

No. 24-1016

In the
Supreme Court of the United States

RISEANDSHINE CORPORATION, DBA RISE BREWING,

Petitioner,

v.

PEPSICO, INC.,

Respondent.

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

BRIEF IN OPPOSITION

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QUESTION PRESENTED

Whether this Court should review an unpublished summary order holding that there is no likelihood of confusion between petitioner's and respondent's trademarks, based on a question presented that implicates no circuit split warranting intervention, the merits of which petitioner did not raise below and no lower court addressed, and resolution of which in petitioner's favor would not change the case's outcome.

CORPORATE DISCLOSURE STATEMENT

Respondent PepsiCo, Inc. has no parent corporation, and no publicly held company owns more than 10% of its stock.

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INTRODUCTION

This case is a run-of-the-mill trademark dispute in which petitioner RiseandShine Corporation (“RBC”), having twice unanimously lost before the Second Circuit—most recently in an unpublished summary order—asks this Court to address an issue that implicates no circuit split, was not raised or addressed below, would not make a difference to the outcome, and lacks sufficient importance to warrant this Court’s intervention. Certiorari should be denied.

In 2015, RBC, a newly-formed startup, set out to develop a nitrogen-infused cold brew coffee. But when it tried to register the trademark RISE COFFEE CO. with the U.S. Patent & Trademark Office (“PTO”), the PTO rejected its application because of the many other products using the word “rise,” thus creating a likelihood of confusion. RBC responded that because “many entities” use the word “rise,” the word is “extremely weak,” defeating likelihood of confusion. The PTO nevertheless reaffirmed its refusal, and RBC instead registered another “rise”-based mark, RISE BREWING CO. Several years later, when a competitor demanded that RBC cease using marks similar to its own using the word “rise,” RBC likewise responded that the word “rise” is “so commonly used” that marks using that word are “relatively weak.”

Shortly thereafter, however, RBC did an about-face. In 2021, it filed this Lanham Act trademark infringement suit against respondent PepsiCo, Inc. (“PepsiCo”), which had recently launched an energy drink called Mountain Dew Rise Energy using the trademark MTN DEW RISE ENERGY. Contrary to its prior representations, RBC contended that the

word “rise” renders its trademark strong and PepsiCo’s use of “rise” creates a likelihood of confusion between PepsiCo’s trademarks for its energy drink and RBC’s trademarks for its coffee product.

RBC obtained a preliminary injunction enjoining use of PepsiCo’s mark. But the Second Circuit unanimously vacated the injunction, pointing to RBC’s prior representations regarding the weakness of the word “rise,” the nearly 100 products on the market using the term “rise,” the many associations between the word “rise” and coffee, and the numerous dissimilarities between RBC’s and PepsiCo’s marks. On remand, the district court granted summary judgment to PepsiCo, and the Second Circuit affirmed in an unpublished, unsigned summary order.

That order does not merit this Court’s intervention. First, RBC contends that review is necessary to resolve a circuit split over whether “trademark strength” is a question of fact or question of law. But trademark strength consists of two subcomponents—acquired strength and conceptual strength—and there is no circuit split on acquired strength, which all courts treat as factual. RBC appears to contend that the Second Circuit alone treats conceptual strength as a question of law, but that argument assumes that the conceptual strength inquiry consists only of determining a mark’s level of distinctiveness, *i.e.*, its “classification” on a spectrum from generic to arbitrary. In the Second Circuit, though, as in other circuits, a mark’s level of distinctiveness is only the starting point for determining conceptual strength. The additional analysis that courts like the Second Circuit further

undertake—which RBC does not challenge—implicates legal elements such as the meaning of the word at issue, and RBC identifies no circuit that treats that further inquiry as a question of fact. Nor would any marginal differences warrant intervention, for courts routinely grant summary judgment on the conceptual strength subcomponent, as well as on overall likelihood of confusion based on other factors in each circuit’s respective multifactor test.

Second, this case is an exceptionally poor vehicle to address the question presented. A ruling for RBC would not change this case’s outcome given the reasoning below, unchallenged Second Circuit precedent, and the record. RBC also never raised below—and no decision below addressed—the merits arguments it now presses, including that *United States PTO v. Booking.com B.V.*, 591 U.S. 549 (2020), and *Hana Financial, Inc. v. Hana Bank*, 574 U.S. 418 (2015), require treating trademark strength as a factual question. And this Court would have to address significant threshold questions, including the role of trademark strength and its subcomponents in the likelihood-of-confusion inquiry, and how to evaluate trademark strength when a plaintiff alleges “reverse confusion,” as here.

Third, the question presented is not of sufficient importance to warrant review. RBC cites no cases turning on this issue, and its invocation of forum-shopping and jury-right concerns is unavailing. Finally, neither *Booking.com* nor *Hana Financial* addresses this issue or demonstrates that the decision below is incorrect. The petition should be denied.

STATEMENT OF THE CASE

A. Factual Background

1. RBC was founded in 2015 by three prep-school classmates and their friend, whose goal was to “find something ... that would have [them] retired by forty.” C.A.App.535, 537-38, 997. RBC’s founders decided to capitalize on the then-hot trend of nitrogen-infused cold brew coffee. C.A.App.997-98.

The founders initially chose RISE COFFEE CO. for the company’s trademark. C.A.App.898. They explained that the name “rise” “symbolizes the start of a new day and getting up and on the go” and that “[t]here’s something energetic” about it. C.A.App.977. In choosing the RISE COFFEE CO. trademark, RBC joined at least 22 other companies already using the word “rise” in their products’ names, including RISE for coffee, RISE for beer, RISE UP for coffee, and RISE UP COFFEE ROASTERS, as the following marks show:





C.A.App.404-10, 491-98.

RBC attempted to register RISE COFFEE CO. with the PTO. C.A.App.916. The PTO rejected RBC's application, citing a "likelihood of confusion with prior registrations" for trademarks also using the word "rise," namely RISE UP, RISE UP COFFEE ROASTERS, and RISE UP ORGANIC COFFEE. C.A.App.436-37. RBC urged the PTO to reconsider, arguing: "[M]any entities have used the word 'Rise' in relation to [RBC's] goods, making it unlikely that consumers would give significant weight to this term in ascertaining the source of such goods." C.A.App.438. Accordingly, RBC continued, the "term 'Rise' is *extremely weak* and diluted, such that it creates little source identifying significance that could contribute to any likelihood of confusion." C.A.App.439 (emphasis added).

The PTO reaffirmed its refusal. C.A.App.214. RBC changed its mark to RISE BREWING CO. and reapplied. The PTO registered RISE BREWING CO., indicating that it found the word "brewing" (not "rise") sufficient to differentiate RBC's new mark. C.A.App.260, 267.

