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UNITED STATES DISTRICT COURT  
CENTRAL DISTRICT OF CALIFORNIA

JEAN ROYÈRE SAS, et al.,  
Plaintiffs,

v.

EDITION MODERN, et al.,  
Defendants.

Case No. 2:22-cv-01507 HDV JPR

**ORDER RE: MOTIONS FOR SUMMARY  
JUDGMENT [76, 77, 85]**

1       **I. INTRODUCTION**

2           Jean Royère was an iconic French furniture designer who has been described as one of the  
3 most significant designers of the 20th Century, a “savant of design,” a “cultural phenomenon,” and a  
4 visionary who is celebrated for his use of color, shape, and materials.<sup>1</sup> Recognizing such renown,  
5 Defendant Edition Modern has created a successful business selling furniture “in the style of”<sup>2</sup>  
6 Mr. Royère. Mr. Royère’s estate brings this suit for copyright, trademark, and trade dress violations,  
7 and presents this Court with the age-old question: is it inspiration or imitation?

8           The parties raise cross motions for summary judgment. Plaintiffs seek partial summary  
9 judgment on their copyright claims vis-à-vis eight specific works, and Defendants seek partial  
10 summary judgment on Plaintiffs’ trademark, trade dress, and related claims. As discussed more  
11 thoroughly below, the Court finds that the works at issue are both original and separable under *Star*  
12 *Athletica, L.L.C. v. Varsity Brands, Inc.*, 580 U.S. 405, 409 (2017), and are therefore protected under  
13 the Copyright Act. The Court concludes that Defendants have infringed on Plaintiffs’ copyright, but  
14 declines to rule on the request for permanent injunction on this incomplete record. The Court further  
15 finds that Defendants have not met their burden of establishing the absence of a genuine dispute on  
16 the remaining trademark and trade dress claims. The Court therefore grants Plaintiffs’ motion, in  
17 part, and denies Defendants’ motion.

18       **II. RELEVANT BACKGROUND**

19           **A. Factual Background**

20           Born in 1902, Jean Royère designed hundreds of furniture pieces in France from the 1930s to  
21 the 1970s. Second Amended Complaint (“SAC”) ¶ 7 [Dkt. No. 55]; Plaintiffs’ Response in Support  
22 of Statement of Undisputed Facts (“PSUF”) ¶ 6 [Dkt. No. 104-1]. In 1972, Mr. Royère emigrated to  
23 the United States, where he lived until his death in 1981. SAC ¶ 7; PSUF ¶ 108. In a holographic  
24 will, he bequeathed his estate to his life partner, Dr. Mihailo Dordevic. PSUF ¶ 109–111. On  
25 June 17, 1981, the Tribunal de Grande Instance de Paris determined that Dr. Dordevic was the

26 \_\_\_\_\_  
27 <sup>1</sup> Plaintiffs’ Response in Support of Statement of Undisputed Facts ¶¶ 1, 3, 4 [Dkt. No. 104-1].

28 <sup>2</sup> Edition Modern, <https://www.editionmodern.com/chandelier>.

1 beneficiary of all of Mr. Royère’s property rights. *Id.* ¶ 112. When Dr. Dordevic passed away, he  
2 left his entire estate to his niece, Plaintiff Jelena Markovic. *Id.* ¶ 113. In 1992, the Superior Court of  
3 the State of California determined that Ms. Markovic was the sole beneficiary of all of  
4 Dr. Dordevic’s property rights. *Id.* ¶ 114. The Tribunal Judiciaire de Paris issued a decision  
5 confirming Ms. Markovic’s status as the sole legal successor to Dr. Dordevic’s property in 2021. *Id.*  
6 ¶ 115.

7 Plaintiff Jean Royère SAS is a France-based business that was granted a license by Plaintiff  
8 Markovic to reproduce and distribute reproductions of Mr. Royère’s works. SAC ¶ 1; PSUF ¶ 116.  
9 Ms. Markovic has not licensed the Jean Royère name to any other party. Defendants’ Reply in  
10 Support of Statement of Uncontroverted Facts (“DSUF”) ¶ 29 [Dkt. No. 103-1]. On November 7,  
11 2019, Plaintiff Jean Royère SAS filed an application with the United States Patent and Trademark  
12 Office to register the word mark JEAN ROYÈRE in international classes 11, 20, and 27, and it was  
13 subsequently registered on November 17, 2020 as Registration No. 6197569. SAC ¶ 21.

