No. 24-1016

IN THE
Supreme Court of the United States

RISEANDSHINE CORPORATION, DBA RISE BREWING,
Petitioner,

v.

PEPSICO, INC.,
Respondent.

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

BRIEF OF INTELLECTUAL PROPERTY OWNERS ASSOCIATION AS *AMICUS CURIAE* IN SUPPORT OF NEITHER PARTY

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QUESTION PRESENTED

Whether trademark strength is a question of fact in a likelihood-of-confusion analysis under 15 U.S.C. § 1114.

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INTEREST OF THE *AMICUS CURIAE*

Amicus curiae Intellectual Property Owners Association (IPO) is an international trade association representing a "big tent" of diverse companies, law firms, service providers, and individuals in all industries and fields of technology that own, or are interested in, intellectual property rights.[1] IPO advocates for effective, affordable, and balanced IP rights and offers a wide array of services, including supporting member interests relating to legislative and international issues; analyzing current IP issues; providing information and educational services; and disseminating information to the public on the importance of intellectual property. IPO's mission is to promote high quality and enforceable IP rights and predictable legal systems for all industries and technologies.

IPO regularly represents the interests of its members before Congress and the United States Patent and Trademark Office ("USPTO"); and has filed *amicus curiae* briefs in this Court and other courts on significant issues of intellectual property law. The members of IPO's Board of Directors approved the filing of this brief and are listed in the Appendix.[2]

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[1] No party's counsel authored this brief in whole or part; no party or party's counsel contributed money intended to fund the preparation or submissions of the brief; and no person other than *amicus*, its members, or counsel contributed money intended to fund the preparation or submission of the brief.

[2] IPO procedures require approval of positions in briefs by a two-thirds majority of directors present and voting. The list of directors is attached to this brief.

INTRODUCTION AND SUMMARY OF ARGUMENT

For well over half a century, courts adjudicating trademark disputes have begun their analysis with a legal evaluation of how strong—how distinctive—a plaintiff's mark is, along a spectrum ranging from generic or purely descriptive (unprotectible), to descriptive with secondary meaning (weak), to suggestive (somewhat stronger), to arbitrary or fanciful (the strongest). It appears to be common ground that this approach originated in Judge Friendly's opinion for the Second Circuit in *Abercrombie & Fitch Co. v. Hunting World, Inc.*, 537 F.2d 4, 9 (2d Cir. 1976). It also appears to be common ground that this approach, in some form or another, now governs the standard for trademark registration and strength in every circuit.

The *Abercrombie & Fitch* spectrum provides a legal test—the more distinctive a mark is, the more muscular its exclusionary force is. It is a test of "distinctiveness," which is a judicial exposition of the legal requirement of trademark law generally and the Lanham Act in particular—that a trademark "distinguish" the goods and services to which it is attached. 15 U.S.C. § 1052.

Amicus IPO urges the Court to conclude that the determination of the strength of a trademark—its distinctiveness—is a mixed question of fact and law in which the legal component dominates the analysis. Such a ruling will have all sorts of salutary effects: It will ensure that strong trademarks are protected; allow for the development of a more coherent body of precedent on trademark strength; ensure coherence and consistency in the treatment of trademarks across the country; create a structure for appropriate judicial review of jury adjudications at both the trial and appellate level; reflect more honestly the review that appellate courts are presently conducting in the name of "clear error" review; and protect the important First Amendment interests in allowing the public to freely use public-domain terms that are generic or purely descriptive.

ARGUMENT

The parties in this case have framed the dispute as a categorical one: Is the strength of a trademark a question of fact or a question of law? *Amicus*, taking no position on the ultimate outcome of this case, believes that neither framing is correct. The "strength"—which is to say, the *distinctiveness*—of a mark presents a mixed question of fact and law. Further, the review of that question—whether on a motion for preliminary relief, a motion to dismiss, a motion for summary judgment, an in-trial or post-trial motion for judgment as a matter of law, or appellate review—should treat the legal component of this mixed question as predominant. This will allow for effective judicial review in individual cases, and will also ensure that a durable body of judicial decisions is available to guide courts and litigants in the future.

