

No. \_\_\_\_\_

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

FOREMOST TITLE & ESCROW SERVICES, LLC,

*Petitioner,*

vs.

FCOA, LLC,

*Respondent.*

**On Petition For A Writ Of Certiorari To The  
United States Court Of Appeals For The  
Eleventh Circuit**

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**PETITION FOR WRIT OF CERTIORARI**

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## QUESTION PRESENTED

Under 15 U.S.C. § 1065, certain trademarks are incontestable. All Circuits considering the issue, except the Eleventh, do not presume that an incontestable mark is strong and likely to cause confusion with a junior mark. Instead, every other Circuit requires the incontestable mark holder to prove the mark's strength and infringement—the likelihood of consumer confusion. But the Eleventh Circuit presumes that an incontestable trademark is strong, whether or not it is, and requires a junior mark holder to rebut that presumption, granting an incontestable mark-holder an additional right in the mark beyond the inability to challenge the mark's validity. This right is not intended by the Lanham Act or by the Constitution.

This Court, in *KP Permanent Make-Up, Inc. v. Lasting Impression I, Inc.*, 543 U.S. 111, 117-18 (2004), explains that “[s]ection 1115(b) places a burden of proving likelihood of confusion (that is, infringement) on the party charging infringement even when relying on an incontestable registration.” (citing *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 780 (1992) (Stevens, J, concurring); *Lone Star Steakhouse & Saloon, Inc. v. Alpha of Virginia, Inc.*, 43 F.3d 922, 935 (4th Cir. 1995)) (“And that...requires a showing the defendant's actual practice is likely to produce confusion in the minds of consumers about the origins of the goods or services in question.”).

The question presented is:

Whether the Eleventh Circuit is correct to relieve an incontestable trademark-holder of its burden to prove that its mark is strong and likely to be confused with a junior mark?

**PARTIES TO THE PROCEEDING**

This case involves these parties: Foremost Title & Escrow Services, LLC (“Petitioner” or “Foremost Title”) and FCOA, LLC (“Respondent”)

**CORPORATE DISCLOSURE STATEMENT**

Petitioner has no parent corporations, and no shareholders owns 10% or more of its stock.

## STATEMENT OF RELATED PROCEEDINGS

The related proceedings are:

1. *FCOA, LLC, v. Foremost Title & Escrow Services, LLC*, No. 1:17-cv-23971-KMW (S.D. Fla.), judgment entered on August 1, 2019.
2. *FCOA, LLC v. Foremost Title & Escrow Services, LLC*, No. 21-12355 (11th Cir.), judgment entered on March 29, 2023.

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## **PETITION FOR CERTIORARI**

Foremost Title & Escrow Services, LLC (“Foremost Title”), petitions for a writ of certiorari to review the judgment of the United States Court of Appeals for the Eleventh Circuit.

## **OPINIONS BELOW**

The Eleventh Circuit’s opinion is reported at 57 F.4th 939 and reproduced at Pet. App. 1a. The district court’s opinion is reported at 416 F. Supp.3d 1381 and is reproduced at Pet. App. 40a.

## **JURISDICTION**

The court of appeals’ opinion was issued on January 12, 2023. Petitioner timely petitioned for rehearing and rehearing en banc. The court of appeals denied the petitions on March 29, 2023. Pet. App. 41a. This Court has jurisdiction under 28 U.S.C. § 1254(1).

## **STATUTORY PROVISIONS INVOLVED**

The Lanham Act’s relevant provisions are reproduced at Pet. App. 63a.

## **INTRODUCTION**

A small law firm with offices in Georgia and South Carolina decides to start an affiliated title company to help its clients through the real estate purchase process. After brainstorming, the firm decides to call its new title company Foremost Title to reflect that it will offer the best service to its customers. The firm confirms that no other title company in the two states uses the name Foremost. The firm spends money developing and marketing the title company by creating a website, printing brochures, and advertising to its client base.

Foremost Insurance Company, a Farmers Insurance Group subsidiary, with more than three million insurance policies across the country, gets wind of this new title company and decides that a title company named Foremost affects its incontestable Foremost trademark, irrespective that the two Foremosts conduct business in totally different industries, do not have any overlap in their respective universes of actual or potential customers, do not compete with one another, and are legally barred from ever competing. No one associates the self-laudatory mark Foremost with Foremost Insurance.

Foremost Insurance has two options to “protect” its mark. Option 1: sue in South Carolina (within the Fourth Circuit), where Foremost would have to prove that consumers associate “Foremost” with Foremost Insurance to prove that consumers will likely be confused by Foremost Title’s business activities. Option 2: file in Georgia (within the Eleventh Circuit), where the court will presume that consumers associate “Foremost” with Foremost Insurance because Foremost Insurance’s trademark is incontestable and thereby will shift the burden to Foremost Title to prove that there is no consumer confusion between it and Foremost Insurance.

This counterfactual illustrates the problems with the circuit courts’ differing treatment of incontestable marks. Just by filing a trademark action in a court within the Eleventh Circuit, a trademark plaintiff enjoys enhanced property rights against a junior user that it would not have anywhere else in the country.

