


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



**FOREMOST TITLE & ESCROW SERVICES, LLC,**

*Petitioner,*

v.

**FCOA, LLC,**

*Respondent.*

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**On Petition for a Writ of Certiorari to the  
United States Court of Appeals for the Eleventh Circuit**

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**BRIEF IN OPPOSITION**

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July 28, 2023

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## COUNTERSTATEMENT OF QUESTION PRESENTED

Whether the weight assigned by the Eleventh Circuit to evidence regarding one factor of the multi-factor “likelihood-of-confusion” test in a trademark infringement action conflicts with *KP Permanent Make-Up, Inc. v. Lasting Impression I, Inc.*, 543 U.S. 111 (2004), creates a real and embarrassing conflict with the case law of other circuits, or conflicts with the purpose of the Lanham Act.

## **CORPORATE DISCLOSURE STATEMENT**

Respondent FCOA, LLC (“FCOA”), is fully owned by Foremost Insurance Company Grand Rapids, Michigan, a privately held Michigan corporation. There is no publicly held corporation owning more than 10% of FCOA, LLC’s stock, or the stock of any parent company.

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## **OPINIONS BELOW**

The Eleventh Circuit opinion is reported at 57 F.4th 939 and is reproduced at Pet.App.1a. The district court opinion is reported at 416 F.Supp.3d 1381 and is reproduced at Pet.App.41a.



## **JURISDICTIONAL STATEMENT**

Respondent does not dispute this Court's jurisdiction over this case pursuant to 28 U.S.C. § 1254(1) but denies that this case satisfies the standard set forth in Supreme Court Rule 10.



## **COUNTERSTATEMENT OF THE CASE**

Respondent FCOA owns and uses a family of registered trademarks which utilize the word "Foremost." For decades, FCOA has used these marks in the insurance industry. Across the country, over three million customers hold Foremost-branded insurance policies, including homeowner, property, fire, landlord, and mobile home insurance sold through over 33,000 independent agents at 77,000 locations. Foremost-branded insurance is sold to nearly 100,000 customers in Florida alone and generates billions of dollars in insurance premiums every year. FCOA expends significant sums to advertise its marks in

various media including social media, magazines, and brochures.

Petitioner Foremost Title & Escrow, LLC (“FT&E”), was formed in Florida in 2015. It is in the business of conducting real estate closings and issuing title insurance. FT&E markets its title insurance and closing services using the term “Foremost,” including through online advertisements, social media, print media, trade shows and public events. FT&E is therefore using FCOA’s trademarked term “Foremost” in the insurance industry.

FCOA sued FT&E for trademark infringement in federal district court.<sup>1</sup> By this time, FCOA’s marks had reached “incontestable” status under 15 U.S.C. § 1065 because they had been registered on the Principal Register with the Patent and Trademark Office for at least five years, among other statutory formalities. Eventually, both parties moved for summary judgment on FCOA’s trademark infringement claim.

Trademark infringement under the Lanham Act occurs when a defendant, without consent, uses “in commerce any reproduction, counterfeit, copy or colorable imitation of a registered mark” of the plaintiff that “is likely to cause confusion” that a relationship exists between the parties. 15 U.S.C. § 1114(1)(A). Thus, to prevail on a claim of trademark infringement, a plaintiff must illustrate that it owns a valid mark with priority and that the defendant’s mark is likely to cause consumer confusion. *Id.*; *Frehling Enters., Inc. v. Int’l Select Grp., Inc.*, 192

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<sup>1</sup> FCOA filed its complaint in the United States District Court for the Northern District of Florida. The case was transferred to the United States District Court for the Southern District of Florida.

F.3d 1330, 1335 (11th Cir. 1999). The burden to prove likelihood of consumer confusion lies upon the party asserting trademark infringement. *KP Permanent Make-Up*, 543 U.S. at 118.

