

No.

---

---

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

---

TRENDILY FURNITURE, LLC, ET AL., PETITIONERS

*v.*

JASON SCOTT COLLECTION, INC.

---

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

---

**PETITION FOR A WRIT OF CERTIORARI**

---

LEIGHTON M. ANDERSON  
BEWLEY, LASSLEBEN &  
MILLER, LLP  
13215 Penn Street, Ste. 510  
Whittier, CA 90602

DANIEL L. GEYSER  
*Counsel of Record*  
CHANCE FLETCHER  
HAYNES AND BOONE, LLP  
2323 Victory Avenue, Ste. 700  
Dallas, TX 75219  
(303) 382-6219  
*daniel.geyser@haynesboone.com*

---

---

## QUESTION PRESENTED

This case presents a clear, widespread, and entrenched conflict regarding an important statutory question under the Lanham Act, 15 U.S.C. 1051 *et seq.*

In order for trade dress to be protected under the Act, a party must show its dress has acquired “secondary meaning”—“in the minds of the public, the primary significance of a product feature or term is to identify the source of the product rather than the product itself.” *Inwood Labs., Inc. v. Ives Labs., Inc.*, 456 U.S. 844, 851 n.11 (1982). The courts of appeals are now sharply divided over the role of intentional copying in assessing secondary meaning: what, if any, probative value is associated with evidence that a competitor intentionally copied a plaintiff’s product design?

On one side of the split, three circuits hold that “[c]opying is only evidence of secondary meaning if the defendant’s intent in copying is to confuse consumers and pass off his product as the plaintiff’s.” According to these circuits, there are legitimate, pro-competitive reasons to copy a product that have nothing to do with confusing consumers or passing off a good. On another side of the split, the Ninth Circuit holds the opposite: in its view, because the only “logical” reason to copy is to abuse existing secondary meaning, mere copying alone “strongly supports” an inference of secondary meaning—without any “intent-to-confuse” requirement. Other circuits still have fractured in multiple directions, and this critical issue arises constantly in trade-dress litigation.

The question presented is:

Whether, and to what extent, a competitor’s intentional copying alone—without any intent to confuse consumers or pass off its products as plaintiff’s—establishes that plaintiff’s trade dress has secondary meaning.

## II

### **PARTIES TO THE PROCEEDING BELOW AND RULE 29.6 STATEMENT**

Petitioners are Trendily Furniture, LLC; Trendily Home Collection, LLC; and Rahul Malhotra, the appellants below and defendants in the district court. Trendily Furniture, LLC, and Trendily Home Collection, LLC, each have no parent corporation, and no publicly held company owns 10% or more of either entity's stock.

Respondent is Jason Scott Collection, Inc., the appellee below and plaintiff in the district court.

### **RELATED PROCEEDINGS**

United States District Court (D. Ariz.):

*Jason Scott Collection Inc. v. Trendily Furniture LLC, et al.*, No. 17-cv-2712-PHX-JJT (Mar. 9, 2021)  
(judgment)

*Jason Scott Collection Inc. v. Trendily Furniture LLC, et al.*, No. 17-cv-2712-PHX-JJT (Oct. 29, 2021)  
(order denying motion to alter or amend judgment)

United States Court of Appeals (9th Cir.):

*Jason Scott Collection, Inc. v. Trendily Furniture LLC, et al.*, No. 21-16978 (May 30, 2023)

### III

#### TABLE OF CONTENTS

	Page
Opinions below .....	1
Jurisdiction.....	1
Statutory provisions involved.....	2
Introduction.....	3
Statement .....	5
Reasons for granting the petition .....	9
A. There is a square and intolerable conflict over a significant statutory question under the Lanham Act .....	9
B. The question presented is exceptionally important and warrants review in this case.....	30
Conclusion .....	34
Appendix A — Court of appeals opinion (May 30, 2023) .....	1a
Appendix B — District court opinion (Mar. 9, 2021) .....	37a
Appendix C — District court order (Oct. 29, 2021).....	60a

#### TABLE OF AUTHORITIES

##### Cases:

<i>20th Century Wear, Inc. v. Sanmark-Stardust, Inc.</i> , 815 F.2d 8 (2d Cir. 1987).....	27
<i>Abercrombie &amp; Fitch Stores, Inc. v. American Eagle Outfitters, Inc.</i> , 280 F.3d 619 (6th Cir. 2002) .....	25, 26
<i>Aromatique, Inc. v. Gold Seal, Inc.</i> , 28 F.3d 863 (8th Cir. 1994).....	18, 19, 20
<i>Audio Fid., Inc. v. High Fid. Recordings, Inc.</i> , 283 F.2d 551 (9th Cir. 1960) .....	6, 7, 26
<i>Baig v. Coca-Cola Co.</i> , 607 F. App'x 557 (7th Cir. 2015) ...	12
<i>Beatriz Ball, LLC v. Barbagallo Co., LLC</i> , 40 F.4th 308 (5th Cir. 2022).....	24
<i>Bern Unlimited, Inc. v. Burton Corp.</i> , 95 F. Supp. 3d 184 (D. Mass. 2015) .....	14

IV

	Page
Cases—continued:	
<i>Board of Supervisors for La. State Univ. Agric. &amp; Mech. Coll. v. Smack Apparel Co.</i> , 550 F.3d 465 (5th Cir. 2008).....	23
<i>Bonito Boats, Inc. v. Thunder Craft Boats, Inc.</i> , 489 U.S. 141 (1989).....	11
<i>Bristol-Myers Squibb Co. v. McNeil-P.P.C., Inc.</i> , 973 F.2d 1033 (2d Cir. 1992).....	27
<i>Brooks Shoe Mfg. Co., Inc. v. Suave Shoe Corp.</i> , 716 F.2d 854 (11th Cir. 1983) .....	22, 23, 25
<i>Buzz Bee Toys, Inc. v. Swimways Corp.</i> , 20 F. Supp. 3d 483 (D.N.J. 2014) .....	21
<i>Camco Mfg., Inc. v. Jones Stephens Corp.</i> , 391 F. Supp. 3d 515 (M.D.N.C. 2019).....	29
<i>Campbell Sales Grp., Inc. v. Gramercy Park Design, LLC</i> , No. 10-55, 2010 WL 3945350 (M.D.N.C. Oct. 6, 2010) ...	29
<i>Centaur Commc’ns, Ltd. v. A/S/M Commc’ns, Inc.</i> , 830 F.2d 1217 (2d Cir. 1987).....	27
<i>Children’s Factory, Inc. v. Benee’s Toys, Inc.</i> , 160 F.3d 489 (8th Cir. 1998) .....	19
<i>Cold Heading Co. v. B&amp;D Thread Rolling, Inc.</i> , No. 11-15189, 2012 WL 13008688 (E.D. Mich. June 5, 2012) .....	31
<i>Continental Lab. Prods., Inc. v. Medax Int’l, Inc.</i> , 114 F. Supp. 2d 992 (S.D. Cal. 2000) .....	17
<i>Craft Smith, LLC v. EC Design, LLC</i> , 969 F.3d 1092 (10th Cir. 2020).....	14, 15, 18
<i>Dastar Corp. v. Twentieth Century Fox Film Corp.</i> , 539 U.S. 23 (2003).....	32
<i>DayCab Co., Inc. v. Prairie Tech., LLC</i> , 67 F.4th 837 (6th Cir. 2023).....	26
<i>Devan Designs, Inc. v. Palliser Furniture Corp.</i> , No. 91-512, 1992 WL 511694 (M.D.N.C. Sept. 15, 1992).....	29
<i>Duraco Prods., Inc. v. Joy Plastic Enters., Ltd.</i> , 40 F.3d 1431 (3d Cir. 1994).....	20, 21, 22, 23

