

No. 19-462

IN THE
Supreme Court of the United States

A TOP NEW CASTING, INCORPORATED,

Petitioner,

v.

BODUM USA, INCORPORATED,

Respondent.

ON PETITION FOR A WRIT OF CERTIORARI TO THE UNITED
STATES COURT OF APPEALS FOR THE SEVENTH CIRCUIT

BRIEF IN OPPOSITION

NICOLE J. WING, Esq.
Counsel of Record
VEDDER PRICE P.C.
222 North LaSalle Street
Chicago, Illinois 60601
(312) 609-7500
nwing@vedderprice.com

Counsel for Respondent



QUESTION PRESENTED FOR REVIEW

Whether the Seventh Circuit Court of Appeals properly affirmed a jury's verdict in favor of Bodum USA, Inc., and against A Top New Casting, Inc., when the evidence before the jury was sufficient to show that the aesthetic design of the CHAMBORD® French press coffee maker was not functional under the parameters established by this Court.

PARTIES TO THE PROCEEDING

Respondent Bodum USA, Inc. (“Bodum”) is a Delaware corporation. Petitioner A Top New Casting, Inc. (“A Top” or “Petitioner”), at the time of trial, was a New York corporation.

CORPORATE DISCLOSURE STATEMENT

Pursuant to Rule 29.6 of the Rules of the Supreme Court of the United States, Respondent makes the following disclosure:

Respondent has a parent corporation, Bodum Holding AG. No publicly held company owns 10% or more of Respondent's stock.

PROCEEDINGS BELOW

Bodum USA, Inc. v. A Top New Casting, Inc., No. 16 C 2916, United States District Court for the Northern District of Illinois, Eastern Division. Judgment Entered June 6, 2018.

Bodum USA, Inc. v. A Top New Casting Inc., No. 18-3020, United States Court of Appeals for the Seventh Circuit. Judgment Entered June 12, 2019.

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STATEMENT OF THE CASE

The Seventh Circuit's unanimous decision to affirm a jury's verdict and the district court's rulings on post-trial motions protecting Bodum's trade dress rights in the CHAMBORD® French press coffee maker was proper and does not warrant further review by this Court. Petitioner asks this Court to grant certiorari for two reasons: the Seventh Circuit did not apply the standard for determining functionality established by this Court in *TrafFix*, and its decision creates a circuit split with the Ninth Circuit's holding in *Apple*. Neither of these arguments has merit. The Seventh Circuit properly applied *TrafFix* to this case, and correctly distinguished the facts in this case from those in *Apple*. Petitioner uses these arguments as a guise for its true purpose in seeking review from this Court; it aims to have this Court review the merits of the evidence that was before the jury, and reach a different result. Because there is nothing for this Court to review in regards to the Seventh Circuit's proper application of *TrafFix*, and its alignment with the reasoning used in *Apple*, the Petition should be denied.

Bodum is the leading seller of distinctive specialty houseware products, including its coffee and tea makers. For nearly three decades, Bodum has had the exclusive rights to distribute the CHAMBORD®, which is widely known as an iconically designed houseware product. Bodum has spent millions of dollars promoting the CHAMBORD®, which has been recognized as classic by various institutions. Protecting its CHAMBORD® design is paramount to Bodum, and Bodum has expended extensive effort into policing any infringing products.

In 2014, Petitioner began selling a confusingly similar competing French press coffee maker called the SterlingPro through Amazon. In response, Bodum filed suit against Petitioner in the Northern District of Illinois for, in relevant part, trade dress infringement under the Lanham Act. The case was tried before a jury, which found in favor of Bodum. The jury held that Petitioner willfully infringed Bodum's CHAMBORD® trade dress. Petitioner moved for judgment as a matter of law under FED. R. CIV. P. 50, and for a new trial under Rule 59. The court denied both of these motions, and granted Bodum's motion for enhanced damages. The court also granted Bodum's request for a permanent injunction preventing Petitioner from continuing to sell its infringing French presses.

Petitioner appealed to the United States Court of Appeals for the Seventh Circuit. Petitioner did not deny that it copied the CHAMBORD® design—the products' similarity is undeniable. A Top argued only that the claimed trade dress elements on the CHAMBORD® French press were functional, which would deny a product trade dress protection. Bodum argued that the product did not need to look like the CHAMBORD® to serve the purpose of making a cup of coffee, strongly evidenced by the dozens of different ways French press coffee makers are designed. The Seventh Circuit agreed with Bodum and found that A Top confused the concept of something having a use (e.g., the product's handle) and being functional, as that term is used in trade dress law. In making this determination, the Seventh Circuit concluded that Bodum presented sufficient evidence for the jury to have found that Bodum's claimed trade dress was nonfunctional.

