No. ________

In The
Supreme Court of the United States

DEBBIE ROHN and DEAN ROHN,

Petitioners,

v.

VIACOM INTERNATIONAL, INC., ET AL.,

Respondents.

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

PETITION FOR A WRIT OF CERTIORARI

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QUESTIONS PRESENTED

Petitioners hold two incontestable marks: a word mark and a logo mark, for their Guppie Kids clothing line. Respondent Viacom entered the kids clothing business by way of its TV show, Bubble Guppies. Petitioners bring this reverse confusion claim because respondents overwhelmed and converted petitioners' marks, about which respondents knew.

1. Did the Sixth Circuit (the panel includes Circuit Judges Thapar, Kethledge and Siler) refuse to apply established reverse confusion law to petitioners' claims?

2. Did the Sixth Circuit follow established summary judgment standards that apply to mixed questions of law and fact, including under *Hana Financial*, in affirming the granting of respondents' motion for summary judgment?

PARTIES TO THE PROCEEDINGS BELOW

The parties are petitioners Debbie Rohn and Dean Rohn and respondents Viacom International, Inc.; Target Corporation; Sears, Roebuck and Co.; Kmart Holdings; Kohl's Department Stores, Inc.; Genesco, Inc.; Gilt Groupe, Inc.; and Zazzle, Inc.

CORPORATE DISCLOSURE STATEMENT

Petitioners Debbie Rohn and Dean Rohn are individuals, and thus are not subsidiaries or affiliates of a publicly-owned corporation.

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PETITION FOR A WRIT OF CERTIORARI

Petitioners Debbie and Dean Rohn petition for a writ of certiorari to review the judgment of the United States Court of Appeals for the Sixth Circuit.

OPINIONS BELOW

The decision of the court of appeals (the panel included Circuit Judges Thapar, Kethledge, and Siler) is unreported. Pet. App. 1-5. The court of appeals' denial of the petition for rehearing is unreported. Pet. App. 37-38. The decision of the district court is reported at 231 F. Supp. 3d 253 (2017). Pet. App. 7-36.

JURISDICTION

The judgment of the district court granting respondents' motion for summary disposition was entered on February 10, 2017. Pet. App. 6. The Rohns timely appealed. The court of appeals issued its opinion and order affirming the trial court's decision on December 18, 2017. Pet. App. 1-5. The court of appeals' order denying the Rohns' timely petition for rehearing en banc was entered on January 19, 2018. Pet. App. 37-38. Jurisdiction rests on 28 U.S.C. § 1254(1).

STATUTORY PROVISIONS INVOLVED

Pertinent portions of The Lanham (Trademark) Act, Pub. L. No. 79-489, 60 Stat. 427, enacted July 5, 1946, are codified at 15 U.S.C. §§ 1051 *et seq.* 15 U.S.C. § 1065 provides, in pertinent part:

> Except on a ground for which application to cancel may be filed at any time under paragraphs (3) and (5) of section 1064 of this title, and except to the extent, if any, to which the use of a mark registered on the principal register infringes a valid right acquired under the law of any State or Territory by use of a mark or trade name continuing from a date prior to the date of registration under this chapter of such registered mark, the right of the owner to use such 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, shall be incontestable. . . .

15 U.S.C. § 1114(1) provides civil remedies for infringement of a mark holder's rights.

15 U.S.C. § 1115 provides, in pertinent part:

> To the extent that the right to use the registered mark has become incontestable under section 1065 of this title, the registration shall be conclusive 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.

15 U.S.C. § 1125 provides remedies for infringement of a trademark. 15 U.S.C. § 1127 defines "trademark" to

> include[] any word, name, symbol, or device, or any combination thereof – (1) used by a person, or (2) which a person has a bona fide intention to use in commerce and applies to register on the principal register established by this chapter, to identify and distinguish his or her goods, including a unique product, from those manufactured or sold by others and to indicate the source of the goods, even if that source is unknown.

STATEMENT OF THE CASE[1]

Petitioners Debbie and Dean Rohn have been in business together since 1990 as owners of a children's clothing line they called Guppie Kids. Second Am. Complaint, RE 83, Page ID #526, ¶ 22.

One evening, Debbie sat at the dining room table sketching a fish with a necktie – a yuppie guppie – imagining what it would look like on a child's shirt. With the help of a professional graphic designer, the fish with a necktie became the "G" in the word "Guppie", and thus a logo was born. *Id.*, ¶ 23.

[1] The Record Excerpts of petitioners/appellants (Rohns) filed in the district court are cited as "RE".

