

No. 23-194

In the Supreme Court of the United States

TRENDILY FURNITURE, LLC, ET AL., PETITIONERS

v.

JASON SCOTT COLLECTION, INC.

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

REPLY BRIEF FOR THE PETITIONERS

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INTRODUCTION

As the petition established, this case presents an important and recurring question under the Lanham Act: whether a competitor’s intentional copying alone—without any intent to confuse consumers or pass off its goods as plaintiff’s—establishes that plaintiff’s trade dress has secondary meaning. The circuit conflict is both deep and entrenched, as the panel candidly recognized below. The question was raised and resolved at each stage, and there is no conceivable obstacle to resolving it here. It arises constantly in trade-dress litigation nationwide, and its correct disposition is essential to the Lanham Act’s operation—and to preserving legitimate and worthwhile economic competition. Whether a product is protected (or punished) by the Lanham Act should not turn on where a lawsuit happens to be filed. This split has persisted long enough, and this Court’s guidance is urgently warranted.

In response, respondent does not dispute the issue’s obvious importance. Respondent does not contest that it arises constantly in litigation nationwide. And respondent does not identify any procedural obstacles to resolving it here. What respondent does assert is a weak attempt at distraction. Respondent insists that all circuits apply the same standard and credit intentional copying—a contention that cannot withstand even a cursory glance at the decision below. It asserts this is a factbound question based on a totality analysis—while ignoring this question defines the *predicate legal framework* under which those “factbound” analyses are conducted. And respondent says the outcome would be the same even under the proper legal standard—a question obviously best suited for resolution on remand.

Because there is no legitimate reason to leave this important legal question unresolved, the petition should be granted.

A. There Is A Square And Intolerable Conflict

1. As the petition established (Pet. 9-30), the circuit conflict is deep, obvious, and entrenched. The panel below had no trouble recognizing the conflict (Pet. App. 14a & n.7), nor have expert commentators (2 J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition* § 15:38 (5th ed. 2023) (*McCarthy*)). Under any fair reading of the relevant opinions, the circuits are indeed squarely divided in multiple directions—including, critically, three circuits that *exclude* intentional copying from the legal framework absent an “intent to confuse”: “Copying is only evidence of secondary meaning if the defendant’s intent in copying is to confuse consumers and pass off his products as the plaintiff’s.” *Thomas & Betts Corp. v. Panduit Corp.*, 65 F.3d 654, 663 (7th Cir. 1995); see also, e.g., *Yankee Candle Co., Inc. v. Bridgewater Candle Co., LLC*, 259 F.3d 25, 45 (1st Cir. 2001) (“the relevant intent is not just the intent to copy, but to ‘pass off’ one’s goods as those of another”); accord, e.g., *Baig v. Coca-Cola Co.*, 607 F. App’x 557, 561 (7th Cir. 2015).

The Ninth Circuit’s analysis is irreconcilable with the conflicting views of those circuits. See Pet. 10-18 (outlining the First, Seventh, and Tenth Circuits’ established legal framework). Under the law of those three circuits, “the requisite intent is not just an intent to copy: proof of an intent to confuse is required.” 2 *McCarthy*, *supra*, § 15:38 (so explaining). Yet in the Ninth Circuit, any “[p]roof of copying”—without more—“strongly supports an inference of secondary meaning.” Pet. App. 12a (quoting *P & P Imports LLC v. Johnson Enters., LLC*, 46 F.4th 953, 961 (9th Cir. 2022)). And the panel candidly admitted as much below. Rather than saying this conflict

was irrelevant or all circuits have reached a “consensus” (contra Opp. 12), it recognized that other circuits (but not the Ninth Circuit) “impose[]” an “‘intent to confuse’ requirement” (Pet. App. 14a); it explained the logic behind that requirement (*ibid.*), which was directly at odds with the logic animating the Ninth Circuit’s conflicting standard (*id.* at 13a); and yet it refused to adopt that requirement in light of binding circuit authority (*id.* at 14a). See also *P & P Imports*, 46 F.4th at 961-962 (same).