Petitioner asks the Court to consider the appropriate effect the Lanham Act gives to an incontestable trademark when conducting the likelihood of confusion trademark infringement

analysis. This Court’s decision in *KP Permanent Make-Up, Inc. v. Lasting Impression I, Inc.*, 543 U.S. 111 (2004), explains that § 1115(b)’s language—especially as amended in 1988—requires an incontestable trademark holder to prove that the way the junior user uses the mark is likely to confuse a consumer.

Below, the district court, relying on Eleventh-Circuit precedent, found that Respondent’s Foremost mark was presumed strong only because it was incontestable, despite Respondent having no evidence that its Foremost mark has any secondary meaning. Even though Respondent had a presumptively strong mark, the district court still granted summary judgment to petitioner, in part, because petitioner showed that the self-laudatory Foremost mark was in wide use throughout the nation for diverse goods and services and is thus a weak mark.

On appeal, the Eleventh Circuit, relying on its prior-panel-precedent rule, continued to apply “[t]he law in this Circuit [that] is almost certainly incorrect” and concluded that Respondent’s Foremost mark was strong merely because it is incontestable. The court reversed summary judgment concluding that petitioner’s summary judgment evidence could not rebut the Foremost mark’s presumed strength. The Eleventh Circuit denied petitioner’s petitions for rehearing and for rehearing *en banc*.

All other Circuits require proof that an incontestable descriptive mark has strength—that a mark identify a good or service’s source to consumers—though some Circuits treat a mark’s incontestable status as some evidence of the mark’s strength. Nowhere but in the Eleventh Circuit is an incontestable mark presumed strong by judicial fiat alone. Confusing incontestability with strength makes

bad law. This idiosyncratic holding leads to negative economic consequences that Congress did not intend by stifling competition and spawning meritless litigation augmented by forum-shopping. The Court should grant this petition to correct the Eleventh Circuit's conflict with *KP Permanent Make-Up* and its erroneous interpretation of 15 U.S.C. §§ 1065 and 1115(b). Doing so will restore uniformity to trademark law by clarifying that courts should resolve trademark disputes only by determining whether a junior mark causes consumer confusion with a senior mark. This places the burden to prove consumer confusion where it properly belongs: on the party claiming infringement. Incontestable status alone does not factor into the question of a mark's strength. It is time to dispel the fiction that it does.

## STATEMENT OF THE CASE

### A. Legal Framework

In 1946, Congress passed the Lanham Act to create a uniform national trademark registration system. *Park 'N Fly, Inc. v. Dollar Park and Fly, Inc.*, 469 U.S. 189, 193 (1985); *Inwood Labs., Inc. v. Ives Labs., Inc.*, 456 U.S. 844, 861 n.2 (1982) (White, J., concurring). To encourage trademark holders to register their trademarks, the Lanham Act provided exclusive remedies for registered trademarks, 15 U.S.C. § 1114, and provided that a registered trademark “shall be prima facie evidence of the validity of the registered mark and of the registration of the mark, of the registrant's ownership of the mark, and of the registrant's exclusive right to use the registered mark in commerce...,” § 1115(a).

Congress also allowed a registered trademark to attain “incontestable” status if, among other

requirements, the mark holder files an affidavit after five years that the mark has been in continuous use. § 1065. With the statutory conditions met, “the right of the owner to *use* such registered mark...shall be incontestable.” *Id.* (emphasis added).

To prove a trademark infringement claim, a plaintiff must show more than their own right to use the mark, incontestable or not. To claim an exclusive right to use the mark and to prevail on such a claim, the plaintiff must also prove that (1) it holds a valid trademark with priority over the junior mark, and (2) the junior mark’s use is likely to cause confusion with the plaintiff’s mark. Pet. App. 9a (citing *Frehling Enters., Inc. v. Int’l Select Grp., Inc.*, 192 F.3d 1330, 1335 (11th Cir. 1999)).

Congress protected incontestable registered marks by treating its incontestable status as conclusive evidence that the mark is valid and registered, giving the registrant the right to use the mark in commerce. § 1115(b). In other words, when prosecuting an infringement claim, an incontestable trademark holder need not present any evidence showing that the mark is valid or that it has the right to use the mark.

This Court has twice addressed the Lanham Act’s incontestability provision. First in *Park ’N Fly*, this Court, discussing the mark’s *validity*, held that an alleged trademark infringer could not defend itself by arguing that the incontestable trademark was invalid as “merely descriptive.” 469 U.S. at 196-97. That defense, this Court concluded, was not included with those listed in the Lanham Act, even though a merely descriptive mark is not registerable unless it has secondary meaning. *Id.*

Next in *KP Permanent Make-Up*, this Court held that, to prove *infringement* of an incontestable

mark, a plaintiff must prove “that the defendant’s actual practice is likely to cause confusion” in consumer’s minds about where the good or service comes from, and that the defendant need not negate the likelihood of confusion to prevail on a fair-use defense. 543 U.S. at 117, 124.

