

In The
Supreme Court of the United States

CARMEN ELECTRA, TIFFANY TOTH, GEMMA LEE,
JESSA HINTON, JESSE GOLDEN, LINA POSADA,
SHEENA LEE WEBBER, HEATHER RAE YOUNG,
RACHEL KOREN, SABELLA SHAKE URSULA MAYES,

Petitioners,

v.

59 MURRAY ENTERPRISES, INC., DBA NEW YORK
DOLLS GENTLEMEN'S CLUB, JAY-JAY CABARET, INC.,
AAM HOLDING CORPORATION,
DBA PRIVATE EYES GENTLEMEN'S CLUB,

Respondents.

**On Petition For Writ Of Certiorari
To The United States Court Of Appeal
For The Second Circuit**

BRIEF IN OPPOSITION

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QUESTION PRESENTED

Petitioners have filed a petition for a writ of certiorari that is founded on the incorrect premise that there is a Circuit split on an issue decided by the Second Circuit Court of Appeals in its decision affirming the grant of summary judgment in Respondents' favor under the Lanham Act as to the question presented set forth in Petitioners' Petition. That question asks whether an individual must prove a commercial interest in their identity, or must they prove they are recognizable, publicly prominent or a celebrity to bring or sustain a claim for false endorsement under § 43(a)(1)(A) of the Lanham Act. In fact, there is no such Circuit split. Accordingly, the instant petition does not present any compelling reason for this Court to grant the writ in order to resolve a question to which the same answer has been given by the only two Circuits to consider the question. Both courts have held that an individual must have a distinctive mark in order to be in a position to prove the required likelihood of confusion necessary to prove a false endorsement claim for relief under the statute. That several decisions of district courts in other circuits arguably used different analyses to address similar claims by models asserting infringement of their unregistered marks does not supply the required compelling reason for this Court to grant the writ and rule on this issue which is hardly hotly disputed.

Moreover, it is evident that the Second Circuit ruled correctly as to the controlling Lanham Act

QUESTION PRESENTED – Continued

principles and applied the law properly to the record evidence in affirming the ruling of the Southern District of New York that summary judgment should be granted dismissing the Lanham Act claim of all but one of the Petitioners. Petitioners present strawman arguments in a misguided effort to persuade this Court to grant the writ. They argue that the Second Circuit “effectively held that only world-renowned celebrities are entitled to protection under 15 U.S.C. § 1125(a). . . .” (Petition p. 1) and that courts should rely solely on the strength of mark in evaluating false endorsement claims by individuals and ignore all other factors (*id.* p. 2). The Second Circuit issued no such holdings and did not even address whether celebrity status was mandatory. Instead, it held only that, in order to prevail on a false endorsement claim under § 1125(a)(1)(A), the plaintiff must show that she has a distinctive mark such that she can establish a likelihood of consumer confusion. Recognition of such a need to prove a distinctive mark and to adduce evidence probative as to the likelihood of confusion accords with widely accepted principles, and does not mandate proof that the plaintiff is a celebrity or that she is world-renowned. Importantly, the Court clearly recognized that strength of mark is only one of the factors to be evaluated, albeit a critically important factor when, as here, the mark is demonstrably weak, and it did not hold that it was the only factor to be considered as Petitioners pretend was the case.

CORPORATE DISCLOSURE

Pursuant to Supreme Court Rule 29.6, Respondents state that they are privately held corporations and no parent corporations or publicly held companies own 10% or more of Respondents' stock.

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STATEMENT OF THE CASE

Petitioners are models whose claims herein are premised on Respondents' use of Petitioners' images in certain advertising and social media for Respondents' gentlemen's clubs. Petitioners – who do not own the images utilized and who were paid to pose for the subject photographs for which in most instances they signed releases and relinquished control over how their images were used – claim that Respondents' republication of their images in advertisements gives rise to a false endorsement claim under § 43(a)(1)(A) of the Lanham Act. The District Court held correctly, and the Court of Appeals affirmed appropriately, that Petitioners cannot prevail on their false endorsement claim since the factors applied under the applicable test established by the landmark Second Circuit *Polaroid Corporation* decision balance decisively in favor of Respondents. Most critically, Petitioners failed to adduce any competent evidence that they were sufficiently well known and recognizable to be able to show a distinctive mark, and as a result they could not show a likelihood of consumer confusion, and they also could not show any actual confusion because the Court properly excluded Petitioners' survey expert evidence based on its fatally faulty methodology. Petitioners were also unable to show that Respondents acted in bad faith. Based on those failures of proof, the Second Circuit correctly rejected Petitioners' contention that they can prevail solely based on their intent to commercialize their marks, while dispensing with any need to prove that their marks have value because

they are recognizable, based on the correctly decided controlling precedents, as well as Petitioners' inability to adduce evidence as to any likelihood of confusion that would have enabled them to prevail.

Most importantly, this case presents no issue deserving of the Court's time. There is no decisional conflict in need of resolution and there is no other compelling reason for this Court to take up the case. Accordingly, the petition for a writ of certiorari should be denied.



REASONS FOR DENYING THE WRIT

I. THIS CASE POSES NO "CERT-WORTHY" ISSUE

"A petition for a writ of certiorari will be granted only for compelling reasons." Supreme Court Rule 10. No compelling reasons are present here.