REASONS FOR DENYING THE PETITION

The Seventh Circuit’s decision to affirm the jury’s finding of protectable trade dress applied the decision of this Court in *TrafFix*—it did not conflict with or erode that decision. The Seventh Circuit’s decision also does not conflict with the Ninth Circuit’s holding in *Apple*; the *Bodum* and *Apple* cases merely presented distinguishable facts that warranted different conclusions after application of well-established trademark law. The Seventh Circuit correctly held that Bodum presented enough evidence to satisfy the standard set in *TrafFix*, whereby a plaintiff must prove non-functionality by demonstrating that a particular feature or set of features does not affect the cost or quality of a product. In particular, the Seventh Circuit noted that Bodum (unlike Apple) *had* presented evidence that the CHAMBORD® design is not used because of a cost or quality advantage, and the design elements that comprise its trade dress are not relatively simple or inexpensive to manufacture. The Seventh Circuit specifically called out multiple pieces of evidence that met the *TrafFix* legal standard, as addressed below. This is application of *TrafFix* to the facts of this case, not a rewriting of *TrafFix*. Petitioner is merely asking for a review of the merits of the evidence that was before the jury. This is not the function of this Court and, therefore, review by this Court is unwarranted. The Petition should be denied.

I.

**THE DECISION BELOW DID NOT CONFLICT
WITH ESTABLISHED SUPREME COURT
PRECEDENT**

This is a Lanham Act case that involved application of United States Supreme Court precedent that was established nearly 20 years ago—the standards for non-functionality in trademark law. Supreme Court Rule 10 provides as follows:

Review on a writ of certiorari is not a matter of right, but of judicial discretion. A petition for a writ of certiorari will be granted only for compelling reasons. The following, although neither controlling nor fully measuring the Court's discretion, indicate the character of the reasons the Court considers:

(c) a state court or a United States court of appeals has decided an important question of federal law that has not been, but should be, settled by this Court, or has decided an important federal question in a way that conflicts with relevant decisions of this Court.

A petition for a writ of certiorari is rarely granted when the asserted error consists of erroneous factual findings or the misapplication of a properly stated rule of law.

SUP. CT. R. 10.

The Petition flies in the face of Rule 10. Petitioner's first argument is that the Seventh Circuit ignored or misapplied *TrafFix*. Petitioner does *not* argue that there is an important question of federal law that needs to be settled. The law is long-settled. *TrafFix* established that in evaluating whether trade dress is functional, a court should determine whether the trade dress at issue "is essential to the use or purpose of the article or if it affects the cost or quality of the article." *TrafFix Devices v. Mktg. Displays*, 532 U.S. 23, 32 (2001). New standards for non-functionality are not necessary or appropriate. The Seventh Circuit had the appropriate standards before it. Indeed, the Seventh Circuit stated the law as follows:

The Supreme Court has explained that "a product feature is functional," and cannot serve as a trademark, "if it is essential to the use or purpose of the article or if it affects the cost or quality of the article." Even if a claimed trade dress does not satisfy this first test, "it can still be functional if it is a 'competitive necessity,' that is, if its exclusive use 'would put competitors at a significant non-reputation-related disadvantage.'" Where as here, the claimed trade dress is unregistered, it is the burden of the party asserting protection to prove that the trade dress is not functional.

In deciding whether a trade dress element is functional, we consider several factors: (1) the existence of a utility patent, expired or unexpired, that involves or describes the functionality of an item's design element; (2) the utilitarian properties of the item's unpatented

design elements; (3) advertising of the item that touts the utilitarian advantages of the item's design elements; (4) the dearth of, or difficulty creating, alternative designs for the item's purpose; (5) the effect of the design feature on an item's quality or cost.

No one factor is dispositive.

Bodum USA, Inc. v. A Top New Casting Inc., 927 F.3d 486, 491-92 (7th Cir. 2019).

Applying this law, the Seventh Circuit found that Bodum had met its burden.

Rather than arguing in the Petition that new law needs to be established or a conflict with prior law resolved, Petitioner essentially argues that Bodum's evidence was not enough to meet the legal standards. Specifically, Petitioner states that "there was no proof in the record that the design itself—as opposed to the materials used to produce the product—was not the simplest or least expensive to produce." (Pet. App. 6.) Petitioner goes on to state further that "the *only* evidence in the record was the total cost of the Chambord, produced with its expensive glass and chrome plated metal . . . there was no proof in the record that the Chambord was not the cheapest design to produce, independent of its materials." (*Id.*) Deciding sufficiency of the trial evidence is not customary for this Court. *Brooke Grp. v. Brown & Williamson Tobacco Corp.*, 509 U.S. 209, 230 (1993).

