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 FOR RESPONDENT

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PARTIES TO THE PROCEEDING AND RULE 29.6 CORPORATE DISCLOSURE STATEMENT

Petitioner RiseandShine Corporation, d/b/a Rise Brewing, was the sole plaintiff in the district court and the sole appellant in the court of appeals. Respondent PepsiCo, Inc. was the sole defendant in the district court and the sole appellee in the court of appeals.

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

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INTRODUCTION

RiseandShine brought this trademark suit on the strained theory that PepsiCo's 16-ounce fruit-flavored energy drink "MTN DEW RISE ENERGY" is likely to be confused with RiseandShine's 7-ounce cans of "RISE BREWING CO." cold-brew coffee sold using different labels, colors, and iconography. Its case rests almost entirely on both products' use of the everyday word "rise." Yet RiseandShine repeatedly represented, including to the U.S. Patent and Trademark Office, that third-party use of the word "rise" made the term "extremely weak" with "little source identifying significance that could contribute to any likelihood of confusion." RiseandShine filed suit anyway.

A district court granted a preliminary injunction, but the Second Circuit vacated it in a scholarly opinion by Judge Leval (joined by Judges Chin and Menashi). On the inherent-strength subfactor of the court's eight-factor likelihood-of-confusion test, the panel held that "rise" is inherently weak given, *inter alia*, its strong logical associations with coffee, consistent with RiseandShine's prior admissions. It thus concluded that RiseandShine's trademark "commands a narrow scope of protection." The district court subsequently granted summary judgment to PepsiCo. The Second Circuit affirmed in an unpublished opinion stating that inherent strength is a question of law.

RiseandShine hopes this Court will call inherent strength a "question of fact," allowing it to escape the Second Circuit's careful legal reasoning. Inherent strength, however, is quintessentially legal. It concerns how much exclusionary power to grant a

mark based on the word's intrinsic nature. Evaluating inherent strength does not involve deciding historical facts, making credibility determinations, or engaging in other tasks indicative of factual questions. Instead, it requires examining the meaning of words and balancing the scope of a trademark owner's monopoly power with important principles of free competition and the First Amendment to prevent chilling speech—all paradigmatic judicial functions.

Across intellectual property, the issue of how broadly an IP owner can enforce rights is a legal question. In copyright, for example, after determining that a work is copyrightable, courts decide the scope of protection (*e.g.*, whether rights are narrow or broad) as a legal question. In patent cases, this Court held that determining the scope of patent rights is exclusively within the province of courts. Inherent strength, which concerns the scope of trademark protection, should be no different.

RiseandShine's contrary argument is an exercise in obfuscation and is designed to limit a meaningful role for courts. RiseandShine contends that a mark's inherent strength rests exclusively on its distinctiveness—*i.e.*, its placement on a spectrum of classifications ranging from "generic" to "fanciful." RiseandShine then devotes essentially its whole brief to arguing that distinctiveness is a question of fact because it concerns consumer perceptions. That strategy fails at the threshold, because *distinctiveness* and *inherent strength* are separate inquiries. Distinctiveness addresses whether a mark is *valid* to begin with, while inherent strength concerns the *scope* of a valid mark's protection—*i.e.*, its intrinsic power to

exclude. RiseandShine's effort to collapse those two inquiries into one makes no sense and would effectively read inherent strength out of existence. And apart from that attempted erasure, RiseandShine offers no argument that inherent strength lacks the legal element the Second Circuit rightly considered in concluding that its mark is inherently weak.

In any event, even assuming that inherent strength reduces entirely to distinctiveness, it still would not be a factual question. Courts treat similar inquiries conducted from the consumer's perspective as legal questions, particularly when free-expression principles are implicated—and, tellingly, RiseandShine never even identifies what evidence of consumer perception it would offer. At the very least, the uncontested aspects of the Second Circuit's reasoning warrant upholding the judgment.

A ruling that the inherent-strength component of the judge-made likelihood-of-confusion test is a question of law recognizes the historic difference between classifying a mark on the spectrum of distinctiveness and assessing its strength once classified. And it ensures judges have a role in balancing the scope of trademark rights with fundamental constitutional issues, leaving issues that actually involve consumer perceptions (such as the other component of the trademark-strength inquiry, acquired strength) to the factfinder. This Court should affirm.