Supreme Court Rule 10 outlines four categories of cases which, "though neither controlling nor fully measuring the Court's discretion, indicate the character of the reasons the Court considers" in deciding whether to grant review. Those categories are:

1. Cases raising a conflict between one United States court of appeals and another United States court of appeals or state court of last resort on the same important matter;

2. Cases raising a conflict between a state court of last resort and another state court of last resort or a United States court of appeals on an important federal question;
3. Cases in which a state court or a United States court of appeals has decided an important issue of federal law that should be settled by the Supreme Court or is in conflict with relevant Supreme Court precedent; and
4. Cases in which a United States court of appeals has “so far departed from the accepted and usual course of judicial proceedings, or sanctioned such a departure by a lower court, as to call for an exercise of this Court’s supervisory power.”

Supreme Court Rule 10(a)-(c).

The instant Petition is premised on the contention that there is a Circuit split qualifying the case for review on certiorari under Category 1. That is not the case. As the Petition recites:

The Second and Ninth Circuits . . . require evidence of ‘recognizability’ or ‘public prominence’ for a plaintiff to succeed on a claim under section 1125(a). Courts sitting in the Sixth, Seventh and Eleventh Circuit have specifically rejected the proposition that ‘fame’ or ‘recognition’ have any dispositive bearing on a likelihood of confusion analysis, instead holding that what controls is a plaintiff’s intent to commercialize her trademark.

Petition pp. 7-8 (fn. omitted). But the Petition necessarily concedes that the two Circuit Courts of Appeals that have addressed the issue that Petitioners ask this Court to consider are essentially in accord in recognizing a claim for false endorsement and requiring that the plaintiff prosecuting that claim must prove the existence of a recognizable or distinctive mark. The only courts to have applied different analyzes are three district courts in three different circuits.

In the instant case the Court held that a plaintiff must show both that she has a distinctive mark and likelihood of confusion to prove a false endorsement claim under § 1125(a)(1)(A). *Electra v. 59 Murray Enterprises, Inc.*, 987 F.3d 233, 257 (2d Cir. 2021). Similarly, in *Downing v. Abercrombie & Fitch*, 265 F.3d 994, 1007-08 (9th Cir. 2001), the Ninth Circuit held that the plaintiff must show a level of recognition among the segment of society for whom the defendant's product is intended and a likelihood of confusion. There is no Circuit Court of Appeals decision that applies a meaningfully different standard.¹ In fact, the Third Circuit has endorsed the Ninth Circuit's approach. See *Facenda v. NFL Films, Inc.*, 542 F.3d 1007, 1019 (3d Cir. 2008) (describing the proper analysis to be used in assessing

¹ Petitioners' attempt to differentiate the Ninth and Second Circuit approaches (Petition p. 17) is not well founded. Both focus on recognizability as the basis for establishing a distinctive mark as a prerequisite for being able to successfully prosecute a false endorsement claim. Any arguable daylight between these two courts' approaches is not the type of chasm that would merit this Court granting certiorari based on a compelling need for clarification.

likelihood of confusion as to the false endorsement claim of the estate of a well-known broadcaster whose voice was allegedly misappropriated). Given these similar holdings, it is apparent that no Circuit split is present.

By contrast, the Petitioners (p. 8) point to only a handful of district court decisions from other circuits in which the courts applied different standards in declining to dismiss comparable false endorsement claims. *See Arnold v. Treadwell*, 642 F. Supp. 2d 723 (E.D. Mich. 2009) (denying defendant’s summary judgment motion because the plaintiff model intended to commercialize her image); *Edmondson v. Velvet Lifestyle, LLC*, No. 15-cv-24442, 2017 U.S. Dist. LEXIS 219419 (S.D. Fla. July 28, 2017) (granting summary judgment motion because the plaintiffs intended to commercialize their images and evidence of actual consumer confusion); and *Yeager v. Innovus Pharmaceuticals, Inc.*, No. 18-cv-397, 2019 WL 447743 (N.D. Ill. Feb. 5, 2019) (denying defendant’s pre-answer motion to dismiss because the plaintiff pled that his name was used for commercial purposes in advertising a product).

Given this state of affairs, there is hardly a “deep divide in the federal courts” (Petition p. 1) as to the question presented. In light of the absence of a Circuit split, there is no compelling basis, or any basis in the Court’s rules, to grant this petition.

Of course, that district courts “sitting” in Circuits other than the Second and Ninth Circuits may have

applied a different analysis does not mean that those holdings are binding in those other circuits. It is patent that they do not have any *stare decisis* effect. *See, e.g., United States v. Articles of Drug Consisting of 203 Paper Bags*, 818 F.2d 569, 572 (7th Cir. 1987) (“A single district court decision . . . has little precedential effect [, and i]t is not binding on . . . other district judges in the same district”); *Reid v. BCBSM, Inc.*, 787 F.3d 892, 895 n.2 (8th Cir. 2015) (noting that district court rulings “cannot be used as *stare decisis*”); *McGinley v. Houston*, 361 F.3d 1328, 1331 (11th Cir. 2004) (“The general rule is that a district judge’s decision neither binds another district judge nor binds him, although a judge ought to give great weight to his own prior decisions.”). Only Courts of Appeals are the final arbiters of law in their geographic jurisdictions, absent a determination by the Supreme Court. *See, e.g., United States v. AMC Entm’t, Inc.*, 549 F.3d 760, 771 (9th Cir. 2008) (“Similarly, when the Ninth Circuit or any of its coequal circuit courts issue an opinion, the pronouncements become the law of that geographical area.”).

