Technology Ltd. v. Barr Laboratories, Inc.*, 625 F.3d 724, 729 (Fed. Cir. 2010) (Emphasis added). There are no “firm guidelines” for when laches is triggered, and the determination is left to the district court's consideration as a matter of equity. *Symbol II*, 422 F.3d at 1385.

Simply put, an accused infringer may defend against an infringement claim on the ground that the patentee unreasonably delayed in pursuing its patent application and that the accused infringer would now be prejudiced if patentee’s infringement claim were allowed. To show it would be prejudiced, the infringer must show, *inter alia*, that it has acquired intervening rights between the time of filing and the time of issuance.

Lutron does not purport to invoke either of these defenses. Instead, it claims that it asserts the “general equitable doctrine of intervening adverse rights,” a free-floating equitable remedy that it claims is independent from the statutory remedy in the reexamination and reissue statutes or the affirmative defense of prosecution laches. (Dkt. No. 228 at 33). It claims that, before the passage of the 1952 Patent Act, in *Webster Elec. Co. v. Splitdorf Elec. Co.*, 264 U.S. 463, 471,

44 S. Ct. 342, 345, 68 L. Ed. 792 (1924), the Supreme Court recognized the equitable remedy of intervening adverse rights in cases not involving reissue or reexamination patents or where a plaintiff alleged prosecution laches. (Dkt. No. 228 at 33 (quoting *Webster Elec. Co. v. Splitdorf Elec. Co.*, 264 U.S. 463, 471, 44 S. Ct. 342, 345, 68 L. Ed. 792 (1924) (emphasis added)). Specifically, Lutron points to the court’s statement that “in cases involving laches, equitable estoppel *or intervening private or public rights*, the two-year time limit prima facie applies to divisional applications . . . In other words, we follow in that respect the analogy furnished by the patent reissue cases.” (*Ibid.*). Lutron asserts that the insertion of the word “or” in this sentence of the Court’s decision created a general equitable remedy of intervening adverse rights.

While Lutron concedes that this equitable doctrine “presumably” led to intervening rights being codified in the modern reissue and reexamination statutes, it claims that this legislation did not curtail this general doctrine of equity that existed before the passage of the 1952 Patent Act. (Dkt. No. 228 at 33). Lutron also contends that the “equitable defense of intervening adverse rights” is independent from prosecution laches because prosecution laches is a defense to unreasonable delay in prosecuting a patent application, not a case where a patentee seeks to patent a broader set of patent terms in a divisional or continuation patent application. (Dkt. No. 228 at 32).

Lutron misreads its caselaw — and to the extent any independent equitable doctrine of intervening adverse rights exists, it does not apply to the delay in prosecution of a continuation patent. In *Webster Electric*, the court held that prosecution laches — not some independent equitable intervening adverse rights doctrine — was an affirmative defense to a patent infringement claim, where the Plaintiff had unreasonably delayed prosecution of his divisional patent. Indeed, as the Federal Circuit has observed, in subsequent cases where defendants

asserted that plaintiffs had delayed in prosecuting their patent applications, the Court continued to recognize prosecution laches, not the “general equitable doctrine of intervening adverse rights,” as an affirmative “defense to an infringement action involving new claims issuing from *divisional and continuing applications* that prejudice intervening adverse public rights”. See *Symbol Techs., Inc. v. Lemelson Med.*, 277 F.3d 1361, 1364 (Fed. Cir. 2002) (“*Symbol I*”) (citing *Crown Cork & Seal Co. v. Ferdinand Gutmann Co.*, 304 U.S. 159, 58 S.Ct. 842, 82 L.Ed. 1265, 37 USPQ 351 (1938); *Gen. Talking Pictures Corp. v. W. Elec. Co.*, 304 U.S. 175, 58 S.Ct. 849, 82 L.Ed. 1273, 37 USPQ 357 (1938)) (emphasis added). The legal authority invoked by Defendant does not support a general equitable defense of intervening adverse rights to a patent infringement claim.

Moreover, none of the other authorities cited by Lutron supports its assertion that a defendant may assert a general equitable defense of intervening adverse rights because the patentee has delayed in its prosecution of a *continuation* patent. All of the other cases that Lutron cites in support of general equitable intervening adverse rights defenses were cases involving alleged infringement of *reissue* patents, not *continuation* patents. (Dkt. No. 228 at 32 (citing *Sontag Chain Stores Co. v. Nat’l Nut Co.*, 310 U.S. 281, 295 & 284-294 (1940) (collecting cases); *Huber v. Nelson Mfg. Co.*, 148 U.S. 270, 291 (1892); *Ives v. Sargent*, 119 U.S. 652, 662 (1887); *Wollensack v. Reiher*, 115 U.S. 96, 100-01 (1885); *Mahn v. Harwood*, 112 U.S. 354, 360-61 (1884)). To the extent that any such general equitable defense of intervening adverse rights exists, Lutron provides no authority suggesting that it is an available affirmative defense to a claim for infringement of a continuation patent.

Lutron’s textual evidence of an independent equitable defense of intervening adverse rights also does not hold up to scrutiny. Lutron claims that *Webster Electric* held, “that in cases

involving laches, equitable estoppel *or intervening private or public rights*, the two-year time limit prima facie applies to divisional applications . . . In other words, we follow in that respect the analogy furnished by the patent reissue cases.” *Webster Elec. Co.*, 264 U.S. at 471(emphasis added). However, in *Webster Electric*, the Court affirmed that prosecution laches was an affirmative defense to infringement because the patentee had delayed the prosecution of its divisional patent — which would render this sentence about other defenses dictum. Indeed, in a decision only 12 years after *Webster Electric*, the Supreme Court held that the presumptive two-year limit for prosecution of a patent application in the quoted sentence was dictum, because it was “not directly applicable to the precise question of laches upon which the case turned.” *Crown Cork*, 304 U.S. at 167-68.