STATEMENT OF THE CASE

A. Legal Background

1. Trademark protection

a. Trademarks "have ancient origins" and "were protected at common law and in equity" at the Nation's founding. *Matal v. Tam*, 582 U.S. 218, 224 (2017). The "principle underlying trademark protection is that distinctive marks—words, names, symbols, and the like—can help distinguish a particular artisan's goods from those of others." *B&B Hardware, Inc. v. Hargis Indus., Inc.*, 575 U.S. 138, 142 (2015). From its very first trademark decision, this Court has recognized that a mark is entitled to protection only if it is "distinctive in its original signification, pointing to the origin of the article, or it must have become such by association," *Del. & Hudson Canal Co. v. Clark*, 80 U.S. 311, 323 (1871); *see also Elgin Nat'l Watch Co. v. Ill. Watch Case Co.*, 179 U.S. 665, 673 (1901) ("[N]o sign or form of words can be appropriated as a valid trademark" that does not "point out distinctively the origin or ownership of the articles to which it is affixed.").

Over time, judges devised a range of classifications to evaluate a mark's "distinctiveness" and thus its validity, *i.e.*, entitlement to protection. In its early cases, this Court recognized these common-law classifications, holding that a "generic" or "merely descriptive" mark is not "entitled to protection," *Clark*, 80 U.S. at 323-24, whereas a mark that is "arbitrarily" chosen or "fanciful" is sufficiently distinctive to warrant protection, *Hamilton-Brown Shoe Co. v. Wolf Bros. & Co.*, 240 U.S. 251, 256-57 (1916).

In *Abercrombie & Fitch Co. v. Hunting World, Inc.*, 537 F.2d 4, 9-11 (2d Cir. 1976), Judge Friendly summarized the "classic formulation" of these common-law categories. *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 768 (1992). In order of "increasing distinctiveness," they are: (1) generic, (2) descriptive, (3) suggestive, (4) arbitrary, and (5) fanciful. *Id.* Judge Friendly's *Abercrombie* rubric is frequently denoted the "spectrum of distinctiveness" and is now the accepted method for determining a mark's validity, *i.e.*, its entitlement to protection. *U.S. Patent & Trademark Office v. Booking.com B.V.*, 591 U.S. 549, 553 (2020). Judge Friendly explained, for example, that courts adopted the middle "suggestive" category to "accord protection to marks that were neither exactly descriptive on the one hand nor truly fanciful on the other," and he noted that "the validity of a mark ends where suggestion ends and description begins." *Abercrombie*, 537 F.2d at 10.

b. The Lanham Act "largely codified" common-law trademark doctrine. *Moseley v. V Secret Catalogue, Inc.*, 537 U.S. 418, 428 (2003). To "protect marks," the Act established "a voluntary registration system" administered by the U.S. Patent and Trademark Office (PTO). *Jack Daniel's Props., Inc. v. VIP Prods., Inc.*, 599 U.S. 140, 146 (2023). A mark's registration on the "principal register" constitutes "prima facie evidence" of the mark's validity, among other benefits. *Id.* at 146-47; *see Iancu v. Brunetti*, 588 U.S. 388, 391 (2019).

Whether a mark warrants placement on the principal register turns on its classification on the spectrum of distinctiveness. The Lanham Act makes

two categories of marks from this spectrum ineligible for the principal register. First, "[g]eneric terms are not registrable." *Park 'N Fly, Inc. v. Dollar Park & Fly, Inc.*, 469 U.S. 189, 193-94 (1985); *see* 15 U.S.C. §§1052, 1064(3). Second, "merely descriptive" terms are not eligible for the principal register, unless they have "acquired distinctiveness" (or "secondary meaning"). 15 U.S.C. §§1052(e)(1), 1052(f); *Two Pesos*, 505 U.S. at 769. The PTO also cannot register a mark that is (among other restrictions) "likely … to cause confusion" with another mark. 15 U.S.C. §1052(d); *Matal*, 582 U.S. at 227.

The Lanham Act does not mention the other three judge-made categories on the spectrum of distinctiveness—"suggestive," "arbitrary," and "fanciful." This Court, however, has recognized that marks in these three categories are "inherently distinctive" and thus "may be placed on the principal register." *Booking.com*, 591 U.S. at 553. At the same time, the Court has also repeatedly acknowledged that a mark's placement on the principal register, via classification on the spectrum of distinctiveness, pertains only to whether a mark is "eligible for protection"; it has not opined on what determines the amount of protection a mark receives. *Id.*; *see also, e.g.*, *Two Pesos*, 505 U.S. at 768 (explaining that the "latter three categories of marks" are "inherently distinctive" and thus "entitled to protection").

