

However, bearing in mind its obligation to review dispositive pretrial motions *de novo*, see Gioiosa v. United States, 684 F.2d 176, 178 (1st Cir. 1982), the Court declines to adopt the legal conclusions of the Magistrate Judge with respect to the issue of distinctiveness. The Court's reasons follow.

I. Analysis

The Magistrate Judge stated correctly the elements of a trade dress infringement claim: that the trade dress is (1) used in commerce; (2) non-functional; (3) distinctive; and (4) likely to cause confusion among consumers as to the product's source. R&R, at 6 (citing The Yankee Candle Co., Inc. v. Bridgewater Candle Co., LLC, 259 F.3d 25, 38 (1st Cir. 2001)). This Court concurs in the Magistrate Judge's analysis of the first two and the fourth elements (commercial use, non-functionality, and likelihood of confusion), and that analysis need not be repeated here.

A. Distinctiveness

On the issue of distinctiveness, the Court also agrees with the Magistrate Judge's conclusion that Knox has not proved inherent distinctiveness. R&R, at 9. Knox must therefore establish secondary meaning, either through direct or circumstantial evidence. R&R, at 10.

1. Defining the "Consumer"

The Magistrate Judge stated (rightly, in this writer's view) that "[t]o prove secondary meaning, the First Circuit 'requires at least *some* evidence that consumers associate the trade dress with the source.'" Id. at 11 (citing Yankee Candle, 259 F.3d at 44 (emphasis in original)). The Magistrate Judge proceeded to conclude that "consumers" in this case were limited to "the owners of commercial buildings and private homes . . . who purchase and pay for the lock boxes." The Magistrate Judge rejected the argument that fire departments and their personnel could be considered "consumers" for purposes of establishing secondary meaning.

This Court does not agree. While it is true that "[t]he opinions of retailers and distributors" are not evidence of the associations of the "consuming public," see Yankee Candle, 259 F.3d at 43 n.14, the role of fire department personnel in this case is considerably more substantial than that of a mere retailer or distributor. All marketing, sales, and commercial efforts of any kind with respect to the lock boxes are directed at fire department personnel, not at the ultimate purchaser of the lock box. This is so because, as the Magistrate Judge noted, "a fire district must approve the use of a certain company's lock box within [its] district and agree to carry the company's master key" *before* the ultimate purchaser of the box

may enter the market for a lock box. R&R, at 12. Even at that point, long after the fire department has made its decisions about which lock boxes are acceptable and which are not, the ultimate purchaser is arguably beholden to the judgment and direction of the fire department official; the purchaser "may call a fire department to find out how to obtain a lock box[, and] [t]he fire department then directs" the purchaser to a company solely of its own choosing. Id.

Thus, it is the fire department official who possesses almost all of the usual attributes of the consumer: it is to him or her that all sales efforts are directed; he or she decides the relative worth of the subject products; and it is because of his or her judgments and decisions alone that one lock box is ultimately purchased and another is rejected.² The only thing the fire official does not supply is payment; that is the role of the purchaser, but it is the purchaser's only part in this consuming process.

The "consuming public," in its business sense, cannot

² Indeed, as observed by the Magistrate Judge, this is the very conclusion reached by EAS: "Accordingly, the consumer that is involved in the purchasing decision is the fire chief (or his or her designee), who is extremely sophisticated as to what product he or she is purchasing." R&R, at 12 (citing EAS's Original Mem. at 21). The Magistrate Judge attributes this language to "careless drafting," but this Court views it instead as a concession by EAS that fire department personnel do, in fact, occupy a central role in the consuming process.

logically be confined solely to the end user of the product. Two examples may serve to illustrate this point. An interior decorator frequently selects the fabrics, accents, and furnishings for a client; thus, even though the interior decorator does not ultimately foot the bill for the furnishings, nor "consume" them, he or she makes all of the choices associated with consuming the product -- preferring one vendor and disfavoring another -- and the ultimate purchaser, usually in blissful ignorance, enjoys (and pays for) the fruits of this expertise. Likewise, a schoolteacher selects one textbook over all others for her class. Makers of textbooks surely know this, and target their marketing accordingly. The fact that the schoolteacher does not actually purchase and use the textbooks does not mean that he or she is not the most critical link in the chain of purchase. In this Court's view, the opinions of persons who directly and incontrovertibly impact or influence the decision of the customer to purchase a product or service *vel non* must be considered in reaching a determination about the existence of secondary meaning.

An appropriate analogy is found in the "likelihood of confusion" analysis. "If likelihood of confusion exists, it must be based on the confusion of some relevant person; *i.e.*, a customer or purchaser." Astra Pharmaceutical Prods., Inc. v.

Beckman Instruments, Inc., 718 F.2d 1201, 1206 (1st Cir. 1983).

The contours of the Astra test have since been given higher relief:

[the test] is focused on the likelihood that commercially relevant persons or entities will be confused. See Astra Pharmaceutical, 718 F.2d at 1207. Actual and potential customers of the trademark owner are the most obvious "relevant persons," but other persons might be relevant in a given case. "To be actionable . . ., the confusion must threaten the commercial interests of the owner of the mark, but it is not limited to the confusion of persons doing business directly with the [trademark owner or infringer]." Restatement (Third) of Unfair Competition § 20 at 210 (1995).

CMM Cable Rep., Inc. v. Ocean Coast Properties, Inc., 888 F. Supp. 192, 200 (D. Me. 1995), aff'd (without discussion of the standard), 97 F.3d 1504 (1st Cir. 1996); see also Landscape Forms, Inc. v. Columbia Cascade Co., 113 F.3d 373, 382-83 (2nd Cir. 1997) ("The likelihood of confusion test concerns not only potential purchasers but also the general public. But, such third parties are only relevant if their views are somehow related to the goodwill of the aggrieved manufacturer.") (citations omitted).