Given the foregoing principles, a district court in the Sixth, Seventh or Eleventh Circuits presented with similar claims in the future might well decide to eschew the rationales adopted by other district judges in their circuits – which do not carry *stare decisis* effect – and instead follow the rulings of the Second and Ninth Circuits assuming same are found to not be inconsistent with other authorities on point from their own circuits. Similarly, any district court in any other circuit would presumably decide the issue based on any

germane precedents in their circuit and potentially based on precedents from other circuits absent any controlling authority in their own circuits.

According to Petitioners, it is necessary for this Court to grant the Petition in order to clarify whether the mere intent to commercialize one's mark is sufficient to support a false endorsement or false association claim or whether it is necessary, as Petitioners contend that the Second Circuit requires, that a plaintiff must establish something akin to celebrity status in order to prevail. There is no call for the Court to address this issue. As demonstrated in Point II, the Second Circuit's multi-factor analysis of what a plaintiff must show in order to prove false endorsement – focused appropriately on proof of a distinctive mark and likelihood of confusion – constitutes a reasonable, well-functioning basis by which to assess the claims of these Petitioners and other potential plaintiffs who may assert claims based on similar alleged infringements. In other words, it is not necessary for this Court to opine about the non-issue of whether celebrity status is the *sine qua non* for success on a false endorsement claim because the Second Circuit did not actually adopt any such artificial standard. Of course, this Court has confirmed that marks merit protection under § 43(a) only if they are distinctive. *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 769 (1992). The Second Circuit's ruling flows logically from that principle.

In sum, the Petition does not meet this Court's high standard for granting certiorari. As the Court held in determining that a writ of certiorari had been

improvidently granted, certiorari should not be granted “‘except in cases involving principles the settlement of which is of importance to the public as distinguished from that of the parties, and in cases where there is a real and embarrassing conflict of opinion and authority between the circuit courts of appeals.’” *Rice v. Sioux City Mem’l Park Cemetery*, 349 U.S. 70, 79 (1955) (internal citation omitted). *See also City and County of San Francisco v. Sheehan*, 575 U.S. 600, 610 (2015) (dismissing one question raised by petition as improvidently granted “[b]ecause certiorari jurisdiction exists to clarify the law, its exercise ‘is not a matter of right, but of judicial discretion.’ Supreme Court Rule 10.”).

II. THE SECOND CIRCUIT’S DECISION WAS CORRECT

The Petition also attempts to persuade this Court that granting the writ would be appropriate because the Second Circuit adopted an interpretation of § 43(a) of the Lanham Act that is inconsistent with the statutory text, the legislative history and the statutory purpose. It is respectfully submitted that Petitioners are wrong and that they have not presented a persuasive showing that this Court should rule on the question presented.

15 U.S.C. § 1125(a)(1)(A) prohibits the use of a protected mark in a way that is likely to cause consumer confusion “as to the origin, sponsorship, or approval of [the plaintiff’s] goods.” Petitioners’ false

endorsement claim under that statute requires them to prove that Respondents: (1) in commerce, (2) made a false or misleading representation of fact (3) in connection with goods or services (4) that is likely to cause consumer confusion as to the origin, sponsorship, or approval of the goods or services. *Electra*, 987 F.3d at 257. “To succeed on a false endorsement claim under the Lanham Act, ‘a plaintiff must prove (1) that the mark . . . is distinctive as to the source of the good or service at issue, and (2) that there is the likelihood of confusion between the plaintiff’s good or service and that of the defendant.’” *Id.* citing *ITC Ltd. v. Punchgini, Inc.*, 482 F.3d 135, 154 (2d Cir. 2007). That emphasis on likelihood of confusion is appropriate in view of the Supreme Court’s observation: “It is, of course, also undisputed that liability under § 43(a) requires proof of the likelihood of confusion.” *Two Pesos, Inc.*, 505 U.S. at 769-70 (citations omitted).

Petitioners assert that it is appropriate to accord weight to the commercial interests of a plaintiff based on the statutory purpose as reflected by the legislative history of the Lanham Act. Petition p. 9. This argument does not advance Petitioners’ position. It goes without saying that trademark protection is designed in part to protect the investment of the trademark holder from infringement. But not every trademark holder will be entitled to such protection. The Lanham Act imposes all manner of perquisites for recovery under its various sections and it does not permit recovery despite other insufficiencies of the trademark holder’s claim solely based on that person or entity’s having a

commercial interest. The statutory purpose is not served, and instead is undermined, by removing appropriate obstacles to recovery in cases in which, as here, the plaintiffs cannot prove that they have strong, protectable marks or a likelihood of confusion.