In any event, even the most cursory review of the Seventh Circuit's analysis proves Petitioner's contentions untrue. The Seventh Circuit specifically noted:

Bodum presented sufficient evidence from which a jury could conclude that the Chambord's design conferred no cost or quality advantage that made it functional. Bodum's expert, Mr. Anders, testified the Chambord design was "complex" and that there are "simpler ways of doing this." He explained the more complex the structure, the more expensive the product is to manufacture, so he disagreed with A Top's expert that the Chambord was the least expensive method to manufacture a French press. Mr. Anders also explained that plastic is generally cheaper to use than metal in manufacturing, so plastic-framed French presses would be cheaper to manufacture than the metal-framed Chambord.

Joergen Bodum further supported Mr. Anders's opinion in his testimony regarding the many different French presses Bodum produces. For example, Bodum's "Bistro" French press does not have a metal frame, a domed lid, or a C-shaped handle. Mr. Bodum testified that the Bistro is less expensive to produce ("maybe less than half of what it costs to make a Chambord") and less time-consuming to produce because it requires less material than the Chambord. Although the Bistro was a successful first product for the company, Mr. Bodum testified he decided to produce the Chambord, a more complex and expensive product, in addition to the Bistro because he was interested in its iconic French design. Mr. Bodum also discussed the manufacturing costs to produce

Bodum’s various French press coffeemakers. He explained that the Chambord is neither the cheapest nor the most expensive French press Bodum sells. Thus, Mr. Bodum’s testimony supported that the Chambord’s overall design conferred no particular cost advantage that made it functional.

Indeed, Jian Liang, A Top’s CEO, testified that A Top produces another French press with a plastic frame that is less expensive than the metal SterlingPro. This testimony further demonstrates that the Chambord’s design does not provide a cost advantage. Contrary to A Top’s argument, Bodum provided evidence sufficient for the jury to conclude that the Chambord’s appearance is costlier to manufacture than to design around, which supports that the Chambord trade dress is not functional.

Bodum, 927 F.3d at 494-95.

The Seventh Circuit also pointed to evidence showing that the design Bodum claims trade dress over includes materials that are more expensive than necessary to create a functioning French press. *Id.* at 493-94. Petitioner’s assertion that “there was no proof in the record that the design itself—as opposed to the materials used to produce the product—was not the simplest or least expensive to produce” is unsupported and baseless. (Pet. App. 6.) The Seventh Circuit specifically highlighted the CHAMBORD®’s complex design, how costly it is to manufacture and its composition of expensive materials

that are not necessary to create a functioning French press. Even Petitioner’s CEO conceded that Petitioner produces another French press that is cheaper than its model at the center of this case. These are all facts that go beyond just the materials used to make the French press, and point to non-functionality under the *TrafFix* standards.

The Seventh Circuit did not disregard *TrafFix* and create its own law, like the Petition suggests it did. Petitioner maintains that the District Court erred “when it required no proof that the *design* did not confer a cost or quality advantage and was not the cheapest way to manufacture the Chambord.” (Pet. App. 6.) Yet, the Seventh Circuit specifically addressed Bodum’s burden to prove that its design did not confer a cost or quality advantage when it stated that Bodum “merely needed to prove that preventing competitors from copying the Chambord’s particular *design* would not significantly disadvantage them from producing a competitive and cost-efficient French press coffeemaker.” *Bodum*, 927 F.3d at 492. Bodum *was* required to prove that its design did not confer a cost advantage, and the court held that it met that burden. *See id.* at 494 n.4 (“The Chambord design [does] not confer any particular cost or quality advantage for the product.”). The court applied the law, and Petitioner disagrees with that application. But, the role of this Court is not to review the merits of the underlying case. *Cavazo v. Smith*, 132 S. Ct. 2, 9 (2011) (“Error correction is outside the mainstream of the Court’s functions.”) (Alito, J., concurring) (citation omitted). The question before the Court is whether there is a question or conflict that needs to be decided—and the answer to that question is “no.”

II.**THERE IS NO CONFLICT BETWEEN THE
SEVENTH AND NINTH CIRCUITS**

Petitioner’s second effort to shoehorn this case into the category of decisions worthy of review is to manufacture a circuit split that does not exist. Supreme Court Rule 10 contemplates consideration of a situation in which “a United States court of appeals has entered a decision in conflict with the decision of another United States court of appeals on the same important matter; has decided an important federal question in a way that conflicts with a decision by a state court of last resort; or has so far departed from the accepted and usual course of judicial proceedings, or sanctioned such a departure by a lower court, as to call for an exercise of this Court’s supervisory power.” SUP. CT. R. 10(A). This is not the present situation. Both the Seventh Circuit in *Bodum* and the Ninth Circuit in *Apple* applied the Supreme Court precedent in *TrafFix*. As courts often do, they came to different results because of distinguishable facts.