In 1990, with the help of a friend, the Rohns successfully registered a trademark of the Guppie logo with the United States Patent and Trademark Office as a "design plus letters." Second Am. Complaint, RE 83, Page ID #527. It was registered to be used with all the following goods which Debbie was researching how to produce: baby bunting, bloomers, boxer briefs, boxer shorts, coats, dresses, hats, jackets, leggings, mittens, pants, shirts, shoes, shorts, skirts, slippers, slips, socks, suits, sweatpants, sweatshirts, sweaters, ties, and underwear. *Id.*

When Guppie Kids was first established, Debbie was 30 years old with two children under age five. Every day was an opportunity to teach her children the values with which she was raised, the values she believed were important to living a good life and having a good future. She wanted her business to foster those values. Second Am. Complaint, RE 83, Page ID #528.

Starting with her earliest t-shirts, Debbie's Guppie Kids clothing tags included the line "I'm a Guppie Kid." What did it mean to be a Guppie Kid? To answer that, Debbie developed an acronym – Growing Up Playing Pursuing Individual Excellence – and a pledge (officially copyrighted in 1995) that also appeared on the clothes' cardboard hanging tags:

> "We pledge to work very hard to do our best, because someday we would like to be a success. But most important to be a GUPPIE, we pledge to be kind, loving, and help others. That would make us truly happy."

Second Am. Complaint, RE 83, Page ID #528-529.

In 1995, a friend of Debbie's who had access to more resources took an interest in Guppie Kids and offered to help. The Rohns signed a licensing agreement with her, and she went to some clothing shows, researched fabrics, organized a professional photo shoot, and encouraged Debbie's vision. Second Am. Complaint, RE 83, Page ID #530.

She renewed and protected her trademark throughout the 1990s and 2000s, and she always had products available for sale. In the late-1990s, she created her own email address: guppiekid@hotmail.com. *Id.*

In the early-2000s, Debbie hired a web designer to create Guppie Kids' first website, and she bought the URL guppiekids.com. When the site went live, Guppie Kids began to receive online orders from other states – Arizona, Colorado, California – and Debbie saw the potential for direct sales via the Web. *Id.*

It is undisputed that the Rohns own two registrations: a word mark and a logo mark. Both have been in continuous use in interstate commerce in connection with clothing since at least as early as the dates specified in the respective trademark applications. Second Am. Complaint, RE 83, Page ID #532.

The first is for the word mark GUPPIE, in connection with hats, jackets, boxer briefs and/or boxer shorts, pants, shorts, t-shirts, ties, sweatshirts, hooded shirts, gloves, and infant's underwear. Joint Statement of Facts ("JSF"), RE 200, Page ID #1228-1229, ¶¶ 2-3. It looks like this:

GUPPIE

The Rohns also own a trademark for the following logo, in connection with baby bunting, bloomers, boxer briefs, boxer shorts, coats, dresses, hats, jackets, leggings, mittens, pants, shirts, shorts, skirts, slips, socks, suits, sweat pants, sweat shirts, sweaters, ties and underwear:

JSF, RE 200, Page ID #1229, ¶¶ 5-6.

Viacom admits that its Bubble Guppies show did not premiere on a Nickelodeon network until January 2011. JSF, RE 200, Page ID #1234, ¶¶ 41, 43. However, even before then, the Rohns learned that such a show was in development, and wrote a letter to MTV

Networks (parent company of Nickelodeon), dated January 19, 2009. Second Am. Complaint, RE 83, Page ID #533. In it, the Rohns wanted to be sure that MTV Networks understood that if it intended to produce related clothing, it would need to negotiate a trademark licensing agreement with them. Their letter even was complimentary and encouraging of the new TV show and kindly offered to "work together." Their letter continues, "Like our Guppie message promotes: we need to treat others the way we would like to be treated." Second Am. Complaint, RE 83, Page ID #533. In its March 20, 2009 response letter, MTV's legal counsel dismissed the Rohns' concerns, noting that, "It is our contention that if we choose to use 'Bubble Guppies' on clothing, it will not infringe on rights you may have." Second Am. Complaint, RE 83, Page ID #533-534.

Around the January 2011 premiere of the Bubble Guppies children's television show, the Rohns learned that Nickelodeon was offering iron-on Bubble Guppie decals for clothing. The Rohns sent another letter to MTV/Viacom, once again offering to license their Guppie trademark. There was no response. Second Am. Complaint, RE 83, Page ID #534.

On July 19, 2011, Viacom successfully trademarked "Bubble Guppies" as a standard character mark for use in "entertainment services in the nature of a television series featuring animation, comedy, and drama" and for "providing online information in the field of entertainment concerning television programs." JSF, RE

200, Page ID #1234. Significantly, the Viacom trademark did not apply to clothing.

In January 2013, Debbie and Dean learned that various national mega-retailers (including Kmart, Kohl's, Sears, Target, and several online stores) were offering clothing designed with the words "Bubble Guppies" and even "Hello Guppies!" Second Am. Complaint, RE 83, Page ID #50. After the television show was first aired, Viacom licensed use of its BUBBLE GUPPIES mark to a variety of retailers, including Kohl's, JCPenney's, and others, and these retailers have begun to manufacture and sell clothing bearing the BUBBLE GUPPIES and GUPPIE marks. Second Am. Complaint, RE 83, Page ID #534-535.