I. Trademark Law Is Aided By Judicial Control And Common-Law Development

Trademark law, while governed by statute, is rooted in the common law. "Trademarks and their precursors have ancient origins, and trademarks were protected at common law and in equity at the time of the founding of our country." *Matal v. Tam*, 582 U.S. 218, 224 (2017) (citing 3 J. McCarthy, *Trademarks and Unfair Competition* § 19:8 (4th ed. 2017)).

"[F]ederal law," such as the Lanham Act, "does not create trademarks," *B&B Hardware, Inc. v. Hargis Indus., Inc.*, 575 U.S. 138, 142 (2015), but it does play an important "role in protecting them." *Id.*

"The Lanham Act … creates a federal cause of action for trademark infringement." *Id.* Section 32 of that Act thus provides for liability where a registered mark is used in commerce "in connection with the sale, offering for sale, distribution, or advertising of any goods or services on or in connection with which such use is likely to cause confusion, or to cause mistake, or to deceive." 15 U.S.C. § 1114(1)(a), (b). The portion of this statutory test that is at issue in this case involves the language "likely to cause confusion, or to cause mistake, or to deceive."

Although this statutory provision (along with other statutory provisions providing remedies for unauthorized use of unregistered marks, *see*, *e.g.*, 15 U.S.C. § 1125(a)(1)(A)) contains no express reference to the "strength" of the mark at issue, courts have, through interpretation of the Lanham Act and common-law adjudication, determined that marks occupy a spectrum of "strength" based on the distinctiveness of the mark. "In assessing the likelihood of confusion, courts consider the mark's distinctiveness: 'The weaker a mark, the fewer are the junior uses that will trigger a likelihood of consumer confusion.'" *United States Patent & Trademark Office v. Booking.com B.V.*, 591 U.S. 549, 562 (2020) (quoting 2 J. McCarthy, *Trademarks and Unfair Competition* § 11.76 (5th ed. Supp. 2020)).

"Distinctiveness" as a requirement of a trademark is compelled by the text of the Lanham Act. "Prime among the conditions for registration, the mark must be one 'by which the goods of the applicant may be distinguished from the goods of others.'" *Booking.com*, 591 U.S. at 553 (quoting 15 U.S.C. § 1052). A "generic" term occupies "the lowest end of the distinctiveness scale," and is entitled to no trademark protection whatsoever, because "[t]he name of the good itself (e.g., 'wine') is incapable of 'distinguish[ing] [one producer's goods] from the goods of others.'" *Id.* at 554 (quoting 15 U.S.C. § 1052).

Beyond "generic" terms, which receive no protection, courts have taken upon themselves the task of creating a gradient scale of increasing distinctiveness, ranging from the unprotectible "generic" term to the muscular "arbitrary" or "fanciful" marks. Judge Friendly is widely viewed as having authored "the classic formulation" of this approach (*Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 768 (1992)) in *Abercrombie & Fitch Co.*, 537 F.2d at 9. Under the *Abercrombie & Fitch* degrees of distinctiveness, a non-generic mark may be—

- "descriptive," which is also not entitled to trademark protection unless it has also acquired "secondary meaning" (i.e., it "has become distinctive of the applicant's goods in commerce," 15 U.S.C. § 1052(e), (f));
- "suggestive," which suggests the product's nature or attributes;
- "arbitrary," the use of real words used in an unrelated context; or
- "fanciful," totally made-up terms.

See Abercrombie & Fitch, 537 F.2d at 9; *see also* Pierre N. Leval, *Trademark: Champion of Free Speech*, 27 Colum. J.L. & Arts 187, 191 (2004) (characterizing this spectrum as "a cone, point down," to "depic[t] the degree of legal muscle (or power to exclude) possessed by any particular mark").