The Eleventh Circuit employs a multi-factor test for likelihood of consumer confusion which considers (1) the strength of the allegedly infringed mark; (2) the similarity of the infringed and infringing marks; (3) the similarity of the goods and services the marks represent; (4) the similarity of the parties' trade channels and customers; (5) the similarity of the advertising media used by the parties; (6) the intent of the alleged infringer to misappropriate the proprietor's goodwill; and (7) the existence and extent of actual confusion in the consuming public. *Frehling*, 192 F.3d at 1335. The Eleventh Circuit also sometimes analyzes the additional factor of consumer sophistication. *Fla. Int'l Univ. Bd. of Trs. v. Fla. Nat'l Univ., Inc.*, 830 F.3d 1242, 1255 (11th Cir. 2016) ("FIU"). All circuits in the United States which have reached the issue employ substantially similar tests for likelihood of consumer confusion which measure between six and thirteen factors. 4 J. McCarthy, *McCarthy on Trademarks & Unfair Competition* §§ 24:30-24:43 (5th ed. 2023).

The district court analyzed the *Frehling* factors and found that, as a matter of law, the parties' marks did not create a likelihood of confusion among consumers that a relationship existed between the parties. Pet.App.7a. Summarized succinctly, the district court found that (1) FCOA's marks were "relatively weak" because, while under *Dieter v. B&H Industries of Florida*, 880 F.2d 322, 329 (11th Cir. 1989), their incontestable status provides a presumption that

they are “relatively strong,” FT&E adduced evidence of third-party registrations and business listings using the term “Foremost,” which weakened the marks; (2) FCOA’s marks were not sufficiently similar to FT&E’s mark; (3) FCOA’s and FT&E’s marks represented similar goods or services; (4) both FCOA and FT&E advertise their services using online advertising, websites and social media; (5) FT&E did not intend to cause consumer confusion; (6) no evidence existed of actual consumer confusion about the parties’ marks; and (7) FT&E’s clients were sophisticated and unlikely to be confused. *Id.* at Pet.App.12a, 50a-52a. The district court therefore granted FT&E’s motion for summary judgment.

FCOA appealed to the United States Court of Appeals for the Eleventh Circuit, which conducted a *de novo* review of the eight likelihood-of-confusion factors. *Id.* at Pet.App.8a-36a. The Eleventh Circuit concluded that the district court consistently and incorrectly drew inferences against FCOA and held that when the likelihood-of-confusion factors are properly examined, first individually and then as a whole, a genuine issue of material fact exists on the question of whether FT&E’s use of its mark is likely to cause consumer confusion.<sup>2</sup> *Id.* at Pet.App.13a, 35a-36a.

FT&E takes issue only with the Eleventh Circuit’s treatment of one of the eight factors, the strength of FCOA’s marks. A mark’s strength depends on its “conceptual” strength and its “commercial” strength.

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<sup>2</sup> FCOA is a related company to Foremost Insurance Company (“FIC”). The Eleventh Circuit opinion used the term “FIC” to refer collectively to both.

Assessing conceptual strength is the first step in assessing a mark's strength. *Id.* at Pet.App.14a.

A mark's conceptual strength is categorized from weakest to strongest as either generic, descriptive, suggestive, or fanciful/arbitrary.<sup>3</sup> *Id.* The Eleventh Circuit determined that "Foremost" is a descriptive mark, and because the marks had reached "incontestable" status under 15 U.S.C. § 1065, *Dieter* applies. *Id.* at Pet.App.15a-16a, 19a.

In *Dieter*, the Eleventh Circuit held that a descriptive mark which reaches "incontestable" status is presumed to be "at least descriptive with secondary meaning, and therefore a relatively strong mark." *Dieter*, 880 F.2d at 329. Thus, the Eleventh Circuit presumed FCOA's marks are "relatively" strong. Pet. App.16a, 19a. But this does not – and did not – end the analysis.

The Eleventh Circuit recognizes that focusing solely on the conceptual strength of a mark is an "incomplete method of analysis" and that determining the strength of any mark requires weighing its commercial strength as well. *Id.* at Pet.App.16a, 17a, *citing FIU*, 830 F.3d at 1259. This is the second step. Thus, as a practical matter, a plaintiff alleging trademark infringement in the Eleventh Circuit almost always offers evidence of commercial strength.