	Page
Cases—continued:	
<i>Dwyer Instruments Inc. v. Sensicon Inc.</i> , No. 09-10, 2012 WL 3207254 (N.D. Ind. Mar. 23, 2012) .....	12
<i>Ferrari S.P.A. v. Roberts</i> , 944 F.2d 1235 (6th Cir. 1991) .....	27
<i>Gallagher v. Funeral Source One Supply &amp; Equip. Co., Inc.</i> , No. 14-115, 2015 WL 6738733 (D.N.H. Nov. 4, 2015) .....	14
<i>Groeneveld Transp. Efficiency, Inc. v. Lubecore Int'l, Inc.</i> , 730 F.3d 494 (6th Cir. 2013) .....	27
<i>Harlequin Enters. Ltd. v. Gulf &amp; W. Corp.</i> , 644 F.2d 946 (2d Cir. 1981) .....	27
<i>Herman Miller, Inc. v. Palazzetti Imps. &amp; Exps., Inc.</i> , 270 F.3d 298 (6th Cir. 2001) .....	27
<i>Hyde Park Storage Suites Daytona, LLC v. Crown Park Storage Suites, LLC</i> , 631 F. Supp. 3d 1203 (M.D. Fla. 2022) .....	23
<i>International Bancorp, LLC v. Societe des Bains de Mer et du Cercle des Etrangers a Monaco</i> , 329 F.3d 359 (4th Cir. 2003) .....	30
<i>Inwood Labs., Inc. v. Ives Labs., Inc.</i> , 456 U.S. 844 (1982) .....	I
<i>Jack Daniel's Props., Inc. v. VIP Prods., LLC</i> , 143 S. Ct. 1578 (2023) .....	3, 31
<i>Lanard Toys Ltd. v. Toys "R" Us-Del., Inc.</i> , No. 15-849, 2019 WL 1304290 (M.D. Fla. Mar. 21, 2019) .....	23
<i>Larsen v. Terk Techs. Corp.</i> , 151 F.3d 140 (4th Cir. 1998) .....	28
<i>LoggerHead Tools, LLC v. Sears Holding Corp.</i> , No. 12-9033, 2016 WL 5112020 (N.D. Ill. Sept. 20, 2016) .....	12
<i>M. Kramer Mfg. Co., Inc. v. Andrews</i> , 783 F.2d 421 (4th Cir. 1986) .....	28, 29
<i>MJM Prods. v. Kelley Prods., Inc.</i> , No. 03-390, 2003 WL 22205129 (D.N.H. Sept. 24, 2003) .....	14

VI

	Page
Cases—continued:	
<i>Mud Pie, LLC v. Belk, Inc.</i> , No. 18-607, 2019 WL 3268823 (W.D.N.C. July 18, 2019).....	28
<i>National Presto Indus., Inc. v. U.S. Merchs. Fin. Grp., Inc.</i> , No. 18-3321, 2022 WL 3536443 (D. Minn. Aug. 18, 2022).....	20
<i>Osem Food Indus. Ltd. v. Sherwood Foods, Inc.</i> , 917 F.2d 161 (4th Cir. 1990) .....	28
<i>P &amp; P Imports LLC v. Johnson Enters., LLC</i> , 46 F.4th 953 (9th Cir. 2022).....	15, 18
<i>Pebble Beach Co. v. Tour 18 I Ltd.</i> , 155 F.3d 526 (5th Cir. 1998).....	23, 25
<i>Pocket Plus, LLC v. Runner’s High, LLC</i> , No. 21-4, 2021 WL 5048197 (N.D. Iowa Oct. 12, 2021).....	20
<i>Predator Int’l, Inc. v. Gamo Outdoor USA, Inc.</i> , 863 F. Supp. 2d 1055 (D. Colo. 2012).....	17
<i>Reader’s Digest Ass’n, Inc. v. Conservative Digest, Inc.</i> , 821 F.2d 800 (D.C. Cir. 1987).....	25
<i>RJR Foods, Inc. v. White Rock Corp.</i> , 603 F.2d 1058 (2d Cir. 1979) .....	27
<i>Thomas &amp; Betts Corp. v. Panduit Corp.</i> , 65 F.3d 654 (7th Cir. 1995).....	10, 12, 17, 18, 20, 29
<i>Toyo Tire Corp. v. Atturo Tire Corp.</i> , No. 14-206, 2021 WL 463254 (N.D. Ill. Feb. 9, 2021).....	12
<i>TraFFix Devices, Inc. v. Marketing Displays, Inc.</i> , 532 U.S. 23 (2001).....	4, 16, 31
<i>Versa Prods. Co., Inc. v. Bifold Co. (Mfg.) Ltd.</i> , 50 F.3d 189 (3d Cir. 1995).....	22
<i>Wal-Mart Stores, Inc. v. Samara Bros., Inc.</i> , 529 U.S. 205 (2000).....	4, 13, 15, 16, 30, 32
<i>Yankee Candle Co., Inc. v. Bridgewater Candle Co., LLC</i> , 259 F.3d 25 (1st Cir. 2001).....	12, 13, 14, 18, 20

VII

Page

Statutes:

Lanham Act, 15 U.S.C. 1051 *et seq.*... I, III, 2-5, 9-11, 13, 15,  
17, 19, 20, 22, 24, 26, 30, 32  
15 U.S.C. 1125 (§ 43) ..... 2, 5  
15 U.S.C. 1125(a) (§ 43(a))..... 5  
15 U.S.C. 1127 (§ 45) ..... 2  
28 U.S.C. 1254(1) ..... 1

Miscellaneous:

J. Thomas McCarthy, *McCarthy on Trademarks and  
Unfair Competition* (5th Cir. 2023)  
Vol. 1, § 8:9 ..... 4  
Vol. 2, § 15:38 (5th ed. 2023) ..... 4, 9, 10, 17, 18, 28, 31, 32



In the Supreme Court of the United States

---

No.

TRENDILY FURNITURE, LLC, ET AL., PETITIONERS

*v.*

JASON SCOTT COLLECTION, INC.

---

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

---

**PETITION FOR A WRIT OF CERTIORARI**

---

Trendily Furniture, LLC, Trendily Home Collection, LLC, and Rahul Malhotra respectfully petition for a writ of certiorari to review the judgment of the United States Court of Appeals for the Ninth Circuit in this case.

**OPINIONS BELOW**

The opinion of the court of appeals (App., *infra*, 1a-36a) is reported at 68 F.4th 1203. The order and opinion of the district court (App., *infra*, 37a-59a) is unreported but available at 2021 WL 871666. And the post-judgment order of the district court (App., *infra*, 60a-64a) is unreported but available at 2021 WL 5040252.

**JURISDICTION**

The judgment of the court of appeals was entered on May 30, 2023. The jurisdiction of this Court is invoked under 28 U.S.C. 1254(1).

**STATUTORY PROVISIONS INVOLVED**

Section 43 of the Lanham Act, 15 U.S.C. 1125, provides in relevant part:

**False designations of origin, false descriptions, and dilution forbidden**

**(a) Civil action**

(1) Any person who, on or in connection with any goods or services, or any container for goods, uses in commerce any word, term, name, symbol, or device, or any combination thereof, or any false designation of origin, false or misleading description of fact, or false or misleading representation of fact, which—

(A) is likely to cause confusion, or to cause mistake, 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, or

(B) in commercial advertising or promotion, misrepresents the nature, characteristics, qualities, or geographic origin of his or her or another person's goods, services, or commercial activities,

shall be liable in a civil action by any person who believes that he or she is or is likely to be damaged by such act.

\* \* \* \* \*

Section 45 of the Lanham Act, 15 U.S.C. 1127, provides in relevant part:

**Construction and definitions; intent of chapter**

In the construction of this chapter, unless the contrary is plainly apparent from the context—

\* \* \* \* \*

The term “trademark” includes 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.

\* \* \* \* \*

## INTRODUCTION

This case presents a square and indisputable conflict over a significant question under the Lanham Act: whether a competitor’s intentional copying alone—without any intent to confuse consumers or pass off its goods as plaintiff’s—establishes that plaintiff’s trade dress has secondary meaning.<sup>1</sup>

In the decision below, the Ninth Circuit candidly admitted that “some circuits” have “imposed this ‘intent to confuse’ requirement when considering the intentional copying factor in the secondary meaning analysis.” But the Ninth Circuit reaffirmed it had rejected such a requirement, and “under our precedent,” intentional copy-

---

<sup>1</sup> Trade dress is “the overall appearance of a product and its packaging (a Hershey’s Kiss, in its silver wrapper).” *Jack Daniel’s Props., Inc. v. VIP Prods., LLC*, 143 S. Ct. 1578, 1583 (2023).

ing alone “supports a strong inference of secondary meaning.” That critical legal issue was squarely resolved below, and it was the driving force of the Ninth Circuit’s analysis. Remarkably, it reflects one of *five* separate approaches to the issue by eleven different circuits, and it arises constantly in trade-dress litigation nationwide.

This case easily satisfies the traditional criteria for granting review. The conflict is obvious, acknowledged, and entrenched. It has already been recognized by multiple courts and commentators. Experts have flatly rejected the Ninth Circuit’s logic as “flawed,” and emphasized the many “reasons for copying another’s trade dress which can negate any possible inference of secondary meaning.” 2 J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition* § 15:38 (5th ed. 2023) (*McCarthy*). The Ninth Circuit’s rationale further ignores this Court’s admonition that “product design almost invariably serves purposes other than source identification.” *Wal-Mart Stores, Inc. v. Samara Bros., Inc.*, 529 U.S. 205, 213 (2000). And the Ninth Circuit’s rule invites precisely the kind of “misuse or overextension of trade dress” that this Court has repeatedly “caution[ed] against.” *TrafFix Devices, Inc. v. Marketing Displays, Inc.*, 532 U.S. 23, 29 (2001). Yet at least three circuits have adopted the Ninth Circuit’s position, and one circuit (the Fourth) has taken it even further—declaring that intentional copying is “prima facie” evidence of secondary meaning. Despite being recognized as “especially unsound,” those circuit positions have now persisted for decades—as have the conflicting positions of multiple circuits. 1 *McCarthy, supra*, § 8:9; 2 *McCarthy, supra*, § 15:38.