In 2016, RBC launched its coffee product, which it sells in 7-ounce cans:



C.A.App.97.

In 2018, RBC received a cease-and-desist letter from a company identifying similarities in the parties’ logos (which both contained “rise”) and noting that the company had used its logo for “coffee[] since 2012.” C.A.App.983. RBC responded that “RISE is so commonly used” that trademarks using the word “rise” are “*relatively weak* and afforded only a narrow scope of protection.” C.A.App.988-92 (emphasis added).

2. In 2020, PepsiCo began developing an energy drink. PepsiCo created an innovative, caffeinated, fruit-flavored energy drink featuring ingredients like zinc, antioxidants, and vitamins. C.A.App.302. PepsiCo extended the iconic MTN DEW brand and chose the name MTN DEW RISE ENERGY (here, MDRE) because it evoked “morning energy and new beginnings” and the concept of “‘rising up’ and overcoming obstacles.” C.A.App.306, 940.

PepsiCo’s brand team designed a lion’s head logo to serve as MDRE’s symbol and connected it to MTN DEW by using the triangular shards from MTN DEW

cans. C.A.App.303. The lion's head was the centerpiece of the 16-ounce MDRE can. App.17a; C.A.App.303. The logo design also featured the MTN DEW house mark and vivid colors for each flavor:



App.17a; C.A.App.306. MDRE launched nationwide in March 2021. C.A.App.302.

B. RBC Obtains a Preliminary Injunction.

In 2021, RBC sued PepsiCo, alleging violations of the Lanham Act and state law. RBC alleged liability based on, *inter alia*, a “reverse confusion” theory, under which a junior user “selects a trademark that is likely to cause consumers to believe, erroneously, that the goods marketed by the [senior] user are produced by the [junior] user.” *Lang v. Ret. Living Publ’g Co.*,

949 F.2d 576, 583 (2d Cir. 1991); App.78a. RBC sought a preliminary injunction enjoining PepsiCo's mark.

The district court granted the preliminary injunction, concluding that RBC had demonstrated that PepsiCo's actions are "likely to cause confusion." App.76a-77a. The court applied the eight factors the Second Circuit uses to evaluate "likelihood of confusion": "(1) the strength of the trademark; (2) the degree of similarity between the plaintiff's mark and the defendant's allegedly imitative use; (3) the proximity of the products and their competitiveness with each other; (4) the likelihood that the plaintiff will 'bridge the gap' by developing a product for sale in the defendant's market; (5) evidence of actual consumer confusion; (6) evidence that the defendant adopted the imitative term in bad faith; (7) the respective quality of the products; and (8) the sophistication of the relevant population of consumers." App.79a (citing *Polaroid Corp. v. Polarad Electronics Corp.*, 287 F.2d 492, 495 (2d Cir. 1961)).

The court determined that the "strength of the mark" factor "tilts slightly" toward RBC because "the word 'RISE' is suggestive" and RBC had provided some evidence of "market distinctiveness." App.80a-84a. The court added that the "similarity of the marks" factor "tips strongly" toward RBC. App.84a, 86a. The court concluded that three remaining factors favored RBC, two were inconclusive or neutral, and one was inapplicable. App.87a-90a.

Weighing the *Polaroid* factors, the district court held that RBC would likely prevail in showing likelihood of confusion. App.80a, 91a. The court also

concluded that RBC had satisfied the other preliminary-injunction factors. App.91a-94a.

C. The Second Circuit Vacates the Preliminary Injunction.

The Second Circuit unanimously vacated the preliminary injunction. App.45a-63a. In an opinion by Judge Leval, the court held that the preliminary injunction was “premised on two significant errors.” App.46a.

First, the district court erred in concluding that the strength of RBC’s mark “slightly favored” RBC. The Second Circuit noted that a mark’s strength is comprised of its “inherent strength” and “acquired strength.” App.6a-7a. As to inherent strength, the Second Circuit agreed with the district court that RBC’s mark should be classified as “suggestive,” but “labeling a mark as ‘suggestive’ is not the end of the inquiry,” because “it can be difficult to distinguish weak suggestive marks from descriptive ones.” App.54a. The court then observed that “the strong logical associations between ‘Rise’ and coffee represent weakness and place the mark at the low end of the spectrum of suggestive marks.” App.29a; *see also* App.56a (cataloguing the “close associations between the word ‘Rise’ and coffee,” which “constitute[] a weakness of the mark under the trademark law”). The Second Circuit also noted that RBC had previously “acknowledged” that “the presence of multiple marks using the word ‘Rise’ indicated the mark’s weakness.” App.58a. The district court’s failure to account for these aspects, the Second Circuit observed, “constituted legal error.” App.55a. In so holding, the court explained that while “classification of a mark is

a factual matter,” there “is an undeniable legal element in the determination of how much strength a given mark commands.” *Id.*

As for “acquired strength,” the court saw “merit” in PepsiCo’s argument that, because RBC alleged “reverse confusion,” any acquired strength would not help RBC. App.60a. It did not resolve that issue, however, because RBC had not shown “sufficient acquired strength to counterbalance the inherent weakness of its mark.” App.61a.

Second, the Second Circuit examined the similarity-of-the-mark factor and deemed the district court’s finding that RBC’s and PepsiCo’s marks are “confusingly similar” to be “clear error.” App.61a. The court reviewed the two products’ features and concluded that “the differences appear far more notable than the similarities,” including the use of the colorful lion’s head and the fact that RBC’s “seven-ounce can is less than half the size of Defendant’s sixteen-ounce can,” as shown here:



App.62a. In short, there was “little about the appearance of the two cans that would suggest to a consumer that they come from the same source.” App.63a.

D. The District Court Grants Summary Judgment to PepsiCo.

After discovery, PepsiCo moved for summary judgment. RBC submitted no new evidence on inherent strength, arguing instead that the Second Circuit relied on “hearsay” in determining that its mark was “inherently weak.” Dkt.398 at 6-7.

The district court granted summary judgment for PepsiCo. App.15a-44a. As to inherent strength, the court adhered to the Second Circuit’s observation that the mark was “‘decidedly’ weak,” a conclusion “based on the nature of the mark and not on any extrinsic evidence.” App.29a. As to acquired strength, the court held that RBC failed to create a genuine factual dispute, noting in particular RBC’s failure to submit any survey evidence establishing secondary meaning. App.32a.

As to similarity, the district court acknowledged the Second Circuit’s holding that deeming the marks similar was “clear error.” App.34a-35a. It then noted that “the record has not changed since the Second Circuit’s decision.” App.35a. Thus, this factor “weighs strongly against” RBC. *Id.* The court also concluded that one remaining factor favored neither party, another was inapplicable, and four favored RBC—though, in some respects, “only slightly, given the nature and quantum of evidence.” App.39a.