The Rohns only learned of the existence of this clothing in 2013, and sent letters to them advising them of the Rohns' ownership of the GUPPIE registration. Second Am. Complaint, RE 83, Page ID #535. Viacom responded with a cease-and-desist letter, claiming that the Rohns' attempts to protect their property constituted tortious interference with contract. Second Am. Complaint, RE 83, Page ID #535-536.

Petitioners filed the instant suit on January 23, 2014; Complaint, RE 1, Page ID #1-34.

A. The District Court Decision.

Petitioners bring a reverse confusion claim arising out of what was in essence respondents' conversion of petitioners' intellectual property rights.

Specifically, petitioners' three-count complaint alleged claims of (1) trademark infringement; (2) false designation of origin; and (3) unfair competition (state law). Complaint, RE 1, Page ID #1-34. Petitioners later filed an amended complaint, asserting the same claims. First Am. Complaint, RE 76, Page ID #485-505. Petitioners filed a second amended complaint, also asserting the same claims. Second Am. Complaint, RE 83, Page ID #522-542.

On cross-motions for summary judgment, the district court granted respondents' motion and denied petitioners' motion. Pet. App. 7-36.

B. The Sixth Circuit's Decision.

A panel of the Sixth Circuit affirmed, opining that "Guppie Kid's sales had largely dried up well before the Bubble Guppies came along", and otherwise finding summary judgment appropriate. Pet. App. 1.

C. The Sixth Circuit's Order Denying Petitioners' Petition for Rehearing En Banc.

Petitioners timely filed a petition for rehearing en banc, which the Sixth Circuit denied by order entered on January 19, 2018. Pet. App. 37-38.

REASONS FOR GRANTING THE PETITION

I. The Sixth Circuit's decision conflicts not only with established Sixth Circuit law on claims of reverse confusion, but also with other federal circuits on the very same issue.

The Sixth Circuit has recognized four types of causes of actions in trademark law: (1) "palming off"; (2) confusion of sponsorship; (3) reverse confusion of sponsorship; and (4) dilution. *Ameritech, Inc. v. American Information Technologies Corp.*, 811 F.2d 960, 964-965 (6th Cir. 1987). The third type – reverse confusion – is at issue here.

The first two types described by *Ameritech* are appropriately thought of as forward confusion cases, and comprise the bulk of the trademark causes of action brought in the Sixth Circuit. The fourth type, dilution, is also not at issue here.

The *Ameritech* court recognized reverse confusion as a separate cause of action, and modeled its analysis after *Big O Tire Dealers, Inc. v. Goodyear Tire & Rubber Co.*, 561 F.2d 1365, 1374-1375 (10th Cir. 1977). There, the Tenth Circuit denominated the cause of action as "different" than the other causes of action. In turn, the *Ameritech* court similarly indicated that reverse confusion cases "differ[]" from forward confusion causes of action, holding that:

> A third kind of infringement is reverse confusion of sponsorship. A reverse confusion claim differs from the stereotypical confusion of

> source or sponsorship claim. Rather than seeking to profit from the goodwill captured in the senior user's trademark, *the junior user saturates the market with a similar trademark and overwhelms the senior user.* The public comes to assume the senior user's products are really the junior user's or that the former has become somehow connected to the latter. *The result is that the senior user loses the value of the trademark – its product identity, corporate identity, control over its goodwill and reputation, and ability to move into new markets.*

Ameritech, *supra*, at 964; emphasis added. The distinction between forward and reverse confusion is important because when assessing the strength of the senior user's mark, a conclusion that the mark is weak supports a claim for reverse confusion. In fact, it is the very foundation of reverse confusion.

The doctrine of reverse confusion has expanded to be recognized throughout the United States.[2]

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[2] *Attrezzi LLC v. Maytag Corp.*, 436 F.3d 32 (1st Cir. 2006); *Banff Ltd. v. Federated Dept. Stores, Inc.*, 841 F.2d 486 (2d Cir. 1988); *Fisons Horticulture, Inc. v. Vigoro Indus. Inc.*, 30 F.3d 466 (3d Cir. 1994); *Capital Films Corp. v. Charles Fries Productions, Inc.*, 628 F.2d 387 (5th Cir. 1980); *Ameritech, Inc. v. American Information Technologies Corp.*, 811 F.2d 960 (6th Cir. 1987); *Sands, Taylor & Wood Co. v. Quaker Oats Co.*, 978 F.2d 947 (7th Cir. 1992), *cert. denied*, 507 U.S. 1042, 113 S. Ct. 1879, 123 L.Ed.2d 497 (1993); *JL Beverage Co., L.L.C. v. Jim Beam Brands Co.*, 828 F.3d 1098 (9th Cir. 2016); *Big O Tire Dealers, Inc. v. Goodyear Tire & Rubber Co.*, 561 F.2d 1365 (10th Cir. 1977); *In Re Shell Oil Co.*,