Following *Park ’N Fly*, the Eleventh Circuit recognized that this Court had not addressed how a trademark’s incontestable status affects the mark’s strength and held that a court must presume incontestable marks “to be at least descriptive with secondary meaning, and therefore relatively strong mark[s].” *Dieter v. B & H Indus. of Sw. Florida, Inc.*, 880 F.2d 322, 329 (11th Cir. 1989). Other Circuits give varying weight to an incontestable trademark’s status, but all require an incontestable trademark holder to introduce some evidence that the mark has secondary meaning to consumers. This petition asks the Court to resolve this important question dividing the United States Courts of Appeals.

### **B. Factual Background**

Respondent’s Foremost mark has been in use since 1952 when its parent company, Foremost Insurance Company, was founded. Pet. App. 2a. Foremost Insurance used the mark to sell insurance and now sells homeowners’ insurance, property insurance, fire insurance, business insurance, landlord insurance, and mobile home insurance. Pet. App. 3a. Foremost Insurance does not sell title insurance and Florida law prohibits Foremost Insurance from selling title insurance. Pet. App. 3a.

In 2015, Robert Stok and Joshua Kon, partners at the Stok Folk + Kon law firm (“SFK”), formed Foremost Title to conduct real estate closings, which includes providing title insurance from insurance

underwriters Fidelity National Title Insurance Company and Old Republic Title Insurance Company. Pet. App. 4a-5a. Neither Fidelity nor Old Republic operate under the Foremost mark. SFK and Foremost Title share the same office and phone number. Pet. App. 4a. Before deciding to use Foremost, Stok and Kon brainstormed about what to name SFK's title company and searched Florida's online business list. Pet. App. 4a. After finding no other Florida title companies using "Foremost," Stok and Kon decided to name the title company Foremost Title & Escrow. Pet. App. 4a. Foremost Title gets its business from SFK clients and realtor referrals. Pet. App. 4a.

At the end of 2016, Respondent sent Foremost Title a cease-and-desist letter claiming that Foremost Title was infringing its marks. Pet. App. 42a-43a. Foremost Title disputed that it was infringing on Respondent's mark. Pet. App. 43a. Foremost Title invested time and money developing its website, promoting its services, creating public awareness in its specific market, and developing customers and partners. Pet. App. 43a. Nearly ten months later, Respondent sued Foremost Title alleging that Foremost Title was infringing on its Foremost mark. Pet. App. 6a.

### **C. Proceedings Below**

Respondent sued Foremost Title alleging federal trademark infringement under the Lanham Act, § 1114. Pet. App. 6a. Foremost Title denied the allegations in Respondent's complaint and asserted affirmative defenses.

Both parties cross-moved for summary judgment. Pet. App. 6a. The district court, using the procedure outlined in *Nunez v. Superior Oil Co.*, 572

F.2d 1119, 1123-24 (5th Cir. 1978),<sup>1</sup> granted Foremost Title's motion and entered judgment in Foremost Title's favor. Pet. App. 6a-7a. Respondent appealed, and the Eleventh Circuit reversed. Pet. App. 1a-39a. The Eleventh Circuit found that disputed factual issues, including as relevant here, about the Foremost mark's strength, should have prevented summary judgment and that the district court misapplied *Nunez*. Pet. App. 2a, 13a.

Foremost Title moved for rehearing and rehearing *en banc*, which the Eleventh Circuit Denied. Pet. App. 40a Foremost Title now petitions for certiorari.

### REASONS FOR GRANTING THE PETITION

This Court should grant the petition because (1) the Eleventh Circuit's presumption that incontestable marks are strong conflicts with this Court's *KP Permanent Make-Up* decision requiring trademark holders to prove actual infringement, (2) the Eleventh Circuit's decision applying the *Dieter* presumption conflicts with the law in every other Circuit and with the Lanham Act's text, and (3) the *Dieter* presumption creates negative economic effects not allowed by the Lanham Act's text.

The Eleventh Circuit has repeatedly recognized that its precedent "arguably" or "almost certainly" is "incorrect." Yet it refuses to reconsider this precedent, creating disunion and confusion in national

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<sup>1</sup> Under *Nunez*, a court deciding summary judgment may draw inferences against a non-movant when (1) "there are no genuine issues of material fact," (2) "no issues of witness credibility," and (3) the court decides the motion "based on the cold record consisting of affidavits, depositions, and stipulations." Pet. App. 8a-9a (quoting *Useden v. Acker*, 947 F.2d 1563, 1572 (11th Cir. 1991)).

trademark law. The question presented here has come before the Court several times before without the Court granting certiorari<sup>2</sup> and, if not resolved by granting this petition, will remain incipient. Granting this petition is necessary to revitalize the Lanham Act's text and purpose so that incontestable trademark holders do not have different, atextual rights in the Eleventh Circuit that they do not have anywhere else in the country.

Every other Circuit recognizes that a trademark's incontestability only resolves the first question—whether the plaintiff owns a valid mark. Yet the Eleventh Circuit alone relieves a plaintiff from proving its mark's strength—the second most important confusion factor—only because it is incontestable and not because the mark, in reality, has any strength at all.