Petitioners assert further that the Second Circuit's approach offends the plain language and statutory scheme since there is already a cause of action for trademark dilution under § 1125(c) for "famous" marks. They argue that the omission of language from one section of a statute while including that language in another section gives rise to a presumption that Congress intentionally excluded or included the language. Petition p. 10. The Court should give short shrift to this simplistic argument. A statutory trademark dilution claim for relief is predicated on the presumption that there are certain famous marks that can be diluted when adopted by others. The statute even defines what is required to establish a famous mark: The mark must qualify under a four-factor test mandated by § 1125(c)(2). The Second Circuit did not import that specific concept of fame into its discussion of § 1125(a)(1)(A) and it appropriately did not analyze those four factors which have no application as to Petitioners' false endorsement claim. In fact, the words fame and famous do not appear in the *Electra* decision. The Court addressed only the elementary requirement that a mark must be distinctive in order to merit protection under a false endorsement theory.

Petitioners argue further that the Second Circuit's approach is inconsistent with the statutory text, which

provides for a claim for relief on behalf of “any person who believes he or she is likely to be damaged,” because standing would now be limited to those who are recognizable (Petition p. 12, quoting § 1125(a)). This argument is sophistry. It has never been the law that any person can successfully prosecute a claim under § 43(a) absent a protectible interest in a mark. It falls to the courts to identify the circumstances under which such an interest exists and whether the putative markholder can prevail. In the instant case the Second Circuit has identified the necessary analysis in a manner consistent with the statute as construed by the Supreme Court and its own and other courts’ interpretations.²

A. Even Assuming Respondents Made a False Statement, Petitioners Cannot Prevail

Since there is no dispute that Respondents’ advertisements and promotions were used “in commerce” and “in connection with goods or services,” a threshold issue is whether Respondents made a false or misleading representation of fact. The District Court held that,

² Petitioners’ argument that the Second Circuit’s ruling is inconsistent with its own precedents (Petition p. 16) is incorrect, but even if it were well founded, that contention does not support granting the writ. A Circuit Court of Appeals is empowered to overrule its own precedents and of course courts are regularly called upon to interpret prior rulings and apply them to new fact patterns, as happened here. This Court would be overwhelmed if its case load was expanded to encompass every instance in which a Circuit Court of Appeals reconsidered one of its own previously settled rulings.

as to a § 1125(a)(1)(A) false endorsement claim, a defendant's unauthorized and suggestive use of a person's image can satisfy the requisite element of falsity. *See, e.g., Roberts v. Bliss*, 229 F. Supp. 3d 240, 249 (S.D.N.Y. 2017) ("The false or misleading representation of fact, in the context of a false endorsement claim, may involve the misleading implication that a celebrity or public figure endorses a product, when she does not"); *A.V.E.L.A., Inc. v. Estate of Marilyn Monroe, LLC*, 131 F. Supp. 3d 196, 208 (S.D.N.Y. 2015) (citing cases holding that "the use of an image on a product can support a claim for false endorsement"). *See also* 5 McCarthy on Trademarks and Unfair Competition § 28:15 (5th ed. 2018). App. B p. 67a.

The District Court concluded that Respondents' display of Petitioners' images constituted false or misleading representations of fact for purposes of a false endorsement claim. *Id.* While Respondents do not concede that point, it does not change the outcome, which is dictated by the absence of any evidence that Petitioners were recognizable without having been identified by name in Respondents' advertisements, such that there was no representation of endorsement by someone of value as an endorser and also no likelihood of confusion. *See Pelton v. Rexall Sundown, Inc.*, No. 99-cv-4342 (JSM), 2001 WL 327164, at *3 (S.D.N.Y. Apr. 4, 2001). The Second Circuit ruled correctly that Petitioners failed to raise a genuine issue of fact as to whether Respondents' alleged false representations of fact were likely to cause consumer confusion as to the origin, sponsorship, or approval of the goods or services.

Petitioners argue ineffectually that a finding of falsity should obviate any requirement that they prove injury, relying on inapposite authorities applicable to false advertising claims under § 1125(a)(1)(B). Petition p. 15. But Petitioners did not plead false advertising claims. As to false endorsement claims such as those asserted herein, the District Court and the Second Circuit appropriately did not import an analysis that has never been applied to false endorsement claims because it does not comport with the elements set forth in § 1125(a)(1)(A). False advertising means that a party has conveyed something false about its product. Here, Respondents' advertisements were not literally false since they did not make any statements and only reproduced photos. *See Gibson v. Resort at Paradise Lakes, LLC*, 16-cv-791, 2018 U.S. Dist. LEXIS 80471, at *39 (M.D. Fla. Feb. 2, 2018). Evidence that consumers were likely to have been confused and deceived as to whether the person depicted endorsed the service is therefore required, as is evidence that the marks are distinctive. As determined, it was fatal to Petitioners' case that they could not prove distinctiveness or adduce evidence of likelihood of confusion.

B. Petitioners Did Not Raise A Genuine Issue of Material Fact As To The Likelihood of Consumer Confusion

In the Second Circuit, “[i]t is well settled that the crucial determinant in an action for trademark infringement or unfair competition is whether there is any likelihood that an appreciable number of

ordinarily prudent purchasers are likely to be misled, or indeed simply confused, as to the source of the goods in question.” *Pirone v. MacMillan, Inc.*, 894 F.2d 579, 584 (2d Cir. 1990) (internal quotation marks omitted). Petitioners bear the burden to prove a probability of confusion, not a possibility. *Playtex Prods., Inc. v. Georgia-Pacific Corp.*, 390 F.3d 158, 161 (2d Cir. 2004). It is appropriate to dismiss such a claim as a matter of law if the plaintiff has failed to raise any genuine issue of material fact including as to likelihood of confusion. *Pirone*, 894 F.2d at 584-85. The case at bar is simply an example of such a dismissal based on the failure of the plaintiffs to adduce sufficient evidence to carry their burden.

