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 *AMICUS CURIAE* INTERNATIONAL TRADEMARK ASSOCIATION IN SUPPORT OF NEITHER PARTY

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STATEMENT OF INTEREST OF THE *AMICUS CURIAE*

The International Trademark Association ("INTA") submits this brief in support of neither party.[1]

INTEREST OF *AMICUS CURIAE*

Founded in 1878, *amicus curiae* INTA (formerly known as the United States Trademark Association) is a not-for-profit organization dedicated to the support and advancement of trademarks and related intellectual-property concepts as essential elements of trade and commerce. INTA has more than 7,200 members in 191 countries. Its members include trademark owners as well as law firms and other professionals who regularly assist brand owners in the creation, registration, protection, and enforcement of their trademarks. All INTA members share the goal of promoting an understanding of the essential role that trademarks play in fostering effective commerce, fair competition, and informed decision-making by consumers.

INTA was founded in part to encourage the enactment of federal trademark legislation after the invalidation on constitutional grounds of the United States' first trademark act. Since then, INTA has been instrumental in making recommendations and providing assistance to legislators in connection with major trademark legislation.

1. This brief was authored solely by INTA and its counsel. No party or counsel for a party made a monetary contribution intended to fund the preparation or submission of this brief. No person other than *amicus curiae*, its members, and its counsel made such a monetary contribution to its preparation or submission. *See* S. Ct. R. 37.6.

INTA's members frequently are plaintiffs, defendants, and advisors in legal actions under the U.S. Trademark (Lanham) Act, including matters involving claims of trademark infringement and unfair competition. INTA is interested in the development of clear, consistent, and equitable principles of trademark law. INTA has participated as *amicus curiae* in numerous cases involving significant trademark issues.[2]

2. Cases in which INTA has filed *amicus* briefs include: *Dewberry Grp., Inc. v. Dewberry Eng'rs Inc.*, 604 U.S. 321 (2025); *Vidal v. Elster*, 602 U.S. 286 (2024); *Jack Daniel's Props., Inc. v. VIP Prod. LLC*, 599 U.S. 140 (2023); *Abitron Austria GmbH v. Hetronic Int'l, Inc.*, 600 U.S. 412 (2023); *U.S. Pat. & Trademark Off. v. Booking.com B. V.*, 591 U.S. 549 (2020); *Romag Fasteners, Inc. v. Fossil, Inc.*, 590 U.S. 212 (2020); *Peter v. Nantkwest, Inc.*, 589 U.S. 23 (2019); *Iancu v. Brunetti*, 588 U.S. 388 (2019); *Mission Prod. Holdings, Inc. v. Tempnology, LLC*, 587 U.S. 370 (2019); *Fourth Estate Pub. Benefit Corp. v. Wall-Street.com, LLC*, 585 U.S. 1029 (2018); *Matal v. Tam*, 582 U.S. 218 (2017); *Hana Fin., Inc. v. Hana Bank*, 574 U.S. 418 (2015); *B&B Hardware, Inc. v. Hargis Indus., Inc.*, 575 U.S. 138 (2015); *Pom Wonderful LLC v. Coca-Cola Co.*, 573 U.S. 102 (2014); *Already, LLC v. Nike, Inc.*, 568 U.S. 85 (2013); *KP Permanent Make-Up, Inc. v. Lasting Impression I, Inc.*, 543 U.S. 111 (2004); *Dastar Corp. v. Twentieth Century Fox Film Corp.*, 539 U.S. 23 (2003); *Moseley v. V Secret Catalogue, Inc.*, 537 U.S. 418 (2003); *TrafFix Devices, Inc. v. Mktg. Displays, Inc.*, 532 U.S. 23 (2001); *Wal-Mart Stores, Inc. v. Samara Bros.*, 529 U.S. 205 (2000); *Fla. Prepaid Postsecondary Educ. Expense Bd. v. Coll. Sav. Bank*, 527 U.S. 627 (1999); *Dickinson v. Zurko*, 527 U.S. 150 (1999); *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159 (1995); *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763 (1992); *K Mart Corp. v. Cartier, Inc.*, 486 U.S. 281 (1988); *see also, e.g.*, *Shammas v. Focarino*, 784 F.3d 219 (4th Cir. 2015); *Ferring B.V. v. Watson Labs., Inc.-Fla.*, 764 F.3d 1382 (Fed. Cir. 2014); *Christian Louboutin S.A. v. Yves Saint Laurent Am. Holding, Inc.*, 696 F.3d 206 (2d Cir. 2012).