14 Defendant Denis de la Mézière is the owner and founder of Defendant Edition Modern, a  
15 company that sells furniture inspired by modern French designers, including Mr. Royère, as well as  
16 pieces designed by Mr. Mézière. DSUF ¶¶ 1–2, 4–5. As early as 2015, Defendant Edition Modern  
17 began using the JEAN ROYÈRE mark on invoices and price lists. *Id.* ¶¶ 17–18. Since 2015,  
18 Defendants have sold furniture pieces that bear the styles of Royère’s designs, *id.* ¶¶ 39, 41, 43–48,  
19 50, 52, 54, 56, 58, 60, 61, 63–88, and have sold pieces specifically advertised with the JEAN  
20 ROYÈRE mark or under the heading “Jean Royère Collection,” *id.* ¶¶ 340–349.

## 21 **B. Procedural Background**

22 Plaintiffs sue Defendants for creating, marketing, and selling counterfeit copies of Jean  
23 Royère works without consent. Plaintiffs initiated this action against Defendants on March 4, 2022,  
24 and eventually filed a First Amended Complaint. [Dkt. Nos. 1, 34]. Defendants filed a Motion to  
25 Dismiss the First Amended Complaint, which the Court granted, in part, and denied, in part, with  
26 leave to amend the complaint. [Dkt. Nos. 36, 54].

27 On October 26, 2022, Plaintiffs filed the Second Amended Complaint asserting the following  
28 ten claims: (1) copyright infringement; (2) contributory copyright infringement; (3) vicarious

1 copyright infringement; (4) trademark infringement; (5) contributory trademark infringement;  
2 (6) vicarious trademark infringement; (7) trade dress infringement; (8) false designation of origin,  
3 15 U.S.C. § 1125; (9) unfair competition, Cal. Bus. & Prof. Code § 17200; and (10) declaratory  
4 relief. SAC at 10–28. Plaintiffs allege Defendants counterfeited over fifty separate Jean Royère  
5 works, and reference in their SAC eight specific designs and trade dress: Liane wall light, Mille  
6 Pattes standing lamp, Ours Polaire (Polar Bear) armchair, Ours Polaire (Polar Bear) sofa, Yo-Yo bar  
7 stool, Bouquet chandelier, Coeur floor lamp, and Val d’Or coffee table. *Id.* ¶¶ 41, 86; Exhibit 1.  
8 They seek an order enjoining Defendants from manufacturing, marketing, or selling products that  
9 copy Mr. Royère’s works, among other forms of compensatory, declarative, and injunctive relief.  
10 *Id.*, Prayer for Relief ¶¶ 1–15.

11 On June 23, 2023, Plaintiffs filed a Motion for Partial Summary Judgment (“Plaintiffs’  
12 Motion”), seeking a judgment of copyright infringement of the Ours Polaire (Polar Bear) sofa and  
13 armchair, Liane wall light, Coeur floor lamp, Oeuf chair, Sculpture chair, Yo-Yo stools, and  
14 Éléphanteau chair (hereinafter collectively referred to as the “Works”). [Dkt. No. 76]; *see also*  
15 Defendants’ Opposition (“Opp.”) [Dkt. No. 95]; Plaintiffs’ Reply [Dkt. No. 104]. Defendants also  
16 filed a Motion for Partial Summary Judgment (“Defendants’ Motion”), arguing that Plaintiffs cannot  
17 prove their trademark and trade dress claims as a matter of law. [Dkt. Nos. 77, 85 (under seal)]; *see*  
18 *also* Plaintiffs’ Opposition (“Opp.”) [Dkt. No. 94]; Defendants’ Reply [Dkt. No. 103]. The Court  
19 heard oral argument on October 19, 2023 and took the Motions under submission. [Dkt. Nos. 110].

### 20 **III. LEGAL STANDARD**

21 Summary judgment should be granted “if the movant shows that there is no genuine dispute  
22 as to any material fact and the movant is entitled to judgment as a matter of law.” Fed. R. Civ.  
23 P. 56(a); *accord Wash. Mut. Inc. v. United States*, 636 F.3d 1207, 1216 (9th Cir. 2011). Material  
24 facts are those that may affect the outcome of the case. *Nat’l Ass’n of Optometrists & Opticians v.*  
25 *Harris*, 682 F.3d 1144, 1147 (9th Cir. 2012) (citing *Anderson v. Liberty Lobby, Inc.*, 477 U.S. 242,  
26 248 (1986)). A dispute is genuine “if the evidence is such that a reasonable jury could return a  
27 verdict for the nonmoving party.” *Liberty Lobby*, 477 U.S. at 248.  
28

1 The moving party bears the initial burden of establishing the absence of a genuine dispute of  
2 material fact. *Celotex Corp. v. Catrett*, 477 U.S. 317, 323 (1986). To carry its burden of production,  
3 the moving party must either: (1) produce evidence negating an essential element of the nonmoving  
4 party’s claim or defense; or (2) show that there is an absence of evidence to support the nonmoving  
5 party’s case. *Nissan Fire & Marine Ins. Co. v. Fritz Cos.*, 210 F.3d 1099, 1102 (9th Cir. 2000).

