

No. 20-873

**In The
Supreme Court of the United States**

—◆—
HERMAN MILLER, INC.,

Petitioner,

v.

BLUMENTHAL DISTRIBUTING, INC.,
DBA OFFICE STAR,

Respondent.

—◆—
**On Petition For A Writ Of Certiorari
To The United States Court Of Appeals
For The Ninth Circuit**

—◆—
**BLUMENTHAL DISTRIBUTING, INC.'S
OPPOSITION TO HERMAN MILLER, INC.'S
PETITION FOR A WRIT OF CERTIORARI**

—◆—
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QUESTION PRESENTED

Whether the Court of Appeals was correct in holding that Herman Miller, Inc. failed to introduce evidence sufficient to establish that the trade dresses of the Eames Aluminum Group chairs met the requisite level of fame to be considered “famous” under the Trademark Dilution Revision Act.

CORPORATE DISCLOSURE STATEMENT

Blumenthal Distributing, Inc. is a publicly held corporation, with no parent or other corporation holding more than 10% of its issued shares.

RELATED CASES

Blumenthal Distributing, Inc. v. Herman Miller, Inc., Nos. 18-56471 and 18-56493 in the Ninth Circuit. Judgment entered June 25, 2020. Rehearing denied August 4, 2020.

Blumenthal Distributing, Inc. v. Herman Miller, Inc., No. 5:14-cv-01926-JAK-SP in the Central District of California. Judgment entered October 31, 2018.

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OPINIONS BELOW

The opinion of the Court of Appeals (Appendix A to Herman Miller, Inc.’s Petition) is reported at *Blumenthal Distributing, Inc. v. Herman Miller, Inc.*, 963 F.3d 859 (9th Cir. 2020). The order of the Court of Appeals denying Blumenthal Distributing, Inc.’s (“OSP”) petition for panel rehearing and OSP and Herman Miller, Inc.’s motions for rehearing *en banc* (Appendix E to Herman Miller’s Petition) is not reported. The opinion of the district court denying OSP’s motion for JMOL (Appendix B to Herman Miller’s Petition) is reported at 2017 WL 3271706 (C.D.Cal. Aug. 1, 2017).

JURISDICTION

The judgment of the Court of Appeals was entered on June 25, 2020. The jurisdiction of this Court is invoked under 28 U.S.C. § 1254(1). The Court of Appeals also denied the parties’ requests for rehearing *en banc* on August 4, 2020. This Court’s March 19, 2020 Order extended the deadline to file any petition for a writ of certiorari due on or after March 19, 2020, to 150 days from the date of the lower court judgment, order denying discretionary review, or order denying a timely petition for rehearing. That Order remained in effect as of the filing of Herman Miller, Inc.’s Petition for a Writ of Certiorari.

CONSTITUTIONAL AND STATUTORY PROVISIONS INVOLVED

15 U.S.C. § 1125(c)(2)(A) defines the term “fame” for purposes of proving a “famous” trademark has been diluted:

“For purposes of paragraph (1), a mark is famous if it is widely recognized by the general consuming public of the United States as a designation of source of the goods or services of the mark’s owner. In determining whether a mark possesses the requisite degree of recognition, the court may consider all relevant factors, including the following:

(i) The duration, extent, and geographic reach of advertising and publicity of the mark, whether advertised or publicized by the owner or third parties.

(ii) The amount, volume, and geographic extent of sales of goods or services offered under the mark.

(iii) The extent of actual recognition of the mark.

(iv) Whether the mark was registered under the Act of March 3, 1881, or the Act of February 20, 1905, or on the principal register.”



I. INTRODUCTION

This case involves the product configuration trade dresses of certain chairs (referred to herein as the “Eames” chairs) sold by Herman Miller, Inc. (“HM”). At trial HM received jury verdicts that the trade dresses of the Eames chairs were infringed and diluted by the sale of certain chairs by Blumenthal Distributing, Inc., d/b/a Office Star Products (“OSP”). The Court of Appeals affirmed the judgment of infringement but reversed the judgment of dilution. As to dilution, the Court of Appeals found that the evidence, taken in the light most favorable to HM, was insufficient to show the requisite level of fame required under the Trademark Dilution Revision Act of 2006 (“TDRA”), 15 U.S.C. § 1125(c). As a result, the judgment for HM on its dilution claim was reversed.