FCOA did so. FCOA adduced evidence that its marks have commercial strength, which is "the real-

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<sup>3</sup> A descriptive mark tells the public something about the product and is valid and protectible only when secondary meaning is shown. *Univ. of Ga. Athletic Ass'n v. Laite*, 756 F.2d 1535, 1540 (11th Cir. 1985).

world consumer recognition of a mark, most often created by the efforts and work of the mark holder.” *Id.* at Pet.App.16a. “Commonly used evidence of commercial strength includes third party use; advertising and promotion; sales and number and types of customers; recognition by trade, media and customers; and survey of likely customers.” *Id.* at Pet.App.17a *citing* 2 J. McCarthy, *McCarthy on Trademarks & Unfair Competition* § 11:81 (4th ed. 2016).

FCOA provided evidence of the size and scope its agent class, its billions of dollars in annual insurance premiums, its recognition in independent publications, survey evidence, and other facts pertinent to commercial strength. *Id.* at Pet.App.20a-21a. Therefore, aside from evidence that its marks are incontestable and have some presumed strength, FCOA adduced separate evidence that its marks are commercially strong.

FT&E attempted to rebut this evidence by asserting that FCOA’s marks were weakened because third parties are using them. The Eleventh Circuit recognizes that a mark may be weakened if it is used by third parties in a manner which significantly diminishes consumer recognition of the original mark, *Laité*, 756 F.2d at 1545 n.27, but FT&E proffered only “a list of businesses printed from Secretary of States’ webpages and trademark registrations” which is not reliable evidence of actual third-party use of a mark. Pet.App.20a. The Eleventh Circuit therefore held that FT&E did not produce reliable evidence that FCOA’s marks were weakened by third-party use. *Id.* Thus, notwithstanding the fact that FCOA’s descriptive marks had reached incontestable status, this is a typical case in which both parties presented evidence regarding the commercial strength of the

allegedly infringed marks, which is required in the Eleventh Circuit. *Id.* at Pet.App.17a, 20a-21a.

After reviewing the evidence of strength, the Eleventh Circuit concluded that “a reasonable factfinder conducting a separate inquiry on the strength of [FCOA’s] marks could find the marks strong based on both the *Dieter* presumption and the additional evidence of commercial strength.” *Id.* at Pet.App.21a (emphasis added). So FT&E is incorrect when it states that the Eleventh Circuit concluded that FCOA’s marks were strong only because they are incontestable. Pet. at 3. FCOA also adduced evidence of its marks’ commercial strength.

FT&E does not challenge the Eleventh Circuit’s analysis of the other likelihood-of-confusion factors. Thus it does not challenge the Eleventh Circuit’s conclusions that (1) a reasonable factfinder could determine that the parties’ marks are similar; (2) a reasonable factfinder could find that the parties’ products are similar; (3) a reasonable factfinder could find that FCOA’s customer base overlaps with FT&E’s; (4) there is overlap in the parties’ advertising audiences; (5) FT&E did not intend to cause consumer confusion, but this would not prevent consumers from becoming confused; (6) there is no evidence that consumers have actually confused FT&E with FCOA, but a reasonable factfinder could discount this because there has been little time for actual confusion to develop; or (7) a reasonable factfinder could find that FT&E’s customer base is unsophisticated and thus more likely to be confused. Pet.App.35a.

Upon examining the likelihood-of-confusion factors “independently and then together,” the Eleventh Circuit held that “a reasonable factfinder could find a likelihood

that consumers would be confused by the marks” and reversed and remanded the matter for trial. *Id.* at Pet.App.11a, 36a. The Eleventh Circuit did not state that FT&E bore the burden to disprove likelihood of confusion. Rather, the court recognized that in trademark infringement actions the plaintiff bears the burden to prove both that it owns a valid mark with priority and that the defendant’s mark is likely to cause consumer confusion with the plaintiff’s mark. *Id.* at Pet.App.9a.

FT&E then petitioned the Eleventh Circuit for rehearing and rehearing en banc, primarily upon the argument that *KP Permanent Make-Up* effectively overruled *Dieter*’s holding that the incontestable status of a mark is pertinent to its strength. The Eleventh Circuit denied FT&E’s petition without asking FCOA to respond.





## REASONS FOR DENYING CERTIORARI

“Review on a writ of certiorari is not a matter of right, but of judicial discretion. A petition for writ of certiorari will be granted only for compelling reasons.” Sup. Ct. R. 10.