2. Trademark infringement

The Lanham Act "also creates a federal cause of action for trademark infringement." *Jack Daniel's*, 599 U.S. at 147. A mark owner can allege that "another is using a mark that too closely resembles the

plaintiff's." *B&B Hardware*, 575 U.S. at 144. A defendant is liable if the plaintiff owns a mark entitled to protection and the defendant's use of its own mark "is 'likely to cause confusion'" as to the origin, sponsorship, or association of the defendant's goods or services. *Jack Daniel's*, 599 U.S. at 147; *see* 15 U.S.C. §§1114(1)(a), 1125(a)(1)(A).

This Court has never addressed how to satisfy the Lanham Act's "likelihood of confusion" standard. Accordingly, the courts of appeals have formulated multi-factor tests for evaluating whether a plaintiff established a likelihood of confusion. The first of these tests was articulated by Judge Friendly in *Polaroid Corp. v. Polarad Electronics Corp.*, 287 F.2d 492 (2d Cir. 1961). He observed that "likelihood of confusion" is a "function of many variables," including "the strength of [the] 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." *Id.* at 495. Other circuits subsequently adopted variants of the *Polaroid* framework. *See, e.g.*, *In re Chippendales USA, Inc.*, 622 F.3d 1346, 1353 n.12 (Fed. Cir. 2010) (noting the "influential 'Polaroid test'"); *Perini Corp. v. Perini Constr., Inc.*, 915 F.2d 121, 127 (4th Cir. 1990); *Int'l Kennel Club of Chi., Inc. v. Mighty Star, Inc.*, 846 F.2d 1079, 1087 (7th Cir. 1988).

Consistent with *Polaroid*, all circuits consider "trademark strength" as a factor. Trademark strength refers not to a mark's validity or eligibility for

protection, but to the "scope of trademark protection to which the mark is entitled." *Top Brand LLC v. Cozy Comfort Co.*, 143 F.4th 1349, 1364 (Fed. Cir. 2025) (quoting *Surfvivor Media, Inc. v. Survivor Prods.*, 406 F.3d 625, 631 (9th Cir. 2005)). "Under the Lanham Act, stronger marks receive greater protection." *A&H Sportswear, Inc. v. Victoria's Secret Stores, Inc.*, 237 F.3d 198, 222 (3d Cir. 2000). If "[a] mark is particularly strong, use of that mark by another can give rise to likelihood of confusion even if the use occurs in connection with a totally distinct product line," whereas "if a mark is weak, use of a similar mark even on similar goods is unlikely to cause confusion if minor differences distinguish one party's mark from another." *Water Pik, Inc. v. Med-Sys., Inc.*, 726 F.3d 1136, 1151 (10th Cir. 2013).

Courts typically divide a mark's overall strength into two subfactors: "inherent strength" (sometimes called "conceptual strength") and "acquired strength" (sometimes called "commercial strength"). Pet.App.51a. This Court has never addressed, much less defined, either subfactor, and the circuits have adopted varying definitions, particularly as to inherent strength. Lower courts have defined inherent strength as anything from "the linguistic or graphical 'peculiarity' of the mark," *CareFirst of Md., Inc. v. First Care, P.C.*, 434 F.3d 263, 269 (4th Cir. 2006), to "the obviousness of [a mark's] connection to the good or service to which it refers," *Network Automation, Inc. v. Advanced Sys. Concepts, Inc.*, 638 F.3d 1137, 1149 (9th Cir. 2011). One treatise—without citation to any case—defines it as "the inherent potential of the term at the time of its first use." J. Thomas McCarthy, *McCarthy on Trademarks*

& Unfair Competition §11:73 (5th ed. 2023) ("McCarthy"). The circuits are more settled on a definition of acquired strength, which generally means "the degree to which [a mark] has achieved public recognition in the marketplace." Pet.App.51a.