The district court then weighed the factors, mindful that it “should focus on the ultimate question

of whether consumers are likely to be confused,” and noting that, in the Second Circuit, the “ultimate question of consumer confusion” is “a question of law.” App.42a. The court concluded that RBC had not shown a likelihood of confusion, warranting summary judgment for PepsiCo. App.43a.

E. The Second Circuit Affirms.

RBC appealed. RBC did not challenge the district court’s ruling that the “similarity” factor “weighs strongly against” it. App.35a. Instead, it made three arguments. First, the district court “misinterpreted” the Second Circuit’s initial opinion “as having resolved” the “inherent strength” issue “as a matter of law” when, instead, Second Circuit precedent required treating that issue as a factual matter. C.A.Br.17. RBC alleged a factual dispute on inherent strength by citing dictionary definitions for the word “Rise”—an argument it did not make in the district court. CA.Br.29-30. Second, on acquired strength (the other subcomponent of trademark strength), the district court “ignor[ed] key evidence, resolv[ed] factual disputes, and fail[ed] to draw all inferences in [RBC]’s favor.” C.A.Br.21. Third, the district court erred by “treating the test for likelihood of confusion as a question of law instead of a question of fact.” C.A.Br.21.

In an unpublished, unsigned summary order, the Second Circuit unanimously affirmed. App.1a-14a. On inherent strength, the court held that the district court “correctly concluded that it was bound by the previous panel’s determination” that “rise” is “an inherently weak mark for a coffee product” given its association with coffee, caffeine, and beginning the

morning. App.7a. The court next held that RBC had not “raised triable issues of fact regarding the acquired strength of its mark.” App.8a. The court observed, as had the district court, that the record on acquired strength had barely changed since the preliminary injunction proceedings, and it noted in particular the “absence of any consumer studies that link ‘RISE’ to [RBC].” App.9a. Although “not the only way to establish” acquired strength, the “absence of survey evidence is probative.” *Id.* Finally, the court rejected RBC’s argument that likelihood of confusion is a question of fact rather than law. App.10a.

The Second Circuit concluded by stating that there is “not a likelihood that consumers would be confused by PepsiCo’s use of the term ‘Rise.’” App.11a. The court noted that it has “found the similarity-of-marks” factor “dispositive at the summary judgment stage.” App.12a. Regardless, “when viewing the *Polaroid* factors in the aggregate ... there is no likelihood of confusion and thus summary judgment was warranted in PepsiCo’s favor.” App.13a.

REASONS FOR DENYING THE PETITION

I. RBC Does Not Identify A Circuit Split Warranting Review.

RBC contends that the Court should intervene because “[t]welve circuits consider trademark strength an issue of fact” while the Second Circuit alone “consider[s] it a question of law.” Pet.i. This characterization is imprecise at best, as RBC fatally ignores that “trademark strength,” one of the many factors in determining likelihood of confusion, is itself comprised of two subcomponents: “conceptual strength” (or “inherent strength”) and “acquired

strength.” *See* App.6a; MCCARTHY ON TRADEMARKS & UNFAIR COMPETITION §11.80 (5th ed. 2025). As Judge Leval’s decision below illustrates, conceptual strength can incorporate a legal element when the inquiry goes beyond mere classification of a mark and includes examining the inherent meaning of a word, while acquired strength looks to external evidence like sales and advertising. There is no circuit split on whether that additional analysis of conceptual strength, *i.e.*, beyond classification of a mark’s distinctiveness, is a question of fact or law. And both trademark strength and the ultimate determination of likelihood of confusion are routinely decided on summary judgment across all circuits when there is no true issue for the jury to decide.

A. RBC’s question presented alleges a split over “trademark strength,” which RBC defines as a trademark’s “level of distinctiveness.” Pet.i. RBC asserts that this “spectrum for distinctiveness” refers to a mark’s “conceptual strength” (or “inherent strength”), and that “every circuit in the nation ... treats the conceptual strength of a trademark as a question of fact.” Pet.10-11. Elsewhere, however, RBC acknowledges that “trademark strength” includes not just “conceptual strength” but also “acquired strength,” and argues that “the circuit courts consider a trademark’s conceptual and acquired strength as factual questions.” *Id.* at 1. Still other times, RBC refers generally to a split over “strength of the mark” without identifying whether it means overall trademark strength, conceptual strength, or acquired strength. *See id.* at 10, 13, 14, 18.

RBC is equally imprecise in describing how the Second Circuit purportedly diverges from other circuits. After contending that other circuits “consider a trademark’s conceptual and acquired strength as factual questions,” RBC asserts that only the Second Circuit “consider[s] *it* a legal *question*,” without specifying whether “it” refers to overall trademark strength, conceptual strength, or acquired strength. *Id.* at 1 (emphases added). RBC later refers to the Second Circuit treating both “conceptual strength” and “acquired strength” as “questions of fact,” before describing the court’s alleged shift to treating “strength of mark”—*i.e.*, conceptual strength *and* acquired strength—“as a ‘legal’ question.” *Id.* at 12-13.

This imprecision is significant because, while RBC contends that the Second Circuit “applies a different standard for trademark law than everywhere else in the country,” RBC never contends that the Second Circuit treats *acquired* strength any differently than other circuits. Nor could it, because the decision below unquestionably treated acquired strength as a question of fact, concluding that RBC had not “raised triable issues of fact regarding the acquired strength of its mark.” App.8a. Given that acquired strength is one of the two subcomponents of trademark strength, and all circuits (including the Second Circuit) treat acquired strength as a question of fact, it is thus inaccurate for RBC to allege that the Second Circuit “treat[s] strength of mark as an issue of law,” Pet.13 (capitalization altered), and that this Court’s intervention is therefore necessary to “unify[] the standard for analyzing the strength of a trademark,” *id.* at 18.

Even as to conceptual strength, RBC's allegation of a circuit split is incorrect, and this case does not implicate any divide among the circuits. RBC describes "conceptual strength" as where a mark lies along the "spectrum for distinctiveness," meaning how it is classified "from generic on the weakest end to arbitrary and fanciful on the strongest end." Pet.10. It then contends that such "conceptual strength" should "be determined as a question of fact." *Id.* RBC points to the decision under review as "unambiguously cement[ing]" the Second Circuit's approach that "conceptual strength" is a "question of law." *Id.* at 13. But that decision is unpublished and non-precedential and thus could not have "cement[ed]" anything.