These categories are legal constructs—judge-created rules that elaborate on the legal standard supplied by the statute. They assist judges and parties with the task of conceptualizing and applying the basic requirements of the statute, a statute that is itself grounded in the common law of trademarks. Indeed, this Court has recognized the *Abercrombie & Fitch* spectrum as the "classic" version of this test and applied it. *See*, *e.g.*, *Two Pesos*, 505 U.S. at 768 ("Marks are often classified in categories of generally increasing distinctiveness; following the classic formulation set out by Judge Friendly … ."); *Wal-Mart Stores, Inc. v. Samara Bros., Inc.*, 529 U.S. 205, 210-11 (2000) ("courts have applied the now-classic test originally formulated by Judge Friendly").

II. Trademark Strength Is The Kind Of Mixed Question Of Fact And Law That Merits Plenary Judicial Review

In *U.S. Bank, N.A. v. Village at Lakeridge, LLC*, 583 U.S. 387 (2018), this Court addressed the question of what standard of review should be applied to a bankruptcy court's finding that a creditor was a non-statutory "insider." In so doing, the Court noted that "a bankruptcy judge must tackle three kinds of issues—the first purely legal, the next purely factual, the last a combination of the other two." *Id.* at 393. The "first[,] purely legal" inquiry was the content of the legal test, *id.*; the second, "purely factual" question was "findings of what we have called 'basic' or 'historical' fact—addressing questions of who did what, when or where, how or why." *Id.* at 394. It was not disputed that those questions were to be reviewed *de novo* and for clear error, respectively. *Id.*

The dispute in *U.S. Bank* was over the standard of review for the third and final step—"whether the historical facts found satisfy the legal test." *Id.* And to answer this question, the Court looked to its precedents governing the appellate review of so-called mixed questions of fact and law. *See Pullman–Standard v. Swint*, 456 U.S. 273, 289 n.19 (1982); *Miller v. Fenton*, 474 U.S. 104, 114 (1985); *Salve Regina College v. Russell*, 499 U.S. 225, 231-33 (1991).

The Court in *U.S. Bank* concluded that the mixed question as to "insider" status was best treated as a factual question, reviewed deferentially, because "a raft of case-specific historical facts" had to be "consider[ed] as a whole, balance[d] one against another—all to make a determination that when two particular persons entered into a particular transaction, they were (or were not) acting like strangers." 583 U.S. at 397-98. "That is about as factual sounding as any mixed question gets." *Id.* at 397.

But "[m]ixed questions are not all alike." *Id.* at 395-96. "[S]ome require courts to expound on the law, particularly by amplifying or elaborating on a broad legal standard. When that is so—when applying the law involves developing auxiliary legal principles of use in other cases—appellate courts should typically review a decision *de novo*." *Id.* at 396 (citing *Salve Regina College*, 499 U.S. at 231-33).

That describes well the question of conceptual trademark strength. Unlike the question of "insider" status under the bankruptcy laws, which depended on so many case-specific determinations, the question of where a single mark falls on the *Abercrombie & Fitch* spectrum of distinctiveness is ideally suited for judicial determination. There are no questions of intent, no need to sift a multitude of facts—just a determination of how inherently distinctive a particular word or set of words is in labeling a product or service. *Cf. Markman v. Westview Instruments, Inc.*, 517 U.S. 370, 388 (1996) ("judges, not juries, are the better suited to find the acquired meaning of patent terms"). On the spectrum "between a pristine legal standard and a simple historical fact," *Miller v. Fenton*, 474 U.S. at 114, the question of trademark strength will fall much closer to the legal side than to the "multifarious, fleeting, special, narrow facts that utterly resist generalization" and thus merit deferential review. *Pierce v. Underwood*, 487 U.S. 552, 561-62 (1988). *See also* Restatement (Third) of Unfair Competition § 21 cmt. m ("The interpretation of the factors listed in this Section, such as the meaning of 'strength' and its substantive relevance to the likelihood of confusion, remain issues of law.").