For a trade dress to be “famous” under the TDRA, the trade dress must be “widely recognized by the general consuming public of the United States as a designation of source of the goods or services of the [trade dress] owner.” 15 U.S.C. § 1125(c)(2). The requisite level of fame has been described as that of a “select class” of marks that are “truly prominent and renowned,” (*Avery Dennison Corp. v. Sumpton*, 189 F.3d 868, 875 (9th Cir. 1999)), “part of the collective national consciousness,” (*Thane Int’l, Inc. v. Trek Bicycle Corp.*, 305 F.3d 894, 912 (9th Cir. 2002) (applying prior version of 15 U.S.C. § 1125)) and “have a degree of distinctiveness and ‘strength’ beyond that needed to serve as a trademark” (*Avery Dennison*, 189 F.3d at 876).

There is no conflict among the circuits as to the requisite level of fame required by the TDRA. This case does not raise any conflict with governing Supreme Court precedents. Nor does this case present an exceptionally important issue of federal law with significant practical consequences.

The *de novo* review by the Ninth Circuit was straightforward. It simply considered the sufficiency of the evidence supporting the finding that the Eames trade dresses were famous. The test applied was “whether the evidence, construed in the light most favorable to [HM], permits only one reasonable conclusion, and that conclusion is contrary to the jury.” *Estate of Diaz v. City of Anaheim*, 840 F.3d 592, 604 (9th Cir. 2016); see *Blumenthal Distrib., Inc. v. Herman Miller, Inc.*, 963 F.3d 859, 872 (9th Cir. 2020) (internal citation omitted). The Court of Appeals precisely followed this test. And the Court found the evidence lacking.

The Ninth Circuit construed the facts in the light most favorable to HM. This is highly deferential to the jury verdict. Even so, HM’s evidence failed to meet the high bar for fame under the TDRA. HM now seeks to lower the bar.

In its Petition, HM asserts that this case presents the same issue as that presented by *Google, LLC v. Oracle America, Inc.*, No 18-956, namely that the Ninth Circuit’s review implicates the Seventh Amendment, and seeks the issuance of a GVR order. This request should be denied. HM is not correct that any “fact tried by a jury [was] re-examined” by the Ninth Circuit. The

question in *Google* is whether Google’s copying of a portion of Oracle’s copyrighted software code is protected by fair use. The fair use doctrine is “an equitable rule of reason,” which typically involves the balancing of competing interests and inherently requires any facts in evidence to be accorded relative weight. *Harper & Row Publ’rs, Inc. v. Nation Enters.*, 471 U.S. 539, 560 (1985).

There is no balancing of competing interests in this case. The single question raised by this appeal is whether HM met its burden of presenting evidence sufficient to show the product configuration trade dresses of the Eames chairs meet the requisite level of fame required by the TDRA. The evidence is not at issue. The sufficiency of the evidence is. On appeal, this requires a *de novo* review by the Court. *Theme Promotions v. News Am. Mktg. FSI*, 546 F.3d 991, 999 (9th Cir. 2008) (“We review the district court’s grant or denial of a renewed motion for JMOL *de novo*. See *Josephs v. Pac. Bell*, 443 F.3d 1050, 1062 (9th Cir. 2006); *Johnson v. Paradise Valley Unified Sch. Dist.*, 251 F.3d 1222, 1226 (9th Cir. 2001). We must decide whether the evidence, construed in the light most favorable to the non-moving party, permits only one reasonable conclusion, and that conclusion is contrary to the jury’s verdict.”) (internal citations in original).

A GVR in this case would be pointless; HM failed to meet its burden of proof at trial, and regardless of the outcome in *Google v. Oracle*, HM cannot change this simple fact.