The Sixth Circuit employs an eight-factor analysis in determining whether a defendant's use of the plaintiffs' mark created a likelihood of confusion: (1) strength of the plaintiffs' mark; (2) relatedness of the goods or services; (3) similarity of the marks; (4) evidence of actual confusion; (5) marketing channels used; (6) likely degree of purchaser care and sophistication; (7) the defendant's intent in selecting the mark; and (8) likelihood of expansion of the product lines using the marks. *Bliss Clearing Niagara, Inc. v. Midwest Brake Bond Co.*, 339 F. Supp. 2d 944, 963-964 (W.D. Mich. 2004) (citing *Frisch's Rests., Inc. v. Shoney's Inc.*, 759 F.2d 1261, 1264 (6th Cir. 1985)). The Sixth Circuit has explained:

> [T]hese factors imply no mathematical precision, but are simply a guide to help determine whether confusion is likely. They are also interrelated in effect. Each case presents its own complex set of circumstances and not all of these factors may be particularly helpful in any given case. But a thorough and analytical treatment must nevertheless be attempted. The ultimate question remains whether relevant consumers are likely to believe that the products or services offered by the parties are affiliated in some way.

Daddy's Junky Music Stores, 109 F.3d at 280. Any dispute about the evidence that pertains to the eight factors presents a factual issue. *Data Concepts, Inc. v.*

992 F.2d 1204 (Fed. Cir. 1993). Also see Restatement (Third) of Unfair Competition, § 20, comment f.

Digital Consulting, Inc., 150 F.3d 620, 624 (6th Cir. 1998), *abrogated on other grounds by Hana Fin., Inc. v. Hana Bank*, 574 U.S. ___, 135 S. Ct. 907 (2015) ("[i]f the facts relevant to the applicable factors are contested, factual findings must be made with respect to each of these factors").

Viacom here and the district court below relied upon *Therma-Scan, Inc. v. Thermoscan, Inc.*, 295 F.3d 623 (6th Cir. 2002) for support at various levels, albeit in different ways, because the district court was so internally inconsistent in its opinion. But *Therma-Scan* involved both a forward confusion cause of action and a reverse confusion cause of action argued in the same case. Here, Viacom did not differentiate between the analyses, and cited indiscriminately to confuse the analyses. Viacom did so based on its argument that *Therma-Scan* stands for more than the proposition that the eight-factor analysis must be used in reverse confusion cases, while ignoring the foundations of the reverse confusion analysis and how it fundamentally differs from a forward confusion analysis. Instead, Viacom argued, and the district court found, that the analysis itself is the same. But *Therma-Scan* does not say that. To do so would create an impossible standard for a plaintiff in a reverse confusion case.

Furthermore, on the reverse confusion side of the analysis, the *Therma-Scan* court decided to follow one Ninth Circuit case, *Cohn v. PetSmart, Inc.*, 281 F.3d 837 (9th Cir. 2002), on the subject, because it felt that the facts were the same, and differed from *Ameritech*. The *Therma-Scan* court followed *Cohn* on its facts.

However, the *Therma-Scan* court did not hold that the plaintiff's much weaker mark was not strong, but instead analyzed the mark exactly contrary to the manner in which it was analyzed here by the district court and argued here by Viacom. Rather, the *Therma-Scan* court followed the Ninth Circuit's factual analysis and adopted it for purposes of that case. The eight-factor analysis was performed differently for the reverse confusion analysis than for the forward confusion analysis.

Thus, even in *Cohn*, the Ninth Circuit indicated that the focus was on the relative strength of the defendants' (larger junior user) mark, rather than that of the smaller senior use, because a relatively larger strength made it more likely to be overwhelmed in the marketplace, which is precisely what happened in the instant case.

Notably, the Ninth Circuit subsequently clarified its analysis and its review on summary judgment, in *JL Beverage Co. L.L.C. v. Jim Beam Brands Co.*, 828 F.3d 1098 (9th Cir. 2016). There, the Ninth Circuit explained that "in reverse confusion cases, the junior mark holder's commercial strength 'creates a potential that consumers will assume that' the senior holder's mark refers to the junior holder's mark, 'and thus perceive that the businesses are somehow associated' ". *JL Beverage*, *supra*, at 1109.

Here Viacom and the district court relied on *Therma-Scan*, which in turned relied on *Cohn*, which in turn has now been explained by the Ninth Circuit to be contrary to Viacom's argument and the district court's ruling, as it applies to the relative strength of the mark analysis in a reverse confusion case. *JL Beverage* is also instructive and contrary to not only the district court's decision here, but also the manner in which it performed its summary judgment review.