When determining whether an alleged trademark infringer's use "is likely to cause confusion" under 15 U.S.C. § 1114, courts in every circuit apply a multifactor test, including an assessment of the trademark's strength. Twelve circuits consider trademark strength an issue of fact. The Second Circuit considers it a question of law. This case presents the question of whether trademark strength is a question of fact in a likelihood of confusion analysis under 15 U.S.C. § 1114. INTA and its members have a particular interest in this case because enforcement of trademark rights is critical for brand owners to preserve goodwill in their trademarks.

In this case, INTA takes no position on whether Petitioner or Respondent should prevail on the merits. INTA does take a position on the question presented: It urges this Court to hold 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 regarding the strength of the mark must be decided by a jury.

SUMMARY OF THE ARGUMENT

The Second Circuit stands alone as the only circuit that treats any component of the "strength of the mark" analysis as a pure legal issue. The Second Circuit's recent holding that the conceptual strength prong of the strength-of-the-mark analysis is a question of law, not fact, is out of step with Supreme Court precedent. Fact-intensive questions—like an ordinary consumer's perception of a trademark, the crowdedness of a field of third-party marks, and the strength of a trademark—are traditionally and correctly considered questions for a factfinder. *Hana Fin., Inc. v. Hana Bank*, 574 U.S. 418, 422 (2015) ("Application 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. Indeed, we have long recognized across a variety of doctrinal contexts that, when 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.").

While courts may reasonably differ as to the methods and considerations to be used to analyze the strength of a trademark, each of those considerations involves a fact-intensive analysis and thus is a question for a factfinder. The Court should hold that when the facts do not involve equitable relief alone or warrant the entry of summary judgment or judgment as a matter of law, the question regarding the strength of the mark must be decided by a jury. This is especially true when a jury trial has been requested.

ARGUMENT

A. Most Fundamental Questions in Trademark Law Are Questions of Fact

As this Court held in *Hana Bank*, "[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." *Hana Fin.*, 574 U.S.at 422. In evaluating such questions, the factfinder's function is to determine the perception of the purchasing public. *Lane Cap. Mgmt., Inc. v. Lane Cap. Mgmt., Inc.*, 192 F.3d 337, 344 (2d Cir. 1999). Noted trademark scholar J. Thomas

McCarthy observes that "most issues in trademark law" present "a question of fact to be determined from the perspective of the ordinary purchaser." 2 McCarthy on Trademarks and Unfair Competition § 17:26 (5th ed.).

Consistent with this principle, the most fundamental issues in trademark law turn on the perceptions of ordinary consumers, an inquiry generally entrusted to the factfinder. *See, e.g.*, *United States Pat. & Trademark Off. v. Booking.com B.V.*, 591 U.S. 549, 560 (2020) ("whether a term is generic depends on its meaning to consumers."); *Peoples Fed. Sav. Bank v. People's United Bank*, 672 F.3d 1, 15 (1st Cir. 2012) ("whether a term is generic… is a question of fact."); *In re Miracle Tuesday, LLC*, 695 F.3d 1339, 1343 (Fed. Cir. 2012) ("Whether a mark is primarily geographically deceptively misdescriptive is a question of fact."); *Elvis Presley Enters., Inc. v. Capece*, 141 F.3d 188, 202 (5th Cir. 1998) ("Consumer perception is the controlling factor" in assessing "whether the junior user's market is one into which the senior user would naturally expand."); *Lane Capital*, 192 F.3d at 345 ("Whether a mark is primarily merely a surname is a question of fact."); *Fun-Damental Too, Ltd. v. Gemmy Indus. Corp.*, 111 F.3d 993, 1002 (2d Cir. 1997) ("Whether a trade dress is or is not functional is a question of fact…"); *Star-Kist Foods, Inc. v. P.J. Rhodes & Co.*, 769 F.2d 1393, 1396 (9th Cir. 1985) ("[Abandonment] is a factual issue, well within the domain of the district court…").