As the panel summed up: “[t]hough some circuits have adopted * * * an intent to confuse requirement, we have not done so.” Pet. App. 14a & n.7. Instead, “under our precedent,” intentional copying alone “supports a strong inference of secondary meaning.” *Ibid.* It takes no more than skimming the decision below to confirm a recognized conflict over the primary factor undergirding the central element of all trade-dress litigation nationwide. See, *e.g.*, *ibid.* (admitting conflict with *Thomas & Betts* (Seventh Circuit) and *Yankee Candle* (First Circuit)); *P & P Imports*, 46 F.4th at 962 (admitting same conflict with *Craft Smith, LLC v. EC Design, LLC*, 969 F.3d 1092, 1110 (10th Cir. 2020)). And this conflict is sufficiently important that an expert has devoted entire *sections* of a treatise to establishing the conflict and criticizing the Ninth Circuit’s approach. 2 *McCarthy, supra*, §15:38 (outlining split); 1 *McCarthy, supra*, § 8:9 (“this inference of secondary meaning rests on flawed logic,” “relies on” “erroneous belief[s],” and “is especially unsound in the field of trade dress”).

2. Faced with this obvious conflict, respondent attempts (through sheer repetition) to invent their own alternate reality. Notwithstanding the clear law above, respondent insists *all* circuits agree “evidence of intentional copying is probative of secondary meaning.” Opp. 2-3; see also, *e.g.*, *id.* at 12 (“evidence of intentional copying is a

relevant * * * factor in each of those circuits”); *id.* at 15 (“Each of those circuits holds that evidence of intentional copying is probative of secondary meaning.”); *id.* at 31 (“ten circuits agree that evidence of intentional copying is probative of secondary meaning”); *id.* at 33 (“*every circuit agrees* that evidence of intentional copying is a relevant consideration”) (emphasis in original)).

This is baffling. The contrary circuit opinions are not difficult to understand. In unequivocal holdings, three circuits have *rejected* intentional copying absent an intent to confuse. See 2 *McCarthy, supra*, § 15:38 (“proof of an intent to confuse is required”). If that “‘intent to confuse’ requirement” is unmet (Pet. App. 14a), the factor is irrelevant and receives “no weight.” Pet. 12 n.3 (quoting district-court authority under *Thomas & Betts, supra*). Contrary to respondent’s contention, these circuits refuse to credit copying alone; “[t]he *relevant* intent is * * * to ‘pass off’ one’s goods as those of another,” and copying is otherwise “*not* * * * probative of secondary meaning.” *Yankee Candle*, 259 F.3d at 44-45 (emphases added); contra Opp. 31 (“evidence of intentional copying *is* probative of secondary meaning”) (emphasis added).

So how does respondent get this so wrong? It simply mischaracterizes the decisions. Take *Thomas & Betts*. Respondent describes the case as assigning “heavy, if not determinative, evidentiary weight” “where ‘the defendant’s intent in copying is to confuse consumers and pass off his product as the plaintiff’s.’” Opp. 24 (quoting 65 F.3d at 663). But without truncating the critical language, here is what the Seventh Circuit *actually* said: “*Copying is only evidence of secondary meaning if* the defendant’s intent in copying is to confuse consumers and pass off his products as the plaintiff’s.” *Thomas & Betts*, 65 F.3d at 663 (omitted language in italics; underline added). The

Seventh Circuit thus set a mandatory precondition for intentional copying to be relevant at all—and it is “only” evidence “if” that “intent-to-confuse” requirement is satisfied. It is not hard to interpret what that language means—or to see the obvious conflict with the Ninth Circuit. Pet. App. 14a (disavowing an “‘intent to confuse’ requirement” and reaffirming that copying alone “supports a strong inference of secondary meaning”).¹

Respondent has an obvious incentive to paper over the circuit conflict, but it cannot rewrite the actual opinions through sheer will. And it is simply false that “*every circuit agrees* that evidence of intentional copying is a relevant consideration” (Opp. 33). Back in reality, “many courts have refused to infer secondary meaning from mere intentional copying”; under that entrenched position, “intentional copying supports a finding of secondary meaning only where the defendant intended to confuse consumers and pass off its products as the plaintiff’s.” *Continental Lab. Prods., Inc. v. Medax Int’l, Inc.*, 114 F. Supp. 2d 992, 1010 (S.D. Cal. 2000) (citing, *e.g.*, *Thomas & Betts, supra*); see also, *e.g.*, *Gallagher v. Funeral Source One Supply & Equip. Co., Inc.*, No. 14-115, 2015 WL 6738733, at *8 n.14 (D.N.H. Nov. 4, 2015) (applying *Yankee Candle* to reject secondary meaning; “the relevant intent is not just the intent to copy, but to “pass off” one’s goods as those of another”). Under any fair reading, a