Here, the panel's decision rests on its *factual finding* that the Rohns' trademarks are *commercially* weak:

> *Thus, few consumers were likely to know about Guppie Kid in the first place. Few if any consumers were therefore likely to confuse the Rohns' brand with Viacom's.* That would explain why the Rohns offer no evidence that any consumer has actually confused the two brands, which is the best evidence that consumers are likely to confuse them. See *Progressive*, 856 F.3d at 433. And without some proof that any consumers actually confused or had a reason to confuse the brands, a reasonable jury could not find that Viacom infringed on the Rohns' trademarks.
>
> *   *   *
>
> . . . [T]he "ultimate question" remains whether consumers are likely to think that the two brands are related. *Homeowners Grp., Inc. v. Home Mktg. Specialists, Inc.*, 931 F.2d 1100, 1107 (6th Cir. 1991). *And nowhere do the Rohns show that consumers knew about their brand to begin with – let alone confused Viacom's brand with theirs. Thus, a jury could not*

> *find that Bubble Guppies apparel infringes on their Guppie Kid trademarks.*

Rohn v. Viacom, File No. 17-1225 (6th Cir. 2017); Pet. App. 4-5; emphasis added. That conclusion is flawed for four principal reasons. *First*, the panel addressed only one factor out of the eight-factor test, ignoring other factors, including, as one significant example, evidence of Viacom's intent.

Second, a "few" consumers or customers are still consumers or customers. There is no *de minimis* exception that lets the junior user off the hook merely because the senior user's marks were commercially weak, and neither the district court nor the court of appeals nor respondents cite any.

Third, the panel misunderstood and misapplied the key point that in a reverse confusion claim the very foundation of a reverse confusion claim is a weak senior mark. In *Progressive*, Judge Guy recognized in his partial dissent that the majority inappropriately took the "reverse" out of "reverse confusion":

> The majority fails to recognize the error made by the district court in conflating forward confusion and reverse confusion. **The distinction between forward and reverse confusion is important because in applying the first *Frisch* factor, the strength of the plaintiff's mark, a conclusion that the mark is weak supports a claim for reverse confusion. In fact, it is the very foundation of reverse confusion.**

As the Third Circuit observed in *A & H Sportswear, Inc. v. Victoria's Secret Stores, Inc.*:

> [I]n a direct confusion claim, a plaintiff with a commercially strong mark is more likely to prevail than a plaintiff with a commercially weak mark. Conversely, in a reverse confusion claim, a plaintiff with a commercially weak mark is more likely to prevail than a plaintiff with a stronger mark, and this is particularly true when the plaintiff's weaker mark is pitted against a defendant with a far stronger mark. 237 F.3d 198, 231 (3d Cir. 2000); see also *Big O Tire Dealers, Inc. v. Goodyear Tire & Rubber Co.*, 561 F.2d 1365, 1367-1368, 1372 (10th Cir. 1977) (jury could find reverse confusion where large junior user's multi-million-dollar nationwide advertising campaign overpowered small senior user's mark).

Progressive Distribution Services, Inc. v. United Parcel Service, Inc., 856 F.3d 416 (6th Cir. 2017) (Guy, J., dissenting in part); emphasis added. Here, not only did the panel run roughshod over the Rohns' evidence of conceptual strength and the Fed. R. Civ. P. 56 standard of review – by finding that their marks' commercial weakness mattered more than their marks' conceptual strength – but it ignored the point that commercial weakness is the very foundation of a reverse confusion claim. In other words, it is because the Rohns' marks were commercially weak that they were overwhelmed by Viacom, the junior user.

Fourth, the panel evaluated the "confusion" test backwards. In a forward confusion case, the junior user's/infringer's use of a senior user's mark results in confusion as to the source of *junior user's* goods, as a result of which the junior user reaps the benefit of the senior user's goodwill.

In a case of reverse confusion, because the defendants are much better known than plaintiffs and have spent far more in marketing than the plaintiffs, the infringers' use of plaintiffs' mark results in confusion as to the source of *the plaintiff's* goods, here Guppie Kids clothing, as to which it is undisputed that petitioners had and have *both* a word mark and a logo mark, both of which were registered long before respondents got into the Guppie business. Either of petitioners' two marks is independently sufficient to provide all the remedy and relief petitioners sought in their summary judgment motion and to defend fully against respondents' competing summary judgment motion.