II. STATEMENT OF THE CASE

HM asserts that it has both unregistered and registered trade dress rights relating to its Eames Aluminum Group chairs. Based on those asserted unregistered and registered trade dress rights, HM asserted claims of trade dress infringement and dilution against OSP. The asserted unregistered trade dress was identified by HM's industrial design expert Robert Anders ("Anders") as the overall configuration of the combination of (a) the continuous seat back web, (b) the two side rails, (c) the upper spreader (back cross-bar) and (d) the circular forms (corner screws) at the ends of the side rails, and if present, (e) the armrests. (ER201:21-ER203:6, ER204:3-18). HM also claims rights in the overall look of the combination of the elements above with a Thin Pad or Soft Pad web construction. (See ER182-185).

According to Anders, no trade dress rights are claimed by HM for any subset of these features, only the combination of the features as a whole. (ER202:3-ER203:6). Examples of the Eames chairs are depicted below. (ER533-551).



Thin Pad Management Chair



Thin Pad Side Chair



Soft Pad Side Chair

With regard to the asserted registered trade dress rights, HM owns Trademark Registration No. 3,105,591 (the “Registration”), which issued in 2006 and states: “The mark consists of the overall shape and appearance of the upper portion of a chair frame, including the armrests. The chair frame is made of polished aluminum and polished aluminum is claimed as part of the mark.” (ER532).



The Registration drawing, reproduced above, shows an upper portion of a chair frame in solid lines. The upper portion consists of two side rails, an upper spreader or cross-bar, corner screws, and armrests. The base of the chair, including the tilt mechanism, is shown in broken or dotted lines, which are not claimed as part of the registration. (ER532).

At trial, HM Portfolio Lead Casey Bond (“Bond”) testified with regard to HM’s marketing of its Eames chairs. Neither Bond nor HM’s history expert John Berry (“Berry”) were aware of any studies that show the demographics of customers for the Eames chair, nor the results of any surveys or studies that reflect

the level of recognition of the Eames chair by the general public. (ER280:8-22 (Bond); ER289:9-22 (Berry)).

Bond testified that as of the trial in 2016, the company (HM) has Facebook followers of approximately 300,000, Twitter followers of about 400,000, and Instagram followers of about 175,000 (ER274:24-ER275:10), and that each year HM attends the NeoCon trade show. (ER274:9-19). Over 50,000 people attended NeoCon in 2016. (*Id.*) However, HM did not show any nexus between followers of HM (i.e., the company in general which sells many products) on social media to any recognition of the Eames trade dresses. Nor did HM present evidence as to the number of social media followers prior to October 2010, the date when OSP first introduced its accused chairs. (ER494). Further, no evidence was presented as to the number of attendees that visited HM's showroom at the NeoCon trade show or if the Eames chair was ever displayed. Bond also testified that the Eames chair was used in the television show *Mad Men* (ER273:14-ER274:6), but there was no evidence as to how many viewers watched *Mad Men* nor the demographics of viewers of the cable television show, and HM again did not show any nexus to any recognition by the general public at any point in time, let alone prior to October 2010.

HM presented no evidence of advertising of the Eames chairs through widespread advertising or marketing channels, e.g., television or magazines with a national circulation and broad consumer appeal. As the Ninth Circuit observed, "the Eames chairs appeared in obscure publications such as

Contract, Metropolis, and an ‘industry publication’ called Monday Morning Quarterback.” Blumenthal, 963 F.3d at 871.

HM’s expert Berry testified that a version of the Eames chair was inducted into art museums, including the Museum of Modern Art and the Los Angeles County Museum of Art. But HM presented no evidence as to the number of visitors to these museums, nor the number of visits to the exhibits, nor the demographics of these visitors, nor did HM show any nexus to any recognition by the general public. (SER78:15-22).

In its Petition, HM asserts that OSP’s Director of Seating Design Julien Egger (“Egger”) testified that he believed that the Eames chairs were famous. What he actually testified was that he believed that the Eames chairs were famous among people with a furniture design background and architects, but that to his knowledge, no one else would regard the Eames chair as famous. (ER217:5-13).

The total sales for the Eames Aluminum Group from 1991 through 2015 was 337,583 units. (ER552). The Soft Pad chairs totaled 70,581 unit sales over this same time period and Thin Pad chairs totaled 267,002 unit sales. (*Id.*) Looking at sales prior to the introduction of the accused chairs in 2010, sales of the Soft Pad chairs from 1991 through 2010 only totaled approximately 54,000 units, and sales of the Thin Pad chairs from 1991 through 2010 only totaled approximately 175,000 units. (*Id.*)

HM presented no evidence of sales, display, or recognition of the chair frame, i.e., of an Eames chair without any upholstery, as claimed in the Registration.

Jury Instruction No. 30 related to trade dress dilution and fame. (SER1759). In its Petition, HM discusses only a portion of the jury instruction, leaving out additional paragraphs, including an instruction that

“Herman Miller bears the burden of proving by a preponderance of the evidence that each of its alleged trade dresses is famous. A trade dress is famous if it is widely recognized by the general consuming public of the United States as a designation of source of the goods or services of the trade dress owner, whether or not the public knows the name of the trade dress owner.”

(SER1759).

The jury was also properly instructed, in Jury Instruction No. 30, that for dilution by each accused chair, “Herman Miller must prove that its corresponding, protectable trade dress was famous prior to the time that Office Star began selling the accused chair.” (SER1759). *See* 15 U.S.C. § 1125(c)(1); *Nissan Motor Co. v. Nissan Computer Corp.*, 378 F.3d 1002, 1013 (9th Cir. 2004) (a defendant’s first use of its mark “fixes the time by which famousness is to be measured”).

It was HM's burden to show that its trade dresses were each widely recognized by the general consuming public, but as the Ninth Circuit found, it did not do so. It was also HM's burden to show that its trade dresses achieved the requisite level of fame among the general consuming public prior to October 2010. Again, HM failed to show that even the scant evidence it provided fell into the correct timeframe.

The jury found that Herman Miller proved that its registered trade dress was distinctive and famous, the asserted unregistered trade dress in the Eames Thin Pad design was distinctive and famous, and that the asserted unregistered trade dress in the Eames Soft Pad design was distinctive and famous. (ER182-185).

After the trial, OSP moved under Fed. R. Civ. P. 50(b) to set aside the dilution verdicts for insufficient evidence of fame for each of the asserted trade dresses. The District Court denied the motion as to each asserted trade dress, but did grant a motion for remittitur finding the total dilution damages amount awarded by the jury to be unsupported.

OSP appealed the denial of its renewed motion for judgment as a matter of law to the Ninth Circuit, arguing that HM fell short of its burden of proving fame of the asserted trade dresses.

The Ninth Circuit, reviewing the renewed motion for judgment as a matter of law *de novo* as required (see *Dunlap v. Liberty Natural Prods., Inc.*, 878 F.3d 794, 797 (9th Cir. 2017)), ruled that the evidence HM presented at trial did not support a finding of fame

under the TDRA for any of the trade dresses as a matter of law.

III. ARGUMENT

A. The Ninth Circuit Properly Found That the Evidence Was Insufficient to Conclude That the Eames Chair Trade Dresses Were Famous Under 15 U.S.C. § 1125(c)

For a trade dress to be “famous” under 15 U.S.C. § 1125(c), the trade dress must be “widely recognized by the general consuming public of the United States as a designation of source of the goods or services of the [trade dress’s] owner.” 15 U.S.C. § 1125(c)(2). The requisite level of fame has been described as that of a “select class” of marks that are “truly prominent and renowned,” and “have a degree of distinctiveness and ‘strength’ beyond that needed to serve as a trademark.” *Avery Dennison*, 189 F.3d at 875, 876. Put in simpler terms, the requisite level of fame must be that of “a household name.” *Thane*, 305 F.3d at 911.¹

As noted in *Avery Dennison*, “Dilution causes of action, much more so than infringement and unfair competition laws, tread very close to granting ‘rights in gross’ in a trademark.” 189 F.3d at 875. The Court

¹ See also *Nissan Motor Co. v. Nissan Computer Corp.*, 378 F.3d 1002 (9th Cir. 2004) (same); *Rosetta Stone Ltd. v. Google, Inc.*, 676 F.3d 144, 171 (4th Cir. 2012) (same); *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 1373 (Fed. Cir. 2012) (same); *Kibler v. Hall*, 843 F.3d 1068, 1083 (6th Cir. 2016) (same); *Bd. of Regents v. KST Electric*, 550 F. Supp. 2d 657, 674 (W.D. Tex. 2008) (same).

continued, “We view the famousness prong of both dilution analyses as reinstating the balance – by carefully limiting the class of trademarks eligible for dilution protection, Congress and state legislatures granted the most potent form of trademark protection in a manner designed to minimize undue impact on other uses.” *Id.* In discussing prior proposed legislation, the Court also observed:

“In a 1987 report, which recommended an amendment to the Lanham Act to provide a federal dilution cause of action, the Trademark Review Commission of the United States Trademark Association emphasized the narrow reach of a dilution cause of action: ‘We believe that a limited category of trademarks, those which are truly famous and registered, are deserving of national protection from dilution.’ Trademark Review Commission, *Report & Recommendations*, 77 Trademark Rep. 375, 455 (Sept.-Oct. 1987).”

Id.

Proving fame in the context of dilution is a high bar and difficult to achieve. *Coach*, 668 F.3d at 1373 (“It is well-established that dilution fame is difficult to prove.”); *Everest Capital, Ltd. v. Everest Funds Mgmt. LLC*, 393 F.3d 755, 763 (8th Cir. 2005) (“The judicial consensus is that ‘famous’ is a rigorous standard.”); *Kibler*, 843 F.3d at 1083 (“It is difficult to establish fame under the Act sufficient to show trademark dilution.”). It is even more difficult for product configuration trade dresses. This is because “product design

almost invariably serves purposes other than source identification.” *Wal-Mart Stores, Inc. v. Samara Bros., Inc.*, 529 U.S. 205, 213 (2000).

The Ninth Circuit’s opinion regarding the evidence presented by HM at trial makes clear that HM fell far short of meeting its burden of proving each of the asserted Eames chair trade dresses was famous:

“Taken in the light most favorable to HM, the evidence establishes only that: HM spent, on average, \$550,000 per year on advertising the Eames chairs from 2004 through 2015 (and under \$400,000 per year from 2004 through 2009); the Eames chairs appeared in obscure publications such as *Contract*, *Metropolis*, and an ‘industry publication’ called *Monday Morning Quarterback*; at the time of trial in 2016, HM had, at the very most, around 875,000 unique followers on Facebook, Twitter, and Instagram combined; most of the Eames chairs are sold through a distribution channel consisting of only around 45 independently owned dealers with 130 locations across the country; and the Eames chairs were ‘very heavily’ featured in the TV show *Mad Men*, have appeared in other TV shows and movies, and have been exhibited at several American museums, including the Museum of Modern Art and the Henry Ford Museum. Because the evidence of the claimed EAMES trade dresses’ fame is plainly weaker than the evidence that *Thane* held legally

insufficient, we must hold that, as a matter of law, those trade dresses were not famous.”

Blumenthal, 963 F.3d at 871.

In its Petition, HM attempts to mislead the Court by suggesting other evidence was in the record. It was not. Tellingly, HM does not even bother trying to support its speculative arguments, such as “virtually any American who has ever visited office buildings or watched television or movies will in fact have seen the Eames chairs – probably many times.” This was not evidence in the record. What was in the record were modest sales of the Thin Pad chair of an average of 10,500 units per year between 1991 and 2015, and total sales of the Soft Pad chair of approximately 70,000 units through the same time period. HM presented very little evidence probative of fame of each of its asserted trade dresses (the registered chair frame, the unregistered trade dress in the Eames Thin Pad design, and the unregistered trade dress in the Eames Soft Pad design). Moreover, in casting the evidence in light very favorable to HM, the Ninth Circuit gave full weight to *all* of the evidence of advertising, publicity, and sales provided by HM, irrespective of HM’s burden of proving fame prior to October 2010, the date “by which famousness is to be measured.” *Nissan*, 378 F.3d at 1013.