Section 1065 establishes an “incontestable” “right of the owner to use [its] registered mark in commerce for the goods or services on or in connection with which such registered mark has been in continuous use for five consecutive years subsequent to the date of such registration and is still in use in commerce....” Congress explained that a registered incontestable mark is conclusive evidence that (1) the mark and its registration are valid, (2) the registrant owns the mark, and (3) the registrant has the exclusive right to use the mark. § 1115(b). A party

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<sup>2</sup> See *Renaissance Greeting Cards, Inc. v. Dollar Tree Stores, Inc.*, 552 U.S. 951 (2007) (denying certiorari); *Davis v. Walt Disney Co.*, 547 U.S. 1159 (2006) (same); *Intern. Select Group v. Frehling Enterprises, Inc.*, 530 U.S. 1214 (2000) (same); *Shakespeare Co. v. Silstar Corp. of Am., Inc.*, 522 U.S. 1046 (1998) (same); *DeCosta v. Viacom Intern.*, 509 U.S. 923 (1993) (same); *Munters Corp. v. Matsui Am., Inc.*, 498 U.S. 1016 (1990) (same); *B&H Indus. of Sw. Florida, Inc. v. Dieter*, 498 U.S. 950 (1990) (same).

with this conclusive evidence still must prove infringement. *Id.* The Lanham Act’s text is silent about any correlative coupling between incontestability and strength.

A court must first look at statute’s text to determine its meaning; if the text is unambiguous, the “judicial inquiry is complete.” *Connecticut Nat’l Bank v. Germain*, 503 U.S. 249, 253–54 (1992). And courts “are not allowed to add or subtract words from a statute.” *CSX Transp., Inc. v. Alabama Dep’t of Revenue*, 888 F.3d 1163, 1176 (11th Cir. 2018) (citation omitted); *Bd. of Educ. of Hendrick Hudson Cent. Sch. Dist., Westchester Cnty. v. Rowley*, 458 U.S. 176, 190 n.11 (1982) (citation omitted).

Under the likelihood of confusion test, trademarks are evaluated for their strength. Pet. App. 11a (quoting *Fla. Int’l Univ. Bd. of Trs. v. Fla. Nat’l Univ., Inc.*, 830 F.3d 1242, 1255 (11th Cir. 2016)); *JL Beverage Co., LLC v. Jim Beam Brands Co.*, 828 F.3d 1098, 1106 (9th Cir. 2016). A mark’s strength is its ability to allow consumers to identify the good or service’s source. Pet. App. 13a (citing *Frehling*, 192 F.3d at 1335; *John H. Harland Co. v. Clarke Checks, Inc.*, 711 F.2d 966, 973–74 (11th Cir. 1983)); *see also Jack Daniel’s Properties, Inc. v. VIP Products LLC*, 599 U.S. \_\_\_, \_\_\_ (2023) (slip op., at 4) (citing *Moseley v. Secret Catalogue, Inc.*, 537 U.S. 418, 428 (2003)) (“And the single type of confusion most commonly in trademark law’s sights is confusion ‘about the source of a product or service.’”).

The strength inquiry is key because only a trademark’s strength should determine the scope of its protection. *Welding Services, Inc. v. Forman*, 509 F.3d 1351, 1361 (11th Cir. 2007) (citing *Amstar Corp. v. Domino’s Pizza, Inc.*, 615 F.2d 252, 259 (5th Cir.1980)). “The stronger or more distinctive a

trademark or service mark, the greater the likelihood of confusion and the greater the scope of protection afforded it, and conversely, the weaker the mark, the less protection it receives.” *Id.*

A junior user’s use of a particularly strong mark can cause consumer confusion even if the mark is used for a different product. *Water Pik, Inc. v. Med-Sys., Inc.*, 726 F.3d 1136, 1151 (10th Cir. 2013). “If the trade mark is a coined word, such as Kodak, it is more probable that all goods on which a similar designation is used will be regarded as emanating from the same source than when the trade-mark is one in common use on the variety of goods, such as ‘Gold Seal’ or ‘Excelsior.’” *Id.* (quoting *Arrow Distilleries, Inc. v. Globe Brewing Co.*, 117 F.2d 347, 349 (4th Cir. 1941)). But when a junior user uses a weak mark for similar goods or services as the senior mark that use “is unlikely to cause confusion if minor differences distinguish one party’s mark from another.” *Id.* (citing *First Sav. Bank, F.S.B. v. First Bank Sys., Inc.*, 101 F.3d 645, 655 (10th Cir. 1996)). Courts must also consider that some marks may be strong in one geographical market but weak in another. *Ameritech, Inc. v. Am. Info. Techs. Corp.*, 811 F.2d 960, 967 (6th Cir. 1987).

The strength inquiry looks at the mark’s conceptual strength and commercial strength. Pet. App. 14a (citing *FIU*, 830 F.3d at 1258; 2 J. McCarthy, *McCarthy on Trademarks and Unfair Competition* § 11:80 (5th ed. 2023)). To evaluate conceptual strength, courts look at what distinctiveness category the mark falls into. Pet. App. 14a (citations omitted); *JL Beverage*, 828 F.3d at 1107. Those categories, from weakest to strongest, are generic, descriptive, suggestive, fanciful, or arbitrary. *Id.* This taxonomy is the same as that used to determine whether a

trademark may be registered. *United States Patent & Trademark Office v. Booking.com B. V.*, 140 S.Ct. 2298, 2302-03 (2020) (citations omitted).