The question presented raises legal and practical issues of surpassing importance, and its correct disposition is essential to the Lanham Act’s effective administration.

The existing confusion is intolerable: stakeholders on both sides cannot reliably predict whether trade dress will be protectable or not—or whether introducing a competing product will be considered legitimate competition or impermissible source confusion. It is well past time for a definitive, uniform answer to this core question involving a central element under the Act.

Because this case presents an optimal vehicle for resolving this important question of federal law, the petition should be granted.

### STATEMENT

1. This case involves a dispute between two “high-end furniture manufacturers” that operate in the same Texas market. App., *infra*, 2a. Respondent is run by a designer who started “creating hand-carved furniture out of reclaimed teak in a small village in Indonesia,” featuring “large, heavy-set pieces” “embellished with detailed wood carvings and metal designs.” *Id.* at 2a-3a.

According to respondent, petitioners were approached by a retailer to “manufacture” three pieces like respondent’s. App., *infra*, 3a. The retailer gave petitioners “printed photographs” of those pieces; petitioners sent those photographs to its factory in India; and that factory produced “a set of nearly identical imitations.” *Ibid.* Petitioners pitched and sold those imitations under its own trade name (the “M.J. Collection”), and marketed to respondent’s retailers and others (including those who fell outside respondent’s “exclusivity agreements”). *Ibid.*

2. After sending two cease-and-desist letters, respondent sued petitioners under Section 43(a) of the Lanham Act, 15 U.S.C. 1125(a), alleging petitioners “intentionally copied” three of its “unique furniture designs” and “sold them to Texas retailers.” App., *infra*, 2a, 5a. As relevant here, the district court “found a genuine issue of material

fact as to whether [respondent's pieces] had acquired secondary meaning"—“such that customers can identify the products' source by their look.” *Id.* at 5a, 39a (describing this as “an essential element of trade dress”). After holding a bench trial, the district court concluded respondent's products had “acquired secondary meaning.” *Id.* at 5a.<sup>2</sup>

a. As the district court explained, secondary meaning requires “a mental recognition in buyers' and potential buyers' minds that products connected with the [trade dress] are associated with the same source.” App., *infra*, 40a. While noting that secondary meaning “can be established in many ways,” the court ultimately focused predominantly on a single factor—petitioners' intentional copying. *Id.* at 41a-44a (treating this factor first and foremost in its own designated section).

As its core finding, the court concluded that respondent “has shown that [petitioners] intentionally copied the look of [respondent's] furniture pieces,” which is “substantial evidence of the secondary meaning of [respondent's] trade dress.” *Id.* at 41a. Under Ninth Circuit law, the court recounted, “[p]roof of copying strongly supports an inference of secondary meaning,” as “[t]here is no logical reason for the precise copying save an attempt to realize upon a secondary meaning that is in existence.” *Ibid.* (quoting *Audio Fid., Inc. v. High Fid. Recordings, Inc.*, 283 F.2d 551, 557-558 (9th Cir. 1960)). It thus made no difference that petitioners “testified it is common practice in the furniture industry to copy furniture designs.” *Id.* at 42a. According to the court, the only reason petitioners would copy respondent's designs was “to realize

---

<sup>2</sup> Respondent also sued petitioners for copyright infringement. Petitioners paid the judgment on the copyright claims and are contesting only the trademark claims in this Court. App., *infra*, 5a, 29a n.12.

upon a secondary meaning that is in existence.” *Id.* at 43a-44a.

The district court then looked together to “other factors” to “bolster[]” its “finding that [respondent’s] trade dress has the requisite secondary meaning such that [petitioners] intentionally capitalized on [respondent’s] goodwill by copying the precise look of [respondent’s] products.” App., *infra*, 44a. In the end, “[f]or all of these reasons,” the court concluded that respondent “demonstrated that its trade dress has acquired a secondary meaning such that it serves a source-identifying role.” *Id.* at 46a.

b. Petitioners filed a motion to alter or amend the judgment, which the court denied. App., *infra*, 60a-64a. The court then finalized the award of fees and costs, and petitioners appealed.

3. The Ninth Circuit affirmed. App., *infra*, 1a-36a.

Again as relevant here, the panel agreed with the district court that respondent’s trade dress had acquired secondary meaning. App., *infra*, 12a-20a; see also *id.* at 12a (noting the parties’ stipulation that respondent’s “trade dress is not inherently distinctive”). While the panel likewise noted that “[s]econdary meaning can be established in a variety of ways,” it too focused on intentional copying. *Ibid.*

As the panel explained, “we have recently reiterated” that “[p]roof of copying strongly supports an inference of secondary meaning.” App., *infra*, 12a. The court grounded its rationale in the belief that “[t]here is no logical reason for the precise copying save an attempt to realize upon a secondary meaning that is in existence.” *Id.* at 12a-13a (quoting *Audio Fid.*, *supra*). Because petitioners “admit[] that [they] intentionally copied” respondent’s works, and ordered their “factory in India to manufacture

exact copies \* \* \* based on photographs” to gain a retailer’s business, the court declared that petitioners must have been acting “to capitalize on [respondent’s] good will.” *Id.* at 13a.

The panel acknowledged petitioners’ argument that certain decisions suggest “‘intentional copying supports a finding of secondary meaning only where the defendant intended to confuse consumers and pass off its product as the plaintiffs,’ *an intention which was not present here.*” App., *infra*, 13a-14a (emphasis added). Petitioners are “correct,” the panel admitted, “that, in some circuits, courts have imposed this ‘intent to confuse’ requirement when considering the intentional copying factor in the secondary meaning analysis.” *Id.* at 14a & n.7 (detailing circuit conflict). In the end, however, the panel concluded that “[t]hough some circuits have adopted \* \* \* an intent to confuse requirement, we have not done so.” *Ibid.* Instead, “under our precedent,” the intentional copying alone “supports a strong inference of secondary meaning.” *Ibid.*

After finding that intentional copying supported secondary meaning, the panel finally observed that “[t]he district court properly considered several other factors in findings secondary meaning.” App., *infra*, 15a. “Taken together with [petitioners’] intentional, direct copying,” the panel concluded, “this evidence is sufficient to indicate that the district court correctly found that [respondent] established that its trade dress has secondary meaning.” *Id.* at 16a.



## REASONS FOR GRANTING THE PETITION

### A. There Is A Square And Intolerable Conflict Over A Significant Statutory Question Under The Lanham Act

The decision below further cements a deep and obvious conflict over a fundamental question under the Lanham Act: whether a competitor’s intentional copying alone—without any intent to confuse consumers or pass off its products as plaintiff’s—establishes that plaintiff’s trade dress has secondary meaning.

This question is a constant feature in trade-dress litigation nationwide. It targets the core element dictating whether trade dress is protected under the Lanham Act. And yet for decades, courts have been wildly fractured in every possible direction—with at least eleven circuits now breaking an astounding *five* different ways. The conflict has been repeatedly acknowledged by courts and commentators, including twice by the Ninth Circuit alone in the past 13 months. And while multiple courts recognize the indisputable division, not one has been willing to surrender—and the massive conflict would still persist even were any side to back down.

The stark division over this significant question is untenable. As it now stands, the Lanham Act’s critical scope rises or falls based on where an action is filed—leaving countless parties guessing whether basic competitive conduct is permitted or forbidden under federal law. Courts and experts have widely repudiated the Ninth Circuit’s “flawed” logic (*2 McCarthy, supra*, § 15:38), which assigns undue protection to everyday designs that properly belong in the public domain—and do nothing to advance the Lanham Act’s core objectives. A definitive answer is long overdue, and this Court alone can eliminate the rampant confusion.

The circuit conflict is undeniable and entrenched, and it should be resolved by this Court.

1. According to settled law in three circuits (the Seventh, First, and Tenth), copying alone is not evidence of secondary meaning; instead, the plaintiff must prove the copier “intended to confuse consumers and pass off its product as the plaintiff’s.” App., *infra*, 13a-14a & n.7; see also 2 *McCarthy*, *supra*, § 15:38 (for circuits on this side of the conflict, “the requisite intent is not just an intent to copy: proof of an intent to confuse is required”). As the panel conceded below, that position is directly at odds with Ninth Circuit authority: “[t]hough some circuits have adopted \* \* \* an intent to confuse requirement, we have not done so.” App., *infra*, 14a.

a. In *Thomas & Betts Corp. v. Panduit Corp.*, 65 F.3d 654 (7th Cir. 1995), the Seventh Circuit confronted the identical question presented here, and it adopted the opposite holding: “Copying is only evidence of secondary meaning if the defendant’s intent in copying is to confuse consumers and pass off his products as the plaintiff’s.” 65 F.3d at 663; *contra* App., *infra*, 14a (“under [Ninth Circuit] precedent,” mere copying itself is “strong” evidence “of secondary meaning”).