By like token, here it is the associations of those who participate in the process of consumption, including, but not limited to, the ultimate purchaser, which are relevant to

establish secondary meaning.³ This broader reading of "consumer" better comports with the primary purpose underlying the Lanham Act:

to protect that which identifies a product's source . . . "The purpose of trademark laws is to prevent the use of the same or similar marks in a way that confuses the public about the actual source of the goods or service."

I.P. Lund Trading ApS v. Kohler Co., 163 F.3d 27, 35-36 (1st Cir. 1998) (citing Star Fin. Servs., Inc. v. Aastar Mortgage Corp., 89 F.3d 5, 9 (1st Cir. 1996)). In this case, the decision not to consider the associations of fire department officials -- whose opinions form the only basis for the associations, if any, of the ultimate purchaser -- would be inconsistent with the Lanham Act's essential protective functions.

2. Direct and Circumstantial Evidence of Secondary Meaning

Having defined the relevant class of consumers more broadly than did the Magistrate Judge, the Court now examines whether Knox has presented any direct and/or circumstantial evidence of secondary meaning. "The only direct evidence probative of secondary meaning is consumer surveys and testimony by

³ Indeed, as respects the definition of the relevant market for purposes of Lanham Act protection, this Court sees no meaningful distinction between the terms "consumer," as used in secondary meaning analysis, and "customer," under the likelihood of confusion rubric.

individual consumers." Yankee Candle, 259 F.3d at 43. As in Yankee Candle, Knox has not presented any consumer surveys.

Unlike in Yankee Candle, however, and contrary to the Magistrate Judge's findings, Knox has presented some "evidence that individual consumers associate the particular features at issue" with Knox. Id. Exhibit Y to the Appendix to Plaintiff's Rule 12.1 Statement ("Pl. App.") includes several orders placed by actual purchasers with EAS for Knox's lock boxes. Four of these orders constitute direct evidence probative of secondary meaning: (1) Stratford United Methodist Church of Stratford, Connecticut, specifically requested a "Knox Box" from EAS. The evidence demonstrates that EAS filled this order with an EAS box on April 23, 2001; (2) one Ruth Nash of Williamsburg, Massachusetts ordered a "Residential Knox Box" on April 21, 2001, which order was filled by EAS on April 26, 2001 with an EAS box; (3) CHR Condominium Management of Allston, Massachusetts ordered a "Knox Residential" on February 2, 2001, and was invoiced for an EAS box on April 16, 2001; and (4) Robichaud Hardware of Methuen, Massachusetts ordered a "KNOX-BOX" on April 14, 2001, and was invoiced for an EAS box on April 23, 2001. This is precisely the type of direct evidence adverted to in Yankee Candle: that of consumers (purchasers, no less) who associate the particular features of a lock box with

Knox.

Furthermore, given the broader class of individuals that this Court has deemed relevant to the manner in which Knox's product is consumed by the public, the statement by a Fire Marshall in Connecticut to Knox's Director of Public Affairs, Larry Pigg, that he could not tell Knox and EAS products apart, is also relevant direct evidence of secondary meaning.

Finally, Knox has presented substantial circumstantial evidence of secondary meaning: Knox has used its trade dress for 25 years and its products are extremely well-known in the industry (Pl. App. Ex. L, at 73-74); Knox has marketed and advertised its trade dress extensively during its years of operation, augmenting its solid reputation in the industry (Pl. App. Ex. O, at ¶ 26); and EAS has made efforts both to copy intentionally and to "pass off" its product as a Knox product (Pl. App. Ex. X, at 45-47, 49-51, 77-78). This represents circumstantial evidence of secondary meaning, as defined by the First Circuit: "the length and manner of the use of the trade dress, the nature and extent of advertising and promotion of the trade dress, and the efforts made to promote a conscious connection by the public between the trade dress and the product's source." Yankee Candle, 259 F.3d at 43. Moreover, Knox's evidence of EAS's bad intent is far stronger than that

proffered by the plaintiff in Yankee Candle: there is proof here of actual "passing off," rather than merely the unconsummated intent to copy. See id. at 45.⁴

Thus, it is this Court's view that the totality of the direct and indirect evidence of secondary meaning associated by the consuming public with Knox's trade dress is sufficient to withstand summary disposition. Of course, it remains Knox's burden at trial to prove its case on all of these elements.

II. Conclusion

For the foregoing reasons, this Court, with respect to Count I, adopts the Magistrate Judge's conclusions of law that Knox has established a genuine issue of material fact on the issues of commercial use, non-functionality, and likelihood of confusion. However, the Court holds that Knox has presented sufficient evidence to establish a triable issue of fact as to distinctiveness, and declines to adopt the R&R to the extent that it recommends otherwise. Summary judgment as to Count I is therefore DENIED. Summary judgment is also DENIED as to Counts

⁴ Knox also argues that there is an inherent inconsistency in the Magistrate Judge's findings that Knox established a likelihood of confusion but failed to establish secondary meaning. Specifically, Knox contends that the evidence that supports the finding that Knox established a strong trade dress (which is considerable) is precisely the same as that which Knox proffered as circumstantial evidence of secondary meaning. The Court believes that there is some merit to this argument for the reasons discussed supra, but need not decide this issue in light of its ruling.

II and IV, and GRANTED as to Count III.

IT IS SO ORDERED.

William E. Smith
United States District Judge

Date: