IN THE UNITED STATES DISTRICT COURT
FOR THE NORTHERN DISTRICT OF GEORGIA
ATLANTA DIVISION

D.H. PACE COMPANY, INC., d/b/a OVERHEAD DOOR COMPANY OF ATLANTA and OVERHEAD DOOR COMPANY OF KANSAS CITY, Plaintiff, v. OGD EQUIPMENT COMPANY, LLC, Defendant.	CIVIL ACTION FILE NO. 1:20-cv-410-TCB

<u>O R D E R</u>

This case comes before the Court on Defendant OGD Equipment Company, LLC's motion [215] for summary judgment and Plaintiff D.H. Pace Company, Inc.'s motion [280] for partial summary judgment. Also before the Court is Pace's motion [313] to strike portions of OGD's brief in support of its motion for summary judgment.

I. Background

A. The Parties

Pace is a garage door company based in Olathe, Kansas. It is in the business of selling, installing, and servicing garage doors in the greater Atlanta and Kansas City areas. It operates under the trade names "Overhead Door Company of Atlanta" and "Overhead Door Company of Kansas City." It maintains the websites *overheaddooratlanta.com* and *overheaddoorkansascity.com*. It advertises the trade names on its websites, in social media, through search engines, and at trade and home shows. It employs a large staff and operates a fleet of approximately 300 vehicles bearing the trade names in their respective cities.

In certain markets, Pace operates under distribution agreements with Overhead Door Corporation ("ODC")—a well-known manufacturer of garage doors and door openers. In those markets, Pace has a non-exclusive license to sell ODC products and is permitted—and in fact obligated—to conduct business under the trade names "Overhead Door Company of [Geographical Name]." Pursuant to the distribution agreements, Pace is permitted—after obtaining ODC's approval—to use ODC's marks including "Overhead Door" and "Overhead," in connection with the promotion and sale of ODC products.

In the two relevant markets, Pace offers "a comprehensive selection of residential and commercial door systems" through Overhead Door Company of Atlanta and Overhead Door Company of Kansas City.

While only ODC manufacturers "Overhead Doors" under that specific trade name, there are many other manufacturers of garage doors. In fact, Pace sells garage doors from several non-ODC manufacturers.

OGD is a Texas-based company that promotes itself as offering "overhead door service across the nation" and "installations, repairs, and maintenance for overhead doors and dock equipment." First entering the Atlanta and Kansas City markets in 2019, OGD provides residential and commercial property owners with dock equipment and door services, including door installation, repair, and replacement. OGD began operating as "Overhead Garage Door" in 2011. In July 2012, it applied to register its Overhead Garage Door logo with the United

States Patent and Trademark Office. That registration was surrendered and canceled in early 2021.

B. OGD/ODC Litigation and Settlement

In 2017, following correspondence regarding its use of the trade name "Overhead Garage Door," OGD filed a lawsuit against ODC and one of its distributors. OGD sought a finding that "overhead," "overhead door," and "overhead doors" were generic terms. ODC then asserted a counterclaim against OGD, alleging that the term "Overhead Door" was closely associated with ODC and its licensed affiliates and that OGD was knowingly and wrongfully passing itself off as an ODC affiliate.

In November 2019, after two years of contentious litigation, OGD and ODC entered into a settlement agreement (the "Settlement Agreement") that resolved all claims and contained mutual releases. In it, OGD agreed to cease use of "Overhead Garage Door" unless it is immediately preceded by "OGD." OGD was also forbidden from using or promoting the terms "Overhead Door Company," "Overhead Door [Geographic Area]," and "Overhead Door Co."

The Settlement Agreement provides that ODC must not direct any of its distributors or licensees to take legal action against OGD if the acts of OGD do not constitute a breach of the settlement terms. Further, under the terms of the agreement, OGD may use a redacted version of the agreement as a defense in any legal action brought by an ODC distributor or licensee. That said, the agreement—by its terms—is not binding on any "current and future licensees . . . of ODC . . . ." [266-4] ¶ 1.

C. Pace/OGD Litigation

On January 28, 2020, Pace filed this suit against OGD. In it, Pace alleges unfair competition by OGD in violation of Section 43(a) the Lanham Act, deceptive trade practices in violation of the Georgia Uniform Deceptive Trade Practices Act, statutory and common law unfair competition, and common law trademark infringement. Pace alleges that it owns valuable common law rights in the trade names "Overhead Door Company of Atlanta" and "Overhead Door Company of Kansas City," and that OGD's use of "Overhead Garage Door LLC" is designed to mislead and confuse customers and is in violation of both federal and state law. Pace seeks injunctive relief as well as corrective advertising and lost profits.

While a dispute exists as to whether Pace must obtain ODC's permission before filing a lawsuit regarding the trade names at issue, and while ODC never directed Pace to file this action, it is evident that ODC now consents to the suit. *See* [337] at 5.

OGD has filed a counterclaim [25-2] against Pace. In it, OGD seeks a declaratory judgment that the terms "overhead," "overhead door," and "overhead doors" are generic and thus unprotectable under trademark law.

On January 20, 2021, the Court granted in part [120] Pace's motion for judgment on the pleadings. It granted judgment on the pleadings for Pace as to the portions of OGD's counterclaim for declaratory judgment beyond residential customers in Atlanta and Kansas City. In a footnote that has taken on outsized importance in this case, the Court limited the scope of the case to residential customers in the two relevant markets, holding that "the operative inquiry is only whether residential consumers in Atlanta and Kansas City believe the terms to be generic." [120] at 17 n.4.

Extensive discovery—and many discovery disputes—followed. On July 26, 2021, OGD filed its motion [215] for summary judgment on both its counterclaim and all claims asserted by Pace. In it, it asserts that Pace—as a non-exclusive licensee of ODC—lacks sufficient rights to bring suit on the marks. Additionally, OGD argues that the Settlement Agreement between it and ODC bars Pace's claims. Even if Pace has sufficient rights and standing to sue, OGD contends, ODC is a necessary party. Finally, OGD argues that even if Pace is permitted to proceed with the suit in the absence of ODC, the terms "Overhead" and "Overhead Door(s)" are indisputably generic and therefore Pace's claims must fail as a matter of law.

On the same day, Pace filed a motion [280] for partial summary judgment. It seeks summary judgment on fifteen of OGD's affirmative defenses. It argues that the defenses either lack supporting evidence, fail as a matter of law, or do not constitute defenses at all.

On August 23, 2021, Pace filed a motion [313] to strike portions of OGD's brief in support of its motion [215] for summary judgment. Specifically, it argues that hundreds of the exhibits that OGD attached to its motion either go beyond the scope of the case by mentioning markets outside of Atlanta and Kansas City or constitute inadmissible hearsay. Pace additionally moves to strike one specific exhibit to OGD's response which Pace claims violates Rule 26 of the Federal Rules of Civil Procedure because it is an expert report from a different case whose author was not properly identified and whose contents were not adequately disclosed.

Oral argument on the motions was conducted on February 22, 2022. The motions have been thoroughly briefed and are now ripe for the Court's ruling.

II. Legal Standard

Summary judgment is appropriate when "there is no genuine dispute as to any material fact and the movant is entitled to judgment as a matter of law." FED. R. CIV. P. 56(a). There is a "genuine" dispute as to a material fact if "the evidence is such that a reasonable jury could return a verdict for the nonmoving party." *FindWhat Inv. Grp. v. FindWhat.com*, 658 F.3d 1282, 1307 (11th Cir. 2011) (quoting *Anderson v. Liberty Lobby, Inc.*, 477 U.S. 242, 248 (1986)). In making this determination, "a court may not weigh conflicting evidence or make credibility determinations of its own." *Id.* Instead, the court must "view all of the evidence in the light most favorable to the nonmoving party and draw all reasonable inferences in that party's favor." *Id.*

"The moving party bears the initial burden of demonstrating the absence of a genuine dispute of material fact." *Id.* (citing *Celotex Corp. v. Catrett*, 477 U.S. 317, 323 (1986)). If the nonmoving party would have the burden of proof at trial, there are two ways for the moving party to satisfy this initial burden. *United States v. Four Parcels of Real Prop.*, 941 F.2d 1428, 1437–38 (11th Cir. 1991). The first is to produce "affirmative evidence demonstrating that the nonmoving party will be unable to prove its case at trial." *Id.* at 1438 (citing *Celotex Corp.*, 477 U.S. at 331). The second is to show that "there is an absence of evidence to support the nonmoving party's case." *Id.* (quoting *Celotex Corp.*, 477 U.S. at 324).

If the moving party satisfies its burden by either method, the burden shifts to the nonmoving party to show that a genuine issue remains for trial. *Id.* At this point, the nonmoving party must "'go beyond the pleadings,' and by its own affidavits, or by 'depositions, answers to interrogatories, and admissions on file,' designate specific facts showing that there is a genuine issue for trial." *Jeffery v. Sarasota White Sox, Inc.*, 64 F.3d 590, 593–94 (11th Cir. 1995) (quoting *Celotex Corp.*, 477 U.S. at 324).

III. Discussion[1]

A. Pace's Right to Sue

OGD argues that Pace lacks the right to bring its claims. Specifically, it argues that Pace does not have sufficient rights in the marks to bring suit because it is a non-exclusive licensee and is not the real party in interest. Further, OGD asserts that Pace is contractually

[1] As an initial matter, the Court will deny Pace's motion [313] to strike as moot. While the Court agrees that the voluminous evidentiary submissions by OGD go well beyond the scope of the issues before it, the Court reaches its conclusion even considering the disputed exhibits.

barred from bringing this action because of the Settlement Agreement between OGD and ODC, settling the claims between them.

Pace responds that it has standing under § 43(a) of the Lanham Act, which places its interests in the marks squarely within the protections that the statute affords. It argues that because the distribution agreements between itself and ODC do not reserve in ODC the exclusive right to sue for infringement, the agreements do not limit Pace's rights to pursue infringers for unfair competition and deceptive trade practices. It also contends that the Settlement Agreement does not bar its claims. Rather, it argues, the Settlement Agreement expressly provides that it is not binding on distributors and licensees such as Pace.

1. Standing and Rights in the Marks

Pace attempts to frame the discussion around whether it has "standing" under the Lanham Act to bring its claims. OGD argues that the proper framework is actually whether Pace has the "right" to bring its claims by virtue of its licensor-licensee relationship with ODC. The Court will address these arguments in turn.

a. Standing

A violator of the Lanham Act "shall be liable in a civil action by any person who believes that he or she is likely to be damaged." 15 U.S.C. § 1125(a)(1). The Supreme Court affirmed the expansive nature of standing under the Lanham Act in *Lexmark International, Inc. v. Static Control Components, Inc.*, 572 U.S. 118, 129–34 (2014). In *Lexmark*, the Court held that standing requires a "plaintiff[] whose interests 'fall within the zone of interests protected by the law invoked.'" *Id.* at 129 (quoting *Allen v. Wright*, 468 U.S. 737, 751 (1984)). Additionally, the plaintiff's injuries must have been proximately caused by violations of the statute. *Id.* at 132.

The Court in *Lexmark* held that the zone of interests protected by the Lanham Act include "protect[ing] persons . . . against unfair competition" and that the statute "mak[es] actionable the deceptive and misleading use of marks." *Id.* at 131 (quoting 15 U.S.C. § 1127).

To prove proximate cause, a Lanham Act plaintiff "ordinarily must show economic or reputational injury flowing directly from the deception wrought by [the defendant]; and that that occurs when deception of consumers causes them to withhold trade from the plaintiff." *Id*. at 133.

Pace has developed a reputation and earned consumer goodwill because of its use of the marks in Atlanta and Kansas City. It is indisputable that OGD's use of similar marks has led to widespread confusion among customers. Pace has provided over 170 examples of customers' confusion between itself and OGD. It has also provided customer service logs and audio recordings of phone calls it received wherein customers complained of being misled by OGD's advertising and personnel.

By way of example, one customer performed a web search seeking the phone number for Overhead Door Company of Kansas City, which Pace operates. [321-12] at 2. It instead found the number for OGD, with whom the customer scheduled a service call. After a dissatisfactory experience, he confirmed with the service technician that he was "with Overhead Door." Only after a confrontation with the technician did the customer discover that the technician was not actually from Overhead Door Company of Kansas City, but instead from OGD. *Id*. at 2–3.

Another Kansas-based Pace customer attempted to book a service call with Overhead Door Company of Kansas City through Google. Instead, an OGD technician arrived and purported to fix the garage doors, charging the customer $189 but leaving no receipt. When the customer found that the repairs were unsuccessful, she realized that the technician had placed an OGD sticker on her machine. This was the first time she realized that it was OGD—not Pace—who had performed the failed repair. [321-13] at 2.

With scores of other examples of similar confusion—largely caused by OGD and its technician and corporate practices—and with Pace's goodwill and company reputation squarely within the Lanham Act's zone of protection, the Court holds that Pace meets the requirements for standing under the statute.

b. Pace's Rights in the Marks

Rather than contest Pace's "standing," OGD argues that Pace lacks sufficient rights in the marks to bring its claims because it is a non-exclusive licensee, having been given derivative rights in the marks by ODC.

OGD bases its position in part on the Eleventh Circuit's ruling in *Kroma Makeup EU, LLC v. Boldface Licensing + Branding, Inc.*, 920 F.3d 704 (11th Cir. 2019), which held that "a licensee's right to sue to protect the mark 'largely depends on the rights granted to the licensee in the licensing agreement.'" 920 F.3d at 708 (quoting *Drew Est. Holding Co. v. Fantasia Distrib., Inc.*, 875 F. Supp. 2d 1360, 1366 (S.D. Fla. 2012)). It further held that § 1125(a) of the Lanham Act does not get "such an expansive reading" where "a licensing agreement between two parties governs each party's entitlement to infringement claims." *Id*. (quoting *Lexmark*, 572 U.S. at 129). The court in *Kroma* then held that—under the licensing agreement—the licensee lacked sufficient rights to bring an infringement claim against the defendant.

OGD thus argues that because the licensing agreement between ODC and Pace does not give Pace the right to sue for trademark infringement, *Kroma's* holding bars such claims.

Pace responds that OGD misconstrues *Kroma's* holding and overstates its applicability to this case. It asserts that *Kroma* did not issue a blanket holding that a licensee—exclusive or non-exclusive—

cannot possess sufficient rights to bring a Lanham Act claim. Rather, Pace argues, the circuit court construed the specific licensing agreement between the parties to prohibit the licensee from bringing an infringement claim. *See id.* (finding that the key question was, "does the licensing agreement between [licensor] and [licensee] give . . . the licensee, sufficient 'rights in the name' to sue under the Lanham Act?" and answering it in the negative (quoting *Camp Creek Hosp. Inns, Inc. v. Sheraton Franchise Corp.*, 139 F.3d 1396, 1412 (11th Cir. 1998))).

The court in *Kroma* found that—because of the language of the licensing agreement—the licensor "alone has the exclusive right to sue for infringement." *Id*. at 709–10.

In *Kroma*, the licensee "maintained the exclusive right to *use* the mark . . . ." But "importantly, [the agreement] only vested [the licensee] with the obligation to 'inform [the licensor] of any illegal use of the trademark,' prompting [the licensor] to file suit against the infringer—at which point [the licensor] would be required to compensate [the licensee] for its losses resulting from the infringement." *Id*. at 709. The court held that the two provisions, read together, meant that the licensor alone could sue for infringement of the mark.

While Pace is correct that such limiting provisions are absent in its licensing agreement with ODC, *Kroma* requires the Court to analyze what rights were *given* to the licensee, not what rights were withheld.

The *Kroma* court determined that "the issue boils down to [the licensee's] rights pursuant to the agreement. *Id.*

Here, Pace is granted the "right to use" the marks "in connection with the sale of products purchased by [Pace] from [ODC]." [321-1] at 15. Nowhere in the licensing agreement is Pace granted the right to sue. Absent such a provision—which the *Kroma* court found to be central to its holding—the Court holds that Pace lacks sufficient rights under the licensing agreement with ODC to bring its claims against OGD.[2]

Beyond the contractual bar dictated by *Kroma*, Pace, as a non-exclusive licensee, simply does not possess sufficient rights in the marks

[2] *See Kroma*, 920 F.3d at 710 ("Our sister courts of appeals have agreed with the general sentiment that a license agreement between two parties can limit a licensee's ability to bring a Lanham Act claim."). The plain interpretation of the licensing agreement is that it does not grant these rights to Pace, and the Court will not presume the existence of such a right, especially in a non-exclusive licensee.

to bring its claims. *Quabaug Rubber Co. v. Fabiano Shoe Co.*, 567 F.2d 154, 159–60 (1st Cir. 1977) (holding that "[plaintiff] is not a 'registrant' or an 'exclusive licensee' and does not have standing to assert federal statutory trademark infringement under the Lanham Act . . . . Nor does it have standing to seek relief for common law trademark infringement, since only the owner of the trademark may do so."); *Shell Co. v. Los Frailes Serv. Station, Inc.*, 596 F. Supp. 2d 193, 202 (D.P.R. 2008) (parties who can bring trademark infringement claims "include[] assignees . . . and . . . may include exclusive licensees, but . . . certainly does not include nonexclusive licensee." (citing *Quabaug*, 567 F.2d at 159–60)); *Aceto Corp. v. TherapeuticsMD, Inc.*, 953 F. Supp. 2d 1269, 1280 (S.D. Fla. 2013) ("Trademark licensees . . . typically do not have standing to sue" under federal trademark infringement statutes.) (quoting *Geltech Sols., Inc. v. Marteal, Ltd.*, 09-CV-81027, 2010 WL 1791423, at *3 (S.D. Fla. May 5, 2010)).

Pace argues that its unfair competition claims should withstand summary judgment even if the Court dismisses its infringement claim. However, it has pointed to no applicable case law—and the Court has found none—that allows a non-exclusive licensee to bring any claims, premised on the licensor's marks alone, in the absence of the licensor. This is especially so where, as here, the licensing agreement does not grant the licensee anything more than the right to "use" the marks nor, as discussed above, does it grant the licensee the right to sue on the marks.

"The law is clear that while a license is in effect, use of a licensed mark by a licensee inures to the benefit of the licensor." *Casa Dimitri Corp. v. Invicta Watch Co. of Am.*, 270 F. Supp. 3d 1340, 1357 (S.D. Fla. 2017) (quoting *Clayton v. Howard Johnson Franchise Sys., Inc.*, 730 F. Supp. 1553, 1560 (M.D. Fla. 1988)). "As a result, from its use, 'the licensee, itself, retains no independent right in the mark.'" *Id.* (quoting *Cotton Ginny, Ltd. v. Cotton Gin, Inc.*, 691 F. Supp. 1347, 1354 (S.D. Fla. 1988)); *see also Marrero Enters. of Palm Beach, Inc. v. Estefan Enters., Inc.*, No. 06-81036-CIV, 2007 WL 4218990, at *2–3 (S.D. Fla. Nov. 29, 2007) (holding that a licensor must be joined to grant complete relief among the parties because the licensee's rights were "derived under a license agreement.")

Pace's rights in the marks derive from the licensing agreement between itself and ODC.[3] Despite Pace now claiming that it has independent rights in the marks, it has asserted in previous litigation that it "uses the OVERHEAD DOOR trade name . . . under its distributor agreement" with ODC and that it is "entitled to *use* the OVERHEAD DOOR trade name and operate its business as the "Overhead Door Company of Kansas City pursuant to" the licensing agreement. [325-22] ¶¶ 15, 18. Because Pace's rights are solely derived from the licensing agreement—and because the licensing agreement does not grant Pace the right to sue on the marks—it lacks sufficient rights in the marks Overhead Door Company of Atlanta/Kansas City to bring its claims.

To the extent that Pace can assert "common law" rights separate from those under the marks, "the licensee's common law rights 'merge' into, and become property of, the licensor[]." *Angel Flight of Ga., Inc. v.*

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[3] Specifically, in the licensing agreement, ODC grants Pace "the right to use the name 'Overhead Door Company of [Atlanta/Kansas City]'" and the "right to use" ODC's "marks, including . . . the trade names 'OVERHEAD DOOR' and 'OVERHEAD,' but only on or in connection with the sale of products purchased by" Pace from ODC. [284] at 10 § 3.

Angel Flight Se., Inc., No. 1:03-cv-3629-JTC, 2007 WL 9700530, at *2 (N.D. Ga. Feb. 12, 2007). "A licensee's prior claims of any independent rights to a trademark are lost, or merged into the license, when he accepts his position as licensee, thereby acknowledging the licensor owns the marks and that his rights are derived from the licensor and enure to the benefit of the licensor." *Id.* (quoting *Bunn-O-Matic Corp. v. Bunn Coffee Servs., Inc.*, 88 F. Supp. 2d 914, 923 (C.D. Ill. 2000)); *contra Ass'n of Co-op Members, Inc. v. Farmland Indus., Inc.*, 684 F.2d 1134, 1143 (5th Cir. 1982) (holding that while "[t]he licensor of a trademark is usually treated as a necessary or indispensible party in an infringement action by its licensee," "[t]his is not the case where . . . the rights asserted in the trademark derive not from a license agreement but from the common law." (citing *Pure Food Prods. Inc. v. Am. Bakeries Co.*, No. 72 C 2017, 1972 WL 19316, at *1 (N.D. Ill. Nov. 28, 1972))).

Because Pace's rights in the marks derive from its licensing agreement with ODC, Pace may not independently maintain its claims. Accordingly, the Court holds that Pace—as a non-exclusive licensee of the marks—cannot bring its claims for trademark infringement, unfair competition, or deceptive trade practices. The claims are due to be dismissed for lack of sufficient rights in the marks.[4]

2. Settlement Agreement

OGD also argues that Pace is barred from bringing its claims by the very existence of the Settlement Agreement between OGD and ODC. It contends that because ODC cannot itself reassert the claims it brought in the prior litigation, Pace—as a licensee of ODC—cannot bring its claims in this case. OGD argues that Pace's rights as a licensee are derived from ODC's rights in the marks. Because ODC cannot bring infringement claims against OGD, it argues, neither can Pace. The Court agrees.

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[4] Pace argues that it was given permission by ODC to bring these claims and that, alone, gives it sufficient rights to pursue its claims. On September 10, 2021, the last day it could file a reply brief in support of its motion, Pace filed a three-paragraph affidavit of the vice president and general manager of ODC, Richard Owen. In it, Owen states that Pace, as an ODC distributor, is not required to obtain ODC's approval prior to enforcing the trade names at issue.

The Court finds that this purported approval—after Pace's repeated representations under oath throughout discovery that ODC had *not* authorized this lawsuit—does not save Pace's claims. The ability to bring such claims is governed by the plain language of the licensing agreement, and the Court finds that such language is unambiguous. In the absence of any provision to the contrary, Pace is not entitled to bring suit on the marks.

OGD cites *Biosyntec, Inc. v. Baxter Healthcare Corp.*, 746 F. Supp. 5, 10 (D. Or. 1990), as support for its argument. In *Biosyntec*, the court held the licensor's "voluntary discharge of its claims against [the third-party infringer] is binding as to [the licensee]." *Biosyntec*, 746 F. Supp. at 11.

Here, ODC's voluntary discharge of its claims against OGD strips Pace of any claims against OGD premised on the same conduct. Because Pace's rights in the mark are derived exclusively from its licensing agreement with ODC, ODC's surrender of its rights in the Settlement Agreement acts to eliminate Pace's rights to bring suit on the marks.

The court in *Biosyntec* also found that the licensee was barred by the terms of the licensing agreement from bringing an infringement claim. While no such explicit bar exists in this case, the Court held, *supra*, that absent an express grant of the right to sue, a non-exclusive licnesee may not independently maintain claims on the licensor's marks.[5]

[5] In *Biosyntec*, the licensee was exclusive—given *more* rights than a non-exclusive licensee such as Pace. Even with the additional rights, the licensee was barred from bringing suit because of the settlement agreement.

Pace argues that the Settlement Agreement, by its terms, does not apply to licensees like itself. Paragraph 1 of the Settlement Agreement reads, in part, "[t]he Parties expressly acknowledge that [the agreement] shall not be binding on . . . current and future licensees, distributors, and resellers of ODC *except* OD Lubbock." [266-4] ¶ 1.

While the Court agrees that the Settlement Agreement's affirmative obligations are non-binding on ODC's non-Lubbock distributors, ODC's voluntary discharge of its claims against OGD is necessarily binding on Pace's claims because those claims are premised entirely on Pace's derivative rights.

Thus, the Court finds that the Settlement Agreement further bars Pace's claims. Because Pace's rights in the marks are derived entirely from its licensing agreement with ODC, ODC's voluntary discharge of those rights in the Settlement Agreement acts to discharge Pace's rights as well.

3. Conclusion

For the foregoing reasons, OGD's motion for summary judgment will be granted with respect to Pace's infringement claim and its claims for unfair competition under the Lanham Act. It will also be granted as to Pace's claims for deceptive trade practices in violation of the Georgia Uniform Deceptive Trade Practices Act and statutory and common law unfair competition, as those claims are based on Pace's derivative rights in the marks. Pace's motion for partial summary judgment will be denied as to OGD's second, third, fourth, and fifth affirmative defenses.

B. Genericness

OGD moves for summary judgment on its counterclaim for a declaratory judgment that the terms "overhead" and "overhead door(s)" are generic in connection with garage doors and garage door servicing. It argues that Pace bears the burden of proving non-genericness and that it has failed to meet that burden. It contends that the "relevant public" uses or understands the terms "overhead" and "overhead door" to refer to "doors that open overhead" or garage doors. OGD points to extensive evidence of the purportedly generic use of the terms. It points to generic use by Pace and ODC, generic use by Pace's customers, and generic use of the terms throughout the industry—in trade publications, government documents, and patent filings.

Pace counters that the marks must be viewed in their entireties. Therefore, it asserts, the question is not whether "overhead" and "overhead doors" are generic, but whether "Overhead Door Company of Atlanta" and "Overhead Door Company of Kansas City" are generic to the relevant public. It argues that even if the Court finds that the terms are generic, such a finding does not foreclose its unfair competition claim. It suggests that such a claim can be maintained even if the marks themselves are unprotectable. Finally, it contends, there is a genuine dispute as to the genericness of "overhead" and "overhead door" such that summary judgment would be improper. It cites ample evidence for this argument, including a survey of relevant consumers, sworn declarations from its customers about their perception of the terms, and dictionary definitions. It also argues that OGD's evidence is insufficient to prove genericness because it does not focus on the relevant genus of consumers, is irrelevant because it concerns commercial—not residential—doors, and is far outweighed by evidence suggesting the terms are not generic.

While the Court finds that there is indeed a genuine and material dispute as to the genericness of the terms, because the Court is granting summary judgment on Pace's claims in their entirety, it will dismiss OGD's counterclaim for declaratory judgment as moot. Accordingly, OGD's motion for summary judgment on its counterclaim will be denied as moot. Similarly, Pace's motion for summary judgment with respect to OGD's sixth affirmative defense—genericness of the marks—will be denied as moot. OGD's counterclaim for declaratory judgment on genericness will be dismissed as moot.

C. OGD's Other Affirmative Defenses

Pace also moves for summary judgment on several of OGD's other affirmative defenses: fair use; innocent infringement; third-party use; estoppel (delay, waiver, and acquiescence); and unclean hands. Because the Court is granting summary judgment for OGD in its entirety, Pace's motion for summary judgment as to these defenses will be denied as moot.

IV. Conclusion

For the foregoing reasons, OGD's motion [215] for summary judgment is granted in part and denied in part. It is granted as to Pace's claims for common law trademark infringement, Lanham Act, statutory, and common law unfair competition, and for deceptive trade practices. It is denied as to its counterclaim for declaratory judgment on genericness. However, its counterclaim for declaratory judgment is dismissed as moot.

Pace's motion [280] for partial summary judgment is denied. It is denied on the merits as to OGD's second, third, fourth, and fifth affirmative defenses. Its motion as to OGD's sixth, eighth, tenth, twelfth, thirteenth, fifteenth, seventeenth, eighteenth, nineteenth, and twentieth affirmative defenses is denied as moot. Additionally, Pace's motion [313] to strike is denied as moot. The Clerk is directed to close this case.

IT IS SO ORDERED this 8th day of March, 2022.

Timothy C. Batten, Sr.
Chief United States District Judge