The starting point for the necessary analysis has long been supplied by the eight-factor test for likelihood of consumer confusion set forth in Judge Henry Friendly’s landmark decision in *Polaroid Corp. v. Polarad Elecs. Corp.*, 287 F.2d 492, 495 (2d Cir. 1961). *Electra*, 987 F.3d at 257. “[A]pplication of the *Polaroid* test is not mechanical, but rather, focuses on the ultimate question of whether, looking at the products in their totality, consumers are likely to be confused” (*Starbucks Corp. v. Wolfe’s Borough Coffee, Inc.*, 588 F.3d 97, 115 (2d Cir. 2009) (internal quotation marks omitted)), and as a result “[n]o single factor is dispositive.” *Brennan’s, Inc. v. Brennan’s Rest., LLC*, 360 F.3d 125, 130 (2d Cir. 2004). Hence, “that one or more factors may weigh in one party’s favor does not preclude summary judgment in the other’s favor with respect to

likelihood of confusion.” *Disney Enters., Inc. v. Sarelli*, 322 F. Supp. 3d 413, 432-33 (S.D.N.Y. 2018).

As the Second Circuit ruled here, it is appropriate to utilize a modified version of the *Polaroid Corporation* test, omitting elements that are not helpful as to this false endorsement claim. The Court identified the relevant factors as the strength of the mark, evidence of actual consumer confusion, and evidence that the mark was adopted in bad faith. *Electra*, 987 F.3d at 257, citing *Starbucks Corp.*, 588 F.3d at 115. *See also Beastie Boys v. Monster Energy Co.*, 66 F. Supp. 3d 424, 456 (S.D.N.Y. 2014). Based on the approach it customarily employs in such cases, the Second Circuit was appropriately deferential to the District Court’s findings with respect to the predicate facts underlying each such factor. *Electra*, 987 F.3d at 257 (citing *Playtex Prods., Inc.*, 390 F.3d at 162).³

The Second Circuit held specifically that the District Court “properly analyzed the record of each Appellant’s public prominence to determine the strength

³ Petitioners’ argument that the Second Circuit should have reviewed the entirety of the District Court’s ruling *de novo* because some other Circuit Courts utilize *de novo* review of decisions granting summary judgment (Petition p. 19) fails. That generally applicable standard is of no moment in view of the Second Circuit rule that is specifically applicable here; *i.e.*, it defers to the district court findings as to predicate facts underlying each *Polaroid Corporation* factor. 987 F.3d at 257. Petitioners do not present a compelling reason for this Court to wade into whether such deference is appropriate. Petitioners do not suggest that there is a Circuit split that warrants this Court reaching this narrow issue.

of their marks, because among other reasons, the advertisements at issue provided no information identifying Appellants other than their pictures.” *Electra*, 987 F.3d at 258. The *Electra* Court cited *Bondar v. LASplash Cosmetics*, No. 12-cv-1417 (SAS), 2012 WL 6150859, at *7 (S.D.N.Y. Dec. 11, 2012), which held that “the misappropriation of a completely anonymous face could not form the basis for a false endorsement claim, because consumers would not infer that an unknown model was ‘endorsing’ a product, as opposed to lending her image to a company for a fee.” As the Second Circuit concluded, “because the ultimate question under *Polaroid Corporation* is the likelihood of consumer confusion, the district court properly analyzed Appellants’ recognizability.” 987 F.3d at 258 (citing *Bondar*). The Second Circuit’s citation to *Bondar* is an implicit endorsement of that Court’s ruling that 43(a) “does not require celebrity, only a likelihood of confusion . . . there is a level of consumer recognition short of celebrity – as that term is commonly understood – capable of causing consumer confusion” (*Id.* at *7). That holding undermines Petitioners’ unsupported contention that the Second Circuit mandated a finding of celebrity status for all false endorsement claims brought by individuals.

Petitioners argue that the Second Circuit has improperly addressed the concept of false endorsement because the statute does not use the term endorsement. Petition p. 5. Petitioners are mistaken. Section 1125(a)(1)(A) gives rise to liability only if there is a false description of or false representation of fact or

false designation of origin likely to cause confusion or to deceive as to the “affiliation, connection, or association of such person with another person, or as to the origin, sponsorship, or approval of his or her goods, services, or commercial activities by another person. . . .” Construing “affiliation, connection or association” as connoting endorsement is appropriate, and as a result the existence of a claim for false endorsement under this statute is recognized by the Second Circuit and most if not all of the other Circuit Courts of Appeals. *E.g.*, *Jordan v. Jewel Food Stores, Inc.*, 743 F.3d 509, 522 (7th Cir. 2014) (recognizing the existence of a false endorsement claim, which requires proof of likelihood of confusion). *Accord Webster v. Dean Guitars*, 955 F.3d 1270, 1278 (11th Cir. 2020); *Dryer v. NFL*, 814 F.3d 938, 944 (8th Cir. 2016); *Facenda v. NFL Films, Inc.*, 542 F.3d at 1015; *McBee v. Delica Co.*, 417 F.3d 107, 115 (1st Cir. 2005); *ETW Corp. v. Jireh Publishing, Inc.*, 332 F.3d 915, 925-26 (6th Cir. 2003); *Downing v. Abercrombie & Fitch*, 265 F.3d at 1008. Accordingly, to the extent Petitioners are actually asking this Court to rule that there is no false endorsement claim for relief under § 1125(a)(1)(A), they certainly cannot invoke any Circuit split as a putative basis to do so.