6 Once the moving party has met its initial burden, Rule 56(c) requires the nonmoving party to “go  
7 beyond the pleadings and by [his or] her own affidavits, or by the ‘depositions, answers to  
8 interrogatories, and admissions on file,’ designate ‘specific facts showing that there is a genuine  
9 issue for trial.’” *Id.* at 324 (quoting Fed. R. Civ. P. 56(c), (e)); *see also Norse v. City of Santa Cruz*,  
10 629 F.3d 966, 973 (9th Cir. 2010) (“Rule 56 requires the parties to set out facts they will be able to  
11 prove at trial.”). “In judging evidence at the summary judgment stage, the court does not make  
12 credibility determinations or weigh conflicting evidence.” *Soremekun v. Thrifty Payless, Inc.*, 509  
13 F.3d 978, 984 (9th Cir. 2007). “Rather, it draws all inferences in the light most favorable to the  
14 nonmoving party.” *Id.*

#### 15 **IV. DISCUSSION**

##### 16 **A. Copyright Ownership**

17 Plaintiffs seek a judgment that Defendants are infringing on their copyrights. To prevail on a  
18 claim of copyright infringement, a plaintiff must show (1) that they own a valid copyright in the  
19 infringed work and (2) that the defendant copied protected elements of plaintiff’s work. *Feist*  
20 *Publications, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 361 (1991).

21 The parties disagree about whether Plaintiffs can prove ownership of valid copyrights. *See*  
22 Plaintiffs’ Motion at 20–23; Defendants’ Opp. at 9–17. Although a copyright must generally be  
23 registered to be eligible for protection under Section 411 of the Copyright Act, foreign works are  
24 exempt from this requirement. 17 U.S.C. § 411; *Fourth Est. Pub. Benefit Corp. v. Wall-Street.com,*  
25 *LLC*, 139 S. Ct. 881, 891 (2019). Courts understand foreign works to be those that do not meet the  
26 definition of “United States work,” as defined by 17 U.S.C. § 101. *See teamLab Inc. v. Museum of*  
27 *Dream Space, LLC*, 650 F. Supp. 3d 934, 945–46 (C.D. Cal. 2023); *Kernal Recs. Oy v. Mosley*, 794  
28 F. Supp. 2d 1355, 1359 (S.D. Fla. 2011) (“[I]f AJE does not qualify as a ‘United States work,’ it is

1 exempt from the registration requirement of § 411(a).”), *aff’d sub nom. Kernel Recs. Oy v. Mosley*,  
2 694 F.3d 1294 (11th Cir. 2012); *Elohim EPF USA, Inc. v. Total Music Connection, Inc.*, No. 14-cv-  
3 02496-BRO-Ex, 2015 WL 12655484, at \*4 (C.D. Cal. Nov. 19, 2015) (“[T]he party seeking to  
4 protect a [foreign] work must first establish that the subject of copyright is not a United States  
5 work.” (citing *Kernel Recs. Oy*, 794 F. Supp. at 1358–59)).

6 Section 101 of the Copyright Act defines a “United States work” as one that is (1) first  
7 published in the United States; (2) first published simultaneously in the United States and another  
8 country that is party to an international agreement; or (3) unpublished and “all the authors of the  
9 work are nationals, domiciliaries, or habitual residents of the United States.” 17 U.S.C. § 101. A  
10 foreign work may be one that is first published outside of the United States, *or* “unpublished” and  
11 the works’ author is a national of a country other than the United States. *Cf. id.*; *see teamLab Inc.*,  
12 650 F. Supp. 3d at 945–47 (finding the subject works were “unpublished foreign works” and  
13 therefore exempt from § 411(a)’s pre-suit registration requirement). The Copyright Act defines  
14 “publication” as “the distribution of copies . . . of a work to the public by sale or other transfer of  
15 ownership, or by rental, lease, or lending.” 17 U.S.C. § 101. Publication may be met through “the  
16 offering to distribute copies . . . to a group of persons for purposes of further distribution, public  
17 performance, or public display.” *Id.*; *see also teamLab Inc.*, 650 F. Supp. 3d at 947 (noting that  
18 “publication requires commercial exploitation”). Defendants contend that Plaintiffs must establish  
19 the “exact timing” of the first publication, *see Defendants’ Opp.* at 11, but the Court is unpersuaded  
20 that the statute or any binding case law impose this requirement.

