

No. 20-1817

IN THE
Supreme Court of the United States

EZAKI GLICO KABUSHIKI KAISHA, D/B/A EZAKI GLICO
CO., LTD. & EZAKI GLICO USA CORP.,
Petitioners,

v.

LOTTE INTERNATIONAL AMERICA CORP. & LOTTE
CONFECTIONARY CO. LTD.,
Respondents.

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

PETITION FOR REHEARING

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RULE 29.6 DISCLOSURE STATEMENT

The Rule 29.6 disclosure statement in the petition for writ of certiorari remains accurate.

PETITION FOR REHEARING

Under Supreme Court Rule 44.2, Petitioners seek rehearing of the Court’s order denying certiorari. Petitioners respectfully request that the Court vacate its order and hold the petition until this Court’s final disposition of *Sulzer Mixpac AG v. A&N Trading Co.*, No. 21-417, which is pending on certiorari.

Petitions for rehearing of an order denying certiorari may be granted where there are “intervening circumstances of a substantial or controlling effect.” Sup. Ct. R. 44.2. That standard is met where, as here, the Court has called for a response in a petition raising the same question presented, and the Court may grant certiorari to resolve a clear circuit split on that question. *See, e.g., Simmons v. Sea-Land Servs., Inc.*, 459 U.S. 931 (1982), 462 U.S. 1114 (1983) (granting rehearing, vacating, and remanding in light of *Pallas Shipping Agency, Ltd. v. Duris*, 461 U.S. 529 (1983), a petition involving the same circuit split granted one month after the Court denied certiorari in *Simmons*); *Melson v. Allen*, 558 U.S. 900 (2009), 561 U.S. 1001 (2010) (granting rehearing, vacating, and remanding in light of *Holland v. Florida*, 560 U.S. 631 (2010), a petition involving the same circuit split granted one week after the Court denied certiorari in *Melson*); *Addison v. New Hampshire*, 563 U.S. 991 (2011), 565 U.S. 1174 (2012) (mem.) (holding rehearing petition until decision on related issue in later-filed certiorari petition in *Perry v. New Hampshire*, 563 U.S. 1020 (2011), 565 U.S. 228 (2012)).

Indeed, a decision on the merits in *Sulzer Mixpac* is likely to favor Sulzer Mixpac—given the Second Circuit’s departure in that case from this Court’s longstanding test for trade dress functionality—and

would likely require reversal of the Third Circuit’s decision in Petitioners’ case, which likewise departed from this Court’s longstanding functionality test. In these circumstances, rehearing is warranted.

The Court denied Petitioners’ petition for a writ of certiorari on November 1, 2021. Seven days later, the Court requested a response in *Sulzer Mixpac*, which presents the same question as Glico’s petition. The first question presented in Glico’s petition is “[w]hether trade dress is ‘functional’ if it is ‘essential to the use or purpose of the article’ or ‘affects the cost or quality of the article,’ as this Court and nine circuit courts have held, or if it is merely ‘useful’ and ‘nothing more,’ as the Third Circuit held below.” Glico Pet. i. *Sulzer Mixpac* raises the same question, phrased slightly differently: “[w]hether any degree of utility categorically renders a product feature functional and thus ineligible for federal trademark protection under the Lanham Act, 15 U.S.C. § 1127.” *Sulzer Mixpac* Pet. i. Both petitions thus ask this Court to decide whether a product design is functional—and thus not subject to trade dress protection—if it is merely “useful” or has “any degree of utility,” or whether trade dress functionality requires a higher standard.

That is a crucial question for trade dress owners, as the amicus briefs in both cases demonstrate. Glico’s petition is supported by the Intellectual Property Owners Association (IPO), the American Intellectual Property Law Association, the International Trademark Association (INTA), and Mondelēz Global LLC. *Sulzer Mixpac*’s petition is similarly supported by INTA; the International AntiCounterfeiting Coalition (IACC); the Industrial Designers Society of America, Inc.; Swissmem; and a group of intellectual property

law professors. *See* Docket, Nos. 20-1817 & 21-417. All of these amici ask this Court to grant certiorari because the Second and Third Circuit’s decisions depart from the Court’s test for trade-dress functionality, lowering the bar for functionality and upsetting longstanding trade dress rights across many industries. *See, e.g.*, IPO Br. 2, No. 20-1817 (criticizing the Third Circuit’s mere “usefulness” test because it “would undermine and jeopardize the settled expectations and investments in the creation and protection of trade dress rights of IPO members and others”); IACC et al. Br. 10, 19, No. 21-417 (supporting certiorari and arguing that the “Second and Third Circuits” (in *Sulzer Mixpac* and *Ezaki Glico*) “depart from the majority view of functionality by categorically eliminating all trade dress protection for any product configuration or feature that has any degree of usefulness whatsoever,” calling “into question the rights in * * * long standing, source identifying trade dress”).