In *Thomas & Betts*, the Seventh Circuit faced trade-dress claims under Section 43(a) of the Lanham Act between “the nation’s largest suppliers of cable ties.” 65 F.3d at 655-656. Plaintiff alleged defendant copied its design for a “two-piece cable tie,” producing a product “essentially identical” to its own. *Id.* at 656. And plaintiff argued that “deliberate copying”—together with “advertising,” a “consumer survey,” and “the product’s ‘classic design’”—supported “a finding of secondary meaning.” *Id.* at 661. Although the lower court agreed the product had secondary meaning, the Seventh Circuit reversed, finding

plaintiff failed to show any “protectable trade dress” under “the proper standard.” *Id.* at 655, 661-662.

The Seventh Circuit initially described the Lanham Act’s critical balance between preserving “effective competition” and prohibiting undue deception. 65 F.3d at 658. On the one hand, competitors cannot “represent [themselves] as the plaintiff” in selling their goods—plaintiffs have “the right not to lose [their] customers through false representations that those are [their] wares which in fact are not.” *Ibid.* (quoting *Bonito Boats, Inc. v. Thunder Craft Boats, Inc.*, 489 U.S. 141, 157 (1989)). On the other hand, competitors must “be able to slavishly copy the design of a successful product”—plaintiffs cannot use trademark law to “monopolize any design or pattern, however trifling.” *Ibid.* The ultimate question, the court explained, is whether a product’s features act primarily “as an identifier of source” or instead “as an element which contributes to [a product’s] inherent appeal.” *Id.* at 658. According to the court, “[t]rade dress protection only extends to the role of such features as signifier of source; when competitors are barred from duplicating features whose value to consumers is intrinsic and not exclusively as a signifier of source, competition is unduly hindered.” *Id.* at 657.

In applying those principles, the Seventh Circuit held the lower court erred in ruling that “intentional[] cop[ying]” supported “a finding of secondary meaning.” 65 F.3d at 663. As the Seventh Circuit explained, copying “in itself is [not] a wrong,” and evidence of intentional copying “is often ambiguous,” especially “where the product itself is copied.” *Id.* at 660, 663. In that context, the court reasoned, “[t]he copier may very well be exploiting a particularly desirable feature, rather than seeking to confuse consumers as to the source.” *Id.* at 663. The court thus declared insufficient that defendant copied plaintiff’s product merely knowing it was “successful” and “seeking

a piece of the market for cable ties with particular features [that] customers desire.” *Ibid.* According to the court, without “evidence that [defendant] intended to pass off [its] product as [plaintiff’s],” the intentional copying was irrelevant: “copying” alone “does not support an inference that any of the copied features possessed secondary meaning.” *Ibid.*

This rule has been established law in the Seventh Circuit for nearly three decades: “[c]opying is only evidence of secondary meaning if the defendant’s intent in copying is to confuse consumers and pass off his product as the plaintiff’s.” *Baig v. Coca-Cola Co.*, 607 F. App’x 557, 561 (7th Cir. 2015) (quoting *Thomas & Betts*, 65 F.3d at 663). That rule is irreconcilable with the Ninth Circuit’s approach. Compare, *e.g.*, App., *infra*, 14a & n.7 (disavowing an “intent to confuse” requirement and noting past “re-affirm[ance] that deliberate copying is relevant” and “may suffice to support an inference of secondary meaning”).<sup>3</sup>

b. The First Circuit adopted the same position in *Yankee Candle Co., Inc. v. Bridgewater Candle Co., LLC*, 259 F.3d 25 (1st Cir. 2001). There, Yankee alleged that

---

<sup>3</sup> See also, *e.g.*, *Toyo Tire Corp. v. Atturo Tire Corp.*, No. 14-206, 2021 WL 463254, at \*9 (N.D. Ill. Feb. 9, 2021) (invoking *Thomas & Betts*, 65 F.3d at 663, and rejecting evidence of “intentional copying” because plaintiff failed to show “any intent by [defendant]” to “confuse consumers and pass off its product as [plaintiff’s]”); *LoggerHead Tools, LLC v. Sears Holding Corp.*, No. 12-9033, 2016 WL 5112020, at \*3 (N.D. Ill. Sept. 20, 2016) (rejecting “intentional copying” under *Thomas & Betts*, *supra*, because “Plaintiff has presented no facts showing Defendants intended to confuse consumers”); *Dwyer Instruments Inc. v. Sensocon Inc.*, No. 09-10, 2012 WL 3207254, at \*11 (N.D. Ind. Mar. 23, 2012) (recognizing “no dispute” that “Defendants copied the design of the Plaintiff’s Lens Mark to offer a product that would directly compete with the Plaintiff’s product,” but assigning “this factor no weight” under *Thomas & Betts*, *supra*).

Bridgewater infringed its trade dress for a scented-candle line, and brought claims under Section 43(a) of the Lanham Act. 259 F.3d at 37-38. The First Circuit held Yankee could not “survive summary judgment on the question of secondary meaning,” despite evidence that Bridgewater intentionally copied Yankee’s trade dress, including “testimony that Bridgewater designers were, at times, told to make the labels look more like Yankee’s.” *Id.* at 43, 44-45.

The First Circuit explained that trade dress is not protected without “acquir[ing] a ‘secondary meaning,’ where ‘the public views its ‘primary significance \* \* \* as identify[ing] the source of the product rather than the product itself.’” 259 F.3d at 38 (quoting *Wal-Mart*, 529 U.S. at 211). And the First Circuit found Yankee failed that standard, noting “the lack of evidence demonstrating a conscious connection by the public between the claimed trade dress and the product’s source.” *Id.* at 44.

While the court acknowledged “Yankee’s evidence of intentional copying,” it ultimately declared that evidence “not \* \* \* probative of secondary meaning.” 259 F.3d at 44-45. Like the Seventh Circuit, the court reasoned that defendants may “copy a product configuration” to “exploit[] a particularly desirable feature,” rather than “to confuse consumers as to the [product’s] source.” *Id.* at 45. And it found that concern “weigh[ed] heavily in this case,” “[g]iven the highly functional nature of certain elements of Yankee’s claimed combination trade dress.” *Ibid.* (noting trade-dress protection “could prevent healthy competition in the scented candle field”). The First Circuit ultimately adopted the same rule as the Seventh Circuit: “the relevant intent is not just the intent to copy, but to ‘pass off’ one’s goods as those of another.” *Ibid.*

Because Yankee could not muster that necessary showing, it could not establish secondary meaning. 259 F.3d at 45. Under the Ninth Circuit’s approach, the First

Circuit would have reached the opposite result. Compare, App., *infra*, 12a (“As we have recently reiterated, [p]roof of copying strongly supports an inference of secondary meaning.”), with, *e.g.*, *MJM Prods. v. Kelley Prods., Inc.*, No. 03-390, 2003 WL 22205129, at \*7 (D.N.H. Sept. 24, 2003) (“the [*Yankee Candle*] court expressly found that the plaintiff’s evidence of intentional copying was *not* probative of secondary meaning”) (emphasis in original).<sup>4</sup>

c. The Tenth Circuit likewise rejected the Ninth Circuit’s position in *Craft Smith, LLC v. EC Design, LLC*, 969 F.3d 1092 (10th Cir. 2020). Unlike the Ninth Circuit, the Tenth Circuit refused to find any probative value in mere copying: “when a competitor copies a product’s design, its purpose is not necessarily to confuse consumers, but to copy aspects of that product that make it more functional.” 969 F.3d at 1106. Indeed, far from establishing a “strong inference” of secondary meaning (App., *infra*, 14a), the Tenth Circuit determined mere copying did not even create a “jury question.” 969 F.3d at 1109-1110; see also *P & P Imports LLC v. Johnson Enters., LLC*, 46

---

<sup>4</sup> See also, *e.g.*, *Gallagher v. Funeral Source One Supply & Equip. Co., Inc.*, No. 14-115, 2015 WL 6738733, at \*8 n.14 (D.N.H. Nov. 4, 2015) (applying *Yankee Candle* to reject secondary meaning despite plaintiff’s contention that “Defendants elected to match Plaintiffs’ design down to the smallest detail” because plaintiff failed “to support his claim regarding defendants’ intent”—and “the relevant intent is not just the intent to copy, but to “pass off” one’s goods as those of another”); *Bern Unlimited, Inc. v. Burton Corp.*, 95 F. Supp. 3d 184, 210 (D. Mass. 2015) (finding no evidence of secondary meaning because “Bern has not produced evidence to support a theory that defendants copied its design to ‘pass off’ their goods as those of Bern’s”—“[i]f a competitor introduces a product with a feature that consumers find desirable, it is acceptable for companies to want to design a similar feature”; “[m]ere similarity of design is not improper”) (applying *Yankee Candle*, *supra*).