21 Defendants do not dispute the fact that Mr. Royère was a French national. *See* PSUF ¶ 108.<sup>3</sup>  
22 Instead, Defendants argue that Plaintiffs do not and cannot offer sufficient evidence to establish  
23 precisely when and where the asserted works were first published, and that any proof Plaintiffs  
24 furnish is inadmissible. *Defendants’ Opp.* at 10–16.

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26  
27 <sup>3</sup> Defendants object to Plaintiffs’ evidentiary support of this fact, however, arguing it is  
28 unauthenticated and based on hearsay. *Id.*

1 After reviewing the very extensive evidentiary record, however, the Court finds that  
2 Plaintiffs have more than sufficiently demonstrated that the Works were first published outside of  
3 the United States. *See, e.g.*, PSUF ¶¶ 37 (referencing 1952, 1954, and 1962 invoices showing sales  
4 of the Ours Polaire armchair in France); 55 (referencing a 1962 invoice showing sales of the Liane  
5 sculptural wall light in France); 66 (referencing a 1954 invoice for the Oeuf chair in France).  
6 Moreover, the Court agrees with Plaintiffs that even if their evidence did not show first publication,  
7 the Works may be considered foreign works as unpublished works created by someone who is a  
8 national of a country other than the United States. In contrast, Defendants set forth no evidence to  
9 establish that the Works were first published in the United States.<sup>4</sup> Thus, as foreign works, the  
10 Works are eligible for copyright protection under 17 U.S.C. § 411.

## 11 **B. Copyright Protectability**

12 Plaintiffs move for summary judgment on the basis that the Works are protectable as  
13 copyrights under the Copyright Act of 1976. Plaintiffs’ Motion at 23–31. Defendants argue that the  
14 Works are not entitled to protection because they are neither original nor separable under *Star*  
15 *Athletica, L.L.C. v. Varsity Brands, Inc.*, 580 U.S. 405, 409 (2017). Defendants’ Opp. at 17–27. For  
16 the reasons discussed below, the Court finds that Plaintiffs have met their burden to show the  
17 protectability of the Works.

### 18 **i. Originality**

19 To qualify for copyright protection, a work must be considered original to the author. *Feist*  
20 *Publications*, 499 U.S. at 345. In the copyright context, original means that “the work was  
21 independently created by the author (as opposed to copied from other works), and that it possesses at  
22 least some minimal degree of creativity.” *Id.* (citation omitted). “[T]he requisite level of creativity  
23 is extremely low; even a slight amount will suffice.” *Id.* So long as a work possesses “some  
24 creative spark, no matter how crude, humble or obvious,” it will meet the standard for originality.

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25  
26 <sup>4</sup> To the extent that Defendants dispute the admissibility of Plaintiffs’ evidence offered in support of  
27 the present Motions, that argument fails. The Court has considered Defendants’ evidentiary  
28 objections and overrules them as discussed more specifically in the Court’s December 6, 2023 Order  
Re: Defendants’ Evidentiary Objections [Dkt No. 121].

1 *Id.* (citation omitted). “Originality does not signify novelty; a work may be original even though it  
2 closely resembles other works so long as the similarity is fortuitous.” *Id.*

3 As to the first element, Plaintiffs’ evidence establishes that Jean Royère independently  
4 created each of the Works. PSUF ¶¶ 19–28, 33–40, 48–51; 59–61; 62–66; 73–76; 83–86; 95–98.  
5 Although Defendants argue that Mr. Royère pulled inspiration from other specific designs, *see, e.g.*,  
6 Defendants’ Opp. at 21, Defendants offer no evidence that the Works were specifically *copied from*  
7 other designs. And whereas Defendants contend that the Works were merely trivial or slight  
8 variations of other furniture designs, *see id.*, even that amount of creative spark meets the low level  
9 of creativity required to consider the designs original. *See Feist Publications*, 499 U.S. at 345. Here  
10 it is readily apparent that the Works each have more than the requisite level of creativity to be  
11 considered original. Indeed, Defendant Edition Modern’s own price list describes Mr. Royère as  
12 having “pioneered an *original* style combining bright colors, organic forms and precious materials.”  
13 PSUF ¶ 5 (emphasis added). To be sure, it is hard to imagine that the Musée des Arts Décoratifs  
14 (Museum of Decorative Arts) in Paris would have a permanent exhibition, *see* PR-SUF ¶ 7,  
15 dedicated to works that do not have the minimal degree of creativity to be considered original under  
16 this test. The Court finds that the Works are original to Mr. Royère.