B. Factual Background

RiseandShine was founded in 2015 by prep-school classmates. C.A.App.535-38. Their goal was to "find something … that would have [them] retired by forty," and they decided to market 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 word "rise" "symbolizes the start of a new day and getting up and on the go," and "[t]here's something energetic" about it. C.A.App.977. At the time RiseandShine selected RISE COFFEE CO., over twenty companies were already using "rise"-formative marks for beverages alone, including coffee (*e.g.*, RISE UP COFFEE ROASTERS), as the following products illustrate:





C.A.App.404-10, 490-99.

In 2015, RiseandShine attempted to register RISE COFFEE CO. with the PTO. C.A.App.916. The PTO rejected RiseandShine's application, citing a "likelihood of confusion with" other registered marks for coffee products using "Rise." C.A.App.436-37. RiseandShine responded, "[M]any entities have used the word 'Rise' in relation to [RiseandShine's] goods, making it unlikely that consumers would give significant weight to this term in ascertaining the source of such goods." C.A.App.438-39. RiseandShine identified "at least six" registered marks "that include the term Rise for various types of coffee goods." *Id.* Accordingly, RiseandShine asserted, the "term 'Rise' is extremely weak" and has "little source identifying significance that could contribute to any likelihood of confusion"; furthermore, "it would be disingenuous to claim" that marks using "Rise" "are strong." *Id.* Instead, such marks "should be given a narrow scope of protection" such that no company can claim broad, exclusive rights to "Rise." *Id.*

The PTO reaffirmed the refusal. C.A.App.214. RiseandShine abandoned its application and reapplied using RISE BREWING CO., which the PTO

registered, indicating that it found the word "brewing" (not "rise") sufficient to differentiate RiseandShine's new mark from the various other "rise" marks. C.A.App.260, 267. In 2016, RiseandShine launched its coffee product, which is sold in small 7-ounce cans:



C.A.App.94, 97.

In 2018, a company using the mark RISE BISCUITS DONUTS sent a cease-and-desist letter to RiseandShine alleging confusion from RiseandShine's RISE BREWING CO. mark. C.A.App.983. RiseandShine responded that "claims to the RISE mark are inherently weak," again taking the position that no company could broadly claim rights to "rise." C.A.App.989. RiseandShine identified over 40 registered marks using the word "rise"—including for "coffee," "soft drinks," and "energy drinks"—and stated that "RISE is so commonly used … that it is relatively weak and afforded only a narrow scope of protection." C.A.App.988-91. RiseandShine does not mention any of these admissions in its brief.

Two years after starting RiseandShine, its founders contacted PepsiCo about an investment or "outright sale." C.A.App.111-12, 973-75. PepsiCo politely rebuffed RiseandShine's outreach and repeated follow-ups. C.A.App.783-84, 852-54, 923, 932, 1015-16.

In 2020, PepsiCo began developing a fruit-flavored energy drink (not a coffee drink) under its popular Mountain Dew brand. C.A.App.302. PepsiCo chose the name MTN DEW RISE ENERGY because it evoked "morning energy and new beginnings" and the concept of "'rising up' and overcoming obstacles." C.A.App.306, 940.

PepsiCo launched MTN DEW RISE ENERGY in 2021. C.A.App.302-04. It was sold in 16-ounce cans (over double the size of RiseandShine's cans) bearing a lion's head logo, the famous MTN DEW mark, and vivid colors:



Pet.App.17a; C.A.App.302-06.

C. Procedural History

1. Preliminary-injunction proceedings

a. In 2021, RiseandShine sued PepsiCo, alleging Lanham Act and state-law violations. C.A.App.220. It sought a preliminary injunction enjoining PepsiCo's mark, which the district court granted. Pet.App.66a.

The court applied the Second Circuit's eight-factor *Polaroid* framework. Pet.App.79a. It determined that the "strength of the mark" factor "tilts slightly" toward RiseandShine because "the word 'RISE'" is "suggestive" and RiseandShine had provided some

evidence of "market distinctiveness." Pet.App.80a-84a. The court also determined that the "similarity of the marks" factor "tips strongly" toward RiseandShine because "the two marks are confusingly similar in appearance." Pet.App.84a-86a. The court held that RiseandShine would likely establish likelihood of confusion. Pet.App.80a, 87a-91a.

b. The Second Circuit vacated the preliminary injunction. Pet.App.45a-63a. In a published opinion by Judge Leval, joined by Judges Chin and Menashi, the court held that the preliminary injunction was "premised on two significant errors." Pet.App.46a.