Here, there is no conflict between the Eleventh Circuit’s ruling below and *KP Permanent Make-Up*, which held that a trademark infringement defendant who raises the statutory affirmative defense of fair use under 15 U.S.C. § 1115(b)(4) has no burden to negate likelihood of confusion in order to establish the defense. *KP Permanent Make-Up*, 543 U.S. at 123. That is because likelihood of confusion is an element of the plaintiff’s claim, and the party charging infringement bears the burden to prove likelihood of confusion. *Id.* Neither the opinion below nor *Dieter* impose a burden on a trademark infringement defendant to disprove likelihood of confusion. In the Eleventh Circuit that burden lies with the party charging infringement regardless of the incontestability of its mark.

Indeed, the Eleventh Circuit has held that as a matter of law, a plaintiff cannot establish likelihood of confusion based solely on the strength that results from an incontestable mark, *Most Worshipful Nat’l Grand Lodge, Free & Accepted Ancient Yorkrite Masons, Prince Hall Origin Nat’l Compact, U.S.A. v. United Grand Lodge GA AF & AYM, Inc.*, 813 Fed. Appx. 455, 460 (11th Cir. 2020), so it is incumbent upon a plaintiff alleging trademark infringement to present evidence of likely confusion beyond an incontestable mark. That is, evidence of an incontestable

mark does not flip the burden to the defendant to disprove likelihood of confusion.

Furthermore, the case below does not create a “real and embarrassing conflict of opinion and authority” between the circuit courts of appeal on an important matter. *Layne & Bowler Corp. v. Western Well Works*, 261 U.S. 387, 393 (1923) (“[I]t is very important that we be consistent in not granting the writ of certiorari except . . . in cases where there is a real and embarrassing conflict of opinion and authority between the Circuit Courts of Appeals”). While the Eleventh Circuit is seemingly the only court to apply a presumption that the incontestable status of a mark shows its strength, this is a *de minimus* inconsistency among the circuits in one part of one factor of a six- to thirteen-factor test.

There is also no conflict between the *Dieter* presumption and the purpose of the Lanham Act. The Lanham Act does not contain a definition for “likely to cause confusion,” 15 U.S.C. § 1114(1)(a), or speak to what factors courts may employ, or how they may employ them, to determine likelihood of confusion, and nothing in the Lanham Act prohibits a court from determining that the incontestable status of a mark is pertinent to its strength for likelihood-of-confusion purposes.

Finally, according to FT&E, the Court has denied certiorari on this issue seven times before. Pet. at 9. This illustrates that the Court does not consider this issue compelling enough to warrant the exercise of its certiorari jurisdiction.

**I. THE OPINION BELOW DOES NOT CONFLICT WITH  
*KP PERMANENT MAKE-UP*.**

FT&E claims that *KP Permanent Make-Up* held that “an incontestable-trademark holder . . . has the burden to prove its mark strength” and therefore “overruled *Dieter*.” Pet. at 15. *KP Permanent Make-Up* does not prohibit the employment of a presumption about the strength of a mark during the likelihood-of-confusion analysis; it does not discuss the test for the strength of a mark or whether the incontestable status of a mark affects its strength. And *Dieter* does not improperly place any burden of proof on a trademark infringement defendant.

In *Dieter*, the Eleventh Circuit held that the incontestable status of a mark under 15 U.S.C. § 1065 “is a factor to be taken into consideration in likelihood of confusion analysis” and that incontestable marks are presumed to be “at least descriptive with secondary meaning and therefore a relatively strong mark.” *Dieter*, 880 F.2d at 329. *Dieter* recognizes that the party asserting infringement bears the burden to prove it. *Id.* at 326, 328.

In *KP Permanent Make-Up*, the Court held that because a plaintiff claiming trademark infringement of an incontestable mark must show likelihood of consumer confusion as part of its *prima facie* case, a defendant raising the statutory affirmative defense of fair use under 15 U.S.C. § 1115(b)(4) has no burden to negate likelihood of confusion in order to establish the defense – to place that burden on the defendant illogically requires it to disprove an element of the plaintiff’s case in order to make out a defense. *KP Permanent Make-Up*, 543 U.S. at 123. This holding is unrelated to *Dieter*, which concerns the level of evi-

dentiary weight accorded to the incontestable status of a mark when considering one factor in the likelihood-of-confusion analysis.