¹ Respondent misses the point in citing examples where circuits considered intentional copying and still declined to find secondary meaning. *E.g.*, Opp. 18. The relevant conflict is over the *underlying legal framework* and whether intentional copying is a legitimate factor at all. In each of respondent’s examples, intentional copying should have been excluded for failing the intent-to-confuse requirement. That some proponents still lost even after a court considered an *impermissible* factor is irrelevant.

conflict obviously exists. Pet. App. 14a (so acknowledging); see also Opp. 12 (reluctantly so conceding: “some circuits deem evidence of intentional copying relevant only when a defendant intended to confuse consumers,” and “the Ninth Circuit does not apply such an intent-to-confuse requirement”).²

3. Respondent next asserts that even if circuits apply materially distinct legal frameworks, review is unwarranted because they supposedly embrace the same underlying “rationale”—“namely, that intentional copying is not *always* indicative of secondary meaning.” Opp. 12-13, 28-29. Both respondent’s premise and its conclusion are wrong.

Its premise is wrong because the Ninth Circuit’s rationale is impossible to square with the logic of circuits adopting the “intent-to-confuse” requirement. Whereas the Ninth Circuit insists “[t]here is no logical reason for the precise copying save an attempt to realize upon a secondary meaning” (Pet. App. 13a), other circuits presume exactly the opposite—precise copying is explained by “any number of reasons unrelated to deception” or “source identification,” including “to render the product itself more useful or more appealing” (*Craft Smith*, 969 F.3d at 1110). The two rationales, in short, are polar opposites.

Respondent’s conclusion is likewise mistaken. It is a mystery why a concrete split between circuits enforcing

² The circuit conflict extends far beyond the Ninth Circuit, and it does indeed include a five-way split between every regional circuit. Pet. 9-30. But the direct conflict highlighted above—between those circuits adopting an intent-to-confuse requirement (the First, Seventh, and Tenth) and those rejecting such a requirement (all other circuits)—is alone readily sufficient to warrant review. The remaining division only underscores the palpable confusion this issue has generated across the country.

different legal frameworks should be excused simply because each side might embrace some of the same underlying logic or views. What matters is the ultimate holding—and a legal framework that *excludes* intentional copying is worlds apart from one assigning intentional copying a *strong* inference. The centerpiece of the panel’s secondary-meaning analysis would vanish under the Seventh, First, and Tenth Circuits’ “intent-to-confuse” requirement. Pet. App. 14a (admitting intent to confuse “was not present here”). Even if each side’s rationale were similar, the legal standards (and results) indisputably are not.

In any event, respondent grounds its argument in *Fuddruckers, Inc. v. Doc’s B.R. Others, Inc.*, 826 F.2d 837 (9th Cir. 1987). See Opp. 28-29. This is baseless. *Fuddruckers* involved a single paragraph of cursory analysis (see 826 F.2d at 844-845) that cannot be squared with today’s prevailing Ninth Circuit precedent—including the panel’s express identification of the rationale underpinning the Ninth Circuit’s *actual* holding. Pet. App. 12a-13a (citing *Audio Fid., Inc. v. High Fid. Recordings, Inc.*, 283 F.2d 551, 558 (9th Cir. 1960)). The panel made emphatically clear where the Ninth Circuit stands: it credits intentional copying alone because it perceives “no logical reason for the precise copying save an attempt to realize upon a secondary meaning.” Pet. App. 13a. That rationale is incompatible with the conflicting notion that “[c]ompetitors may intentionally copy product features for a variety of reasons.” Pet. App. 14a (describing this rationale as underpinning the *rejected* intent-to-confuse requirement); see also *Thomas & Betts*, 65 F.3d at 663 (“[t]he copier may very well be exploiting a particularly desirable feature, rather than seeking to confuse consumers as to the source”). And the panel again made clear its limited understanding of *Fuddruckers*: “deliberate copying is rele-

vant to secondary meaning, and ‘in appropriate circumstances * * * may suffice to support an inference of secondary meaning.’” Pet. App. 14a n.7 (quoting *Fuddrucker*, 826 F.2d at 844). That does not mirror the operative rationale in the opposing circuits.

4. Respondent finally asserts that “[s]econdary meaning is a factbound question, and applying a multifactor test unsurprisingly results in varying outcomes.” Opp. 3. Respondent accordingly submits there is no true certworthy *legal* question for the Court to resolve. Respondent is deeply confused.