Sections 1065 and 1115 do not correlate incontestable status with a confusion analysis. If congress intended incontestability to confer strength to a mark, it could have said so. *Cf. Mont v. United States*, 139 S.Ct. 1826, 1832-33 (2019). It did not. To the contrary, not only did congress not create a presumption in § 1065, it also required an incontestable mark's holder to prove infringement. § 1115(b).

Even the Eleventh Circuit recognizes that a mark's incontestability "says nothing about its strength." *Sovereign Military*, 809 F.3d at 1183-84 (11th Cir. 2015). "That a mark enjoyed incontestable status in the past says very little about its current strength in the marketplace." *Id.* at 1184 (citation omitted). Nor does it say anything about "the perceptions of consumers in the marketplace, which are ordinarily unaffected by the status of the mark's registration." *Id.* at 1183-84. And although *Dieter* was decided before congress "decoupled the questions of incontestability and validity from the questions of infringement and confusion," the Eleventh Circuit still talismanically follows *Dieter*. *Id.* (citing *Caliber Auto. Liquidators, Inc. v. Premier Chrysler, Jeep, Dodge, LLC*, 605 F.3d 931, 939 (11th Cir. 2010); *Frehling*, 192 F.3d at 1336).

**I. The Eleventh Circuit's decision applying the *Dieter* Presumption conflicts with this Court's decision in *KP Permanent Make-Up, Inc. v. Lasting Impression I, Inc.***

In *KP Permanent Make-Up*, the Court held that § 1115(b) requires a plaintiff to "show[] that the

defendant's *actual* practice is likely to produce confusion in the minds of consumers about the origin of the goods or services in question," even if it owns an incontestable mark. 543 U.S. at 117 (citing *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 780 (1992) (Stevens, J, concurring); *Lone Star Steakhouse & Saloon, Inc. v. Alpha of Virginia, Inc.*, 43 F.3d 922, 935 (4th Cir. 1995)) (emphasis added). "Section 1115(b) places a burden of proving likelihood of confusion (that is, infringement) on the party charging infringement even when relying on an incontestable registration." *KP Permanent Make-Up*, 543 U.S. at 118, 121 ("Lasting's assumption that holders of incontestable marks had no need to prove likelihood of confusion prior to 1988 is wrong").

In *KP Permanent Make-Up*, this Court determined § 1115(b)'s proof requirement's outer bounds to decide what a defendant needs to prove to establish its fair-use defense. Thus, *KP Permanent Make-Up*'s precedential holding is that an incontestable-trademark holder has the burden to prove that consumers will confuse the marks to succeed in an infringement action. See Bryan A. Garner, et al., *The Law of Judicial Precedent* § 4, at 51 (2016) (explaining that a holding "depend[s]...on whether the solution of the point was more or less necessary to determining the issues involved in the case.>").

In *Dieter*, the Eleventh Circuit created a presumption from whole cloth that an incontestable mark "is at least descriptive with secondary meaning, and therefore a relatively strong mark." 880 F.2d at 329. The Eleventh Circuit Pattern Jury Instructions require a jury to accept that an incontestable trademark is "at least descriptive with secondary

meaning,” i.e., it has strength.<sup>3</sup> No evidence is needed. Thus, *Dieter*’s effect is to shift the burden of proof to the defendant to disprove the incontestable mark’s strength. See Fed R. Evid. 301 (“[T]he party against whom a presumption is directed has the burden of producing evidence to rebut the presumption.”); Pet. App. 16a (“This *Dieter* presumption *can be rebutted* by looking to the second step: commercial strength.”) (emphasis added).

The *Dieter* presumption conflicts with this Court’s holding that a trademark holder must prove “that the defendant’s *actual* practice is likely to” cause confusion, and effectively pronounced that *Dieter* was wrong the day it was decided. *KP Permanent Make-Up*, 543 U.S. at 117, 121 (citing *Beer Nuts, Inc. v. Clover Club Foods Co.*, 805 F.2d 920, 924-25 (10th Cir. 1986); *United States Jaycees v. Philadelphia Jaycees*, 639 F.2d 134, 137 n.3 (3d Cir. 1981); 5 J. McCarthy, *McCarthy on Trademarks and Unfair Competition* § 32:154, p. 32-247 (4th ed.)) (“Before the 1988 Trademark Revision Act, the majority of courts held that while incontestability grants a conclusive presumption of the ‘exclusive right to use’ the registered trademark, this did not relieve the registrant of proving likelihood of confusion.”).

The Eleventh Circuit’s presumption that an incontestable mark is strong, bypassing the plaintiff’s

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<sup>3</sup> 11th Cir. Pattern Jury Instructions (Civil Cases) Trademark Instructions 10.1 (“In this case, I have determined that [name of plaintiff]’s trademark is covered by an incontestable registration on the Principal Register. The effect of that determination is that the registration is conclusive evidence that the trademark is at least descriptive with secondary meaning. You must accept that [name of plaintiff]’s trademark was at least descriptive and possessed secondary meaning at the time [name of plaintiff] applied for its registration.”).

burden of proving that a consumer will be confused about a good or service's source conflicts with this Court's holding in *KP Permanent Make-Up*. The *Dieter* presumption releases the plaintiff from being required to prove "the second most important" factor in determining whether an infringement is likely to confuse, *see* Pet. App. 14a, 16a-19a, which conflicts with *KP Permanent Make-Up*'s holding that a plaintiff must prove "that the defendant's actual practice" is likely to confuse, 543 U.S. at 117.