*KP Permanent Make-Up* does state the long-standing rule that “the burden of proving likelihood of confusion (that is, infringement) [lies] on the party charging infringement even when relying on an incontestable registration.” *KP Permanent Make-Up*, 543 U.S. at 112. Likewise, in the many years since *Dieter* was decided, the Eleventh Circuit has kept the burden of proving likelihood of confusion precisely there – on the party charging infringement. See, e.g., *Hard Candy, LLC v. Anastasia Beverly Hills, Inc.*, 921 F.3d 1343, 1352 (11th Cir. 2019); *Davidoff & CIE, S.A. v. PLD Int’l Corp.*, 263 F.3d 1297, 1300-01 (11th Cir. 2001); *McDonalds Corp. v. Robertson*, 147 F.3d 1301, 1307 (11th Cir. 1998).

This is true even when the *Dieter* presumption applies to the strength factor because the plaintiff happens to have an incontestable registration. See, e.g. *FIU*, 830 F.3d at 1255, 1265; *Sovereign Mil. Hospitaller Order of St. John of Jerusalem of Rhodes & of Malta v. Fla. Priory of the Knights Hospitaller of the Sovereign Order of St. John & Jerusalem, Knights of Malta, The Ecumenical Order*, 809 F.3d 1171, 1181 (11th Cir. 2015); *Most Worshipful Nat’l Grand Lodge*, 813 Fed.Appx. at 458.

Furthermore, *KP Permanent Make-Up* does not hold that “an incontestable-trademark holder . . . has the burden to prove its mark’s strength” nor does *Dieter* “shift the burden of proof to the defendant to disprove the incontestable mark’s strength.” Pet. at 14, 15. The strength of the allegedly infringed mark, which *KP Permanent Make-Up* references only in passing,

543 U.S. at 123, is one factor in the larger likelihood-of-confusion test. *Frehling*, 192 F.3d at 1335. It is not itself an element of a claim for trademark infringement, so no party carries a “burden” to prove or disprove it.

No single factor in the likelihood-of-confusion test is dispositive, *United States v. Torkington*, 812 F.2d 1347, 1353 n.8 (11th Cir. 1987), and the factors are not “necessary and sufficient conditions” of infringement. *Jellibeans, Inc. v. Skating Clubs of Ga., Inc.*, 716 F.2d 833, 840 (11th Cir. 1983). In fact, the test “presupposes that various factors will point in opposing directions.” *Tana v. Dantanna’s*, 611 F.3d 767, 775 n.7 (11th Cir. 2010). And although it may be possible in theory for a trademark infringement claim to hinge solely on the application of the *Dieter* presumption, as a practical matter *Dieter* will rarely if ever tilt the balance. A relatively weak mark can be infringed depending on the circumstances, and many holders of strong marks have lost claims for trademark infringement. This is the nature of a multi-factorial inquiry. In addition, because the Eleventh Circuit requires the weighing of commercial strength as part of the strength factor, *FIU*, 830 F.3d at 1259, there should be no circumstance where the incontestability of a mark is the only evidence of its overall strength.<sup>4</sup>

Finally, FT&E points out that two panels of the Eleventh Circuit have stated that *Dieter* is arguably incorrect. Pet. at 15. Even so, within the Eleventh Circuit, *Dieter* applies until overruled en banc,

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<sup>4</sup> And if there were such a circumstance, that evidence would be insufficient as a matter of law to establish likelihood of confusion. *Most Worshipful Nat’l Grand Lodge*, 813 Fed.Appx. at 460.

*Savannah Coll. of Art & Design, Inc. v. Sportswear, Inc.*, 983 F.3d 1273, 1279 n.8 (11th Cir. 2020), which the Eleventh Circuit has not seen fit to do, including in this case. In addition, according to FT&E, this Court has declined at least seven opportunities to grant certiorari on this issue. Pet. at 9. This illustrates that both the Eleventh Circuit and this Court do not consider this issue compelling enough to warrant remedy.