Petitioners’ argument that the *Electra* decision “cuts against decades of precedent” (Petition p. 7) relies on citations to inapposite decisions and fails to support this extraordinary, unsupportable contention. *Coach Services, Inc. v. Triumph Learning LLC*, 668 F.3d 1356 (Fed Cir. 2012), is not a false endorsement case. That decision involved an appeal from a ruling by the

Trademark Trial and Appeal Board as to whether a mark could be registered for educational purposes. The Federal Circuit actually confirmed there that strength of a mark are important factors to be addressed in that context to assess whether there is a likelihood of confusion. *Id.* at 1367. *Accord In re i. am. Symbolic, LLC*, 866 F.3d 1315, 1330 (Fed. Cir. 2017). In fact, the Federal Circuit’s analysis of likelihood of confusion echoes the Second Circuit’s. *See In re Chippendales USA, Inc.*, 622 F.3d 1346, 1353 (Fed. Cir. 2010) (“Every court of appeals to consider the question has adopted a similar multi-factor test for evaluating the likelihood of confusion necessary to establish a trademark infringement claim, and all of those tests include a factor that inquires into the ‘strength’ of the asserted mark” (citing 4 McCarthy on Trademarks and Unfair Competition, § 24:30-24:43 (4th ed. 2008) and *Polaroid Corporation*)).

In short, Petitioners have failed to identify any appellate precedent with which the *Electra* decision conflicts. They have also failed to show any error in the manner in which the Second Circuit construed the statute and applied it to the summary judgment record. The Court of Appeals did not “disregard the statutory text” of § 1125(a)(1)(A) or improperly “apply a more stringent ‘endorsement’ inquiry” (Petition p. 5). Instead, it applied an appropriate analysis that has long been recognized as a valid means to require that holders of unregistered marks must prove their marks are distinctive and a likelihood of confusion as to whether they are have become associated with the

third parties who utilize their likenesses as a means to convey endorsement. As developed below, even if Petitioners had been able to prove that they have distinctive marks, dismissal of their claims would nonetheless have been proper because they would be unable to prove likelihood of confusion.

i. Petitioners' Marks Are Not Distinctive and They Failed to Show Likelihood of Confusion

Petitioners (other than Carmen Electra) did not make out their burden to prove that their personas are strong, distinctive marks. To do so, they would have to establish that they have a high level of recognition “among the consumers to whom the advertisements are directed.” *Jackson v. Odenat*, 9 F. Supp. 3d 342, 356 (S.D.N.Y. 2014). Petitioners’ failure of proof was critical inasmuch as “[t]he strength of [their] mark or name is a crucial factor in determining likelihood of consumer confusion.” *Pelton*, 2001 WL 327164, at *3. In fact, the Second Circuit has held that to be one of the three most important elements to be weighed under the *Polaroid Corporation* analysis (the others being similarity of the marks and defendant’s bad faith). *Playtex Prods., Inc.*, 390 F.3d at 167 n. 5. Again, the Second Circuit’s approach is consistent with the Supreme Court’s teaching. *Two Pesos, Inc.*, 505 U.S. at 769-70.

Petitioners seek review by this Court based on their misguided argument that they can prevail simply by showing that they intended to commercialize their

marks, without regard to whether they succeeded in establishing distinctive marks. But that argument ignores the reality that, absent some level of recognition, there is no basis for inferring consumer confusion regarding Petitioners' sponsorship or approval of the Clubs' goods and services because an endorsement by an anonymous face has no value. *Bondar*, 2012 WL 6150859, at *7. Petitioners made the fatal mistake of premising their case on the assumption that they did not have to prove that their putative endorsement had any value. That error is exemplified by the fact that Petitioners' survey expert Martin Buncher conceded that his survey – which the Second Circuit confirmed was “fatally flawed” (*Electra*, 987 F.3d at 258) – was designed so that any pretty face could have been used as a stimulus.

While intent to commercialize one's mark is certainly a required element for a plaintiff to prevail on a false endorsement claim, it is insufficient to enable a plaintiff to prevail when, as here, she cannot establish recognizability as evidence of the strength of her mark. The plaintiff must prove that her name or image is distinctive and thus has some demonstrable value for endorsement purposes in order to prove the other key element that consumers are likely to be confused. At the summary judgment stage, the plaintiff must adduce sufficient evidence as to that value to raise a genuine issue of fact. Petitioners failed to establish their personas were distinctive including because their survey evidence was properly ruled to be inadmissible.

Petitioners' argument that several district court decisions from other circuits did not follow the same analysis or reach the same result (Petition pp. 7-8) is misguided. To the extent the district court decisions from other circuits cited by Petitioners permitted recovery absent proof of distinctiveness of the claimed mark as is necessary to establish likelihood of confusion, they were decided incorrectly and are inconsistent with Second Circuit precedent.