For example, HM provided evidence of followers on its social media pages in 2016. But HM provided no evidence of the number of followers on its company’s social media pages as of October 2010. HM also provided

no evidence of the types of advertising on these social media pages, or the frequency with which the Eames trade dresses were shown on its company pages. HM also provided no evidence of user interaction or engagement. The Panel still gave the evidence of followers on its social media pages full weight, and correctly found that even accepting this as evidence in the pertinent timeframe, HM fell short of its burden of proof. Even assuming the jury accepted *all* of HM's evidence, as the Ninth Circuit did, HM did not, as a matter of law, prove fame among the general consuming public.

The Ninth Circuit's decision made clear that all of the evidence presented by HM was taken "in the light most favorable to HM." But the majority found that the evidence claimed was "plainly weaker" than evidence held to be legally insufficient in past dilution cases, compelling the conclusion that the asserted trade dresses are not famous as a matter of law. This was not a substitution by the Ninth Circuit of its own assessment of fact for that of the jury. This was an analysis of whether all facts presented by HM met HM's burden of proof, and the correct determination that HM's evidence failed to rise to the exacting standards of proving fame for its asserted trade dresses. Notably, the Dissent appears to have addressed whether the evidence supported a finding of secondary meaning, not fame:

"A trade dress is famous when the general consuming public recognizes the trade dress as associated with a singular owner; as is true throughout trademark law, whether the

general consuming public could *name* that owner is irrelevant. See *Maljack Prods., Inc. v. GoodTimes Home Video Corp.*, 81 F.3d 881, 887 (9th Cir. 1996) (explaining that the secondary meaning of a mark is established through proof that the public associates the mark “with a single source, even if that source is anonymous”); 1 J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition* § 3:12 (5th ed.) (explaining that “[a] trademark can identify a single, albeit *anonymous* source,” such that a buyer need not know “the corporate name of the producer or seller” (emphasis added)).

Blumenthal, 963 F.3d at 872 (emphasis in original).

The Dissent did not ask whether HM proved its asserted trade dresses each “have a degree of distinctiveness and ‘strength’ beyond that needed to serve as a trademark,” as is required for proving fame of a mark. *Avery Dennison*, 189 F.3d at 876. Instead, she merely asked whether HM’s evidence could have met the low benchmark of proving the mark serves as a trademark (i.e., has acquired secondary meaning).

As the Panel Majority correctly observed, prior panel guidance on the issue of *fame* compels the conclusion that HM did not meet its burden of proof as a matter of law. The Panel Majority discussed in detail the Ninth Circuit’s analysis in *Thane*, addressing whether the mark TREK was famous under the

Federal Trademark and Dilution Act of 1995 (“FTDA”).² In *Thane*, the Court found the plaintiff had not shown fame of its TREK mark, even though the mark was registered; the company spent “between \$3 million and \$5 million per year” on advertising, including in mainstream publications such as *Rolling Stone Magazine*, *Playboy*, and *Men’s Journal*; had around 4.5 million visitors to its website per year; made over 1,000 different products with the TREK mark that were sold by over 1,600 independent dealers in 2,000 locations across the nation; and sponsored superstar Lance Armstrong, who used TREK bicycles to win multiple Tour de France races, and appeared with a TREK bicycle on the front page of large circulation newspapers, at a press event with a sitting President, and even on a Wheaties box. *Id.* at 899, 912. This evidence far exceeds the evidence provided by HM. Even assuming the jury gave full weight to *all* of HM’s evidence and