## II. THERE IS NO REAL AND EMBARRASSING CONFLICT AMONG THE CIRCUITS.

When deciding whether to grant a petition for certiorari premised on a conflict among the circuits, the Court considers whether one court of appeals has entered a decision which creates a “real and embarrassing conflict” with the decision of another court of appeals on an “important matter.” Sup. Ct. R. 10; *Layne & Bowler*, 261 U.S. at 393. There is no such conflict here.

The Eleventh Circuit is the only federal circuit to take the minority position that a mark which has attained incontestable status under 15 U.S.C. § 1065 is presumed to be “relatively strong” when determining its strength as part of the multi-factor likelihood-of-confusion analysis. 6 J. McCarthy, *McCarthy on Trademarks & Unfair Competition* § 32:155 (5th ed. 2023); *Dieter*, 880 F.2d at 329. Thus, the rule across the country is very nearly uniform. One circuit in the nation considers one additional fact – the incontestability of a trademark – as some evidence of a trademark’s strength, which is itself just one of many factors in the overall test for likelihood of confusion. That is not a real and embarrassing conflict amongst the

circuits. It is a *de minimus* inconsistency among the circuits in one factor of a six- to thirteen-factor test.

This is particularly true since, in addition to conceptual strength, the Eleventh Circuit requires an evaluation of a mark's commercial strength. Pet.App. 17a. The Eleventh Circuit held FCOA's commercial strength evidence alone enables a reasonable jury to find its marks are strong. *Id.* at Pet.App.21a. Because the circuits employ comparable evidentiary factors for commercial strength,<sup>5</sup> the instant case would not be decided differently in any other circuit: FCOA's commercial strength evidence constitutes evidence of the strength of its marks cognizable in every circuit. And while it is theoretically possible that another case with different facts might be decided differently in the Eleventh Circuit than in others based on application of the *Dieter* presumption, this theoretical possib-

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<sup>5</sup> *President & Trs. of Colby Coll. v. Colby Coll.-N.H.*, 508 F.2d 804, 807-09 (1st Cir. 1975); *Centaur Commc'ns, Inc. v. A/S/M Commc'ns, Inc.*, 830 F.2d 1217, 1222 (2d Cir. 1987) *overruled on other grounds by Paddington Corp. v. Attiki Importers & Distribs., Inc.*, 996 F.2d 577 (2d Cir. 1993); *Ford Motor Co. v. Summit Motor Prods., Inc.*, 930 F.2d 277, 292 (3d Cir. 1991); *Perini Corp. v. Perini Constr. Inc.*, 915 F.2d 121, 125 (4th Cir. 1990); *Sec. Ctr., Ltd. v. First Nat'l Sec. Ctrs.*, 750 F.2d 1295, 1301 (5th Cir. 1985); *Leapers, Inc. v. SMTS, LLC*, 879 F.3d 731, 740-41 (6th Cir. 2018); *Echo Travel, Inc. v. Travel Assocs., Inc.*, 870 F.2d 1264, 1267 (7th Cir. 1989); *Co-Rect Prods., Inc. v. Marvy! Advert. Photography, Inc.*, 780 F.2d 1324, 1332 (8th Cir. 1985); *Dep't of Parks & Rec. v. Bazaar de Mundo, Inc.*, 448 F.3d 1118, 1128 (9th Cir. 2006); *FN Herstal SA v. Clyde Armory, Inc.*, 838 F.3d 1071, 1084 (11th Cir. 2016); *Readers Digest Ass'n v. Conservative Digest, Inc.*, 821 F.2d 800, 804-05 (D.C. Cir. 1987). Commercial strength is also called "acquired strength" or "acquired secondary meaning."

ility is not a “real and embarrassing” conflict between the circuits on an “important matter.”

And again, the *Dieter* presumption does not transpose the burden of proving likelihood of confusion or allow a senior user’s weak mark to prevent a junior user from using its own mark “even when no consumer will be confused about its source.” Pet. at 21. *Dieter* only creates a non-conclusive presumption pertaining to one factor in the likelihood-of-confusion test. The burden of proof of likelihood of confusion is not shifted to a defendant simply because a plaintiff’s mark is strong (whether by evidence of conceptual strength, commercial strength, or both, with or without a presumption). A plaintiff with a strong mark still must prove likelihood of confusion, so even with the *Dieter* presumption in play, the party asserting trademark infringement must prove that consumers are likely confused.<sup>6</sup> See, e.g., *FIU*, 830 F.3d at 1265; *Sovereign Mil.*, 809 F.3d at 1181; *Most Worshipful Nat’l Grand Lodge*, 813 Fed.Appx. at 458.