## 17 **ii. Separable and Independent Features**

18 Under the Copyright Act, the “design of a useful article” is eligible for copyright protection  
19 only if “such design incorporates pictorial, graphic, or sculptural features that can be identified  
20 separately from, and are capable of existing independently of, the utilitarian aspects of the article.”  
21 17 U.S.C. § 101. That is the key element that the parties dispute in Plaintiffs’ Motion.

22 “The first requirement—separate identification—is not onerous. The decisionmaker need  
23 only be able to look at the useful article and spot some two- or three-dimensional element that  
24 appears to have pictorial, graphic, or sculptural qualities.” *Star Athletica*, 580 U.S. at 414 (citation  
25 omitted). When assessing the second “independent existence” requirement, courts “must determine  
26 that the separately identified feature has the capacity to exist apart from the utilitarian aspects of the  
27 article.” *Id.* “If the feature is not capable of existing as a pictorial, graphic, or sculptural work once  
28 separated from the useful article, then it was not a pictorial, graphic, or sculptural feature of that



1 article, but rather one of its utilitarian aspects.” *Id.* “The ultimate separability question [] is whether  
2 the feature for which copyright protection is claimed would have been eligible for copyright  
3 protection as a pictorial, graphic, or sculptural work had it originally been fixed in some tangible  
4 medium other than a useful article before being applied to a useful article.” *Id.*

5 The Court finds that the Works each meet this test. In each of the Works at issue, it does not  
6 take much to identify their pictorial, graphic, and sculptural elements. The soft, bulbous shapes of  
7 the Ours Polaire sofa, Ours Polaire armchair, and Sculpture armchair; the vinelike elements of the  
8 Liane wall light; the heart and flower shapes of the Coeur floor lamp; the egg-like shape of the Oeuf  
9 chair; the rings of the Yo-Yo stool; and the upward cup shapes of the Éléphanteau chair, are all  
10 readily separately identifiable. If these artful aspects are separated from each pieces’ utilitarian  
11 aspects, they would qualify as “three-dimensional works of . . . art”. *See Star Athletica*, 580 U.S. at  
12 408 (quoting 17 U.S.C. § 101) (finding that the arrangement of graphics on cheerleading uniforms  
13 could be separated from the uniform and applied in another medium, such as a painter’s canvas, to  
14 qualify as works of art). If the sculptural features of each Work were used in another non-utilitarian  
15 medium—if, for example, the Ours Polaire sofa were made of fine glass such that one could not sit  
16 on it—they could nonetheless exist as sculptural works of art. That many of the Works have, in fact,  
17 been displayed at art museums confirms this. *See* PSUF ¶ 7. And where some original pieces sell at  
18 auction for millions of dollars, *see id.* ¶¶ 14 (\$3.42 million), 46 (€1.57 million), it may be more  
19 appropriate to categorize them primarily as art meant to be appreciated and not touched, rather than  
20 “useful articles.” Even so, for our purposes the Works are easily capable of existing independently  
21 of their utilitarian aspects, and therefore are eligible for copyright protection.

### 22 C. Copying

23 Next, establishing copyright infringement requires proving that original elements of a work  
24 were copied. *Feist Publications*, 499 U.S. at 361. To do so, a plaintiff must first prove that a  
25 defendant copied the work. *Skidmore as Tr. for Randy Craig Wolfe Tr. v. Led Zeppelin*, 952 F.3d  
26 1051, 1064 (9th Cir. 2020). In the absence of direct evidence of copying, “the plaintiff can attempt  
27 to prove it circumstantially by showing that the defendant had access to the plaintiff’s work and that  
28

1 the two works share similarities probative of copying.” *Id.* (citation omitted). A plaintiff must then  
2 prove “unlawful appropriation,” *i.e.* that the works share substantial similarities. *Id.*