First, the Second Circuit held that the district court erred in concluding that the "strength of mark" factor "slightly favored" RiseandShine. As to the mark's inherent strength, the Second Circuit agreed that the mark should be classified as "suggestive" on the spectrum of distinctiveness. Pet.App.51a, 54a. But, the court explained, "labeling a mark as 'suggestive' is not the end of the inquiry," because "[s]uggestiveness" is "not necessarily dispositive of" inherent strength. Pet.App.54a. The court observed that "it does not necessarily follow that every suggestive mark is stronger than every descriptive mark." Pet.App.57a.

The Second Circuit held that the district court committed "legal error" in neglecting to account for these considerations. Pet.App.55a. The court added that there is a "legal element in the determination of how much strength a given mark commands." Pet.App.55a. It faulted the district court for "fail[ing] to note … the strong logical associations between 'Rise' and coffee," which rendered the mark—while

suggestive as a matter of distinctiveness—"inherently weak." Pet.App.57a; *see* Pet.App.56a (cataloguing the "close associations between the word 'Rise' and coffee" and noting that the "intended and achieved reference of the RISE mark is illustrated by Plaintiff's company name—RiseandShine—something that a morning cup of coffee helps us to do"). The court observed, "The trademark law does not favor giving one marketer an exclusive right to prevent others from using such valuable marketing terms"—like the word "rise"—"in their own marketing campaigns." Pet.App.59a.

The Second Circuit also faulted the district court for "discount[ing]" RiseandShine's prior statements about its mark's inherent weakness. Pet.App.59a. The court noted RiseandShine's claim to being the "exclusive user of the principal term 'RISE' to identify a single-serving, canned caffeinated beverage," but highlighted "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"—*i.e.*, breakfast-related products similarly "allud[ing] to increased energy, particularly in the morning hours." Pet.App.55a-56a, 58a. The court remarked that RiseandShine had "acknowledged [a] crowded field in its application to" the PTO yet now "argues that there is no such room for multiple 'Rise' marks to coexist peacefully, even outside the coffee sector"—a position that was "not persuasive." Pet.App.58a-59a; *see also* Pet.App.63a (explaining that RiseandShine "chose a weak mark in a crowded field"). The court further held that RiseandShine had "not shown that its RISE mark has achieved sufficient acquired strength." Pet.App.61a.

Second, the Second Circuit held that the district court committed "clear error" in finding the marks "confusingly similar." Pet.App.61a. The court found that neither the "shared use" of the word "rise" nor "the use of large bold letters" rendered "the two products 'confusingly similar.'" Pet.App.62a. Moreover, it noted, the two cans "are different in size, proportion, style, color, and artwork"; the word "RISE" is "presented in very different manners," with the word on PepsiCo's product "partially covered at the top by [PepsiCo's] prominently displayed house mark, 'MTN DEW'"; the "lower half of [PepsiCo's] can depicts a large, stylized lion's head" complementing "the can's angular font"; and RiseandShine's "seven-ounce can is less than half the size of [PepsiCo's] sixteen-ounce can," as shown here:



Pet.App.62a-63a; C.A.App.402. In short, there "is little about the appearance of the two cans that would suggest to a consumer that they come from the same source." Pet.App.63a.

2. Summary-judgment proceedings

a. After discovery, PepsiCo sought summary judgment. RiseandShine submitted no new inherent-strength or similarity evidence, and "minimal" new acquired-strength evidence. Pet.App.9a. Notably, it offered no acquired-strength or consumer-confusion surveys, while PepsiCo submitted six surveys showing no confusion. Pet.App.32a, 35a-37a.

The district court granted summary judgment for PepsiCo. Pet.App.15a-44a. As to inherent strength, the court adhered to the Second Circuit's "binding conclusion" that the mark is "weak." Pet.App.28a. As to acquired strength, the court held that RiseandShine's evidence was "similar[]" to its prior evidence and "no reasonable jury could conclude" that RiseandShine's mark achieved commercial strength "linking the Rise mark to [RiseandShine's] product." Pet.App.30a, 32a. The court remarked that RiseandShine "provide[d] no context to determine" whether its advertising spending "is significant in the relevant market" and "offer[ed] no survey evidence in support of acquired meaning." Pet.App.32a.