FT&E’s argument culminates in the assertion that FCOA “presented no evidence that consumers associate its Foremost mark as the source of any product.” Pet. at 21. That is inaccurate; FCOA did not rely solely on the *Dieter* presumption for its evidence

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<sup>6</sup> Utilizing a hypothetical where both parties have incontestable marks, FT&E posits that each would receive the *Dieter* presumption leaving only “conjecture” to decide who bears the burden of proof. Pet. at 21. But the party charging infringement plainly holds the burden to prove likelihood of confusion even after *Dieter* and the likelihood-of-confusion analysis measures only the strength of the *senior* user’s mark; the strength of the junior user’s mark is irrelevant. *La Quinta Worldwide LLC v. Q.R.T.M., S.A. de C.V.*, 762 F.3d 867, 875 (9th Cir. 2014).



of strength. FCOA produced plenty of evidence that its marks are commercially strong, Pet.App.20a-21a, which naturally is evidence that consumers associate its Foremost mark as the source of its products. Pet.App.16a (“Commercial strength refers to the real-world consumer recognition of a mark. . . .”). From this incorrect assertion FT&E claims that so long as FCOA’s marks are incontestable, it can stop FT&E from using its own mark. *Id.* at Pet.App.21a. But mere ownership of an incontestable mark is not even the entire question on the single factor of mark strength, and certainly does not equate by itself to an ability to stop others from using it; likelihood of confusion still must be shown. *United Grand Lodge*, 813 Fed.Appx. at 460.

### **III. THE OPINION BELOW DOES NOT CONFLICT WITH THE PURPOSE OF THE LANHAM ACT.**

There is no conflict between the opinion below and the purpose of the Lanham Act. Nothing in the Lanham Act prohibits a court from determining that the incontestable status of a mark is pertinent to its strength for likelihood-of-confusion purposes.

FT&E asserts that 15 U.S.C. § 1065, which enumerates the circumstances in which a mark becomes “incontestable,” and § 1115(b), which states that an incontestable trademark’s registration is conclusive evidence of the registrant’s exclusive right to use the mark, “do not correlate incontestable status with a confusion analysis.” Pet. at 12. That may be true, but the Lanham Act does not prohibit such a correlation either.

FT&E admits the Lanham Act’s text “is silent about any correlative coupling between incontestability

and strength,” Pet. at 10, and the Lanham Act does not direct how, or how not, to measure likelihood of confusion. *Freedom Sav. & Loan Ass’n v. Way*, 757 F.2d 1176, 1182 (11th Cir. 1985). This left courts to craft a test. Absent a mandate from Congress on how likelihood of confusion must be measured, a presumption that an incontestable mark has some strength does not conflict with the Lanham Act.

FT&E also claims that the *Dieter* presumption contradicts the Lanham Act because it “allow[s] descriptive trademark holders to prevent junior users from using their marks without need to prove that the junior user is likely to confuse consumers.” Pet. at 22-23. This is FT&E’s repeated refrain – that the Eleventh Circuit somehow alleviates a plaintiff’s burden to prove likelihood of consumer confusion under 15 U.S.C. § 1114(a)(1) and therefore conflicts with the Lanham Act and/or *KP Permanent Make-Up*. But *Dieter* only creates a presumption when examining one factor for likelihood of confusion; it does alleviate a plaintiff’s burden to show likelihood of consumer confusion.

FT&E also claims that Congress did not intend to give incontestable mark holders “superior rights over any trademark, registered or unregistered.” Pet. at 23. *Dieter* does not grant additional rights to the holder of an incontestable mark. *Dieter* merely considers the mark’s incontestable status as part of the strength factor of the likelihood-of-confusion inquiry along with the mark’s commercial strength or lack thereof. And in this case FCOA produced evidence of its marks’ widespread commercial strength. This is no conflict with the Lanham Act.



**CONCLUSION**

For these reasons, the Court should deny FT&E's petition for writ of certiorari.

Respectfully submitted,

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July 28, 2023