Courts assess the strength of a mark by considering both its conceptual strength, which reflects its degree of inherent distinctiveness, and its commercial strength, which reflects its recognition in the marketplace. All circuit courts follow this two-prong approach. 1 McCarthy

§ 11:80. As to the commercial strength prong, the circuit courts universally treat secondary meaning as a question of fact, not of law. McCarthy § 15:29 ("Whether or not a designation has acquired secondary meaning is a question of fact, not an issue of law"); *see also Flynn v. AK Peters, Ltd.*, 377 F.3d 13, 19 (1st Cir. 2004) ("The establishment of secondary meaning in a word is an issue of fact…" (citation omitted)); *Arrow Fastener Co. v. Stanley Works*, 59 F.3d 384, 393 (2d Cir. 1995) ("Whether secondary meaning has attached to a mark is a question of fact."); *Dranoff-Perlstein Assocs. v. Sklar*, 967 F.2d 852, 862 (3d Cir. 1992) ("The existence of secondary meaning and likelihood of confusion are questions of fact."); *Appliance Liquidation Outlet, L.L.C. v. Axis Supply Corp.*, 105 F.4th 362, 376–77 (5th Cir. 2024) ("Whether a mark has acquired secondary meaning is a question of fact." (citation omitted)); *Uncommon, LLC v. Spigen, Inc.*, 926 F.3d 409, 424 (7th Cir. 2019) ("Secondary meaning, like descriptiveness, is a question of fact…"); *OpenAI, Inc. v. Open A.I., Inc.*, No. 24-1963, 2024 WL 4763687, at *1 (9th Cir. Nov. 13, 2024) ("Whether a mark has secondary meaning is a question of fact reviewed for clear error."); *FN Herstal SA v. Clyde Armory Inc.*, 838 F.3d 1071, 1084 (11th Cir. 2016) ("Distinctiveness and the existence of secondary meaning are questions of fact…" (internal quotation marks omitted)).

That all circuits treat the commercial strength prong as a question of fact is unsurprising, as this analysis considers, among other things, advertising expenditures, sales data, exclusivity, and length of use. *See, e.g., Boston Duck Tours, LP v. Super Duck Tours, LLC*, 531 F.3d 1, 23, 87 U.S.P.Q.2d 1385 (1st Cir. 2008) ("[T]he commercial strength of [a] mark…is assessed by examining the length of time the mark has been used, the trademark holder's renown in the industry, the potency of the mark in the product field (as measured by the number of similar registered marks), and the trademark holder's efforts to promote and protect the mark…" (internal quotation marks omitted)); *Ford Motor Co. v. Summit Motor Prods., Inc.*, 930 F.2d 277, 292 (3d Cir. 1991) ("A non-exclusive list of factors which may be considered includes the extent of sales and advertising leading to buyer association, length of use, exclusivity of use, the fact of copying, customer surveys, customer testimony, the use of the mark in trade journals, the size of the company, the number of sales, the number of customers, and actual confusion."); *Fortune Dynamic, Inc. v. Victoria's Secret Stores Brand Mgmt., Inc.,* 618 F.3d 1025, 1034-35 (9th Cir. 2010) (evidence of sales and advertising expenses "is sufficient to make the relative commercial strength of [a] mark a question for the jury."). Even the Second Circuit treats commercial strength as a question of fact. *See Guthrie Healthcare Sys. v. ContextMedia, Inc.*, 826 F.3d 27, 37-38 (2d Cir. 2016) (the Court "generally review[s] determinations as to individual *Polaroid* factors for clear error, at least to the extent they involve factual determinations," and noting only that "determinations as to whether the senior user's mark is sufficiently fanciful or arbitrary … to be deemed a strong mark, or in contrast, merely identifies or describes the senior user's commerce so as to be unenforceable or weak" "may involve issues of law.").

B. Conceptual Strength is a Fundamental Question That Should Also Be Treated As A Question of Fact

As this Court noted in *U.S.P.T.O. v. Booking.com B. V.,* 591 U.S. 549, 563 & 563 n.6, 140 S. Ct. 2298, 207 L. Ed. 2d

738 (2020), conceptual strength concerns the placement of the mark on the so-called "spectrum of distinctiveness," and its identification as either generic, descriptive, suggestive, arbitrary, or fanciful. Determining inherent strength likewise requires a factual analysis, including parsing the meaning of words in the mark and how reasonable consumers may perceive the term. *Id.* In *Booking.com*, this Court noted (in the context of the related inherent distinctiveness analysis):

> Whether any given 'generic.com' term is generic, we hold, 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. And as noted in n6:

> Evidence informing that inquiry can include… dictionaries, usage by consumers and competitors, and any other source of evidence bearing on how consumers perceive a term's meaning,

Id.