Thus, *KP Permanent Make-Up* overruled *Dieter* and held that an incontestable-trademark holder, here Respondent, has the burden to prove its mark's strength. The Eleventh Circuit continues to ignore this Court's *KP Permanent Make-Up* holding, even after petitioner sought *en banc* review explaining how this Court overruled the *Dieter* presumption, and even though the Eleventh Circuit recognizes that the *Dieter* presumption is "arguably" or "almost certainly" "incorrect." Pet. App. 16a n. 13; *Savannah Coll. of Art & Design, Inc. v. Sportswear, Inc.*, 983 F.3d 1273, 1280 n.10; *Sovereign Military Hospitaller Order of Saint John of Jerusalem of Rhodes & of Malta v. Florida Priory of the Knights Hospitallers of the Sovereign Order of Saint John of Jerusalem, Knights of Malta, The Ecumenical Order*, 809 F.3d 1171, 1183-84 (11th Cir. 2015). The Court should thus grant the petition to resolve the conflict with this Court's decision.

## **II. The Eleventh Circuit's strength-presumption conflicts with the First, Second, Third, Fourth, Fifth, Sixth, Seventh, Ninth, and Tenth Circuits' decisions.**

The circuits give differing weight to a trademark's incontestable status when evaluating its strength. That status, some circuits say, is evidence

that the mark has strength and helps prove that the mark has secondary meaning—that consumers associate the mark with a particular source. Others hold that incontestable status does not move the needle on the trademark’s strength inquiry. Yet in conflict with every other circuit and this Court, the Eleventh Circuit presumes incontestable trademarks have strength and relieve the trademark holder’s need to prove that this presumption reflects reality.

This difference usually only matters for descriptive incontestable trademarks. This is so because generic trademarks are not protected, and suggestive, fanciful, or arbitrary marks are inherently distinctive and protected. *Booking.com*, 140 S.Ct. at 2302-03. But descriptive marks, such as *Foremost*, are not valid unless the mark has acquired secondary meaning. *Id.* (citing *Wal-Mart Stores, Inc. v. Samara Brothers, Inc.*, 529 U.S. 205, 210–211 (2000)).

Incontestable descriptive marks are conclusively valid, and their holders need not prove they have secondary meaning to prove the mark’s validity. Thus, if a descriptive mark is not presumed to have secondary meaning, even when evaluating the mark’s strength in conducting a likelihood of confusion inquiry, then a court would be questioning the mark’s validity. *See Park ’N Fly*, 469 U.S. at 196 (“[T]he Lanham Act also refutes any conclusion that an incontestable mark may be challenged as merely descriptive.”). Or so goes the Eleventh Circuit’s circular reasoning.

Murkier, uncharted waters would show the absurdity of the Eleventh Circuit’s illogical position in infringement litigation between two incontestable marks. Following *Dieter* to its logical conclusion, both incontestable marks would have a presumption of strength leaving it open to pure conjecture about

which incontestable mark would bear the burden of proof.

The First, Second, Third, Fourth, Fifth, Sixth, Seventh, Ninth, and Tenth Circuits and the Trademark Board<sup>4</sup> all disagree with the Eleventh Circuit's presumption that a descriptive incontestable trademark has secondary meaning and is strong and require trademark holders to prove a mark's strength whether it is incontestable or not. *DeCosta v. Viacom Intern., Inc.*, 981 F.2d 602, 606 (1st Cir. 1992) (holding—in deciding a *res judicata* issue—that § 1065 does not make it easier for a mark holder to prove confusion); *Safer, Inc. v. Oms Investments, Inc.*, 94 U.S.P.Q.2d 1031 (T.T.A.B. 2010) (“Accordingly, the fact that opposer’s federally-registered trademark has achieved incontestable status means that it is conclusively considered to be valid, but it does not dictate that the mark is ‘strong’ for purposes of determining likelihood of confusion.”); *see also* 6 J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition* § 32:155 (4th ed.) (“*Dieter* is incorrect because it confuses the status of a designation as a valid trademark with the separate issue of whether that valid trademark has sufficient strength that the junior user’s usage is likely to cause confusion. The later issue is one of infringement, which should not be foreclosed by incontestable status”).

The Second and Third Circuits allow courts to consider a trademark’s incontestable status as evidence of the mark’s strength. In *The Sports Auth., Inc. v. Prime Hosp. Corp.*, 89 F.3d 955, 959 (2d Cir. 1996), Sports Authority challenged the defendant’s

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<sup>4</sup> The Eighth Circuit, D.C. Circuit, and the Federal Circuit have not addressed this question.

use of the words “Sports Authority” in its restaurant’s name “Sports Authority Food, Spirits & Sports.” The defendant argued that the Second Circuit precedent required the court to look at independent strength indicators and could not just rely on “The Sports Authority” mark’s incontestable status. *Id.* at 961. The Second Circuit rejected that argument concluding that for summary judgment purposes, a jury could have concluded that the mark was strong because it was incontestable. (“We agree that independent indicia of strength is relevant to deciding whether the strength of the mark weighs in favor or against a finding of likelihood of confusion under *Polaroid*.... [A] trier of fact could reasonably conclude that TSA’s word mark, having been incontestable for five years, is strong for the purposes of the Polaroid test.”).