F.4th 953, 962 (9th Cir. 2022) (conceding direct conflict between Ninth Circuit precedent and, “*e.g.*, *Craft Smith*”).

In *Craft Smith*, the Tenth Circuit analyzed trade-dress claims under the Lanham Act involving popular spiral-bound personal organizers. 969 F.3d at 1096. Plaintiff alleged defendant “sought to emulate [plaintiff’s] planner with its own product,” specifically pitched creating a planner “like [plaintiff’s]” for Michaels (a prominent retailer), used plaintiff’s planner as a sample to obtain “pricing estimates from [a] manufacturer,” and in the end “intentionally cop[ied]’ it.” *Id.* at 1098 & n.4. The district court nonetheless found plaintiff “failed to create a genuine issue of material fact” over “secondary meaning,” and the Tenth Circuit agreed. *Id.* at 1096.

The Tenth Circuit described the “difficult[ies]” of establishing secondary meaning for “product-design trade dress.” 969 F.3d at 1106, 1111. To show secondary meaning, “the trade dress’s ‘*primary significance*’ in the minds of potential consumers is no longer as an indicator of something about the product itself but as an indicator of its source or brand.” *Id.* at 1107. Yet the “primary significance” of a product’s design is rarely its source: “[c]onsumers are aware of the reality that, almost invariably, even the most unusual of product designs \* \* \* is intended not to identify the source, but to render the product itself more useful or more appealing.” *Id.* at 1106 (quoting *Wal-Mart*, 529 U.S. at 213). Thus, to establish secondary meaning, even when a competitor copies a product exactly, the plaintiff must prove “the trade dress serves primarily as a source identifier,” rather than some function (like a design’s desirability) “other than source identification.” *Id.* at 1110-1111.

As the Tenth Circuit concluded, these principles undercut the probative value of mere copying. 969 F.3d at 1110. “[W]hen a competitor copies a design, it may have

done so for any number of reasons unrelated to deception—in fact, as recognized by the Supreme Court, most often designs are copied “to render the product itself more useful or more appealing.” *Ibid.* (quoting *Wal-Mart*, 529 U.S. at 213). “For example,” the court noted, “by choosing a similar calendar layout or size for [its] planner, [defendant] likely did so to take advantage of an already popular layout and size,” not to confuse consumers about “its source.” *Ibid.* And because plaintiff’s “evidence of intentional copying may be explained by ‘factors other than source identification,’” it failed “to create a genuine issue of material fact regarding \* \* \* secondary meaning.” *Ibid.*<sup>5</sup>

The Tenth Circuit “recognize[d]” its approach “may make it more difficult to obtain trade-dress protection for a product’s design.” 969 F.3d at 1113 n.27. But it found that “reflects the reality that trade-dress protection is an awkward fit for product design” in the first place. *Ibid.* (recognizing this Court’s own “caution[] against misuse or overextension of trade dress,” especially for “product-design trade dress”) (citing *TrafFix Devices, Inc. v. Marketing Displays, Inc.*, 532 U.S. 23, 29 (2001), and *Wal-Mart*, 529 U.S. at 213). Given that “product design almost invariably serves purposes other than source identification,” copying alone is unlikely to convey secondary meaning. *Id.* at 1110-1111, 1113 n.27.

The Tenth Circuit’s holding and rationale are impossible to square with the Ninth Circuit’s decision. Whereas

---

<sup>5</sup> The court adopted similar logic in discounting evidence of sales volume: “a product might enjoy high sales because the product itself is desirable—not because of any reason related to its source.” 969 F.3d at 1109. Accordingly, the court held, “circumstantial evidence that can easily be explained by ‘factors other than source identification’” is insufficient “to create a genuine issue of material fact on secondary meaning.” *Ibid.*



the Ninth Circuit understands mere copying alone as “strong” evidence of secondary meaning (App., *infra*, 14a), the Tenth Circuit refuses to assign the same evidence any probative weight (969 F.3d at 1110-1111). And whereas the Ninth Circuit insists “[t]here is no logical reason for the precise copying save an attempt to realize upon a secondary meaning” (App., *infra*, 13a), the Tenth Circuit presumes exactly the opposite—precise copying is explained by “any number of reasons unrelated to deception” or “source identification,” including “to render the product itself more useful or more appealing” (969 F.3d at 1110).

Had this action arisen in Colorado instead of Arizona, the courts below would have applied the opposite legal standard to the core evidence undergirding the central element of respondent’s Lanham Act claim—effectively gutting respondent’s primary theory for establishing secondary meaning. Respondent instead secured a “strong inference” of secondary meaning based on a factor deemed irrelevant under the settled law of three circuits. See, e.g., *Predator Int’l, Inc. v. Gamo Outdoor USA, Inc.*, 863 F. Supp. 2d 1055, 1061 (D. Colo. 2012) (“Even assuming intentional copying, there is little support for the proposition that copying alone, regardless of the reason for such copying, would be sufficient to establish secondary meaning.”); *Continental Lab. Prods., Inc. v. Medax Int’l, Inc.*, 114 F. Supp. 2d 992, 1010 (S.D. Cal. 2000) (“many courts have refused to infer secondary meaning from mere intentional copying”; “[i]nstead, intentional copying supports a finding of secondary meaning only where the defendant intended to confuse consumers and pass off its products as the plaintiff’s”) (citing, e.g., *Thomas & Betts, supra*); 2 *McCarthy, supra*, § 15:38 (outlining partial conflict).

The conflict between these two competing approaches is undeniable. App., *infra*, 14a & n.7 (admitting conflict with *Thomas & Betts* (Seventh Circuit) and *Yankee Candle* (First Circuit)); *P & P Imports*, 46 F.4th at 962 (admitting conflict with *Craft Smith* (Tenth Circuit)).

2. Adopting still another approach, three other circuits (the Eighth, Third, and Eleventh) hold that secondary meaning *may* be inferred from intentional copying, but *no* inference is permissible when there is a neutral explanation for the copying. See, e.g., *2 McCarthy*, *supra*, § 15:38 (“There may be several reasons for copying another’s trade dress which can negate any possible inference of secondary meaning.”). Unlike the holding below, when such a legitimate reason exists, the copying itself does not necessarily indicate the original product has secondary meaning. Contra App., *infra*, 14a & n.7 (recognizing “a variety of [neutral] reasons” for copying, but reaffirming that “under our precedent,” intentional copying “supports a strong inference of secondary meaning”).

a. In *Aromatique, Inc. v. Gold Seal, Inc.*, 28 F.3d 863 (8th Cir. 1994), the Eighth Circuit resolved trade-dress litigation involving “potpourri packaged in pillow-shaped double cellophane bags,” where the outcome again turned on secondary meaning. 28 F.3d at 870.

Like the Ninth Circuit, the Eighth Circuit found “[t]he existence of secondary meaning of a mark may be inferred from evidence of deliberate copying of that mark.” 28 F.3d at 871. But unlike the Ninth Circuit, the court also held that “a contrary inference may nevertheless be drawn once other evidence has been considered.” *Ibid.* As the court reasoned, “[w]here there is demand for a type of product, capitalizing on that demand by copying that product does not necessarily indicate that the original product has secondary meaning.” *Ibid.* And examining the

record, the court concluded “[t]he copying” at issue “cannot support an inference of secondary meaning,” despite harboring “no doubt that [defendant] deliberately copied [plaintiff’s] products.” *Ibid.*<sup>6</sup>

The Eighth Circuit reaffirmed its position in *Children’s Factory, Inc. v. Bensee’s Toys, Inc.*, 160 F.3d 489 (8th Cir. 1998), another trade-dress case under the Lanham Act. 160 F.3d at 491. The Eighth Circuit found plaintiff’s “line of soft-play products” lacked secondary meaning, despite allegations that defendant “blatantly copied” plaintiff’s toys, including the “admi[ssion]” of defendant’s own president that it “used pictures from [plaintiff’s] catalog to prepare [defendant’s] catalogs.” *Id.* at 491, 495.