As to similarity, the district court observed that the Second Circuit had deemed its prior determination "clear error" and "the record has not changed since" then. Pet.App.34a-35a. Thus, this factor "weigh[ed] strongly against" RiseandShine. *Id.*

The district court then weighed the *Polaroid* factors, noting that the "ultimate question of consumer confusion" is "a question of law." Pet.App.42a. The court concluded that RiseandShine had not shown a likelihood of confusion, warranting summary judgment for PepsiCo. Pet.App.43a.

b. RiseandShine appealed, raising two issues. First, it argued that the district court erroneously treated inherent strength as a legal rather than factual question. Second, it argued that the district court erroneously treated likelihood of confusion as a legal rather than factual question.

In an unpublished, unsigned summary order, the Second Circuit (Judges Bianco, Menashi, and Lee) unanimously affirmed. Pet.App.1a-14a. On RiseandShine's first issue, 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." Pet.App.7a. The court also "disagree[d]" that RiseandShine had "raised triable issues of fact regarding the acquired strength of its mark," highlighting RiseandShine's "minimal additional evidence … on summary judgment" and the "absence of any consumer studies that link 'RISE' to [RiseandShine]." Pet.App.8a-9a.

On RiseandShine's second issue, the court rejected RiseandShine's position, explaining that it has "long held that the balancing of the *Polaroid* factors is a question of law." Pet.App.10a.

The court concluded that, based on the *Polaroid* factors, there was "not a likelihood that consumers would be confused by PepsiCo's use of the term 'Rise.'" Pet.App.11a. It explained that circuit precedent "found the similarity-of-marks" factor "dispositive at the summary judgment stage." Pet.App.12a. The court also rejected RiseandShine's "anecdotal evidence of actual confusion," noting it "is largely centered on the perceptions of industry professionals," not

"*consumer* confusion," and RiseandShine "failed" to submit any consumer surveys. Pet.App.13a. And it deemed supposed "bad faith" evidence—merely that RiseandShine "sought a 'partnership' with PepsiCo, which PepsiCo declined"—as insufficient, especially given "the dissimilarity between the marks." Pet.App.13a. In sum, the Second Circuit held, "when viewing the *Polaroid* factors in the aggregate … there is no likelihood of confusion and thus summary judgment was warranted in PepsiCo's favor." Pet.App.13a.

3. Certiorari-stage proceedings

RiseandShine sought certiorari, presenting only the question "[w]hether trademark strength is a question of fact in a likelihood-of-confusion analysis." Pet.i. Despite pressing it below, RiseandShine did not present the question whether likelihood of confusion is a legal or factual question. Nor did it challenge any other aspect of the Second Circuit's decision.

SUMMARY OF ARGUMENT

I. A trademark's inherent strength is a legal question. Inherent strength comprises a trademark's conceptual scope of protection and the intrinsic power of a word or phrase to exclude other marks. Determining inherent strength does not turn on historical facts, credibility assessments, conflicting evidence, or other customary indicia of factual questions. Nor does it turn on consumer perception, which is the province of the other component of trademark strength, acquired strength. Rather, evaluating a mark's conceptual power to exclude occurs independent of disputed facts. Judges routinely expound upon the meanings and

associations of words and phrases in statutes, contracts, patents, and other written instruments. There is no principled reason to exclude trademarks and the inherent-strength inquiry from that bailiwick.

Judges are also better-positioned to address and resolve the broader legal issues that the inherent-strength inquiry implicates. Trademark law seeks to balance the protection of trademark owners' goodwill and enhancement of consumer choice, on the one hand, with the undesirability of allowing a monopoly on words and phrases, on the other hand. The stronger a mark, the greater the mark owner's ability to suppress the speech of others, triggering concerns about market competition and the First Amendment. These competitive and constitutional concerns reinforce not only that inherent strength is a legal inquiry, but also that striking the right balance among opposing public interests is properly allocated to judges. That is especially so given that trademarks can last indefinitely, creating the possibility of timeless monopolies over words and phrases, thereby elevating the importance of a judicial role.

This Court has held that defining the scope of other intellectual property is a legal question. Judges determine the scope of patent claims—an antecedent to patent infringement—because claim construction requires determining the meaning of words and because judicial interpretation ensures greater predictability and uniformity. Patent obviousness and subject-matter eligibility are also legal questions, despite turning on underlying factual inquiries. Similarly, courts also hold that whether a copyrighted work is entitled to narrow ("thin") or broad protection

is a legal question. Determining the inherent strength of a trademark should receive the same treatment.