The Second Circuit's approach to the conceptual strength prong is ambiguous at best, as circuit precedent even in the Second Circuit has repeatedly treated a mark's placement on the spectrum of distinctiveness—a key aspect of conceptual strength—as a factual matter. *See Fun-Damental Too, Ltd. v. Gemmy Indus. Corp.*, 111 F.3d 993, 1001 (2d Cir. 1997) ("Classification under the *Abercrombie* spectrum of distinctiveness is a question of fact reviewed under the clearly erroneous standard"); *Lane Cap. Mgmt., Inc. v. Lane Cap. Mgmt., Inc.*, 192 F.3d 337, 344 (2d Cir. 1999) ("The classification of a mark is a factual question. The factual issue presented is how the purchasing public views the mark."); *Hasbro, Inc. v. Lanard Toys, Ltd.*, 858 F.2d 70, 74 (2d Cir. 1988) ("[I]t is [consumers'] perception that determines whether a mark is descriptive or suggestive."). The court below acknowledged this precedent but effectively dismissed it by asserting "that there is an undeniable legal element in the determination of how much strength a given mark commands." *RiseandShine Corp. v. PepsiCo, Inc.*, 41 F.4th 112, 121–22 (2d Cir. 2022). The Second Circuit's approach here conflicts with all other circuits.

Because of the factual nature of the inquiry (as discussed above), each circuit court agrees that the core of conceptual strength analysis—*i.e.*, the categorization of the mark as generic, descriptive, suggestive, arbitrary, or fanciful—is a question of fact. *See, e.g.*, *Peoples Fed. Sav. Bank v. People's United Bank*, 672 F.3d 1, 15 (1st Cir. 2012) ("[T]he district court's determination as to whether a term is generic, descriptive, or inherently distinctive is a question of fact."); *E.T. Browne Drug Co. v. Cococare Prods., Inc.*, 538 F.3d 185, 192 (3d Cir. 2008) ("Whether [a mark] is generic or descriptive, and whether that term has acquired secondary meaning, are questions of fact."); *Soweco, Inc. v. Shell Oil Co.*, 617 F.2d 1178, 1183 (5th Cir. 1980) ("Any given term's correct categorization is a factual issue."); *In re N. Carolina Lottery*, 866 F.3d 1363, 1368 (Fed. Cir. 2017) ("Placement of a term on the continuum [of distinctiveness] is a question of fact.").[3]

3. The factual inquiry may be impacted by legal considerations, but that does not change its essential nature as a question of fact.

The Second Circuit is the only circuit that treats any part of the strength-of-the-mark analysis as a legal question. That court breaks the analysis into two steps, first placing the mark onto the spectrum of distinctiveness and then looking at marketplace evidence to determine its "intra-category" strength. But the Second Circuit's treatment of the conceptual strength analysis as a question of law is an anomaly even under Second Circuit law, which treats every other element of the likelihood of confusion test as a question of fact. *See Guthrie*, 826 F.3d at 37-8 (the Court "generally review[s] determinations as to individual Polaroid factors for clear error, at least to the extent they involve factual determinations").

The evidence underlying the conceptual strength analysis (including the evidence the Second Circuit considered in determining that the "RISE" trademark is conceptually weak) confirms that the inquiry is factual. The Second Circuit based its decision upon marketplace evidence demonstrating that the relevant field was crowded. Multiple third-party brands used similar marks, and in turn, that Respondent's mark was conceptually weak. *See* 41 F.4th at 123 ("Now, having registered its trademark, Plaintiff argues that there is no such room for multiple 'Rise' marks to coexist peacefully, even outside

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For instance, the trademark may be protected by a registration that enjoys incontestable status, meaning that it cannot be attacked on grounds that it is merely descriptive. 15 U.S.C. §1065. Or determination as to the mark's level of distinctiveness may have been made at the USPTO and subject to issue preclusion in later litigation. *See B & B Hardware, Inc. v. Hargis Indus., Inc.*, 575 U.S. 138, 135 S. Ct. 1293, 191 L. Ed. 2d 222 (2015). In neither event would the underlying factual issue be treated purely an issue of law.

the coffee sector. That is not persuasive. If there was room for Plaintiff's use of 'Rise' in the already crowded coffee field, there would also be room for Defendant's, especially on a product that is distinct from coffee." *See also A & H Sportswear, Inc. v. Victoria's Secret Stores, Inc.*, 237 F.3d 198, 222 (3d Cir. 2000) (assessing crowdedness of the field as part of conceptual strength analysis); *Variety Stores, Inc. v. Wal-Mart Stores, Inc.*, 888 F.3d 651, 662 (4th Cir. 2018) ("[T]he frequency of prior use of a mark's text in other marks, particularly in the same field of merchandise or service, illustrates the mark's lack of conceptual strength."). Determining whether a field is crowded is not an abstract legal exercise. It requires a factfinder to examine how consumers view the marketplace evidence and answer a series of inherently factual questions: What third-party marks actually exist? How extensive is the use by each such party? How similar are those marks to the plaintiff's mark? What goods or services are they used on? Are those goods or services sufficiently related to the parties' goods or services to bear on the strength of the plaintiff's mark? And ultimately, how does the existence of multiple third-party marks impact consumer perception of the plaintiff's mark?