The Second Circuit recognized that the District Court correctly applied its standard and weighed the pertinent factors, and its standard is the correct one. Petitioners challenge the language used in decisions addressing false endorsement claims because it does not reference confusion as to "affiliation, connection or association" even though § 43(a) includes that language. Petitioners cannot establish that the courts whose rulings they criticize would have reached a different result had they cited that statutory language. A plaintiff who cannot raise a genuine issue of fact as to affiliation, connection or association due to the absence of a distinctive mark will be unable to prove the required likelihood of confusion as necessary to prove a false endorsement claim. Plaintiffs such as the Petitioners here who cannot establish recognizability do not have strong, distinctive marks and they therefore face a daunting path to establish likelihood of confusion. As the Second Circuit held, Petitioners stumbled on that path and never found their way.

Dallas Cowboys Cheerleaders, Inc. v. Pussycat Cinema, Ltd., 604 F.2d 200, 205 (2d Cir. 1979), a leading

Second Circuit decision, is instructive. The plaintiff prevailed there because its well-known cheerleader uniform, which defendant appropriated for a pornographic film, “unquestionably brings to mind the Dallas Cowboys Cheerleaders.”⁴ By contrast here, Petitioners failed to prove that they have strong marks in their personas because they could not adduce any proof that their photos bring to mind anything more than a generic attractive woman to a likely consumer of Respondents’ services.⁵

The decision of the Southern District of New York in *Pelton* is also instructive. There, the district court granted summary judgment in favor of the defendant who used plaintiff’s photo on packaging for its dietary products based on the lack of evidence that plaintiff was recognizable despite her claimed international renown based on having modeled in magazines and promotional campaigns. 2001 WL 327164, at *3–4. *See also Albert v. Apex Fitness, Inc.*, No. 97-cv-1151 (LAK),

⁴ Petitioners argue that this decision held that the public’s belief that the mark’s owner sponsored or otherwise approved the use of the trademark satisfies the confusion requirement. 604 F.2d at 204-05. But that decision did not address whether the holder of a weak mark can make out a burden of proof based on a mere assumption that the endorsement was of value. That issue did not arise since the mark at issue there was so widely recognized that it was credible that the defendant’s misappropriation gave rise to confusion.

⁵ Petitioners rely on *Arnold v. Treadwell*, 642 F. Supp. 2d 723 (E.D. Mich. 2009). That decision ruled that the plaintiff model need not prove that she was a celebrity to prevail at trial. The court failed to address whether the plaintiff could prove her mark was distinctive, as is mandatory in the Second Circuit.

1997 WL 323899, at *1 (S.D.N.Y. June 13, 1997); *Pas-selaigue v. Getty Images (US), Inc.*, No. 16-cv-1362 (VSB), 2018 WL 1156011, at *8 (S.D.N.Y. Mar. 1, 2018).⁶

Similarly here, Petitioners – other than Carmen Electra, who is well known for acting, modeling and endorsing – failed to establish that they have distinctive marks. They failed to meet their summary judgment burden to adduce competent evidence that they were recognizable to either the general public or Respondents’ likely customers. Most critically, they relied on incompetent survey evidence that failed to show that they had distinctive personas in any event. In sum, Petitioners’ marks are weak because they could not prove that the use of their images in previous widely disseminated advertising campaigns garnered them actual recognizability.⁷ The record evidence

⁶ See also *Ji v. Bose Corp.*, 538 F. Supp. 2d 349 (D. Mass. 2008) (granting summary judgment dismissing claim based on advertisements using the plaintiff model’s photo because she could not establish that consumers would recognize her).

⁷ The District Court was appropriately dubious as to the import of Petitioners’ current large social media followings. Only one of the 636 respondents surveyed by Petitioners’ expert recognized any of the three models whose photos they were shown. That lone respondent recognized Carmen Electra. But he also incorrectly identified one of the other two models as Paris Hilton, who is not a plaintiff in this action. Tellingly, several of the Petitioners could not even identify each other when shown the photos at issue. Petitioners failed to present evidence as to their social media followings at the time the images at issue were published, as opposed to as of 2018 when the motions were briefed. Moreover, having social media followers does not demonstrate recognition by those followers (and followers can be purchased in any event), and it is

confirms that this most critical *Polaroid Corporation* element tilts decisively against Petitioners due to their lack of distinctive marks.

Petitioners fare no better by arguing that Respondents affirmatively represented that Petitioners are their product. Again, unless any representation by Respondents was likely to confuse the public as to Petitioners' endorsement of Respondents' clubs, it is not actionable. It is of no moment that, as Petitioners contend, many of the survey respondents thought these anonymous models might have endorsed the clubs or might be appearing live at the clubs because there is no evidence that these respondents had any idea that the models were anyone notable whose endorsement was of significance (as well as based on the survey's fatal flaws which render all of the responses suspect).

ii. There is No Record Evidence of Actual Confusion

Petitioners also failed to meet their burden to establish likelihood of confusion because they “point to no evidence of actual consumer confusion.” *Electra*, 987 F.3d at 258. See *Lois Sportswear, U.S.A., Inc. v. Levi Strauss & Co.*, 799 F.2d 867, 875 (2d Cir. 1986). The absence of such evidence is critical since a plaintiff has to prove that element and the defendant need not disprove it. *KP Permanent Make-up, Inc. v. Lasting Impression I, Inc.*, 543 U.S. 111, 121 (2004). Evidence of

unknown whether those followers are in or near New York City or otherwise likely to patronize Respondents' clubs. App. B p. 71a.

actual confusion has been appropriately characterized as “highly probative.” *Allen v. Nat’l Video, Inc.*, 610 F. Supp. 612, 628 (S.D.N.Y. 1985).