II. RiseandShine bases its contrary position on two premises: (1) inherent strength is equivalent to distinctiveness (*i.e.*, placement of a mark on the spectrum from generic to fanciful), and (2) distinctiveness is a question of fact. RiseandShine is wrong about both premises.

First, inherent strength is not equivalent to distinctiveness. Distinctiveness resolves whether a trademark is *valid*—whether it is entitled to protection in the first place. Inherent strength *assumes a valid mark* and then resolves its degree of intrinsic power to exclude for purposes of the likelihood-of-confusion inquiry. It would make no sense for those two different determinations to collapse into one; indeed, RiseandShine's position effectively reads inherent strength out of existence.

That flaw is fatal to RiseandShine's position. RiseandShine's entire argument is that inherent strength is a question of fact because distinctiveness is a question of fact. But because inherent strength is not the same as distinctiveness—and because it includes the undeniably legal considerations that the Second Circuit invoked—RiseandShine's argument fails.

Second, and in any event, RiseandShine is wrong that distinctiveness is a question of fact. This Court has long resolved disputes over distinctiveness on its own, with no reference to factfinding. RiseandShine is also mistaken that determinations made from the perspective of consumers are necessarily factual questions. The law is full of examples to the contrary,

particularly when a determination implicates constitutional principles, as distinctiveness does.

RiseandShine's remaining arguments further undermine its position. RiseandShine suggests that inherent strength must be a question of fact because likelihood of confusion is purportedly a question of fact. But the Second Circuit held that likelihood of confusion is a question of law, and RiseandShine did not seek review of that decision. RiseandShine also invokes the Seventh Amendment jury-trial right, but that has nothing to do with whether a given determination is legal or factual. To the extent the jury's role is relevant, moreover, RiseandShine's position will inject uncertainty into trademark law by sending more infringement cases to unpredictable juries and making it harder to clear marks.

III. Even if inherent strength were purely factual, affirmance remains warranted. First, the Second Circuit's reasoning and the uncontroverted record support the conclusion that no reasonable jury could find RiseandShine's mark inherently strong. Second, the Second Circuit's uncontested rulings on the other *Polaroid* factors justify summary judgment of no likelihood of confusion.

ARGUMENT

RiseandShine asked this Court to decide whether inherent strength is a question of law or fact. But its opening brief reveals that this case turns largely on a different, logically antecedent question: what does inherent strength include? RiseandShine assumes (with essentially no argument) that inherent strength consists *exclusively* of placing a mark on the distinctiveness spectrum, which it contends is a

factual determination. That argument fails at its first step. Inherent strength is not the same as distinctiveness. Inherent strength includes undeniably legal considerations that RiseandShine does not even acknowledge, much less refute. RiseandShine is thus wrong on the question presented for reasons entirely separate from those that dominate its brief. That is all the Court needs to conclude in order to decide (or dismiss) this case. In any event, RiseandShine is wrong about the principal argument in its brief, too: even if inherent strength were equivalent to distinctiveness, it would not be a question of fact because distinctiveness is a question of law.

I. A TRADEMARK'S INHERENT STRENGTH IS A LEGAL QUESTION.

As this Court has acknowledged, "the appropriate methodology" for distinguishing legal and factual questions is "elusive." *Miller v. Fenton*, 474 U.S. 104, 113 (1985). Nevertheless, the principles the Court has applied when addressing this subject demonstrate that the inherent-strength inquiry is a legal question.

In determining whether a question is legal or factual, the Court has long looked to "the nature of the inquiry itself." *Id.* at 115; *see also U.S. Bank, N.A. v. Village at Lakeridge, LLC*, 583 U.S. 387, 395 (2018) (addressing the "nature" of the question). Although there is no agreed-upon definition of inherent strength, it is best understood as the intrinsic "degree of legal muscle (or power to exclude) possessed by" a word or phrase. Pierre N. Leval, *Trademark: Champion of Free Speech*, 27 Colum. J.L. & Arts 187, 191 (2004). A mark inherently possessing "substantial

muscle"—an inherently strong mark—has the "power to exclude not only the identical mark in the identical area, but also confusingly similar marks in broad areas." *Id.* A mark that is inherently weak—even if it "has legal validity" and is thus entitled to protection—"can exclude others only within a very narrow scope," such as from "using the same mark on the same goods." *Id.* Assessing trademark strength "hems in the scope" of such marks: "[t]he weaker a mark, the fewer are the junior uses that will trigger a likelihood of consumer confusion." *Booking.com*, 591 U.S. at 562.