Although the Eighth Circuit was “persuaded” that defendant’s products “were deliberate imitations,” it declared “this alone cannot prove secondary meaning.” 160 F.3d at 497. In so concluding, the Eighth Circuit recounted its holding in *Aromatique*: “although copying a trade dress can be evidence of secondary meaning, [w]here there is demand for a type of product, capitalizing on that demand by copying that product does not necessarily indicate that the original product has secondary meaning.” *Ibid.* (quoting *Aromatique*, 28 F.3d at 871); see also *Pocket Plus, LLC v. Runner’s High, LLC*, No. 21-4,

---

<sup>6</sup> The Eighth Circuit found that defendant’s “conspicuous” labeling of the copied products with its “own trademarks” rendered it “clearly erroneous to infer from [defendant’s] copying” that the trade dress “had acquired secondary meaning.” 28 F.3d at 871; contra, *e.g.*, App., *infra*, 3a-4a, 12a-14a (petitioners created a unique name (“the ‘M.J. Collection’”) for the challenged furniture and marketed it directly to retailers as their own pieces, not petitioner’s—yet the court still found copying supported “a strong inference of secondary meaning”). And the Eighth Circuit reached this conclusion over the dissent’s view that the “imitation of [plaintiff’s] trade dress” was both “studied and extensive.” *Id.* at 880 (Gibson, J., dissenting).

2021 WL 5048197, at \*5 (N.D. Iowa Oct. 12, 2021) (invoking *Aromatique*'s standard). Unlike the Ninth Circuit, the court thus rejected plaintiff's contention that "deliberate copying" was "evidence" of "secondary meaning." *Ibid.*; see also, e.g., *National Presto Indus., Inc. v. U.S. Merchs. Fin. Grp., Inc.*, No. 18-3321, 2022 WL 3536443, at \*24 (D. Minn. Aug. 18, 2022) (applying *Aromatique*, *Thomas & Betts*, and *Yankee Candle* to reject "a finding of secondary meaning" "even if there was deliberate copying").

b. The Third Circuit reached the same conclusion in *Duraco Prods., Inc. v. Joy Plastic Enters., Ltd.*, 40 F.3d 1431 (3d Cir. 1994): "attempts to copy a product configuration will quite often not be probative," as "the copier may very well be exploiting a particularly desirable feature, rather than seeking to confuse consumers as to the source of the product." 40 F.3d at 1453 (citing *Aromatique*, 28 F.3d at 871); but see App., *infra*, 12a-13a (declaring copying "strongly" probative as "[t]here is no logical reason for the precise copying save an attempt to realize upon a secondary meaning").

*Duraco* involved allegations mirroring those in this case: plaintiff, "a manufacturer of plastic planters for use in gardens," alleged defendant "infringed the trade dress of [plaintiff's] most popular product by marketing a planter with a similar shape and texture." 40 F.3d at 1433 (describing plaintiff's Section 43(a) Lanham Act claim). Because the Third Circuit found that "no factfinder could reasonably conclude that [plaintiff] has demonstrated a likelihood of success \* \* \* by establishing secondary meaning," it rejected plaintiff's request for an injunction. *Id.* at 1434 (disposing of appeal on this element alone).

In analyzing plaintiff's claim, the Third Circuit agreed that defendant's products "are strikingly similar in appearance" to plaintiff's, with differences generally perceptible "only in a sharply focused side-by-side comparison."

40 F.3d at 1435-1436. But the Third Circuit believed “[i]t is not *ipso facto* ‘unfair competition’ \* \* \* for one boldly to copy a competitor’s product; it is only ‘unfair competition’ to trade off another’s good will and in the process *dupe consumers into mistaking one’s products for another’s.*” *Id.* at 1448 (emphasis added). Because “the copier may very well be exploiting a particularly desirable feature, rather than seeking to confuse consumers,” the court asserted that copying “will quite often not be probative.” *Id.* at 1453. And the court found that true in that case: “the evidence indicates without contradiction that [defendant] emulated [plaintiff’s] design because [defendant] believed it to be a superior one,” not to pass off its product as plaintiff’s. *Ibid.*<sup>7</sup>

While the Ninth Circuit would have credited the copying as a “strong inference of secondary meaning” (App., *infra*, 14a), the Third Circuit found precisely the opposite—intentional copying is not automatically relevant, and where neutral explanations exist, it will “not be probative” at all. 40 F.3d at 1453; see also, *e.g.*, *Buzz Bee Toys, Inc. v. Swimways Corp.*, 20 F. Supp. 3d 483, 502 (D.N.J. 2014) (applying *Duraco*).<sup>8</sup>

---

<sup>7</sup> The Third Circuit also recounted related common-law principles, which “did not find any ‘unfairness’ \* \* \* in someone’s copying a design—even if it was originally produced through great expenditures of labor, effort, talent, and capital—if the design was unprotected by patent or copyright.” 40 F.3d at 1445. Rather, “[w]hat the courts of equity condemned was not bare-knuckled competition, but fraud and deceit, which are worked when one ‘palms off’ one’s goods as those of another.” *Ibid.*

<sup>8</sup> The Third Circuit reiterated the same principle in examining the likelihood of confusion, a separate element of a Section 43(a) claim: “the mere copying of product configurations does not suggest that the copier was necessarily trying to capitalize on the good will of the source of the original product.” *Versa Prods. Co., Inc. v. Bifold Co.*

c. The Eleventh Circuit likewise discounted the probative value of intentional copying in *Brooks Shoe Mfg. Co., Inc. v. Suave Shoe Corp.*, 716 F.2d 854 (11th Cir. 1983), a trade-dress case involving athletic shoes. At a bench trial, the district court rejected Brooks' Lanham Act claim on multiple grounds, including that Brooks failed to establish its designs had "secondary meaning." 716 F.2d at 856-857.

On appeal, the Eleventh Circuit addressed "whether proof of intentional copying, by itself, is an adequate substitute for proof of secondary meaning." 716 F.2d at 859. And the court answered no, rejecting Brooks' contention that secondary meaning "should [be] presumed" "simply because \* \* \* Suave had intentionally copied [Brooks'] designs and color schemes." *Id.* at 860.

As the Eleventh Circuit explained, "there is a difference between 'intentional copying' and adopting a mark or design 'with the intent of deriving benefit from' another person's mark." 716 F.2d at 860 n.13. While copying thus may be "probative evidence" of secondary meaning, "close copying does not *necessarily* indicate that the defendant has attempted to capitalize on the secondary meaning of plaintiff's trademark or trade dress because '[t]here may have been many other motivations for defendant's actions.'" 716 F.2d at 860. And looking to the record below, the court concluded Suave's intentional copying was not dispositive: "although the district court found that Suave had intentionally copied Brooks' design, the court also found that Suave had not engaged in palming off or actual deception"—and "[i]t must \* \* \* not be forgotten that

---

*(Mfg.) Ltd.*, 50 F.3d 189, 201 (3d Cir. 1995) (citing *Duraco*, 40 F.3d at 1453).

there is absolutely nothing legally or morally reprehensible about exact copying of things in the public domain.” *Id.* at 859-860.<sup>9</sup>

Accordingly, in Florida, unlike California, “attempts to copy a product configuration will quite often not be probative: the copier may very well be exploiting a particularly desirable feature, rather than seeking to confuse consumers as to the source of the product.” *Lanard Toys Ltd. v. Toys “R” Us-Del., Inc.*, No. 15-849, 2019 WL 1304290, at \*26 (M.D. Fla. Mar. 21, 2019) (quoting *Duraco*, 40 F.3d at 1453). Contrary to the Ninth Circuit’s view, “close copying does not *necessarily* indicate that the defendant has attempted to capitalize on \* \* \* secondary meaning.” *Ibid.* (quoting *Brooks*, 716 F.2d at 860); see also *Hyde Park Storage Suites Daytona, LLC v. Crown Park Storage Suites, LLC*, 631 F. Supp. 3d 1203, 1215 (M.D. Fla. 2022) (construing *Brooks*’s holding as “proof of intentional copying *with intent to confuse* is probative evidence of secondary meaning”).

3. For its part, the Fifth Circuit has staked out a position closer to the Ninth Circuit’s, but still departs from Ninth Circuit law in a critical way: while the Fifth Circuit agrees that intentional copying is evidence of secondary meaning, it simply treats that evidence on par with all other factors. See, e.g., *Board of Supervisors for La. State Univ. Agric. & Mech. Coll. v. Smack Apparel Co.*, 550 F.3d 465, 476-477 (5th Cir. 2008); *Pebble Beach Co. v. Tour 18 I Ltd.*, 155 F.3d 526, 541 (5th Cir. 1998). Contrary to the decision below (App., *infra*, 12a-14a), the Fifth Circuit

---

<sup>9</sup> The Eleventh Circuit explained that “[p]alming off is an attempt by one person to induce consumers to believe that his product is actually that of another; it requires an intent to deceive and proof of actual fraud.” 716 F.2d at 859 n.11.

does not credit a “strong” inference from mere copying alone.

In *Beatriz Ball, LLC v. Barbagallo Co., LLC*, 40 F.4th 308 (5th Cir. 2022), for example, the Fifth Circuit vacated the lower court’s finding that plaintiff, “a maker of popular tableware designs,” “failed to establish a protectible trade dress under the Lanham Act.” 40 F.4th at 312. The Fifth Circuit acknowledged plaintiff’s allegation that defendant’s products “look strikingly similar” to plaintiff’s and “copy the “look and feel” of [plaintiff’s] trade dress in every attribute.” *Id.* at 314.