Such inquiries turn on evidence. A court cannot determine whether a marketplace is crowded without first determining what marks are present in that marketplace and how they are used. Nor can it determine whether those marks diminish the conceptual strength of the plaintiff's mark without evaluating their similarity and their relationship to the relevant goods or services. Those are precisely the kinds of factual determinations that courts routinely leave to factfinders. For example, the Third and Fourth Circuits consider this type of marketplace evidence in evaluating conceptual strength. *See, e.g.*, *A & H Sportswear, Inc. v. Victoria's Secret Stores, Inc.*, 237 F.3d 198, 222 (3d Cir. 2000); *Variety Stores, Inc. v. Wal-Mart Stores, Inc.*, 888 F.3d 651, 662 (4th Cir. 2018). The widespread consideration of third-party marks underscores the factual nature of the inquiry. Conceptual strength does not turn solely on a dictionary definition or on a categorical legal label assigned to the mark. It turns ultimately on what the mark means to consumers. Consumer perception is a question of fact subject to the rules of evidence and burdens of proof that vary in different contexts. Indeed, the very premise of the Second Circuit's analysis demonstrates why it cannot properly be characterized as a question of law. The Second Circuit's conclusion depended on what existed in the marketplace and what those third-party uses meant for the strength of Petitioner's RISE mark. But the existence, similarity, and commercial context of those third-party uses are matters established through evidence. A court deciding those questions is not applying a legal rule; it is instead evaluating evidence and drawing factual inferences from it.

Unless there are no material facts in dispute, whether a particular term is suggestive, descriptive, or otherwise weak in relation to particular goods or services cannot typically be determined in the abstract. It requires consideration of the relationship between the term and the goods or services for which it is used. That analysis is fundamentally the same type of factual inquiry that courts already undertake when placing a mark on the distinctiveness spectrum. *See United States Pat. & Trademark Off. v. Booking.com B.V.*, 591 U.S. 549, 560-61 (2020) (holding that categorization of a mark's conceptual strength depends on how consumers "in fact perceive" the mark).

C. The Second Circuit's Approach Is Internally Inconsistent

Not only is the Second Circuit decision below at odds with all other circuit courts to have considered the issue, but it is contrary to the Second Circuit's own precedent.[4] In the seminal case, *Polaroid Corp. v. Polarad Elecs. Corp.*, 287 F.2d 492 (2d Cir. 1961), the Second Circuit identified the subsidiary likelihood of confusion factors to consider in assessing trademark infringement. In so doing, it treated all factors alike, including strength of the mark. Although the test was originally formulated for cases "[w]here the products are different," sixty-five years

4. The application of the correct standard of conceptual strength may not be determinative. Regardless of whether the conceptual strength analysis is one step or two, all circuit courts would agree with the Second Circuit that "labeling a mark as 'suggestive' is not the end of the inquiry[,]" *see RiseandShine Corp. v. PepsiCo, Inc.*, 41 F.4th 112, 121 (2d Cir. 2022) (citing *Lang v. Ret. Living Publ'g Co.*, 949 F.2d 576, 581 (2d Cir. 1991)), because courts then need to engage in the commercial/marketplace strength analysis. All circuit courts would also agree with the Second Circuit that "a finding of suggestiveness does not guarantee a determination that the mark is a strong one[,]" because a suggestive mark could still be commercially weak. *Id.* at 121 (quoting *W.W.W. Pharm. Co. v. Gillette Co.*, 984 F.2d 567, 572 (2d Cir. 1993)); *see also Future Proof Brands, L.L.C. v. Molson Coors Beverage Co.*, 982 F.3d 280, 290 (5th Cir. 2020) ("[C]lassification of the mark on the spectrum is 'not conclusive of strength, … [because] a descriptive mark through vigorous promotion can become a strong mark, and an arbitrary mark that is not well known in the market can be a weak mark.'" (second alteration in original) (citation omitted)).

later the multi-factor test is now applied in essentially all trademark cases in every jurisdiction (hence adding significance to the Second Circuit's unique treatment of one factor unlike all such other jurisdictions). Said the court:

> … the prior owner's chance of success is a function of many variables: the strength of his mark, the degree of similarity between the two marks, the proximity of the products, the likelihood that the prior owner will bridge the gap, actual confusion, and the reciprocal of defendant's good faith in adopting its own mark, the quality of defendant's product, and the sophistication of the buyers. Even this extensive catalogue does not exhaust the possibilities — the court may have to take still other variables into account. American Law Institute, Restatement of Torts, §§ 729, 730, 731.