Indeed, INTA filed amicus briefs in both cases making the same point: In *Ezaki Glico*, INTA explained that “all products and product features have some ‘usefulness,’” and the Third Circuit erred in equating usefulness with functionality, resulting in “a changed landscape, in which the owners of product features claimed as trademarks will receive very different, far more limited protection.” INTA Br. 10, 14, No. 20-1817. In *Sulzer Mixpac*, INTA argued that “the Second Circuit set an extremely low bar for finding functionality, essentially holding that a feature that has *some* utility is functional and therefore not subject to [trade dress] protection,” making it “extremely difficult for trade dress owners to maintain protection under the Lanham Act.” INTA Br. 12, No. 21-417. INTA further explained that the Second Circuit’s decision in

Sulzer MixPac “joins the disturbing trend within some Circuits of either misunderstanding, or simply refusing to follow this Court’s clear articulation of the test for assessing functionality,” citing the Third Circuit’s decision in *Ezaki Glico* as another example. *Id.*

As the petition in *Sulzer Mixpac* explains, the courts of appeals are divided on the test for trade dress functionality, with the Second and Third Circuits holding that a product design is functional if it has any degree of utility, whereas numerous other circuits hold that a product design is functional only if it is *essential* to the use or purpose of the product. *Sulzer Mixpac* Pet. 7-13 (describing split); *see also* *Glico* Pet. 13-20 (describing split). That disagreement is worthy of this Court’s attention. Given this clear circuit split and two back-to-back petitions raising the same issue out of different courts of appeals, the Court may choose to grant certiorari in *Sulzer Mixpac*. It is therefore appropriate for the Court to grant *Glico*’s rehearing petition and hold *Glico*’s petition until this Court has decided *Sulzer Mixpac*. Any ruling in *Sulzer Mixpac*’s favor, and indeed any ruling by this Court clarifying the relevant standard for trade dress functionality, is likely to impact the Third Circuit’s decision in *Glico*’s case.

Petitioners thus respectfully request that the Court grant their petition for rehearing, vacate its order denying certiorari, and hold their petition for certiorari pending final disposition of *Sulzer Mixpac AG v. A&N Trading Co.*, No. 21-417. If the Court grants certiorari and reverses in *Sulzer Mixpac*, or issues a decision that otherwise calls into question the Third Circuit’s decision in Petitioners’ case, Petitioners request

that the Court grant their petition for certiorari, vacate the decision below, and remand (GVR).

In the alternative, Petitioners request that the Court wait to rule on their petition for rehearing until after it issues its decision in *Sulzer Mixpac*, as it has done in a number of previous cases. See *Melson*, 561 U.S. 1001 (granting petition for rehearing, vacating, and remanding after deciding a related issue in *Holland*, 560 U.S. 631 (2010)); *Kent Recycling Servs., LLC v. U.S. Army Corps of Eng'rs*, 578 U.S. 1019 (2016) (granting petition for rehearing, vacating, and remanding after deciding a related issue in *Army Corps of Eng'rs v. Hawkes Co.*, 578 U.S. 590 (2016)); *Simmons*, 462 U.S. 1114 (1983) (granting petition for rehearing, vacating, and remanding after deciding a related issue in *Pallas Shipping Agency*, 461 U.S. 529 (1983)); *Addison*, 565 U.S. 1174 (2012) (mem.) (denying petition for rehearing after deciding a related issue in *Perry*, 565 U.S. 228 (2012)); *Smith v. Florida*, 567 U.S. 954 (2012) (mem.) (denying petition for rehearing after deciding a related issue in *Williams v. Illinois*, 567 U.S. 50 (2012)).

Respectfully submitted,

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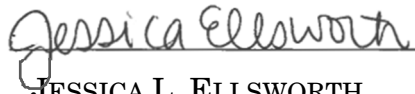
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NOVEMBER 2021

CERTIFICATE OF COUNSEL

Under Rule 44.2, Counsel certifies that the Petition for Rehearing is restricted to the grounds specified in the rule with substantial grounds not previously presented. Counsel certifies that this Petition is presented in good faith and not for delay.



JESSICA L. ELLSWORTH

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November 23, 2021