As for the only published decision in this case—which is not under review, and arose in a preliminary-injunction posture—the panel *did not disagree* that "the classification of a mark is a factual matter." App.55a. And it *agreed* that RBC's mark on the "spectrum for distinctiveness" is properly classified as "suggestive." App.54a. But as the panel then explained, conceptual strength involves more than just a mark's classification along the distinctiveness spectrum; "labeling a mark as 'suggestive' is not the end of the inquiry." *Id.* It was in the course of performing that *additional* analysis of conceptual strength—beyond reviewing the mark's placement on the spectrum of distinctiveness—that the Second Circuit observed that there can be a "legal element in the determination of how much strength a given mark commands." App.55a. And it was only on that additional basis that the court concluded that RBC's mark, although "suggestive," was nevertheless "decidedly weak." App.57a.

The Second Circuit’s analysis of conceptual strength beyond a mark’s classification on the “distinctiveness” spectrum is correct and consistent with other circuits’ approaches. The leading treatise distinguishes between “distinctiveness” and “strength,” explaining that “strength” is “a question of degree” from “very weak to very strong.” MCCARTHY §11:75. Other courts of appeals likewise evaluate conceptual strength beyond just looking at a mark’s placement on the “distinctiveness” spectrum. For example, the Fourth Circuit has held that a mark can be “suggestive” but “conceptually weak,” because a mark’s “designation” on the spectrum of distinctiveness “does not resolve the mark’s conceptual strength.” *Variety Stores, Inc. v. Wal-Mart Stores, Inc.*, 888 F.3d 651, 662 (4th Cir. 2018). The Third Circuit has held that “[a]lthough the conceptual strength of a mark is often associated with the particular category of ‘distinctiveness’ into which a mark falls ... , that is not the only measure of conceptual strength.” *A & H Sportswear, Inc. v. Victoria’s Secret Stores, Inc.*, 237 F.3d 198, 222 (3d Cir. 2000). The Fifth Circuit has held that “the strength inquiry is different from the distinctiveness inquiry.” *Future Proof Brands, L.L.C. v. Molson Coors Beverage Co.*, 982 F.3d 280, 290 (5th Cir. 2020). And so on.

RBC does not challenge this approach to conceptual strength—*i.e.*, additional analysis of a mark’s conceptual strength beyond mere classification of distinctiveness. More important, RBC does not identify any circuit that treats that additional analysis as a factual rather than legal question. That should come as no surprise, for examining a mark’s conceptual strength beyond its designation on the

spectrum of distinctiveness unquestionably implicates legal issues, such as the meaning and associations of a word. *See, e.g., Teva Pharms. USA, Inc. v. Sandoz, Inc.*, 574 U.S. 318, 325 (2015) (explaining that courts “treat document construction as a question of law”); *cf. Loper Bright Enters. v. Raimondo*, 603 U.S. 369, 385–87 (2024). Because there is no split on how the circuits treat this additional analysis of the conceptual strength subcomponent of trademark strength, the Court’s intervention is unnecessary.

B. Additionally, any marginal differences concerning the extent to which conceptual strength is a question of fact or law make virtually no difference in the ultimate likelihood-of-confusion analysis that is the “keystone” of Lanham Act cases. *Jack Daniel’s Props., Inc. v. VIP Prods. LLC*, 599 U.S. 140, 147 (2023); *see* 15 U.S.C. §1114(1)(A). Conceptual strength is but one subcomponent of trademark strength, which is but one of many factors in each circuit’s multifactor balancing test for determining likelihood of confusion. RBC breezily asserts, without support, that these tests are “largely similar” and consider trademark strength the “[c]hief” factor, Pet.i, 1, but in reality, the tests differ substantially in both the number of factors and the emphases they place on various factors. Some circuits employ six factors. *See Team Tires Plus, Ltd. v. Tires Plus, Inc.*, 394 F.3d 831, 833 (10th Cir. 2005). Others use seven, *see Aronowitz v. Health-Chem Corp.*, 513 F.3d 1229, 1239 (11th Cir. 2008); *Eli Lilly & Co. v. Nat. Answers, Inc.*, 233 F.3d 456, 461–62 (7th Cir. 2000); still others, eight. *See Appliance Liquidation Outlet, L.L.C. v. Axis Supply Corp.*, 105 F.4th 362, 381 (5th Cir. 2024); *AWGI, LLC v. Atlas Trucking Co.*, 998 F.3d 258, 264–65 (6th Cir.

2021); *Boston Duck Tours, LP v. Super Duck Tours, LLC*, 531 F.3d 1, 10 n.6 (1st Cir. 2008); *AMF Inc. v. Sleekcraft Boats*, 599 F.2d 341, 348-49 (9th Cir. 1979); App.50a. One circuit uses seven or nine factors. See *George & Co. v. Imagination Ent. Ltd.*, 575 F.3d 383, 393 (4th Cir. 2009); *Petro Shopping Centers L.P. v. James River Petroleum, Inc.*, 130 F.3d 88, 91 (4th Cir. 1997). Another uses ten. See *Arrowpoint Capital Corp. v. Arrowpoint Asset Mgt., LLC*, 793 F.3d 313, 319 (3d Cir. 2015). And one even uses thirteen. See *In re Guild Mortg. Co.*, 912 F.3d 1376, 1379 (Fed. Cir. 2019).

Within each of these tests, moreover, circuits have identified different factors as the most important, ranging from “degree of similarity” of marks, *Affliction Holdings, LLC v. Utah Vap or Smoke, LLC*, 935 F.3d 1112, 1115 (10th Cir. 2019), to “actual confusion,” *George*, 575 F.3d at 398, to “relatedness” of the goods, *Homeowners Grp., Inc. v. Home Mktg. Specialists, Inc.*, 931 F.2d 1100, 1109 (6th Cir. 1991). Only the Eleventh Circuit considers “type of mark” to be “the most important” factor. *Aronowitz*, 513 F.3d at 1239.

Given this “great diversity of factors” underlying the circuits’ likelihood-of-confusion analyses, Barton Beebe, *An Empirical Study of the Multifactor Tests for Trademark Infringement*, 94 Cal. L. Rev. 1581, 1589 (2006)—which RBC does not ask this Court to resolve—the issue of whether one subcomponent (conceptual strength) of one factor (trademark strength) is a question of fact or law does not warrant review. Indeed, even where conceptual strength *is* a factual question, courts frequently grant summary judgment on that subcomponent. See, e.g., *Elevate*

Fed. Credit Union v. Elevations Credit Union, 67 F.4th 1058, 1075 (10th Cir. 2023) (holding that “any reasonable juror would assign relatively weak conceptual strength to” marks using word “elevate”); *Lodestar Anstalt v. Bacardi & Co.*, 31 F.4th 1228, 1259 (9th Cir. 2022) (holding that “no reasonable jury could find that the Untamed Word Mark is arbitrary”); *Donchez v. Coors Brewing Co.*, 392 F.3d 1211, 1218 (10th Cir. 2004) (“We are not persuaded that a jury could rationally find ... that the term ‘beerman’ is descriptive.”).