3 Plaintiffs meet their burden of proof on this issue. First, Plaintiffs produce sufficient  
4 evidence—the underlying facts of which are undisputed—to establish that Defendants copied the  
5 Works. It is undisputed that Defendants use Mr. Royère’s original drawings to manufacture some of  
6 the Works. PSUF ¶¶ 175 (the Oeuf chair); 201 (sending the original drawings of the Éléphantau  
7 chair to Defendants Edition Modern’s manufacturer and stating, “All measurements are based on  
8 original drawings but don’t have to be exactly the same. 1/4” difference won’t hurt the design.”).  
9 Defendants have also represented to clients that they use Jean Royère’s original designs when  
10 creating their versions of the Works. *Id.* ¶¶ 139 (“[Edition Modern] make[s] the Polar chairs and  
11 sofa from the original template.”); 154 (responding to a client inquiry about the Ours Polaire  
12 armchair, “We have been making Royère re-editions for many years, we have all of the rights to do  
13 so.”); 162 (“The Lampshades fabric we use is actually a paper called Manilla Paper. This is the most  
14 standard and close to Jean Royère original designs.”); 180 (informing a client that the Sculpture  
15 chair “is made from an original template” and responding to another that “re-edition (re-issue) made  
16 from the design of Jean Royère”); 188 (responding to a client who asked about the Yo-Yo stools,  
17 “This is a reproduction of Jean Royère’s original design . . .”).

18 Second, to prove that that the works share substantial similarities, Plaintiffs must meet a two-  
19 part test: “The first part, the extrinsic test, compares the objective similarities of specific expressive  
20 elements in the two works.” *Skidmore*, 952 F.3d at 1064 (citation omitted). In this part of the test,  
21 courts may only assess “whether the *protectible elements, standing alone*, are substantially similar.”  
22 *Cavalier v. Random House, Inc.*, 297 F.3d 815, 822 (9th Cir. 2002) (citation omitted). When  
23 objectively comparing works of art, courts consider “the subject matter, shapes, colors, materials,  
24 and arrangement of the representations.” *Id.* at 826. “The second part, the intrinsic test, test[s] for  
25 similarity of expression from the standpoint of the ordinary reasonable observer, with no expert  
26 assistance.” *Skidmore*, 952 F.3d at 1064 (citation omitted); *see Pasillas v. McDonald’s Corp.*, 927  
27 F.2d 440, 442 (9th Cir. 1991) (“The ‘intrinsic test’[] focuses on similarity of expression and asks  
28

1 whether the ordinary reasonable person would find ‘the total concept and feel of the works’ to be  
2 substantially similar.’’ (citation omitted)).

3 As to the extrinsic test, a comparison of Defendants’ works reveals objectively clear  
4 similarities in the shapes, colors, materials, and arrangements of elements with each the Works. *See*  
5 Plaintiffs’ Motion at 8–18. For example, the original Ours Polaire sofa and Defendants’ version are  
6 indistinguishable, especially when comparing their exaggerated bulbous shapes. *See id.* at 8. Like  
7 the original Liane wall lamp, Defendants’ version uses five wavy black metal branches to hold five  
8 ivory shades, all arranged in the same formation. *See id.* at 12. The curved “ears” and arms of the  
9 Defendants’ version of the Éléphanteau chair, its upwardly curved bottom, and its conical legs are  
10 also all similar to those in Mr. Royère’s original version. *See id.* at 18. And as to the intrinsic test,  
11 the Defendants’ works are conceptually similar to the Works “from the standpoint of the ordinary  
12 reasonable observer.” This is presumably by design, as Defendants market their versions as being  
13 “in the style of” Jean Royère designs.

14 In summary, Plaintiffs have carried their burden of establishing the absence of a genuine  
15 dispute that Defendants copied the Works. The Court finds that Defendants infringed Plaintiffs’  
16 copyrights.

#### 17 **D. Permanent Injunction**

18 Plaintiffs seek to enjoin Defendants from any distribution, marketing, manufacture, sale, or  
19 offer for sale of any designs that are substantially similar to the Works. Plaintiffs’ Motion at 34–36.  
20 To obtain a permanent injunction, a plaintiff must demonstrate the following: (1) that it suffered an  
21 irreparable injury; (2) that legal remedies, such as monetary damages, are inadequate to compensate  
22 for that injury; (3) that, considering the balance of hardships between the parties, an equitable  
23 remedy is warranted; and (4) that the public interest would not be disserved by a permanent  
24 injunction. *eBay Inc. v. MercExchange, L.L.C.*, 547 U.S. 388, 391 (2006). Courts must consider  
25 these equitable factors, even after it has made a finding of copyright infringement. *Id.* at 392–93  
26 (“[T]his Court has consistently rejected invitations to replace traditional equitable considerations  
27 with a rule that an injunction automatically follows a determination that a copyright has been  
28 infringed.” (citation omitted)).