The Third Circuit reversed a trademark-injunction denial, finding that the plaintiff still needed to prove the infringing mark was likely to confuse but the trademark’s incontestable status was a relevant consideration of the mark’s strength. *United States Jaycees*, 639 F.2d at 137 n.3 (“We agree with the Philadelphia group, however, that incontestability neither makes unnecessary a showing of likelihood of confusion, nor precludes all discretion in the fashioning of injunctive relief. But because incontestability does bear on the strength of a mark, it is relevant to those two issues....”).

The Fourth, Fifth, Sixth, Seventh, Ninth, and Tenth Circuits and the Trademark Board require evidence, other than the mark’s incontestability, to prove strength. In *Lone Star Steakhouse*, the district court found that the defendant’s use of the “Lone Star” mark was likely to cause confusion just because the mark was incontestable. 43 F.3d at 933. The Fourth Circuit rejected the district court’s approach and

rejected *Dieter*, adopted the Seventh Circuit's approach in *Munters, infra*, and required incontestable trademark plaintiffs to introduce evidence of their marks' strength and that the mark is likely to confuse to avoid summary judgment. 43 F.3d at 935 ("We agree with the above reasoning that incontestability affects the validity of the trademark but does not establish the likelihood of confusion necessary to warrant protection from infringement. Likelihood of consumer confusion remains an independent requirement for trademark infringement.").

In *Oreck Corp. v. U.S. Floor Sys., Inc.*, the Fifth Circuit reversed a jury verdict holding that incontestable status only informs the validity prong and not the confusion prong. 803 F.2d 166, 171 (5th Cir. 1986) ("Incontestable status does not make a weak mark strong").

The Sixth Circuit affirmed summary judgment against an incontestable trademark holder whose only evidence for the mark's strength was that the mark was incontestable because presuming that the mark is strong without determining whether a mark is distinctive or well-known does not address whether a junior user will likely confuse a consumer. *Therma-Scan, Inc. v. Thermoscan, Inc.*, 295 F.3d 623, 632 (6th Cir. 2002) ("Treating a valid, incontestable trademark as an exceptionally strong mark for the purpose of determining whether confusion is likely..., without examining whether the mark is distinctive and well-known in the general population, would shift the focus away from the key question of whether relevant consumers are likely to believe that the products or services offered by the parties are affiliated...") (citations and quotations omitted).

The Seventh Circuit affirmed a district court's permanent injunction denial and rejected the plaintiff's argument that *Park 'N Fly's* incontestability holding prevented a court from deciding that a mark was "merely descriptive" and that a mark was not strong. *Munters Corp. v. Matsui Am., Inc.*, 909 F.2d 250, 252 (7th Cir. 1990). The court held that a court must still consider an incontestable mark's strength when analyzing confusion and that the validity inquiry is separate. *Id.*

The Ninth Circuit, in reversing summary judgment, concluded that the descriptive-suggestive distinction was not relevant because the mark was incontestable and therefore the mark was presumed valid. *Entrepreneur Media, Inc. v. Smith*, 279 F.3d 1135, 1142 n.3 (9th Cir. 2002). But the court also held that whether the mark was suggestive or descriptive for validity purposes did not require the court to find that the mark was strong, and the plaintiff still carried the burden of proving that a consumer would likely be confused by the alleged infringing use. *Id.*

The Tenth Circuit distinguishes between secondary meaning and commercial strength. Secondary meaning is necessary to register a descriptive mark and for the mark to be incontestable. *Hornady Mfg. Co., Inc. v. Doubletap, Inc.*, 746 F.3d 995, 1008 n.13 (10th Cir. 2014). Commercial strength is the analogous principle under the confusion analysis—"the marketplace recognition value of the mark." *Id.* ("Although secondary meaning is presumed, the fact that Hornady's mark is statutorily incontestable [sic] does not resolve the commercial strength inquiry."); *Water Pik*, 726 F.3d at 1153, 1154 n.13.

The Eleventh Circuit's presumption—that a descriptive incontestable mark has secondary

meaning and is relatively strong—skews the whole likelihood of confusion analysis and forces courts to presume facts that do not reflect reality. *Cf.* PRESUMPTION, *Black’s Law Dictionary* (11th ed. 2019) (“1. Something that is thought to be true because it is highly probable.”). Presuming that a trademark is strong leads courts to give a non-deserving trademark unwarranted protection. A mark that, in reality, is weak will preclude a junior user from using the mark even for a different product or service and even when no consumer will be confused about its source. Similarly, a mark that is strong in one location will be mistreated as strong in a different location even if weak in that other location.