Subsequent case law also weighs against the existence of any such free-floating equitable remedy. As Plaintiff correctly observes, Defendant cites no case, in the nearly 100 years since *Webster Electric* was handed down, in which a defendant has invoked the purported “equitable defense of intervening adverse rights.” Nor is this the result of the case’s obscurity. In recent years, the Federal Circuit has repeatedly affirmed *Webster Electric* as authority for the availability of prosecution laches as a defense to patent infringement claims. *Hyatt v. Hirshfeld*, 998 F.3d 1347, 1361 (Fed. Cir. 2021) (collecting cases).

To the extent Lutron may wish me to liberally construe its “equitable defense of intervening adverse rights” as an affirmative defense of prosecution laches, I decline. Lutron pleaded “equitable intervening rights” as an affirmative defense in its amended answer, (Dkt. No. 168 at 13), which it then rephrased as an “equitable defense of intervening adverse rights” in its motion for summary judgment (Dkt. No. 228). I will not rephrase its defense, nor will I deny GeigTech the benefit of briefing arguments for why Lutron is not entitled to assert the

affirmative defense of prosecution laches. Lutron made perfectly clear in its briefing that it does not assert the affirmative defense of prosecution laches, noting in its motion for summary judgment that its affirmative defense of intervening adverse rights was, “not the same as prosecution laches.” (Dkt. No. 228). It has forfeited any affirmative defense of prosecution laches.

Accordingly, I grant Plaintiff’s motion for summary judgment as to Defendant’s affirmative defense of “equitable intervening rights” and deny Defendant’s motion for summary judgment as to the same.

And so we have finally reached the point of going to trial. We will pick a jury on February 26, 2024.

CONCLUSION

For the foregoing reasons, The Court rules on each motion as summarized in the following table:

Motion	Ruling
Defendant’s Motion to Strike Plaintiff’s “Second Motion for Partial Summary Judgment” and Motion to Exclude Non-Infringing Alternatives (Dkt. No. 253)	DENIED
Defendant’s Motion to Strike the Affidavits of Dr. Paul W. Thurman (Dkt. No. 256)	DENIED AS MOOT
Plaintiff’s Motion to Exclude Testimony on Non-Infringing Alternatives (Dkt. No. 224)	GRANTED IN PART AND DENIED IN PART
Plaintiff’s Motion to exclude the opinions of David Franklyn (Dkt. No. 242)	DENIED
Plaintiff’s Motion to Exclude the Opinions of Bruce Isaacson (Dkt. No. 246)	DENIED
Defendant’s Motion to Exclude the Opinions of Nancy Perkins (Dkt. No. 217)	GRANTED IN PART AND DENIED IN PART

Defendant's Motion to Exclude the Opinions of Paul Goldberger (Dkt. No. 208)	DENIED
Plaintiff's Motion to Exclude the Opinions of Dr. Eric Maslen (Dkt. No. 215)	GRANTED IN PART AND DENIED IN PART
Plaintiff's Motion to Exclude the Opinions of Joel Delman (Dkt. No. 234)	GRANTED IN PART AND DENIED IN PART
Defendant's Motion to Exclude the Opinions of Jeffrey Baliban (Dkt. No. 211)	DENIED
Plaintiff's Motion to Exclude the Opinions of Daniel P. Werner (Dkt. No. 221)	DENIED
Plaintiff's First Motion for Partial Summary Judgment (Dkt. No. 199)	STRICKEN IN ITS ENTIRETY
Plaintiff's Second Motion for Partial Summary Judgment (Dkt. No. 238)	GRANTED IN PART AND DENIED IN PART
Defendant's Motion for Summary Judgment (Dkt. No. 227)	DENIED

This decision will temporarily be filed under seal. In accordance with this court's prior order temporarily sealing certain documents referencing material that the parties deem to be confidential, (Docket No. 106), the parties have until 10 days from today to identify any portion of this decision that should remain under seal because they contain the sort of information that is properly filed under seal. Pages and paragraphs in this opinion and in briefs must be identified with specificity, as must exhibits or portions thereof, and each designation must be accompanied by an explanation of why sealing should be permitted in light of the presumption of public access. After I have received any submissions, I will make the necessary rulings and this opinion will be publicly filed, either in its entirety or in appropriately redacted form. The parties should be aware that, as of the present moment, I see no reason to redact anything from this opinion.

They should recall that the trial will be a public, open courtroom trial and everything that goes on, and every bit of evidence, will be publicly available.

This constitutes the opinion and order of the court. It is a written opinion.

The Clerk of the Court is respectfully directed to file this Order under seal, with access restricted to the parties and the court. The Clerk is also directed to close the motions at Docket Numbers 199, 208, 211, 213, 215, 217, 221, 224, 227, 234, 238, 242, 246, 252, 253, 256, 258, and 296, as well as the motion at Docket Number 26 in the related case, 19 Civ. 4693, and to remove them from the Court's list of open motions.

Dated: September 20, 2023



U.S.D.J.

BY ECF TO ALL COUNSEL