But rather than automatically assign a “strong inference” of secondary meaning (compare App., *infra*, 14a), the Fifth Circuit instead treated defendant’s copying as merely one factor in a multifactor analysis. See 40 F.4th at 317. It explained that because secondary meaning is primarily “a mental association in buyers’ minds between the alleged mark and a [product’s] source,” the secondary-meaning determination “is primarily an empirical inquiry.” *Ibid.* In reviewing that factual assessment for clear error, the Fifth Circuit found the district court failed to properly assess multiple factors, including the role of intentional copying. *Ibid.*

The Fifth Circuit noted that “a visual comparison” of the products “makes it difficult to deny that there was an intent to copy.” 40 F.4th at 320. And the Fifth Circuit held such copying had probative value: “When two product designs are so very similar, an inference of intent is permissible.” *Ibid.* And while the court did not automatically credit a “strong” inference (unlike the Ninth Circuit), it did flag the possibility of assigning additional weight: “Moreover, evidence of deliberate copying can be a weighty factor *if it appears the copying attempted to benefit from the perceived secondary meaning.*” *Ibid.* (emphasis added).



Accordingly, like the Ninth Circuit, the Fifth Circuit does assign mere copying probative value, but it does not recognize a “strong” inference absent separate evidence “that a defendant intends to “pass off” its product as that of another.” 40 F.4th at 319. Because such intent was absent here, the Fifth Circuit would not have accepted the Ninth Circuit’s analysis. See, *e.g.*, *Smack Apparel*, 550 F.3d at 477 (treating “intentional” copying as merely one factor in the analysis); *Pebble Beach*, 155 F.3d at 541 (“While each of these types of evidence alone may not prove secondary meaning, in combination they may indicate that consumers consider the mark or trade dress to be an indicator of source.”).<sup>10</sup>

4. While the decision below directly conflicts with settled law in multiple circuits, two circuits (the Sixth and Second) reject the contrary standards above and align with the Ninth Circuit’s approach.

a. In *Abercrombie & Fitch Stores, Inc. v. American Eagle Outfitters, Inc.*, 280 F.3d 619 (6th Cir. 2002), the Sixth Circuit adopted the same rule and rationale as the Ninth Circuit: “This court has long held that ‘evidence of intentional copying shows the strong secondary meaning of [a product] because “[t]here is no logical reason for the precise copying save an attempt to realize upon a second-

---

<sup>10</sup> In a brief encounter with this issue, the D.C. Circuit adopted a position similar to the Fifth Circuit’s. See *Reader’s Digest Ass’n, Inc. v. Conservative Digest, Inc.*, 821 F.2d 800, 804-805 (D.C. Cir. 1987) (recapping “the settled rule that proof of intentional copying is probative of secondary meaning,” acknowledging “[t]he striking similarity between the trade dress \* \* \* is itself probative of intentional copying,” and concluding that plaintiff’s full body of evidence, “in combination with the evidence concerning intentional copying, was more than sufficient to allow the court” to find “secondary meaning”).

ary meaning that is in existence.”” 280 F.3d at 639 (embracing the Ninth Circuit’s decision in *Audio Fidelity, supra*).

In *Abercrombie*, plaintiff claimed defendant violated Section 43(a) of the Lanham Act by “impermissibly cop[ying] the designs of certain articles of clothing, in-store advertising displays, and a catalog.” 280 F.3d at 624. Although defendant contested liability, it “declined to contest the allegation that it intentionally copied the various aspects of [plaintiff’s] claimed trade dress.” *Id.* at 626.

The Sixth Circuit ultimately found that concession dispositive. According to the court, defendant’s “limited admission of intentional copying constitutes evidence that [plaintiff’s] dress has acquired strong secondary meaning.” 280 F.3d at 639. Unlike the standard applied in multiple circuits, it made no difference that defendant did not concede it “intended to confuse consumers [or] pass off its product as the plaintiff’s” (App., *infra*, 13a-14a), but admitted to mere copying alone. The “long held” rule in the Sixth Circuit was that “intentional copying” itself showed “strong secondary meaning,” and defendant’s “limited admission” thus left “the existence of secondary meaning” as “an established fact.” 280 F.3d at 639-640.

That holding has been settled law in the Sixth Circuit for decades. See, e.g., *DayCab Co., Inc. v. Prairie Tech., LLC*, 67 F.4th 837, 850 (6th Cir. 2023) (“evidence of intentional copying shows the strong secondary meaning of [a product] because “[t]here is no logical reason for the precise copying save an attempt to realize upon a secondary meaning that is in existence””); *Herman Miller, Inc. v. Palazzetti Imps. & Exps., Inc.*, 270 F.3d 298, 314 (6th Cir.

2001) (same); *Ferrari S.P.A. v. Roberts*, 944 F.2d 1235, 1239 (6th Cir. 1991) (same).<sup>11</sup>

b. The Second Circuit has likewise applied similar principles. It has declared intentional copying “persuasive, if not conclusive, evidence of consumer recognition and good will,” *20th Century Wear, Inc. v. Sanmark-Stardust, Inc.*, 815 F.2d 8, 10 (2d Cir. 1987), and “[t]he most persuasive” factor in a secondary-meaning analysis, *Centaur Commc’ns, Ltd. v. A/S/M Commc’ns, Inc.*, 830 F.2d 1217, 1224 (2d Cir. 1987). See also, e.g., *Harlequin Enters. Ltd. v. Gulf & W. Corp.*, 644 F.2d 946, 949-950 (2d Cir. 1981); *RJR Foods, Inc. v. White Rock Corp.*, 603 F.2d 1058, 1060 (2d Cir. 1979).

To be sure, the Second Circuit has occasionally backed away from this standard (and the Ninth Circuit), suggesting that “imitative intent can help support a finding of secondary meaning,” but “it does not necessarily mandate one.” *Bristol-Myers Squibb Co. v. McNeil-P.P.C., Inc.*, 973 F.2d 1033, 1042 (2d Cir. 1992) (“we believe that, even assuming [defendant’s] imitative intent, the district court was not bound to find that the ‘PM’ designator had acquired secondary meaning”); contra, e.g., 12a (“[p]roof of copying *strongly* supports an inference of secondary

---

<sup>11</sup> The decision below grouped the Sixth Circuit together with the Seventh and First Circuits in adopting an “intent to confuse” requirement. App., *infra*, 14a n.7 (citing *Groeneveld Transp. Efficiency, Inc. v. Lubecore Int’l, Inc.*, 730 F.3d 494, 514 (6th Cir. 2013)). While the Seventh and First Circuits do indeed fall in that camp, the Sixth Circuit does not; the Ninth Circuit mistakenly referenced *Groeneveld*’s discussion of the *likelihood-of-confusion* element. See *Groeneveld*, 730 F.3d at 514 (contrasting the rules for “proving secondary meaning” and establishing “likelihood-of-confusion”). While the Ninth Circuit’s position *is* consistent with the Sixth’s, both directly conflict with established law in the First, Third, Fifth, Seventh, Eighth, Tenth, and Eleventh Circuits.

meaning””) (emphasis added). Either way, the Second Circuit departs from settled law in multiple circuits, including those imposing an “intent to confuse” requirement. See 2 *McCarthy*, *supra*, § 15:38.

5. As an astounding *fifth* approach, the Fourth Circuit has also confronted this issue—and long repudiated the views of *all* circuits in treating intentional copying as “a prima facie case of secondary meaning.” *M. Kramer Mfg. Co., Inc. v. Andrews*, 783 F.2d 421, 448 (4th Cir. 1986); 2 *McCarthy*, *supra*, § 15:38 (“only the Fourth Circuit applies such a presumption of secondary meaning”). As the decision below recognized, the Fourth Circuit’s position has been disavowed by other circuits: “the Fourth Circuit has gone so far as to hold that copying creates a rebuttable presumption of secondary meaning, but our circuit has rejected that approach.” App., *infra*, 14a n.7 (citation omitted).

According to the Fourth Circuit, intentional copying, without more, triggers “a prima facie case of secondary meaning sufficient to shift the burden of persuasion to the defendant on that issue.” *M. Kramer*, 783 F.2d at 448; *Mud Pie, LLC v. Belk, Inc.*, No. 18-607, 2019 WL 3268823, at \*3-\*4 (W.D.N.C. July 18, 2019) (applying *Kramer*). “In fact,” the Fourth Circuit confirmed, “such evidence not only shifts the burden of persuasion, but acts as a presumption upon which judgment ‘must issue’ in the absence of rebutting proof.” *Larsen v. Terk Techs. Corp.*, 151 F.3d 140, 148 (4th Cir. 1998); see also *Osem Food Indus. Ltd. v. Sherwood Foods, Inc.*, 917 F.2d 161, 164 n.5 (4th Cir. 1990) (given the “presumption of secondary meaning,” “we need not address Osem’s second argument that even without the presumption, it put on enough evidence to show that its trade dress had a secondary meaning”).