Here, Respondent presented no evidence that consumers associate its Foremost mark as the source of any product<sup>5</sup>—that it has secondary meaning and it is conceptually strong. Yet, with the Eleventh Circuit’s presumption, Respondent’s mark can preclude Foremost Title from using the word “Foremost” (meaning the best) in its name even though Respondent and Foremost Title operate in entirely different markets, Respondent underwrites insurance, while Foremost Title provides real estate closing services. Even if we imagine Foremost Title had the financial strength, which it lacks, to underwrite title insurance, the two entities are barred from competing with each other under Florida law. And even if Respondent’s Foremost mark has secondary meaning or is strong in Michigan, or some other market, that should not absolve Respondent from being required to prove that its Foremost mark is strong and has secondary meaning in Foremost

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<sup>5</sup> Respondent’s expert specifically testified that his survey did not test for secondary meaning.

Title's market when claiming that Foremost Title infringed on its trademark. But, under the *Dieter* presumption, a descriptive incontestable mark is presumed strong in any market even if the initial registration was only valid because the descriptive mark attained secondary meaning in a small, distinct market. The Lanham Act does not allow courts to make this presumption when it says that incontestability only pertains to the validity question and specifically requires proof that the junior use is likely to cause confusion.

Thus far, the Court has rejected every petition asking the Court to decide what effect courts should give incontestable status when evaluating an incontestable mark's strength. See *Renaissance Greeting Cards, Inc. v. Dollar Tree Stores, Inc.*, 552 U.S. 951 (2007) (denying certiorari); *Davis v. Walt Disney Co.*, 547 U.S. 1159 (2006) (same); *Intern. Select Group v. Frehling Enterprises, Inc.*, 530 U.S. 1214 (2000) (same); *Shakespeare Co. v. Silstar Corp. of Am., Inc.*, 522 U.S. 1046 (1998) (same); *DeCosta v. Viacom Intern.*, 509 U.S. 923 (1993) (same); *Munters Corp. v. Matsui Am., Inc.*, 498 U.S. 1016 (1990) (same); *B&H Indus. of Sw. Florida, Inc. v. Dieter*, 498 U.S. 950 (1990) (same).

There is a deep, long-standing conflict among the circuits and this Court should grant certiorari to resolve the conflict and reharmonize federal trademark law.

### **III. The way the Eleventh Circuit treats incontestable trademarks creates negative economic consequences contrary to the purposes of the Lanham Act's text.**

Allowing descriptive incontestable trademark holders to prevent junior users from using their marks

without needing to prove that the junior use is likely to confuse consumers is contrary to Congress' express purposes for enacting the Lanham Act and has negative economic consequences not intended by Congress.

The Lanham Act's purpose is to "regulate commerce within the control of Congress by making actionable the *deceptive and misleading* use of marks in such commerce..." 15 U.S.C. § 1127 (emphasis added). Consistent with this purpose, the main criteria "for registration is that the mark 'in fact serve as a "trademark" to identify and distinguish goods.'" *Jack Daniel's Properties*, 599 U.S. at \_\_\_ (slip op., at 4) (quoting 3 J. McCarthy, *McCarthy on Trademarks and Unfair Competition* § 19:10 (5th ed. 2023)). A statute's language accurately expresses the legislative purpose and § 1115(b) says that the purpose of an incontestable trademark's registration is to "serve as conclusive evidence of the registrant's exclusive right to use the registered mark," *Park 'N Fly*, 469 U.S. at 194, and the trademark owner still must prove infringement, §1115(b).

Congress' stated purposes did not include giving incontestable trademark holders superior rights over any other trademark, registered or unregistered.

But contrary to what Congress expressed and enacted, the Eleventh Circuit grants greater rights to incontestable trademark holders and protects their trademarks from infringement claims across a broader market range (both in scope and location) not warranted by the actual possibility—or lack thereof—that a junior use will likely confuse consumers.

Here, Respondent and Foremost Insurance, part of an insurance conglomerate, with over 33,000 agents and 77,000 locations can bully Foremost Title,

a small title company with one location and few employees, and prevent Foremost Title from using the best—or foremost—name chosen by its founders, describing the service its clients can expect and have received. Respondent and Foremost Title are statutorily barred from competing. At its inception, Foremost Title made sure that no other title company in Florida was using the “foremost” mark. Respondent offered no proof that its Foremost mark has any secondary meaning at all. And Respondent could not show that even one consumer was actually confused by the two mark’s use. Yet, in the Eleventh Circuit, Respondent can prevail over Foremost Title because the Eleventh Circuit gives Respondent’s incontestable trademark greater protection than Congress gave it.

New small businesses within the Eleventh Circuit face significant pitfalls that exist nowhere else in the country. If a small business in Alabama, Georgia, or Florida wants to use a self-laudatory word as its mark, it needs to be concerned that some other business, which does not compete with it, may have an incontestable trademark incorporating the same word and that any investment in marketing itself would be for naught, or worse would cause it to be the target of a federal lawsuit, if that other company, who no one associates with the products sold by the nascent business, decides to claim that use of the self-laudatory word infringes on its mark. This result is contrary to what Congress intended and the Court should grant this petition to correct this erroneous statutory interpretation that the Eleventh Circuit is itself confused about because it agrees it is incorrect, yet contumaciously refuses to correct.

**CONCLUSION**

For these reasons, the Court should grant the petition for certiorari.

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