1 The Court declines to rule on the request for an injunction, finding that the briefing and the  
2 evidentiary record are not sufficient for the requisite analysis of the relevant factors. Although  
3 Plaintiffs point to evidence of Defendants’ continued infringement, their only proffered evidence of  
4 irreparable harm is testimony from Plaintiff Jean Royère SAS’s own principals regarding  
5 Defendants’ rights to sell Jean Royère products. *See* Plaintiffs’ Reply at 10; PSUF ¶ 280  
6 (referencing testimony by Plaintiffs Jean Royère SAS’s CEO that clients “don’t understand why  
7 Edition Modern is selling Jean Royère products, if they don’t have the rights”). This evidence,  
8 standing alone, is insufficient for the Court to find that Plaintiffs suffered irreparable harm. *See*  
9 *Reebok Int’l Ltd. v. J. Baker, Inc.*, 32 F.3d 1552, 1557 (Fed. Cir. 1994) (noting that the plaintiffs had  
10 not shown irreparable harm because it provided no evidence to support its assertions of reputational  
11 damage); *Aurora World, Inc. v. Ty Inc.*, 719 F. Supp. 2d 1115, 1169 (C.D. Cal. 2009) (“[B]y failing  
12 to proffer evidence regarding [its brand’s] penetration into the U.S. market, [the plaintiff] failed to  
13 demonstrate that it has significant reputation or goodwill to protect in that market.”); *cf. Apple Inc. v.*  
14 *Psystar Corp.*, 673 F. Supp. 2d 943, 948–49 (N.D. Cal. 2009), *aff’d*, 658 F.3d 1150 (9th Cir. 2011)  
15 (finding irreparable harm because the plaintiffs put forth significant and compelling evidence of the  
16 impact of the defendants’ infringement on the plaintiff’s brand, business reputation, and goodwill).

17 In summary, the Court declines to rule on the present record but will entertain a standalone  
18 motion for preliminary injunction that addresses in detail all of the factual and legal bases for the  
19 relief requested.

### 20 **E. Trademark Rights**

21 Next, Defendants move for summary judgment on Plaintiffs’ trademark infringement claim  
22 (Claim Four). They contend that this claim fails because Defendant Edition Modern can establish its  
23 priority of use of the JEAN ROYÈRE mark. Defendants’ Motion at 4. Plaintiffs argue this  
24 contention fails because Defendants cannot establish that the JEAN ROYÈRE trademark was  
25 abandoned in the first place. Plaintiffs’ Opp. at 7–8.<sup>5</sup>

26 \_\_\_\_\_  
27 <sup>5</sup> The Court notes that abandonment is an affirmative defense that Defendants did not assert in their  
28 Answer. *See* Defendants’ Answer to Second Amended Complaint and Counterclaims [Dkt. No. 56].

1 To demonstrate priority of use, a defendant must prove (1) “that [it] actually adopted and  
2 used the mark[] in commerce prior to [plaintiff’s] registration in such a manner that sufficiently  
3 associated the mark[] with [its use]” and (2) that its “use of the marks was continuous and not  
4 interrupted.” *Dep’t of Parks & Recreation for State of California v. Bazaar Del Mundo Inc.*, 448  
5 F.3d 1118, 1125–26 (9th Cir. 2006) (citations omitted). A first use must be “bona fide and  
6 commercial in character.” *Id.* “[T]he litigant attempting to establish priority of commercial use  
7 must demonstrate both adoption of the mark[] and use in a way sufficiently public to identify or  
8 distinguish the marked goods in an appropriate segment of the public mind as those of the adopter of  
9 the mark.” *Id.* (citation omitted). When assessing prior use in commerce, courts consider the totality  
10 of the circumstances, including non-sales activity. *Id.*

11 Defendants fail to establish the absence of a genuine dispute on this point. The parties agree  
12 that Plaintiff Jean Royère SAS registered the JEAN ROYÈRE mark on May 7, 2019. DSUF ¶¶ 25,  
13 109. They dispute, however, whether this date is properly used as Plaintiffs’ claimed priority date.  
14 Defendants’ Motion at 5; DSUF ¶¶ 17, 18. Defendants point to invoices, price lists, and its website  
15 to prove its continuous use of the JEAN ROYÈRE mark since at least 2016. But such evidence does  
16 not speak specifically to the scope of such use and consequently fails to establish Defendants’ use of  
17 the trademark in a “sufficiently public” manner. *See Brookfield Commc’ns, Inc. v. W. Coast Ent.*  
18 *Corp.*, 174 F.3d 1036, 1052 (9th Cir. 1999) (finding that use of a mark in e-mail correspondence  
19 with lawyers and customers failed to meet the “sufficiently public” standard); *cf. id.* (“Marvel  
20 Comics’s announcements to 13 million comic book readers . . . or the mailing of 430,000 solicitation  
21 letters with one’s mark . . . may be sufficient to create an association among the public . . . .”  
22 (citation omitted)); *see also Bazaar Del Mundo*, 448 F.3d at 1127 (concluding that the defendants’  
23 brochures, without additional evidence of sales activity and extent of distribution, were insufficient  
24 because they were not “designed to attract the attention of the viewer to the marks themselves”  
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27 Affirmative defenses are generally waived if they are not asserted in the answer to a complaint. *In*  
28 *re Cellular 101, Inc.*, 539 F.3d 1150, 1155 (9th Cir. 2008) (citing Fed. R. Civ. P. 8(c)).