While the Fourth Circuit’s “presumption-of-secondary-meaning” rule expands the Ninth Circuit’s “strong-inference” standard, both approaches are rooted in a common rationale: just as the Ninth Circuit presumes there is no “logical reason” for copying “save an attempt to realize upon a secondary meaning” (App., *infra*, 13a), the Fourth Circuit presumes a copier’s “intent must be to benefit from the goodwill of the competitor’s customers by getting them to believe that the new product is either the same, or originates from the same source.” *Osem*, 917 F.2d at 165; see also *M. Kramer*, 783 F.2d at 449. That rationale cannot be squared with the conflicting logic behind other circuits’ “intent-to-confuse” standard: “[t]he copier may very well be exploiting a particularly desirable feature, rather than seeking to confuse consumers as to the source.” *Thomas & Betts*, 65 F.3d at 663.

Bound by circuit precedent, regional district courts have reluctantly applied the Fourth Circuit’s standard—while flagging the circuit conflict. See, e.g., *Camco Mfg., Inc. v. Jones Stephens Corp.*, 391 F. Supp. 3d 515, 523 n.2 (M.D.N.C. 2019) (“The Fourth Circuit is in the minority of circuits to apply such a presumption and ‘may in fact be the only circuit’ that currently does so.”); *Campbell Sales Grp., Inc. v. Gramercy Park Design, LLC*, No. 10-55, 2010 WL 3945350, at \*5 (M.D.N.C. Oct. 6, 2010) (casting doubt on the Fourth Circuit’s rationale: “there may be an even more likely reason why one might copy another’s trade dress[,] such as to capitalize on a particularly attractive or saleable product design”); *Devan Designs, Inc. v. Palliser Furniture Corp.*, No. 91-512, 1992 WL 511694, at \*11 (M.D.N.C. Sept. 15, 1992) (“[w]here product has ‘some intrinsic consumer-desirability’ junior user as likely to capitalize on that as to appropriate secondary meaning”; “[t]he presumption is also circular”).

While the Fourth Circuit refuses to reconsider its position, it recognizes its views “ha[ve] been rejected by other circuits” (*International Bancorp, LLC v. Societe des Bains de Mer et du Cercle des Etrangers a Monaco*, 329 F.3d 359, 371 (4th Cir. 2003))—just as the Ninth Circuit recognized below (App., *infra*, 14a).

\* \* \*

The conflict over this critical statutory question is mature, obvious, and entrenched. It has been widely acknowledged by courts and expert commentators nationwide. The Ninth Circuit confronted the undeniable split, but refused to reconsider its position. The debate has been fully exhausted at the circuit level, with different factions confronting, and rejecting, the opposing analysis. Further percolation is pointless: virtually every circuit has weighed in; the courts are intractably divided at least five different ways; yet only a single approach is correct while the others are inevitably wrong. The profound disconnect only underscores the unsettling confusion this issue has produced, and the obvious need for this Court’s guidance.

Until this Court intervenes, trade-dress protection will vary by circuit—a particularly untenable result in a national economy with multiple stakeholders operating across state lines. Immediate review is warranted.

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

1. The question presented is of obvious legal and practical importance. The need for further review is palpable. The case presents a deep, entrenched conflict over a core question under the Lanham Act. It has profound stakes for trade-dress litigants: trade dress is not subject to protection under the Act without establishing secondary meaning (*Wal-Mart*, 529 U.S. at 216), and a finding of secondary meaning effectively removes the dress from the

public domain—prohibiting a competitor’s use of a product design that might present any number of pro-competitive benefits (*TrafFix*, 532 U.S. at 29).

There is no genuine dispute that the issue arises constantly in courts nationwide, and the sheer number of reported decisions confirms the issue’s significance. Intentional copying is ubiquitous in *all* substantial trade-dress litigation. (If there was no copying, there would be no plausible infringement.) It is thus little surprise that hundreds of courts have grappled with this question—marking the rare legal issue generating precedential authority in every regional circuit. Experts are tracking the question—and devoting extensive analysis to its proper disposition—for obvious reasons. *E.g.*, *Cold Heading Co. v. B&D Thread Rolling, Inc.*, No. 11-15189, 2012 WL 13008688, at \*7 n.5 (E.D. Mich. June 5, 2012) (“[a] number of courts and commentators have questioned the relevance at all of actual copying evidence to secondary meaning”); 2 *McCarthy*, *supra*, § 15:38.

The practical implications for real-world litigation are also enormous. If intentional copying alone is “strong” or “presumptive” evidence of secondary meaning, it is the rare case that can be disposed at summary judgment. This unduly strains the resources of courts and litigants alike, who are forced to entertain trials over weak trade dress that no consumer realistically uses to identify a product’s source. The coercive settlement pressure from such a regime rewards those seeking to avoid legitimate competition and hurts the very market and consumers the Lanham Act was designed to protect. *Jack Daniel’s*, 143 S. Ct. at 1584.<sup>12</sup>

---

<sup>12</sup> Nor does curtailing secondary meaning impair a company’s genuine trade dress or inventiveness. *E.g.*, *Dastar Corp. v. Twentieth*

This is the unusual case with a recognized conflict splintering every regional circuit in multiple directions. The amount of time and resources devoted to litigating these issues—let alone for stakeholders to plan their business decisions against the resulting legal patchwork of varying standards—is staggering. The Lanham Act’s proper administration requires a uniform national rule that designates the same dress as protected (or not) in every jurisdiction. This Court alone can resolve the protracted division, and its guidance is urgently needed.

2. This case is an ideal vehicle for deciding this important question. The dispute turns on a pure question of law: the proper legal standard for evaluating intentional copying and secondary meaning. The question presented was squarely raised and resolved below. The district court’s express finding of secondary meaning was based on intentional copying alone. App., *infra*, 44a (linking “[t]he Court’s finding” to petitioners’ “copying”). It merely “bolstered” that finding with other evidence. *Ibid*. The Ninth Circuit likewise affirmed on the basis of intentional copying (*id.* at 14a); while it later acknowledged the “other factors” (*id.* at 15a), it still coupled those factors with intentional copying—saying the *combined* effect was sufficient to support secondary meaning. *Id.* at 16a

---

*Century Fox Film Corp.*, 539 U.S. 23, 34 (2003). Copyrights and patents provide ample protection for intellectual property that Congress truly wishes to shield from competition. *Wal-Mart*, 529 U.S. at 214. And a product with true secondary meaning—one that indeed primarily serves a source-identifying function—can be established through a host of alternative means. There is no reason to rely on dubious inferences from mere copying as a shortcut—especially when copying is so often a product of innocent (and pro-competitive) explanations. 2 *McCarthy*, *supra*, § 15:38 (so establishing).



("[t]aken together with Trendily's intentional, direct copying"). The Ninth Circuit's analysis necessarily fails if that driving factor is removed from the combination.<sup>13</sup>

The core analysis below thus cannot stand unless the Ninth Circuit's position is correct (and copying alone is "strong" evidence of secondary meaning) or the Fourth Circuit's position is correct (and copying alone is "presumptive" evidence of secondary meaning). Under the contrary approach of every other circuit, the decision below is wrong, and the Ninth Circuit affirmed based on an incorrect legal standard.

Nor are there any factual or procedural obstacles to resolving the question presented. There was no dispute over functionality; there was no dispute over inherent distinctiveness; there was no dispute that petitioners "intentionally copied"; there was no dispute secondary meaning was necessary; the court confirmed there was no intent to "confuse consumers" (such intent "was not present"); and there was no alternative ground for affirmance. App., *infra*, 11a-14a.

The only question is the proper role of intentional copying in the legal analysis. The Ninth Circuit's decision turned on the improper legal standard, and it affirmed a district-court decision that was driven by the same improper legal standard. If the Court grants and reverses, it can always remand for the district court to apply the correct legal standard in the first instance. The question presented is thus squarely teed up and ripe for disposition.

---

<sup>13</sup> Indeed, each court addressed intentional copying in its own section, and each featured intentional copying as the centerpiece of its secondary-meaning analysis. App., *infra*, 12a-15a, 41a-44a.

**CONCLUSION**

The petition for a writ of certiorari should be granted.

Respectfully submitted.

LEIGHTON M. ANDERSON  
BEWLEY, LASSLEBEN &  
MILLER, LLP  
13215 Penn Street, Ste. 510  
Whittier, CA 90602

DANIEL L. GEYSER  
*Counsel of Record*  
CHANCE FLETCHER  
HAYNES AND BOONE, LLP  
2323 Victory Avenue, Ste. 700  
Dallas, TX 75219  
(303) 382-6219  
*daniel.geyser@haynesboone.com*

AUGUST 2023