² The FTDA was enacted in 1995 and was replaced by the TDRA of 2006. It is worth noting that, as the Panel observed, “we do not interpret the TDRA of 2006 to have lowered the standard for whether a mark has achieved fame among the general consuming public.” *Blumenthal Dist.*, 963 F.3d at 871 (citation omitted). In pertinent part, the TDRA actually narrowed the class of marks which could be called famous by eliminating niche fame. *See id.* at 870 (“The FTDA of 1995 was replaced by the Trademark Dilution Revision Act of 2006 (“TDRA of 2006”), which eliminated the concept of niche fame, defining fame as being ‘widely recognized by the general consuming public of the United States as a designation of source of the goods or services of the mark’s owner,’ 15 U.S.C. § 1125(c)(2)(A) (emphasis added), and omitting from its list of suggested factors the two from the FTDA of 1995 that related to niche markets.”); *Coach*, 668 F.3d at 1372-73 (“By using the ‘general consuming public’ as the benchmark, the [TDRA of 2006] eliminated the possibility of ‘niche fame.’”).

construing in the light most favorable to HM, HM fell short of meeting its burden.

Thane is not an outlier. In *Avery Dennison*, evidence of continuous use of “Avery” since the 1930s (registered since 1963) and continuous use of “Dennison” since the late 1800s (registered since 1908), coupled with more than \$5 million per year in advertising, and annual sales of all of its products of \$3 billion were insufficient to establish fame as a matter of law. *Id.*, 189 F.3d at 873, 879.

In *Bd. of Regents*, the Court found that the University of Texas had failed to establish fame among the general consuming public of its longhorn design mark as a matter of law, despite evidence of regularly nationally televised football games on ABC and ESPN “prominently featur[ing]” the logo, 97 nationally televised men’s college basketball games in the prior five seasons, team appearances in Bowl Championship Series games, including the Rose Bowl national championship which had over 35 million viewers, displays of the mark on a football helmet on two separate Wheaties boxes, and retail sales of products in stores such as Wal-Mart and Target totaling nearly \$400 million in 2005-06. *Id.*, 550 F. Supp. 2d at 677.

In *Pinterest, Inc. v. Pintrips, Inc.*, 140 F. Supp. 3d 997, 1033-34 (N.D. Cal. 2015), the Court found that Pinterest had failed to establish fame of its PINTEREST mark as a matter of law, finding that evidence of 25 million monthly active users did not support a finding of fame.

HM's evidence was insufficient to meet the high burden of proving fame. The Ninth Circuit properly held that the evidence was lacking as a matter of law.

B. The Ninth Circuit followed the Statutory language for Fame and Did Not Impose a *De Facto* Requirement of Consumer Survey Evidence

HM in its Petition suggests that the Ninth Circuit has now created a *de facto* requirement that a party claiming its trademark is famous for dilution purposes must present consumer survey evidence. It is unclear how HM reached this conclusion. The opinion references surveys in passing, noting that the Ninth Circuit has previously “explained ‘surveys showing that a large percentage of the general public recognizes the brand, press accounts about the popularity of the brand, or pop-culture references involving the brand would provide evidence of fame.’” *Blumenthal*, 963 F.3d at 870-71 (citing *Thane*, 305 F.3d at 912).

In reaching its determination that HM failed to meet the high evidentiary burden of proving fame, the majority discussed HM's evidence, through the lens of the four factors listed in 15 U.S.C. § 1125(c)(2). HM provided no evidence probative of the third factor: “the extent of actual recognition of the mark.” The majority's decision does not suggest surveys are required or that the four factor test is somehow supplanted, but instead relates to the fact that HM chose not to

provide evidence of actual recognition of the mark, which would usually be shown by survey.

HM attempts to create issues where there are none. The majority considered the facts HM presented in an effort to meet its burden of proof, analyzed those facts under settled law, and concluded HM's evidence fell far short of the high bar. The holding was unremarkable and did not create any new requirements for assessing fame of a mark.

IV. CONCLUSION

This case is unremarkable. The dilution issue was straightforward: HM had a very high burden of proof and it failed to present sufficient evidence to meet that burden. HM stretches the Ninth Circuit's opinion anyway it can to try and frame the case as something it is not. A GVR in this case would be pointless. HM's evidence simply cannot prove dilution, and the Ninth Circuit correctly held as such. HM's Petition should be denied.

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