287 F.2d at 495.

Until recently, the Second Circuit continued to treat all the *Polaroid* factors as factual in nature. Apparently, the first case to rule that the issue of strength of the mark is a matter of law was *City of N.Y. by & through FDNY v. Henriquez*, 98 F.4th 402, 413 (2d Cir. 2024), which stated, citing (or mis-citing) *Tiffany & Co. v. Costco Wholesale Corp.*, 971 F.3d 74, 86 n.7 (2d Cir. 2020), that: "The marks' inherent strength is a legal question." However, what *Tiffany & Co.* actually noted was that prior trademark cases involving summary judgment, "should not be read to suggest that a district court deciding a motion for summary judgment in a trademark infringement case has ... greater discretion than it would have in a non-trademark case to resolve disputed issues of fact or draw inferences against the non-moving party." 971 F.3d at 85 (internal quotation marks and citations omitted). Specifically, the Second Circuit in *Tiffany & Co.* remarked:

> As in any other area of law, then, "[i]f a factual inference must be drawn to arrive at a particular finding on a *Polaroid* factor, and if a reasonable trier of fact could reach a different conclusion, the district court may not properly resolve that issue **on summary judgment**." *Cadbury Beverages, Inc. v. Cott Corp.*, 73 F.3d 474, 478 (2d Cir. 1996); *see also Anderson v. Liberty Lobby, Inc.*, 477 U.S. 242, 249 (1986) ("**[A]t the summary judgment stage** the judge's function is not himself to weigh the evidence and determine the truth ... but to determine whether there is a genuine issue for trial.").

Id. at 86 (alteration in original) (emphasis added.)

The strength of the mark TIFFANY was not even an issue on appeal in *Tiffany & Co.*, and it was merely in a footnote where the court stated (in dicta) that "there is a considerable component of law in the determination whether a mark has the degree of strength necessary to weigh in favor of the party claiming infringement." *Id.* at 86 n. 7 (quoting *Patsy's Brand, Inc. v. I.O.B. Realty, Inc.*, 317 F.3d 209, 216 (2d Cir. 2003)). In footnote seven, the Second Circuit cited *Patsy's Brand*, but neither *Patsy's*

Brand[5] nor *Tiffany & Co.* clarified what component of law was implicated in assessing strength of a mark, and the court appended that footnote to its statement in the text that "… **insofar as** the determination of whether one of the *Polaroid* factors favors one party or another involves a legal judgment—which it often does—we must review that determination *de novo*." *Id.* at 86 (emphasis added). Thus, not only was the court's comment in *Tiffany & Co.* simply *dicta* as part of the court's review of the summary judgment standard, its use of the phrase "insofar as" further limits the breadth of the entire brief discussion to the contingent context in which, "in some cases" one factor outweighs the others.

Lacking any specific guidance in either *Patsy's Brand* or *Tiffany & Co.*, a fair inference is that the component of law implicated in assessing strength the courts had in mind was application of the test from *Abercrombie & Fitch Co. v. Hunting World, Inc.*, 537 F.2d 4, 9 (2d Cir. 1976), distinguishing four levels of strength. Regardless, *City of N.Y. by & through FDNY* simply transformed highly factually contingent dicta from *Tiffany & Co.* and *Patsy's Brand,* that strength sometimes *involves* a legal judgment, not that it *is* a legal judgment, into a new rule of law.

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5. In *Patsy's Brand,* the Court discussed the appropriate level of deference given to a district court's subsidiary conclusions as to each *Polaroid* factor in the context of a summary judgment motion. Solely in this limited context, the Court observed that some subsidiary conclusions are afforded less deference than others, citing strength of the mark as an example. 317 F.3d at 215–16.