To prove consumer confusion, Petitioners relied entirely on the survey conducted by their putative expert Martin Buncher. That reliance was misplaced because, as the District Court ruled and the Second Circuit affirmed, the survey was “fatally flawed” (*Electra*, 987 F.3d at 258), Mr. Buncher was not a qualified expert, and his opinion was appropriately stricken under Federal Rules of Evidence 702 and 403. Petitioners’ Petition in this Court does not challenge that determination. Hence, this case is akin to one in which no survey at all was conducted. Since “the absence of surveys is evidence that actual confusion cannot be shown” (*Sports Auth., Inc. v. Prime Hosp. Corp.*, 89 F.3d 955, 964 (2d Cir. 1996)), Petitioners failed to prove actual confusion. When, as here, the proffered evidence of confusion is solely a defective survey, the plaintiff has not raised an issue of fact sufficient to overcome summary judgment. *Universal City Studios, Inc. v. Nintendo Co.*, 746 F.2d 112, 118 (2d Cir. 1984).

Having lost their chance to prove their case by competent survey evidence, Petitioners were left to rely solely on insufficiently persuasive anecdotal evidence. Their failure to raise a genuine issue as to actual confusion strongly favors Respondents’ position. Hence, it was appropriate to grant summary judgment and not require that the trier of fact decide the issue because “the undisputed evidence would lead to only

one conclusion as to whether confusion is likely.” *Cadbury Beverages, Inc. v. Cott Corp.*, 73 F.3d 474, 478 (2d Cir. 1996) (citations omitted).

iii. There is No Evidence of Bad Faith

Another *Polaroid Corporation* factor that strongly supports Respondents is the dearth of evidence that they acted in bad faith in adopting the supposed “imitative mark.” As the Second Circuit held, “while Appellants urge this Court to conclude that Appellees acted in bad faith, the record merely shows that Appellees failed to investigate whether the third-party contractor responsible for the advertisements secured legal rights to use Appellants’ pictures in the promotional images – not that Appellees intended to use the pictures without legal right to do so.” *Electra*, 987 F.3d at 258.

It is appropriate to evaluate “whether defendant in adopting its mark intended to capitalize on plaintiff’s good will.” *EMI Catalogue P’ship v. Hill, Holliday, Connors, Cosmopulos Inc.*, 228 F.3d 56, 66 (2d Cir. 2000). It is undisputed that Respondents did not specifically request that their contractors provide specific images or identify models they wanted to include in their advertisements. Given the record evidence, the Second Circuit determined appropriately that Petitioners failed to create a genuine issue of fact as to whether Respondents knew or had reason to know that their independent contractors who actually selected the photos used in the advertisements did not have the

rights that Respondents believed they had. Hence, there is no basis in the record to conclude that Respondents intended to capitalize on Petitioners' good will.

Petitioners' contention that bad faith is present because Respondents turned a blind eye to their contractors' misconduct is not supported by any authority. Likewise, Respondents' delegation of the website postings to contractors does not show bad faith because there is no indirect liability for false endorsement based on that third party's acts. *Lepore v. NL Brand Holdings LLC*, 16-cv-08115, 2017 U.S. Dist. LEXIS 163035 (S.D.N.Y. Sept. 28, 2017).

Further, Petitioners cannot overcome their inability to present evidence that Respondents intended to deceive potential customers. Even knowledge of Petitioners' marks and the absence of licenses would not, without more, create an inference of bad faith. *Playtex Prods., Inc.*, 390 F.3d at 166; *Nora Beverages, Inc. v. Perrier Group of America, Inc.*, 269 F.3d 114, 124 (2d Cir. 2001).

In sum, on the summary judgment record, it is evident that Respondents did not "with knowledge of the infringing activity, induce, cause or materially contribute to the infringing conduct of another." *Warner Bros. Entm't, Inc. v. Ideal World Direct*, 516 F. Supp. 2d 261, 267-68 (S.D.N.Y. 2007) (internal citation omitted); see also *Faulkner v. Nat'l Geographic Society*, 211 F. Supp. 2d 450, 473 (S.D.N.Y. 2002).

iv. Balancing All Pertinent Factors Favors Respondents

The Second Circuit's decision confirms that the District Court appropriately balanced the foregoing factors as well as the three remaining less germane factors – similarity of marks, proximity of products and nature and cost of product, which the District Court held favored Petitioners – and concluded correctly that the balance decisively favors Respondents. Again, this conclusion is compelled most strongly by Petitioners' inability to adduce competent proof as to the strength of their marks inasmuch as they could not prove they are sufficiently recognizable such that their appearance in the advertisements could possibly be likely to confuse consumers. *See* App. B pp. 77a-78a.



CONCLUSION

For the foregoing reasons, the petition for writ of certiorari should be dismissed or, in the alternative, denied.

Respectfully submitted,

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