1 (citation omitted)). Defendants have not carried their burden to warrant summary judgment on this  
2 claim.<sup>6</sup>

3 **F. Trade Dress**

4 Defendants also move for partial summary judgment on the grounds that Plaintiffs cannot  
5 prove their trade dress claim (Claim Seven). To prove trade dress infringement, a plaintiff must  
6 demonstrate that (1) the trade dress is nonfunctional, (2) the trade dress has acquired secondary  
7 meaning, and (3) there is a substantial likelihood of confusion between the plaintiff's and  
8 defendant's products. *Art Attacks Ink, LLC v. MGA Ent. Inc.*, 581 F.3d 1138, 1145 (9th Cir. 2009)  
9 (citation omitted). Defendants argue that Plaintiffs cannot establish that their trade dress has  
10 secondary meaning and therefore Claim Seven fails as a matter of law. Defendants' Motion at 11–  
11 21.

12 To demonstrate secondary meaning, a plaintiff must show that “a mental recognition in  
13 buyers' and potential buyers' minds that products connected with the [mark] are associated with the  
14 same source.” *Art Attacks Ink*, 581 F.3d at 1145 (citation omitted). This can be established through  
15 direct and circumstantial evidence, including, “direct consumer testimony; survey evidence;  
16 exclusivity, manner, and length of use of a mark; amount and manner of advertising; amount of sales  
17 and number of customers; established place in the market; and proof of intentional copying by the  
18 defendant.” *Id.*; *Aurora World*, 719 F. Supp. 2d at 1151. Evidence of extensive unsolicited media  
19 coverage can indicate secondary meaning. *adidas Am., Inc. v. Skechers USA, Inc.*, 890 F.3d 747,  
20 754 (9th Cir. 2018) (citation omitted). “[P]roof of copying strongly supports an inference of  
21 secondary meaning.” *Id.* at 755.

22 Plaintiffs offer ample evidence of secondary meaning. *See* Motion at 14–15. In particular,  
23 many of the articles of trade dress at issue have been featured in media as associated with Jean  
24 Royère, by well-known sources such as Architectural Digest, Christie's, and Town and Country.

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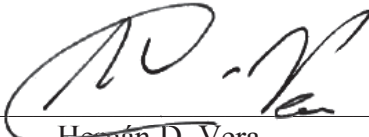
25  
26 <sup>6</sup> Because Plaintiffs' remaining trademark and related claims—Claims Five (contributory trademark  
27 infringement), Six (vicarious trademark infringement), Eight (false designation of origin), and Nine  
28 (unfair competition)—rely on or are similar to the trademark infringement claim (Claim Four),  
Defendants' Motion as to those claims is denied. *See* Defendants' Motion at 9–11.

1 See, e.g., SUF ¶¶ 175 (Éléphantau), 187 (Flaque), 215 (Liane), 230 (Oeuf), 250 (Ondulation  
2 sconce), 266 (Ours Polaire Sofa), 303 (Trefle), and 329 (Sculpture). They have also appeared in  
3 books, web articles, and museum exhibits, all associated with Jean Royère. See, e.g., SUF ¶¶ 173–  
4 178, 184–189. And, as discussed above, *supra* Section IV.C., Plaintiffs have proven that Defendants  
5 copied the Works, further supporting secondary meaning in their trade dress. Consequently, since  
6 Plaintiffs have presented sufficient evidence that a jury court find in its favor on its trade dress claim,  
7 Defendants’ Motion is denied as to Claim Seven.

8 **V. CONCLUSION**

9 In conclusion, the Court finds that Defendants have infringed on Plaintiffs’ copyright, but  
10 that the record does not warrant a permanent injunction at this stage. A genuine dispute of material  
11 fact remains on the remaining trademark and trade dress claims. For the foregoing reasons,  
12 Plaintiffs’ Motion for Partial Summary Judgment is granted, in part, and Defendants’ Motion for  
13 Partial Summary Judgment is denied.

14  
15 Dated: December 7, 2023

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18 Hernán D. Vera  
19 United States District Judge  
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