The question presented turns on the *predicate legal framework*, not how that framework was applied in any given case. It is one thing to discount varied outcomes when applying the same legal standard in different factual contexts; it is another thing entirely to discount varied outcomes when applying *different* legal standards to the same facts. The secondary-meaning analysis may look in part at the totality of the circumstances, but the circuits here disagree over *which* circumstances are relevant in the first place. And this is not merely some minor or tangential factor; this is the *primary* factor in the analysis. It involves an issue (copying) that is present in virtually *every* trade-dress infringement case (else there would be no conceivable infringement). While three circuits declare it legal error to consider mere copying at all, the Ninth Circuit assigns the identical factor strong weight. The daylight between the two competing legal standards is obvious.

The question presented involves a pure question of law that has squarely divided the circuits. It determines whether the *same* type of intentional copying should be favored or excluded from the secondary-meaning analysis. Respondent has every reason to try to minimize the split, but it cannot properly avoid a direct circuit conflict

over the predicate framework by slapping a “factbound” label on a purely legal question.

B. The Question Presented Is Exceptionally Important And Warrants Review In This Case

1. Respondent does not dispute that the question presented is both important and recurring. Nor could it: secondary meaning is an essential predicate to seeking protection under the Lanham Act, and a finding of secondary meaning effectively removes the dress from the public domain. This is precisely why this Court has repeatedly “caution[ed] against” the kind of “misuse or overextension of trade dress” that respondent now invites. *TrafFix Devices, Inc. v. Marketing Displays, Inc.*, 532 U.S. 23, 29 (2001).

2. Instead, respondent tries to dodge review by suggesting it would have prevailed anyway even under the correct legal framework. Opp. 30-31. This fails on every possible level.

It initially fails because intentional copying was the centerpiece of each court’s holding. As petitioner previously established (Pet. 32-33), each court addressed intentional copying in a separate section; and each tethered its ultimate finding specifically to intentional copying. Pet. App. 44a (linking “[t]he Court’s finding” to petitioner’s “copying,” and only “bolster[ing]” that finding with other evidence); *id.* at 16a (concluding that the *combined* effect of copying and other factors was sufficient to support secondary meaning: “[t]aken together with Trendily’s intentional, direct copying—as well as the highly deferential standard of review—this evidence is sufficient”) (emphasis added). There is no indication either court would have automatically reached the same conclusion had it properly excluded intentional copying from the calculus.

In response, respondent insists both courts found there was “a substantial amount of indirect evidence’ of

secondary meaning, excluding the ‘proof of copying.’” Opp. 16 (quoting Pet. App. 18a). Of course, this is what the Ninth Circuit actually said: “the district court relied on proof of copying *and* a substantial amount of indirect evidence.” Pet. App. 18a (emphasis added). The disconnect between respondent’s version and the court’s actual statement is palpable.

In any event, there is no point speculating how the lower courts would reweigh the factors under a proper legal framework. This Court is a “court of review, not of first view.” *Cutter v. Wilkinson*, 544 U.S. 709, 718 n.7 (2005). There is no need to guess how the lower courts might rule when a post-merits remand could provide a definitive answer. And there is every indication that intentional copying was a necessary component of the analysis: the Ninth Circuit, for example, offered alternate factual holdings for some issues, but not this one. See Pet. App. 18a (“even if we were to disregard JSC’s evidence of retailer confusion, that evidence is not necessary”). It is telling the panel did not offer a similar alternate holding here.³

3. Respondent finally asserts that “nothing in the record show[s] that Trendily copied JSC’s trade dress for any reason other than ‘to realize upon a secondary meaning.’” Opp. 4. This is false. The record showed that the furniture style was popular and copied for that reason. The

³ While not strictly relevant to the question presented, respondent glosses over the obvious reason the courts below featured copying as the centerpiece of the analysis: this was the only viable way to overcome respondent’s other shortcomings. Respondent had no consumer studies; petitioner marketed its version of the furniture under its own name and using its own designated product collection; and the evidence focused predominantly on retailers, who are the least likely to be confused—as they are purchasing directly from the source. See, *e.g.*, Pet. App. 17a-18a.

point in copying was not to trick consumers but to offer *petitioner's* own version of the same furniture—which is why petitioner used its own marketing and trade name. Pet. App. 3a. In any event, the Ninth Circuit confirmed that there was no intent to confuse (Pet. App. 14a)—and respondent has no basis for questioning that factual determination here.

CONCLUSION

The petition for a writ of certiorari should be granted.

Respectfully submitted.

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