Even where there is a genuine factual dispute on conceptual strength, moreover, courts frequently grant summary judgment on overall trademark strength after accounting for acquired strength—as RBC’s cases demonstrate. *See, e.g., E.T. Browne Drug Co. v. Cococare Prods., Inc.*, 538 F.3d 185, 192 (3d Cir. 2008) (finding genuine factual dispute on conceptual strength, but holding mark unprotected because no genuine factual dispute on acquired strength). And even when there is a genuine factual dispute on overall trademark strength—or the mark is determined to be strong—courts frequently grant summary judgment on overall likelihood of confusion based on other factors in the circuit’s respective multifactor test. *See, e.g., Lerner & Rowe PC v. Brown Engstrand & Shely LLC*, 119 F.4th 711, 719 (9th Cir. 2024) (affirming summary judgment of no likelihood of confusion despite strong mark); *Swatch AG v. Beehive Wholesale, LLC*, 739 F.3d 150, 162 (4th Cir. 2014) (same); *Sensient Techs. Corp. v. SensoryEffects Flavor Co.*, 613 F.3d 754, 764 (8th Cir. 2010) (same); *Welding Servs., Inc. v. Forman*, 509 F.3d 1351, 1361 (11th Cir. 2007) (declining to grant summary

judgment on lack of distinctiveness but granting summary judgment on no likelihood of confusion); *see also Sorensen v. WD-40 Co.*, 792 F.3d 712, 726 (7th Cir. 2015) (“A court may grant summary judgment even if there is a genuine issue of material fact as to one or more of the seven factors, as long as no reasonable jury, looking at the seven factors as a whole, could conclude that there is a likelihood of confusion.”).

Additionally, the Second Circuit is one of several circuits that treats the ultimate likelihood-of-confusion determination as a question of law. App.10a, 23a-24a. RBC challenged that approach below but does not raise it here. Accordingly, even if the conceptual strength subcomponent of trademark strength were a factual question in the Second Circuit, courts in that circuit could—and would—still ultimately determine likelihood of confusion regardless of any factual disputes among the factors. That makes this case a particularly poor vehicle to address the question presented, *see* p.26, *infra*, but also underscores that any differences between the Second Circuit and other circuits on whether one subcomponent of one factor in a multifactor test is a question of fact or law are ultimately immaterial and do not warrant certiorari.

C. RBC’s argument that every other circuit holds that “conceptual strength ... should be determined ... by a jury” is also misguided and underscores the broader infirmity of its position. Pet.10. In Lanham Act cases, juries are not asked to “determine[]” conceptual strength, or any other factor. Instead, they are asked to determine likelihood of confusion—the

element required under the Lanham Act—as guided by the multifactor test in each circuit.

Thus, for example, the Ninth Circuit’s model jury instructions provide that the jury must determine if the defendant used the trademark “in a manner that is likely to cause confusion.” NINTH CIR. MANUAL OF MODEL CIVIL JURY INSTRUCTIONS 15.6 (Mar. 2025 update). The instructions add that, to guide that determination, the judge “will suggest some factors you should consider,” which comprise the Ninth Circuit’s eight-factor likelihood-of-confusion test. *Id.* 15.18. Similarly, the Fifth Circuit instructs juries to determine “likelihood of confusion” by “consider[ing] the following factors,” which comprise that circuit’s multifactor test. FIFTH CIR. PATTERN CIVIL JURY INSTRUCTIONS (CIVIL CASES) 14.10 (Trademark Infringement) (rev. 2024). Indeed, juries are instructed that “[t]he absence or presence of any one of the [factors] does not determine whether there is, or is not, a likelihood of confusion.” *Id.*

In these and other circuits, therefore, the model instructions, reflecting circuit law, not only demonstrate that juries do not “determine” conceptual strength (or any factor, for that matter) but also reinforce that conceptual strength is only one miniscule subcomponent of the overall likelihood-of-confusion determination—one that a decisionmaker need not even consider when making that determination. That is not the stuff of a circuit split, much less one that calls for this Court’s intervention.

II. This Case Is A Poor Vehicle To Address The Question Presented.

Even if there were a circuit split warranting review, this case would be a poor vehicle for resolving that split for numerous reasons.

A. To begin, a decision holding that conceptual strength is a question of fact would make no difference to the outcome of this case. RBC contends that the Second Circuit’s “treating conceptual strength as a legal question ... resolved the likelihood-of-confusion analysis in this case,” Pet.1, 15-16, but that contention ignores the decisions below, unchallenged Second Circuit precedent, and the uncontroverted record.

First, even treating conceptual strength as a question of fact, it is far from clear that, on remand, the Second Circuit would not simply hold that no reasonable jury could conclude that RBC’s mark was conceptually strong—just as other courts have held in similar circumstances. *See* pp.19-20, *supra*. The Second Circuit recited a series of reasons why RBC’s mark was “inherently weak” if not “decidedly weak.” App.57a. Those reasons included (1) “the close associations between the word ‘Rise’ and coffee”; (2) the fact that there were, on the market, “over 100 uses of the term ‘Rise’ in connection with coffee, tea, bottled beverages, energy drinks, soft drinks, drinkable health supplements, cafes, yogurts, and granolas”; and (3) most problematic, RBC’s own prior acknowledgment to the PTO that “the presence of multiple marks using the word ‘Rise’ indicated the mark’s weakness,” and that the “term ‘Rise’ is extremely weak and diluted” and would not contribute to “any likelihood of confusion.” App.57a-58a. As the

Second Circuit explained, “If there was room for [RBC’s] use of ‘Rise’ in the already crowded coffee field, there would also be room for [PepsiCo’s], especially on a product that is distinct from coffee.” App.59a.

This reasoning strongly indicates that, even treating conceptual strength as a question of fact, the Second Circuit would not alter its conclusion regarding the conceptual strength of RBC’s mark. Instead, it would conclude that RBC had raised no genuine factual dispute that “rise” is not inherently weak. That is particularly so given that, in opposing summary judgment, RBC offered *no* new evidence on conceptual strength. Instead, before the district court, it argued that the Second Circuit’s conceptual strength ruling relied on “hearsay”; then, on appeal, it cited dictionary definitions for the word “Rise” (an argument it never made in the district court). *See* pp.11-12, *supra*. Indeed, it is entirely unclear exactly what “historical fact[s]” regarding conceptual strength need resolving in this case. *Miller v. Fenton*, 474 U.S. 104, 113-14 (1985). Determining that subcomponent here does not turn on any disputed historical facts but instead on the meaning of the word “rise” and what RBC has represented about its mark (which is uncontested).