On the intent issue, "the use of a contested mark with knowledge of the protected mark at issue can support a finding of intentional copying." *Wynn Oil Co. v. American Way Service Corp. ("Wynn Oil II")*, 943 F.2d 595, 603 (6th Cir. 1991). Here, respondent Viacom knew of the petitioners' properly registered mark before it launched its television show, because petitioner expressly raised the issue in a letter she wrote to respondent. Second Am. Complaint, RE 83, Page ID #533. Respondent Viacom ignored that fact in its argument below, instead alleging that neither of the show's creators knew of petitioners' marks or their Guppie Kids clothing line until after the show began airing. Appellees' Br. at 21. Respondent omitted mention of the creator's testimony that it relied on the network (Viacom) to run an intellectual property check and to "clear" and approve the matter. Transcript of Robert Scull dep, at 69. But that the show's creators did not have knowledge of petitioners' claims before airing the show does not exculpate the network, because as even Mr. Scull acknowledged, he relied on respondent to run its checks and to clear the series before going forward with it. Were corporate behemoths like respondent able to "silo" information, like that they received from petitioners, in an effort to avoid liability for infringing on intellectual property rights, it would make a mockery of intellectual property law, and fail to do precisely what this Court recently has said it is intended to ensure:

> This system of federal registration helps to ensure that trademarks are fully protected and supports the free flow of commerce. "[N]ational protection of trademarks is desirable," we have explained, "because trademarks foster competition and the maintenance of quality by securing to the producer the benefits of good reputation." *San Francisco Arts & Athletics, Inc. v. United States Olympic Comm.*, 483 U.S. 522, 531 (1987) (internal quotation marks omitted); see also *Park 'N Fly, Inc.*, *supra*, at 198 ("The Lanham Act provides national protection of trademarks in order to secure to the owner of the mark the goodwill of his business and to protect the ability of consumers to distinguish among competing producers").

Matal v. Tam, 582 U.S. ___, 137 S. Ct. 1744 (2017). In fact, it is telling that Viacom only applied for a service mark under the Guppie mark, but did not apply for a trademark under clothing and merchandise, which was the specific category occupied by petitioners' marks. Respondents also artfully dodged petitioners' apparel marks internationally when respondent Viacom applied for a trademark for Guppies clothing only internationally, where petitioners had not sought protection of their intellectual property. At a minimum it can be inferred that respondent Viacom knew that a U.S. application for registration would be denied, which is why it only applied for a trademark for its Guppies clothing internationally.

Indeed, it is undisputed that Viacom knew about the Rohns' clothing line, because on March 13, 2009 Viacom's legal counsel wrote the Rohns about what that lawyer referred to as the Rohns' "claim that there would be some confusion between clothing created in conjunction with our upcoming television series BUBBLE GUPPIES (the "Series") and your "GUPPIE Kid" clothing line, and offer to work out a licensing agreement for the use of the "Guppie and Design Trademark." Ltr, RE 210, Page ID #1619.

Respondents did not use the mark on clothing in the United States until after any television shows aired. The Rohns put Viacom on notice and offered licensing in January 2009. Only later did Viacom's television show first air (January 2011). Only later still did respondents first sell related children's clothing (January 2013). Use after knowledge equals intent. See

Wynn Oil II, *supra* (use of a mark with knowledge of another's prior use of the mark supports an inference of intentional infringement).

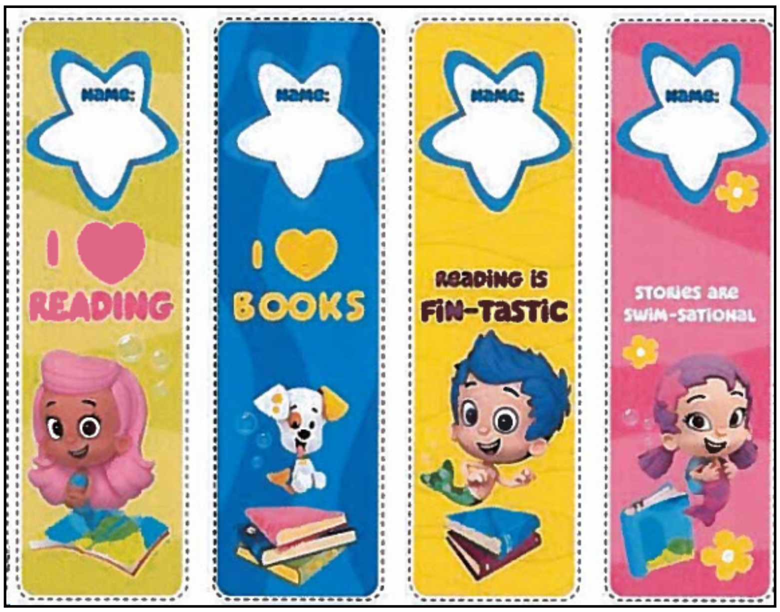
Other factors ignored by the panel but on which the Rohns presented compelling evidence include each of the following:

1. Relatedness of goods. Respondents sell children's clothing, as do petitioners. Respondents sell hats, jackets, pants, shirts, shorts, t-shirts, sweatshirts, hooded shirts, and infant's underwear. Petitioners' mark covers those identical goods. Petitioners sell those identical goods. Petitioners still try to sell those goods on the internet as they had in the past prior to use by respondents which overwhelmed any chance of their doing so. See Transcript of Debbie Rohn dep, RE 201, Page ID #1279, 1286 (quoted above).