Contrary to the sweeping statements in *City of N.Y. by & through FDNY* and *RiseandShine Corp.* that strength of a mark is a legal issue, other Second Circuit precedent—never expressly overturned—held that strength of a mark is an issue of fact. In *Star Indus., Inc. v. Bacardi & Co.*, 412 F.3d 373, 382 (2d Cir. 2005), the Second Circuit concluded that "[a] district court's findings that a mark is not protectable as inherently distinctive is a finding of fact that we generally review for clear error." (citing *Bristol–Myers Squibb Co. v. McNeil–P.P.C., Inc.*, 973 F.2d 1033, 1039–40 (2d Cir. 1992)).[6] *DC Comics, Inc. v. Reel Fantasy, Inc.*, 696 F.2d 24, 26–27 (2d Cir. 1982), cited in *RiseandShine Corp. v. PepsiCo, Inc.*, No. 23-1176-cv, 2024 WL 5165388, at *2 (2d Cir. Dec. 19, 2024) (summary order), was similar.[7] As noted, *Tiffany & Co.* did not purport to overrule any of these cases and *City of N.Y. by & through FDNY* overstated the ruling in *Tiffany & Co.* Moreover, in dismissing as unpersuasive cases cited by *RiseandShine*

6. *Bristol–Myers Squibb Co.* reviewed precedent from other circuits and concluded, in the context of reviewing a preliminary injunction motion, "[w]e agree with these courts that the initial classification of a mark to determine its eligibility for protection is a question of fact left to the determination of the district court." 973 F.2d at 1039–40.

7. *DC Comics, Inc.* noted that "[t]his determination [of likelihood of confusion] in turn depends upon a number of factual variables such as '(1) the strength of the plaintiff's mark, (2) the degree of similarity between the two marks, (3) the proximity of the products or services, ... (4) the defendant ['s] good faith in adopting its mark,' *id.*, as well as the existence of actual confusion and the sophistication of the consumers of the products or services." 696 F.2d at 26 (second alteration in original) (quoting *Polaroid Corp.*, 287 F.2d at 495 (2d Cir.), *cert. denied*, 368 U.S. 820 (1961)).

that strength is a question of fact, the Second Circuit in *RiseandShine* may have violated the rule that only an *en banc* decision by a circuit court can overrule a prior circuit court decision. In *RiseandShine*, the Second Circuit expressly acknowledged the court's own past precedent but declined to address the conflict, simply citing the court's more recent decisions to the contrary. 2024 WL 5165388 at *2. Because no *en banc* panel of the Second Circuit has ever overruled *Star Indus., Inc.* or other like cases, those cases should remain controlling over later Second Circuit decisions to the extent they are inconsistent. *See Matthews v. Barr*, 927 F.3d 606, 614 (2d Cir. 2019); *Shipping Corp. of India Ltd. v. Jaldhi Overseas Pte Ltd.*, 585 F.3d 58, 61, 67 (2d Cir. 2009).

Even assuming the Second Circuit ultimately reached the correct substantive conclusion that Respondent's mark is weak, the decision below provides no adequate basis for treating one portion of the conceptual strength analysis as factual and another as legal. The distinction cannot be justified merely by labeling one inquiry "conceptual" and another "legal." When determining whether a mark is weak because consumers encounter numerous similar marks in the marketplace, the factfinder must evaluate evidence concerning the number and nature of those marks, their similarity, the goods or services with which they are used, and the significance of those uses to consumers. Trademark law routinely requires courts and juries to make factual determinations that ultimately bear on legal conclusions. The Second Circuit's approach also creates an artificial distinction between conceptual and commercial strength. Both inquiries ask fundamentally factual questions about the strength of a mark in the marketplace, and both may depend on overlapping categories of evidence. Commercial strength is unquestionably informed by factual evidence. The same reasoning applies to conceptual strength. Those disputes are particularly ill-suited to resolution as abstract questions of law.

The established allocation of factfinding authority supports treating the entire conceptual strength inquiry as factual. The better approach is therefore to treat conceptual strength as a factual inquiry in its entirety. That approach is consistent with the nature of the evidence, the role conceptual strength plays in the broader likelihood of confusion analysis, and the ordinary division between questions of law and questions of fact. A question is not transformed into a question of law merely because it appears within a doctrinal framework established by courts. The relevant distinction is between determining what the facts are and applying a governing legal rule to those facts. Conceptual-strength questions generally require the former.

D. Courts Will Continue to Decide Strength of the Trademark For Appropriate Motion Practice

The Federal Rules of Civil Procedure establish Article III courts as gatekeepers by differentiating between motions where issues of fact are in dispute or where only equitable relief is sought. For example, on a motion to dismiss pursuant to Fed.R.Civ.P. 12(b)(6), the District Court must accept all well-pleaded factual allegations as true.[8] Where plaintiffs seek equitable injunctive relief under Fed.R.Civ.P. 65, courts weigh the facts and the law