In *Apple*, the Ninth Circuit was tasked with determining whether a jury’s finding that Samsung was liable for the likely dilution of Apple’s iPhone trade dresses under the Lanham Act was proper. *Apple Inc. v. Samsung Elecs. Co.*, 786 F.3d 983, 990 (9th Cir. 2015). Apple claimed that various elements of its iPhone 3G and 3GS products, including their rectangular shape, flat, clear surface, display screen, substantial black borders and display features were nonfunctional and, therefore, protectable as unregistered trade dress. *Id.* at 992. Relevant to this case, Apple argued that the design resulted from

a comparatively simple or inexpensive method of manufacture. *Id.* Specifically, Apple contended that “[t]he iPhone design did not result from a “comparatively simple or inexpensive method of manufacture” because Apple experienced manufacturing challenges.” *Id.* at 994. The Ninth Circuit, in reversing the jury’s finding of protectable trade dress, held that the “manufacturing challenges, however, resulted from the durability considerations for the iPhone and not from the design of the unregistered trade dress.” *Id.* That is, “the durability advantages that resulted from the manufacturing challenges . . . [were] outside the scope of what Apple defines as its unregistered trade dress.” *Id.* Because any complexity or expense in manufacturing was not related to any of Apple’s claimed trade dress elements, the court held that the unregistered trade dress was functional and, therefore, not protectable. *Id.* at 994-95.

In contrast, the Seventh Circuit in *Bodum* found the *TrafFix* test was satisfied because of the evidence presented to the jury, specifically with regard to the claimed trade dress elements. The Seventh Circuit, among other pieces of evidence as discussed above, noted the expert testimony that the CHAMBORD® design is complex, and that this complexity makes it a *more* expensive product to manufacture. *Bodum*, 927 F.3d at 494. Further testimony proved that using metal in the CHAMBORD®’s frame and feet (two of the claimed trade dress elements) is more expensive than plastic. *Id.* The same goes for the metal domed lid, the handle attachment, the rounded knob atop the plunger and the C-shaped handle. *Id.* Contrary to Petitioner’s argument that “there was no evidence in the record to show that the claimed product configuration trade dress was not

relatively simple or inexpensive to manufacture,” all of the elements Bodum claims trade dress in, when configured, contribute to the difficulty and expense in manufacturing the CHAMBORD® design. (Pet. App. 8-9); *Id.* at 494.

Petitioner claims that the Seventh Circuit “attempt[ed] to distinguish *Apple* by finding that the materials used to produce the Chambord conferred no cost advantage.” (Pet. App. 8-9.) This is inaccurate; the Seventh Circuit’s decision was consistent with the rationale used in *Apple*. In *Apple*, “for the design elements that comprise Apple’s unregistered trade dress, Apple point[ed] to no evidence in the record to show they were not relatively simple or inexpensive to manufacture.” *Apple*, 786 F.3d at 994. Bodum, however, proved that the materials that make the CHAMBORD® distinct are well within the scope of what it defines as its unregistered trade dress, and do not confer any cost or quality advantage in manufacturing. *Bodum*, 927 F.3d at 494 n.4. The Seventh Circuit and *Apple* applied the same reasoning, but reached a different result; Bodum was able to prove that the design elements comprising its unregistered trade dress were not relatively simple or inexpensive to manufacture, whereas Apple could not. A factual distinction between two Lanham Act cases does not mean that there is a circuit split that needs to be resolved by this Court. Petitioner again is simply trying to challenge the district and appellate courts’ factual findings, which is not a reason for this Court to grant its petition. *See Easley v. Cromartie*, 532 U.S. 234, 242 (2001) (“We, like any reviewing court, will not reverse a lower court’s finding of fact simply because we ‘would have decided the case differently.’ . . . Where an intermediate court reviews, and affirms, a trial court’s factual findings, this Court will not ‘lightly overturn’ the

concurrent findings of the lower courts.”). Thus, none of the “certworthiness” factors are present to warrant this Court’s supervision. *Ross v. Moffit*, 417 U.S. 600, 617 (1974) (“This Court’s review . . . is discretionary and depends on numerous factors other than the perceived correctness of the judgment we are asked to review.”).

CONCLUSION

Petitioner has not established any compelling reason for this Court to grant a writ of certiorari, and the Petition should be denied for each of the foregoing reasons.

Respectfully submitted,

/s/ _____
NICOLE J. WING, Esq.
Counsel of Record
VEDDER PRICE P.C.
222 North LaSalle Street
Chicago, Illinois 60601
(312) 609-7500
nwing@vedderprice.com

Counsel for Respondent