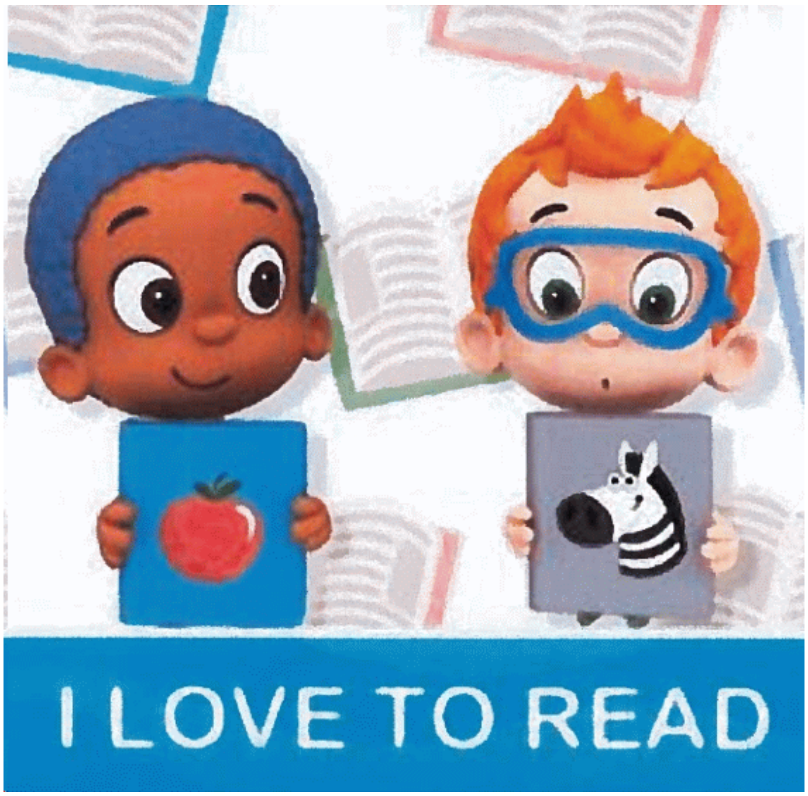
Viacom's attempt to distinguish children's merchandise directed to school-age children (what Viacom says the Rohns did) and children's merchandise directed to preschool-age children (what Viacom says it does) is, on its very face, weak. Worse yet, Viacom argues that the children in the demographic for the show – preschoolers – "generally cannot read so their connection is to the characters"[3] is flatly contradicted by Viacom's own advertising efforts, including the following downloadable bookmarks which say: "I ♥ Reading",

[3] Appellees' Br. at 22. See also Appellees' Br. at 50 ("preschoolers form a connection with the 'Bubble Guppies' ***characters*** – not word marks like GUPPIE that they cannot read." Emphasis in original).

"I ♥ Books", "Reading is Fin-Tastic", and "Stories are Swim-Sational":



Affidavit, RE 210, Page ID #1661. Or this Bubble Guppies post, depicting two Bubble Guppies characters holding up books with the caption, "I LOVE TO READ", which illustrates the disingenuity of respondent Viacom's argument that its target demographic does not read:



Affidavit, RE 210, Page ID #1662.

Indeed, the parties' goods here are more related than the goods and services were in *Ameritech*. They are more related than those in *Therma-Scan*. They are more related than those in *Progressive*. They are more related than those in *Cohn*. They are more related than those in *JL Beverage*. Fact issues exist, precluding summary judgment.

2. Similarity of marks. Petitioners sold Guppies clothing to children and even called its customers "Guppies". Viacom referred to its kids as "Guppies" or

"Guppie Kids", relied on a "G" shaped like a fish, similar to Plaintiffs' logo for "Guppie", and even applied for trademark registration under "Guppie" and not under "Bubble Guppies".

Viacom again argues that over 30 registered trademarks incorporate "guppie" or "guppy." Appellees' Br. at 41. But again Viacom ignores the fact that none of them are related to clothing.

Fact issues exist.

3. Degree of purchaser care. The purchasers of the Rohns' products and respondents' products are adults who are spending relatively small sums of money, i.e., $10 to $20. That is in stark contrast to the facts in *Progressive*, where the Sixth Circuit noted that the product there was very expensive:

> The district court found that Progressive markets its order fulfillment services to businesses seeking "to completely outsource their order fulfilment operations. . . . In short, this is not an impulsive purchase of an inexpensive item made at the checkout lane of a grocery store." Given these circumstances, the court concluded that it was likely that Progressive's customers exercised a high degree of care in purchasing services. It made a similar finding for UPS's customers and concluded that this factor weighed substantially in favor of finding of no confusion.