Second, a decision by this Court would not affect the rulings below against RBC as to *acquired* strength—the other subcomponent of trademark strength—which RBC does not challenge here. The Second Circuit “agree[d] with the district court” that “no reasonable jury could find that the primary significance of the mark ‘RISE’ is to identify [RBC] as the source of the product,” which is the test for

acquired strength. App.8a. The court noted that RBC largely relied on the same acquired-strength evidence that the court had previously rejected. And RBC's "minimal additional evidence" was "insufficient to move the analytical needle." App.9a. The court observed in particular that RBC had failed to provide "any consumer studies that link the 'RISE' mark to" RBC. *Id.* Though not itself dispositive, that failure was "probative" given RBC's unpersuasive other evidence of acquired strength. *Id.*

RBC contends that the Second Circuit "held that [RBC's] evidence of acquired marketplace distinctiveness was not enough to overcome the legal determination of the 'mark's inherent weakness,'" as if to suggest that if the mark were deemed inherently stronger, there would be a triable factual issue on acquired strength or overall trademark strength. Pet.9 (quoting App.9a–10a). But the Second Circuit was clear that RBC had not "raised triable issues of fact regarding the acquired strength of its mark." App.8a. Therefore, even if the district court ignored the Second Circuit's numerous criticisms of the inherent strength of RBC's mark, the lack of any triable factual issue on acquired strength would almost certainly result in a determination for PepsiCo on overall trademark strength. As a result, the outcome below would not change.

Third, RBC does not challenge the lower courts' determinations that the "similarity" factor "strongly" favors PepsiCo. App.35a. On remand after the Second Circuit deemed "clearly erroneous" the district court's finding that RBC's and PepsiCo's marks were "confusingly similar," the district court noted that

RBC had offered no additional evidence on this factor and, citing the Second Circuit’s decision, concluded that this factor “weighs strongly against” RBC. *Id.* RBC has never challenged that determination. That concession is significant because, as the Second Circuit observed below, it has held “the similarity-of-marks factor *dispositive* at the summary judgment stage when the marks are sufficiently dissimilar.” App.12a (citing *Nabisco, Inc. v. Warner-Lambert Co.*, 220 F.3d 43, 46-48 (2d Cir. 2000)) (emphasis added).

Accordingly, even if this Court’s decision (i) resulted in a change in the conceptual-strength determination (ii) in a way that offsets the now-conceded lack of acquired strength, the Second Circuit would nevertheless deem “dispositive” the now-conceded substantial dissimilarity between that mark and PepsiCo’s marks. And even if the Second Circuit did not find that factor dispositive, then because the Second Circuit treats overall likelihood of confusion as a question of law, it would almost certainly conclude that there is no likelihood of confusion given the “dissimilarity” factor weighing “strongly” against RBC and the lack of any triable issue of fact on acquired strength.¹

Fourth, all else aside, the Second Circuit has held that when a Lanham Act defendant submits “consumer surveys tending to rebut charges of actual

¹ RBC asserts that the district court had “determined that the majority of the remaining likelihood-of-confusion factors favored” RBC. Pet.16. But the district court held that those factors “only slightly” favored RBC, and regardless, the Second Circuit largely rejected them below for reasons not challenged here. *See* App.12a-13a, 39a.

consumer confusion,” and a plaintiff “fail[s] to present its own consumer survey,” *Star Indus., Inc. v. Bacardi & Co.*, 412 F.3d 373, 388 (2d Cir. 2005), then “actual confusion cannot be shown,” *The Sports Auth., Inc. v. Prime Hosp. Corp.*, 89 F.3d 955, 964 (2d Cir. 1996). And it is “proper” to “infer from the absence of actual confusion that there was ... no likelihood of confusion.” *McGregor-Doniger Inc. v. Drizzle Inc.*, 599 F.2d 1126, 1136 (2d Cir. 1979). Here, PepsiCo proffered six different surveys “rebut[ting] charges of actual consumer confusion,” while RBC “fail[ed] to present its own consumer survey.” *Star Indus.*, 412 F.3d at 388; *see* C.A.App.912-914, 311-395, 945-949, 959-962, 625-630, 964-969; App.12a-13a (noting that RBC “failed” to provide “consumer surveys”). Accordingly, “actual confusion cannot be shown,” *Sports Auth.*, 89 F.3d at 964, and it is “proper” to thus conclude that there is no “likelihood of confusion,” *McGregor-Doniger*, 599 F.2d at 1136. PepsiCo raised this argument to the Second Circuit below, but the court had no need to address it given its other holdings. Nevertheless, it provides yet another reason why the result of this case would not change following any intervention by this Court, rendering this case an extremely poor vehicle.

B. Furthermore, RBC’s question presented was insufficiently raised and considered below. This Court “normally decline[s] to entertain” arguments not “raised ... in the courts below.” *Kingdomware Techs., Inc. v. United States*, 579 U.S. 162, 173 (2016); *see also* *OBB Personenverkehr AG v. Sachs*, 577 U.S. 27, 38 (2015); *Rent-A-Center, W., Inc. v. Jackson*, 561 U.S. 63, 75-76 (2010). RBC contended below that “the district court erred by analyzing the RISE mark’s strength as

a question of law,” but only because Second Circuit precedent purportedly required treating trademark strength as a question of fact. C.A.Br.22-24. RBC never argued the actual merits of whether trademark strength is a question of law or fact. In particular, it never argued that “treating strength of mark as an issue of law contravenes this Court’s precedent.” Pet.13 (capitalization altered). Despite emphasizing them now, RBC did not once cite *Booking.com* below, and it cited *Hana Financial* only when pressing a completely different issue—that the ultimate likelihood-of-confusion determination is a question of fact rather than law—that it does not raise here. See C.A.Br.18-20, 21-22, 37-45; C.A.Reply.19-26.

Moreover, because RBC did not argue the merits of the question presented below, the Second Circuit never addressed that issue. This Court “does not ordinarily decide questions that were not passed on below.” *City & Cnty. of San Francisco, Cal., v. Sheehan*, 575 U.S. 600, 609 (2015); see also *Town of Chester, N.Y., v. Laroe Ests., Inc.*, 581 U.S. 433, 441 n.4 (2017) (given “lack of a reasoned conclusion on this question from the Court of Appeals, we are not inclined to resolve it in the first instance”). Rather, the Court prefers “the benefit of thorough lower court opinions” addressing the question presented. *Zivotofsky ex rel. Zivotofsky v. Clinton*, 566 U.S. 189, 201 (2012). There is no such “thorough” opinion below here.

The Court would thus be writing on a completely blank slate—which is always suboptimal, but especially here, given “the vexing nature of the distinction between questions of fact and questions of

law.” *Pullman-Standard v. Swint*, 456 U.S. 273, 288 (1982); *see also Miller*, 474 U.S. at 113. Were the Court ever inclined to review RBC’s question presented, it should wait for a case where the issue was raised and discussed below—including in light of *Booking.com* and *Hana Financial*—resulting in a published decision that would “guide [its] analysis,” rather than undertake that analysis in the first instance. *Zivotofsky*, 566 U.S. at 201.