Treating trademark strength as a primarily legal question will yield numerous benefits. For one, it will "best serv[e] the dual goals of doctrinal coherence and economy of judicial administration." *Salve Regina College*, 499 U.S. at 231. It will allow for the development of precedent that will guide future courts (and the agency that issues trademark registrations) in considering where on the distinctiveness spectrum a mark falls. Plus, it will help to ensure that different courts do not reach different conclusions with respect to a single mark's strength. And it will still allow room for deferential, clear-error (or substantial-evidence, in the case of motions for judgment as a matter of law) review of any necessary subsidiary findings of historical fact under "step two" of the *U.S. Bank* approach.

This Court's treatment of copyright law's fair-use doctrine should compel the same approach to questions of trademark distinctiveness. In *Google LLC v. Oracle America, Inc.*, 593 U.S. 1 (2021), this Court concluded that "whether th[e] facts showed a 'fair use' is a legal question for judges to decide de novo." *Id.* at 24. It reached this conclusion by looking to the "judge-made origins" of the copyright statute's fair-use provision, *id.* at 20 (citing 17 U.S.C. § 107, *Folsom v. Marsh*, 9 F. Cas. 342, 348 (No. 4,901) (C.C. D.Mass. 1841) (Story, J.), and *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569, 576 (1994)); the fact that the "ultimate 'fair-use' question primarily involves legal work" because it involves "a concept fashioned by judges," 593 U.S. at 24; and the desirability of "legal interpretations of the fair use provision [that] provide general guidance for future cases." *Id.* Each of these factors, which address fair use as a legal limitation on the exclusionary scope of a copyright, are likewise present when courts determine the distinctiveness of a mark, which similarly limns the exclusionary scope of an asserted trademark.

Further, this is the same adjudicative process that this Court directed for determining a patent's exclusionary scope. In *Teva Pharmaceuticals USA, Inc. v. Sandoz, Inc.*, 574 U.S. 318 (2015), this Court held that the determination of the exclusionary scope of a patent presents a legal question for the court, even though (in rare cases) there may be the need to resolve a "subsidiary factual dispute that helps that court determine the proper interpretation of the written patent claim. The district judge, after deciding the factual dispute, will then interpret the patent claim in light of the facts as he has found them. This ultimate interpretation is a legal conclusion." *Id.* at 332. The same approach makes sense for trademark adjudication, too: The determination of a mark's distinctiveness is, like the interpretation of a patent claim, a legal determination of the mark's "power to exclude." Leval, 27 Colum. J.L. & Arts at 191. *See also Booking.com*, 591 U.S. at 562.

For another, treating a mark's inherent strength as a predominantly legal question will provide an important and necessary bulwark against jury arbitrariness. As Judge Leval's opinion for the Second Circuit in the earlier appeal in this case recognized, factfinder discretion in determining "inherent strength is minimal at best." Pet. App. 55a-56a n.1; 41 F.4th 112, 122 n.1 (2d Cir. 2022). That is because the questions of whether a mark is "generic and unprotected" or "arbitrary or fanciful" are usually resolvable as a simple application of law to the undisputed fact of the content of the mark. *Id.* Treating trademark strength as a predominantly legal inquiry will allow judges to exercise these legal limitations in a more forthright manner before, during, and after jury consideration, through use of summary judgment under Rule 56 of the Federal Rules of Civil Procedure, or judgment as a matter of law under Rules 50(a) and 50(b).

As a practical matter, this is what appellate courts do when they address trademark-strength questions, even when they purport to be reviewing those questions as ones of fact. For example, in *Welding Services, Inc. v. Forman*, 509 F.3d 1351 (11th Cir. 2007) (cited at Pet. 11), the Eleventh Circuit said that "[d]istinctiveness is a question of fact" (*id.* at 1357), but affirmed a grant of summary judgment of no trademark infringement by making an independent judicial determination of trademark strength. *Id.* at 1361 ("While we decline to decide whether the logo was sufficiently distinctive to be protectable, we can say that at most the extent of stylization was marginal. The result is a weak mark, entitled to very little protection (if any)."). *See also Star Indus. v. Bacardi & Co.*, 412 F.3d 373, 383 (2d Cir. 2005) (purporting to apply clear-error review but disagreeing with district court's ruling that the plaintiff's "O" design was "a basic geometric shape or letter" lacking distinctiveness); *Investacorp, Inc. v. Arabian Inv. Banking Corp.*, 931 F.2d 1519, 1524 (11th Cir. 1991) (affirming grant of summary judgment because "the finding that 'Investacorp' is merely descriptive involved no genuine issue of material fact"); *Forum Corp. of N.A. v. Forum, Ltd.*, 903 F.2d 434, 438-39, 443-45 (7th Cir. 1990) (purporting to apply clear-error review but finding error in the district court's conclusion that "forum" is suggestive rather than descriptive, relying on no record evidence—only dictionary meanings—to so hold).