8. Fed.R.Civ.P. 12(b).

in rendering decisions.[9] Fed.R.Civ.P. 65(a)(2) recognizes how a judge's role as a factfinder in the first instance on a preliminary injunction does not vitiate any party's right to a jury trial: "Before or after beginning the hearing on a motion for a preliminary injunction, the court may advance the trial on the merits and consolidate it with the hearing. Even when consolidation is not ordered, evidence that is received on the motion and that would be admissible at trial becomes part of the trial record and need not be repeated at trial. ***But the court must preserve any party's right to a jury trial***." Fed.R.Civ.P. 65(a)(2) (emphasis added).[10] Similarly, a District Court judge's decision on a motion for summary judgment under Fed.R.Civ.P. 56 does not violate the constitutional right to a jury trial if there are no disputed material issues of fact. Consequently, a District Court judge may decide the strength of mark element on a motion to dismiss, for preliminary injunctive relief, or summary judgment without undermining a party's right to a jury trial.[11]

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9. As the Supreme Court noted in *Chauffeurs, Teamsters & Helpers, Local No. 391 v. Terry*, 494 U.S. 558, 564-65 (1990), the Seventh Amendment confers a right to a trial by jury only for suits "which are not of equity"; *see also Dairy Queen, Inc. v. Wood*, 369 U.S. 469, 471-73 (1962); *Am. Cyanamid Co. v. Sterling Drug, Inc.*, 649 F. Supp. 784, 785-77 (D. N.J. 1986).

10. If the parties have opted to try their case before a judge and waived their rights to a jury trial, or if the relief sought is only equitable in nature, the judge may decide a strength of mark question in his or her fact-finding capacity.

11. Federal Rule of Civil Procedure 50 permits a District Court to rule where "a reasonable jury would not have a legally sufficient evidentiary basis to find for the party on that issue." Fed. R. Civ. P. 50(a)(1).

In *Dairy Queen, Inc. v. Wood*, arising out of the termination of a license to use the DAIRY QUEEN trademark and resulting infringement, this Court held that where respondents' claim was for a money judgment "it would be difficult to conceive of an action of a more traditionally legal character. And as an action for damages based upon a charge of trademark infringement, it would be no less subject to cognizance by a court of law." 369 U.S. at 477. As such, the entire claim was subject to the right to jury trial under the Seventh Amendment to the Constitution. *Id.* The Court made clear that the Constitution and *Beacon Theatres* requires that any legal issues for which a trial by jury is timely and properly demanded be submitted to a jury." *Id.* at 472-73. Courts of course continue to recognize the right to a jury trial on the issue of trademark infringement so long as a legal remedy such as damages or royalties are sought. *See Hard Candy, LLC v. Anastasia Beverly Hills, Inc.*, 921 F.3d 1343, 1354 (11th Cir. 2019).

The Second Circuit's anomalous approach is contrary to the structure established by Federal Rules of Civil Procedure 12(b), 56, and 65, and would require courts to treat all elements of the likelihood of confusion analysis *except* one aspect of one sub-element of one element of the likelihood of confusion analysis as factual questions. This would not only complicate administration of the Federal Rules but also create an untenable situation where, a District Court would not be required to preserve a party's right to a jury trial or vest the jury with authority to decide the conceptual strength analysis, because it is a legal question within the exclusive province of the court.[12]

12. It is unclear, under the Second Circuit's approach as set forth in *RiseandShine*, whether the District Court or the jury

All of the other likelihood of confusion factors, including the commercial strength analysis, would be issues subject to a party's right to a jury trial. Moreover, a jury's infringement verdict could therefore be overruled by a District Court simply because the judge disagrees with the jury's determination of whether the mark at issue is conceptually strong or weak.

The Second Circuit's 2022 and 2024 decisions in *RiseandShine* mask these implications because the Second Circuit was assessing the district court's decisions at the preliminary injunction and then summary judgment stages, but those procedural circumstances do not justify the Second Circuit's approach. *See Tiffany & Co. v. Costco Wholesale Corp.*, 971 F.3d at 86. The Second Circuit's reversal of the District Court's strength of mark determination on the preliminary injunction should control at the summary judgment stage only if the facts concerning strength of mark were undisputed by the parties. The Second Circuit's substitution of its own judgment for the District Court's judgment in the 2022 preliminary injunction decision is unwarranted regardless of context and entirely unworkable given the parties' right to a jury trial.

E. Conclusion

The Court should hold that, when a jury trial has been requested and when the facts do not warrant entry

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would have the task of assessing the conceptual strength of the trademark and the commercial strength of the trademark. Either way, dividing the roles between the judge and the jury would be difficult to administer for the court and would be confusing to the jury.

of the summary judgment or judgment as a matter of law, the question regarding the strength of the mark must be decided by a jury.

Respectfully submitted,

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