C. Finally, to review the question presented, the Court would have to address significant threshold issues of first impression on which the lower courts are divided but RBC does not seek review. *See, e.g., Scenic Am., Inc. v. Dep’t of Transp.*, 138 S.Ct. 2, 3 (2017) (where case is “burdened with ... antecedent ... questions,” the “proper course is to deny certiorari”). The first of these is the test for determining likelihood of confusion and what role trademark strength (and any subcomponents, such as conceptual strength and acquired strength) play in that analysis. This case, for example, proceeded under the Second Circuit’s eight-factor test. But other circuits have different tests, applying different factors and assigning different levels of importance to those factors, including trademark strength. *See pp.18-19, supra*. RBC does not ask this Court to resolve those many differences. Yet if the Court grants review, it will be required to address the extent to which trademark strength—or, more specifically, conceptual strength—affects the likelihood-of-confusion analysis, even though different

circuits take varying approaches to that question and no decision below addresses that issue.²

The second unaddressed threshold question involves evaluating trademark strength when, as here, “reverse confusion” is alleged. *See* App.32a (“Plaintiff’s theory of liability is reverse confusion.”); App.49a (noting that RBC “argues that [PepsiCo’s] use of the word ‘Rise’ created a likelihood of *reverse* confusion”). In reverse confusion cases, there are “differences from the rules for forward confusion cases,” particularly as to trademark strength. MCCARTHY §23:10 (capitalization altered). For example, “[i]n a reverse confusion case,” it “makes no sense to apply the forward confusion requirement that the senior user have a mark strong enough that confusion will result.” *Id.* Instead, “the court should evaluate the strength of the junior user’s mark so as to gauge its ability to overpower the senior user’s mark.” *Id.*

Before this Court, however, RBC is not challenging “the strength of the junior user’s [*i.e.*, PepsiCo’s] mark.” Instead, it contends that *its* mark (as the senior user) is stronger than the lower courts determined. But focusing on the strength of RBC’s mark “makes no sense” under RBC’s reverse-confusion

² In *B&B Hardware, Inc. v. Hargis Industries, Inc.*, 575 U.S. 138 (2015), the Court noted that the “factors” in the Trademark Trial and Appeal Board’s and Eighth Circuit’s likelihood-of-confusion tests “are not fundamentally different.” *Id.* at 154. The Court made that observation only in the context of determining whether issue preclusion applied, however. It did not purport to evaluate whether, in practice, applying the tests’ factors produces materially different results. Nor, of course, did the Court address any other circuit’s test or suggest a uniform test for all circuits.

theory. *Id.* At a minimum, the inconsistency between RBC's arguments and its theory of liability renders this case unsuitable for review. If the Court were ever inclined to review the question presented, it should do so in a Lanham Act case premised on ordinary "forward confusion," not the uncommon case involving "reverse confusion," where trademark strength plays a different role in the likelihood-of-confusion analysis.

III. The Question Presented Is Not Of Sufficient Importance To Warrant Review.

The question presented also is of insufficient importance to warrant this Court's review. RBC contends the issue is "critically important" principally because the Second Circuit's allegedly "unique, incorrect standard" raises "forum-shopping concerns." Pet.16-17 (capitalization altered). RBC cites no evidence or precedent to support this assertion—or any *amicus* support. Instead, it simply asserts that "forum-shopping concerns are bound to arise." *Id.* at 17. Not only is that statement vague and conclusory, but by RBC's own telling, the Second Circuit's "shift" to its new approach began over twenty years ago, in 2003, and has been regularly applied in cases since 2020. *Id.* at 15 n.1. Yet RBC identifies no noticeable increase or decrease in Lanham Act cases filed within the Second Circuit. For good reason: a Lanham Act plaintiff's choice of forum is not going to turn on whether one subcomponent of a factor in a multifactor test comprising six to thirteen other factors is a question of fact or law—especially when that factor could cut for or against a plaintiff. Regardless, if forum-shopping concerns are "bound to arise," the better course is to allow further percolation and wait

to see if such concerns actually materialize, and only then consider intervention (in a suitable vehicle, unlike this case).

The question is also unimportant because it matters, if at all, only in a small universe of cases—specifically, Lanham Act cases within the Second Circuit where the trademark strength factor (or, more specifically, the conceptual-strength subcomponent of that factor) would change if it were a question of fact instead of a question of law, in a way that tips the overall likelihood-of-confusion analysis away from one party and toward the other when all the other *Polaroid* factors are considered. That set of cases is already miniscule (if it exists at all), but is even smaller, and less significant, given that the overall likelihood-of-confusion determination in the Second Circuit is a legal question for the district court’s plenary consideration and the appellate court’s *de novo* review.

RBC’s appeal to the jury-trial right, Pet.17-18, is also unavailing. For one, as RBC’s cases demonstrate, many Lanham Act plaintiffs do not even request a jury trial, or they seek only equitable relief. *See, e.g., Moke Am. LLC v. Moke Int’l Ltd.*, 126 F.4th 263, 269 (4th Cir. 2025); *Anheuser-Busch Inc. v. Stroh Brewery Co.*, 750 F.2d 631, 633-35 (8th Cir. 1984). For another, as noted, juries do not determine conceptual strength (or even trademark strength); they determine likelihood of confusion, of which conceptual strength is but a small subcomponent that is not on verdict forms. *See* pp.21-22, *supra*. For still another, even accepting the erroneous premise that juries decide each likelihood-of-confusion factor individually, plaintiffs in the

Second Circuit would get a jury trial on all the *Polaroid* factors *except* the conceptual strength subcomponent—essentially, then, 7.5 out of the 8 factors. That is hardly the revocation of an “important bulwark against tyranny and corruption” warranting this Court’s intervention. Pet.17.

Even then, questions of fact can be taken from the jury if the court believes the evidence is insufficient, as is not-uncommon in Lanham Act cases. *See* pp.19-20, *supra*. Accordingly, even if a jury found that a mark had a particular level of conceptual strength, either the district court or Second Circuit could hold as a matter of law that the evidence did not support that finding. Finally, as noted, courts in the Second Circuit (and the Second Circuit itself) treat the likelihood-of-confusion determination as a question of law—a position unchallenged here. Accordingly, whatever a jury may have found as to the conceptual strength subcomponent is, in practice, subordinated to the court’s overall assessment of likelihood of confusion, substantially minimizing that subcomponent’s role in the ultimate inquiry.

IV. The Decision Below Is Correct.

RBC invokes *Booking.com* and *Hana Financial* to argue that “treating strength of mark as an issue of law contravenes this Court’s precedent.” Pet.13 (capitalization altered). As noted, no court has yet addressed these arguments, but regardless, they are unavailing.