The First Amendment provides yet another important reason to treat trademark strength as a predominantly legal question. While trademark law can undoubtedly "play well with the First Amendment," *Jack Daniel's Properties, Inc. v. VIP Products LLC*, 599 U.S. 140, 159 (2023), it remains true that trademark-law-based restrictions are "content-based" and must be interpreted consistent with the constraints imposed by the First Amendment. Courts therefore must referee the application of trademark law to ensure that it indeed "play[s] well" with the First Amendment. *See Vidal v. Elster*, 602 U.S. 286, 295-301 (2024) (declining to "delineate an exhaustive framework for when a content-based trademark restriction passes muster under the First Amendment").

The determination of trademark strength intersects with the guarantees of the First Amendment's speech clause. Indeed, the very reason that "generic" or purely descriptive terms may not be given the exclusionary force of a trademark is that all persons should be free to call things by what they are or what they do. *See Abercrombie & Fitch*, 537 F.2d at 9 ("no matter how much money and effort the user of a generic term has poured into promoting the sale of its merchandise ..., it cannot deprive competing manufacturers of the product of the right to call an article by its name"); Lisa P. Ramsey, *Descriptive Trademarks and the First Amendment*, 70 Tenn. L. Rev. 1095, 1169 (2003) ("The First Amendment does not allow the government to grant and enforce exclusive rights in descriptive marks because they inherently convey information regarding the attributes of a product."). Likewise, this Court has held that the Lanham Act's prohibition on disparaging marks, 15 U.S.C. § 1052(a), violates the Free Speech Clause of the First Amendment. *Matal*, 582 U.S. at 223. That constitutional limitation is thus omnipresent in trademark disputes.

Consistent with the First Amendment's "rule of independent review," then, plenary judicial determination of questions of trademark strength will ensure that free-speech rights are respected at the same time that proper trademark rights are enforced.

U.S. Bank, 583 U.S. at 396 n.4 ("In the constitutional realm … we have often held that the role of appellate courts 'in marking out the limits of [a] standard through the process of case-by-case adjudication' favors *de novo* review even when answering a mixed question primarily involves plunging into a factual record."); *Bose Corp. v. Consumers Union of U.S., Inc.*, 466 U.S. 485, 499-501 (1984) ("Rule 52(a) does not inhibit an appellate court's power to correct errors of law, including those that may infect a so-called mixed finding of law and fact, or a finding of fact that is predicated on a misunderstanding of the governing rule of law."). The Solicitor General himself recognizes this principle, U.S. *Amicus* Br. at 18, even while denying its application in this case.

In the end, requiring courts to exercise independent, plenary review of the strength of a mark would break no new ground. The strength—distinctiveness—of a trademark is a predominantly legal question compelled by statute and expounded over the years by common-law adjudication. To the extent that any genuinely disputed questions of historical fact need to be determined in the course of making this evaluation of trademark strength, that can be accomplished by breaking the mixed question into its component parts, reviewing the factual component with the deference due under Rule 52(a) of the Federal Rules of Civil Procedure and the clear-error standard, and treating the ultimate question of trademark strength as one deserving of plenary judicial determination and review.

CONCLUSION

For these reasons, the Court should conclude that trademark strength presents a mixed question of fact and law in which the legal component of the question predominates.

SEPTEMBER 15, 2026

Respectfully submitted,

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APPENDIX

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