Progressive, *supra*, at 435 (internal citation omitted). The Sixth Circuit agreed, noting that "[t]he significant investment required in selecting Progressive's services and the commercial aspect of UPS's customer base suggests that the individuals who would be utilizing either service would be unlikely to confuse the two parties." *Id.*

II. The district court and the Sixth Circuit made impermissible findings of fact, contrary to the decisional standard established by this Court.

Whether a likelihood of confusion exists is a mixed question of law and fact subject to *de novo* review. *Data Concepts, Inc. v. Digital Consulting, Inc.*, 150 F.3d 620, 624 (6th Cir. 1998).

Recently this Court unanimously ruled that trademark questions involving mixed questions of law and fact ("tacking" was the specific issue involved there) should typically be determined by juries, not judges. *Hana Fin., Inc. v. Hana Bank*, 574 U.S. ___, 135 S. Ct. 907 (2015). There, this Court ruled that:

> Petitioner first observes that the "legal equivalents" test involves the application of a legal standard. [. . .] True enough, but "the application-of-legal-standard-to-fact sort of question . . . , commonly called a 'mixed question of law and fact,' has typically been resolved by juries." *Gaudin*, 515 U.S., at 512, 115 S. Ct. 2310; see *id.*, at 514, 115 S. Ct. 2310 ("[T]he jury's constitutional responsibility is not merely to determine the facts, but to apply the law to those facts and draw the ultimate

> conclusion. . . ."); *Miller v. Fenton*, 474 U.S. 104, 113, 106 S. Ct. 445, 88 L.Ed.2d 405 (1985) ("[A]n issue does not lose its factual character merely because its resolution is dispositive of the ultimate . . . question."). The "mixed" analysis that takes place during the tacking inquiry is no different. And insofar as petitioner is concerned that a jury may improperly apply the relevant legal standard, the solution is to craft careful jury instructions that make that standard clear.

Hana Financial, *supra*, at 911-912; emphasis added. Any dispute about the evidence that pertains to the eight factors presents a factual issue. *Id.* at 624 (noting that "[i]f the facts relevant to the applicable factors are contested, factual findings must be made with respect to each of these factors").

In *Hana*, the Court addressed the reasonable person standard in a trademark tacking case. The Court observed that "when the relevant question is how an ordinary person or community would make an assessment, the jury is generally the decisionmaker that ought to provide the fact-intensive answer." *Hana*, 135 S. Ct. at 911. This is true even when there is a mixed question of law and fact, as "juries answer often-dispositive factual questions or make dispositive applications of legal standards to facts." *Id.* at 911-912. The Court noted that although juries can be unpredictable in making these applications, that unpredictability has not been a barrier to them hearing mixed questions. *Id.* at 912. The Court then concluded that when a jury is to be empaneled and the facts do not warrant summary judgment, how a reasonable person makes an assessment is a question for the jury. *Id.* Also see *Suchanek v. Sturm Foods, Inc.*, 764 F.3d 750, 762 (7th Cir. 2014) (holding that a jury should have decided whether packaging was misleading to reasonable consumers).

Here, the lower courts erred by ignoring evidence, weighing evidence, and making findings of fact, and by failing to apply the appropriate decisional standard as required by *Hana Financial*, *supra.*

Any dispute about the evidence that pertains to the eight factors presents a factual issue. *Data Concepts, Inc. v. Digital Consulting, Inc.*, 150 F.3d 620, 624 (6th Cir. 1998), *abrogated on other grounds by Hana Fin., Inc. v. Hana Bank*, 574 U.S. ___, 135 S. Ct. 907 (2015) ("[i]f the facts relevant to the applicable factors are contested, factual findings must be made with respect to each of these factors"). The court of appeals made the factual determination that petitioners' trademarks were weak:

> According to the Rohns, a plaintiff with a weak trademark is unlikely to prevent this saturation and thus more likely to show reverse confusion. But whatever the merits of that argument in theory, it makes no practical difference here – since the value of the Rohns' trademarks is not only weak but practically nonexistent. Consumers are unaware of these brands to begin with, and thus the Rohns lack evidence of any kind of confusion.

Rohn v. Viacom, File No. 17-1225 (6th Cir. 2017); Pet. App. 1, 5. The court of appeals not only missed the key point of reverse confusion law – that a weak mark is the very foundation for such a claim – but it made factual determinations that should be left for a jury, as this Court has ruled in an analogous situation, in *Hana Financial*, *supra*.

CONCLUSION

The petition for writ of certiorari should be granted.

Respectfully submitted,

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