At the outset, RBC frequently cites the *Booking.com* syllabus, not the Court’s opinion. On the petition’s very first page, for example, RBC quotes from page 550 of *Booking.com*, which is the syllabus.

See *United States v. Detroit Timber & Lumber Co.*, 200 U.S. 321, 337 (1906). RBC does so again later. See Pet.14-15. Indeed, RBC quotes language—“generic (or nongeneric) character”—found *only* in the syllabus. Pet.14. This is not a promising start for RBC’s merits argument.³

Regardless, *Booking.com* addressed an exceedingly narrow issue: whether the addition of “.com” to a generic word is *per se* generic. 591 U.S. at 557. Rejecting that “sweeping rule,” the Court instead held that “[w]hether any given ‘generic.com’ term is generic ... depends on whether consumers in fact perceive that term as the name of a class or, instead, as a term capable of distinguishing among members of the class.” *Id.* at 551, 560-61. The Court did not address whether that determination is a factual or legal question. RBC emphasizes the language “whether consumers in fact perceive,” but that phrase does not reflect a holding; rather, the parties had agreed that “the relevant meaning of a term is its meaning to consumers.” *Id.* at 556; see, e.g., *Cooper Indus. v. Aviall Servs., Inc.*, 543 U.S. 157, 170 (2004) (noting that “[q]uestions which merely lurk in the record” and are not “ruled upon” are “not to be considered as having been so decided as to constitute precedents”).

Furthermore, because the case arose from PTO proceedings, the Court looked to the section of the Lanham Act governing registration cancellation,

³ RBC also quotes language—“generic (or not generic)” —found nowhere in the syllabus *or* opinion. Pet.1. Presumably RBC meant “generic (or nongeneric),” but as noted, even that language is only in the syllabus.

which provides that “[t]he primary significance of the registered mark to the relevant public ... shall be the test for determining whether the registered mark has become the generic name of goods or services.” 591 U.S. at 556 (quoting 15 U.S.C. §1064(3)). This case does not arise from PTO proceedings and thus does not implicate that statutory guidance. And even if *Booking.com* had some applicability, that decision’s reference to how “consumers in fact perceive” a mark, *id.* at 560, would be relevant to determining a mark’s *acquired* strength—which looks at a mark’s perception in the actual marketplace—and not a mark’s *conceptual* strength. See MCCARTHY §11:80 (defining acquired strength as “the marketplace recognition value of the mark,” which “evaluates the actual customer recognition value of the mark”).

Hana Financial is likewise inapposite. It, too, addressed a narrow and esoteric issue: “whether a judge or jury should determine whether tacking is available in a given case.” 574 U.S. at 420. “Tacking” refers to a party “cloth[ing] a new mark with the priority position of an older mark,” and it is available “when the original and revised marks are ‘legal equivalents’ in that they create the same, continuing commercial impression.” *Id.* at 419-20. In a short, unanimous opinion, the Court issued a concededly limited holding: “We hold only that, when a jury trial has been requested and when the facts do not warrant entry of summary judgment or judgment as a matter of law, the question whether tacking is warranted must be decided by a jury.” *Id.* at 423.

Perhaps recognizing the decision’s narrow scope, RBC invokes *Hana Financial*’s observation that

“[a]pplication of a test that relies upon an ordinary consumer’s understanding of the impression that a mark conveys falls comfortably within the ken of a jury.” Pet.1 (quoting 574 U.S. at 422). As noted, however, the “ordinary consumer’s understanding of the impression that a mark conveys” is more suited toward acquired, not conceptual, strength. Regardless, this single statement made in the context of a doctrine addressing how much a mark was changed does not bear the weight that RBC places upon it. For one, in its very next sentence, the Court declined to adopt a categorical rule. *See* 574 U.S. at 422 (“[W]hen the relevant question is how an ordinary person or community would make an assessment, the jury is *generally* the decisionmaker that ought to provide the fact-intensive answer.” (emphasis added)). The Court also recognized that “the question whether tacking is warranted” must “be decided by a jury” only “when the facts do not warrant entry of summary judgment,” *id.* at 423. *Hana* thus reaffirms that, as in many Lanham Act cases, questions of fact can nevertheless be decided on summary judgment.

For another, it is far from true that operating from the perspective of an ordinary person suffices to treat an inquiry as a factual question. For example, in *Ornelas v. United States*, 517 U.S. 690 (1996), this Court held that whether there is reasonable suspicion for a search is a legal question, even though it involves “the factual and practical considerations of everyday life on which reasonable and prudent men ... act.” *Id.* at 691, 695. Similarly, in *Santa Fe Independent School District v. Doe*, 530 U.S. 290 (2000), the Court observed that whether a statement violates the Establishment Clause is largely “a legal question”

despite turning on whether an objective member of the audience “would perceive it as a state endorsement of prayer in public schools.” *Id.* at 308, 315. Just these two instances demonstrate that one cannot simply leap to the conclusion that a trademark’s conceptual strength is a factual question merely because it may turn on a consumer’s perspective.

Hana Financial is further distinguishable because the ultimate “likelihood of confusion” determination involves a multifactor test that the Second Circuit and other circuits treat as a legal question. The “tacking” issue in *Hana Financial* involved no such multifactor subsidiary decisionmaking, much less one laced with a balancing test decided as a legal question.

Finally, it bears noting that RBC barely addresses the actual reasoning employed by the Second Circuit in this case. RBC contends that a mark’s “character”—whether it is generic, descriptive, suggestive, and so forth—depends on its “meaning to consumers,” thereby rendering it a factual question. Pet.1. As noted, however, the Second Circuit *agreed* with the “character” that the district court affixed to RBC’s mark; it found “no error in the district court’s determination that [RBC’s] mark is ‘suggestive,’” and it did not disclaim that where a mark lies on the distinctiveness spectrum is a question of fact. App.54a. The Second Circuit simply explained that the mere “label[]” a mark receives is not the end of the conceptual-strength inquiry, and in that additional analysis, there can be a “legal element.” App.55a.

Part of that “legal element” unquestionably includes, for example, construing the meaning of a

word or noting that a plaintiff now claiming a strong mark previously represented that its mark was weak, as RBC did to both the PTO and a competitor when such assertions served its then-purposes. The Second Circuit was entirely correct to hold that these and other features demonstrated that RBC's mark, while "suggestive," was nevertheless "decidedly weak" as an inherent matter. App.57a. That reasoning comports with a rule stating that a mark's "character" may be a factual question (as RBC urges) while other aspects have a "legal element" bearing on the assessment of the mark's overall conceptual strength.

CONCLUSION

The Court should deny the petition.

Respectfully submitted,

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