The inherent-strength inquiry is, as the name suggests, "inherent" or "conceptual." Unlike acquired strength, inherent strength "looks to the mark itself, divorced from consumers' actual knowledge of it." *Souza v. Exotic Island Enters., Inc.*, 68 F.4th 99, 111 (2d Cir. 2023). Inherent strength thus lacks the customary indicia of a factual question. It does not turn on any "'basic' or 'historical' fact," *i.e.*, "who did what, when or where, how or why." *U.S. Bank*, 583 U.S. at 395; *see also Google LLC v. Oracle Am., Inc.*, 593 U.S. 1, 24 (2021) (addressing "subsidiary factual questions" like "how much of the copyrighted work was copied"). It does not involve "state of mind," "the credibility of witnesses," or "an evaluation of demeanor." *Miller*, 474 U.S. at 113-14, 116-17. There is no "conflicting testimony" to reconcile. *Id.* at 117. Determining a mark's inherent "power to exclude" occurs "independent of disputed facts," and "factual development at trial will not change the district court's answer," indicative of a "legal question." *Dupree v. Younger*, 598 U.S. 729, 737 (2023).

The task of determining a mark's inherent "power to exclude," moreover, is well-suited for judges. In distinguishing between factual and legal questions, this Court has looked to whether "one judicial actor is better positioned than another to decide the issue in question." *Markman v. Westview Instruments, Inc.*, 517 U.S. 370, 388 (1996). "The construction of written instruments" is "one of those things that judges often do and are likely to do better than jurors." *Id.* Courts thus "treat document construction as a question of law," *Teva Pharms. USA, Inc. v. Sandoz, Inc.*, 574 U.S. 318, 325 (2015), and judges routinely expound upon the meanings and associations of words and phrases in statutes, contracts, patents, and other written instruments. *See, e.g.*, *Loper Bright Enters. v. Raimondo*, 603 U.S. 369, 386 (2024); *M&G Polymers USA, LLC v. Tackett*, 574 U.S. 427, 435 (2015). There is no reason to exclude trademarks, which likewise involve the written word, from that bailiwick. There is especially no reason to exclude the inherent-strength inquiry, the entire point of which is to examine the conceptual nature of a word and its intrinsic power to exclude others' use—functions customarily performed by, and properly allocated to, judges.

The Court's decision in *Markman* is instructive. That case addressed whether patent claim construction is "a matter of law" or "a jury issue." *Markman*, 517 U.S. at 372, 377. The Court explained that "[v]ictory in an infringement suit requires a finding that the patent claim covers the alleged infringer's product or process, which in turn necessitates a determination of what the words in the claim mean." *Id.* at 374. And it held that determining

"what the words in the claim mean" was "better suited" for "judges, not juries." *Id.* at 388; *see also Teva*, 574 U.S. at 332-33 (explaining that claim construction is "a legal question" even if "courts … make subsidiary factual findings"). Similarly, determining "what the words … mean" in a trademark and their corresponding inherent power to exclude—a threshold step in every trademark infringement suit—is equally "better suited" for "judges, not juries."

Judges are also better-positioned to address and resolve broader legal issues that the inherent-strength inquiry implicates. For example, trademark law has long sought to balance the "twin goals of facilitating consumers' choice and protecting producers' good will," *Jack Daniel's*, 599 U.S. at 147, with "the undesirability of allowing anyone to obtain a complete monopoly" on a word as a trademark, *KP Permanent Make-Up, Inc. v. Lasting Impression I, Inc.*, 543 U.S. 111, 122 (2004); *see also Jack Daniel's*, 599 U.S. at 164 (Sotomayor, J., concurring) (noting "the Lanham Act's careful balancing of 'the needs of merchants for identification as the provider of goods with the needs of society for free communication and discussion'" (quoting Leval, *supra*, at 210)). The stronger a mark, the greater a trademark owner's ability to prevent others from using not just identical but nonidentical (and increasingly dissimilar) words and phrases. *See Wal-Mart Stores, Inc. v. Samara Bros., Inc.*, 529 U.S. 205, 210 (2000) ("Competition is deterred … not merely by successful suit but by the plausible threat of successful suit[.]"). Granting an owner exclusive rights in a mark "when there is a close conceptual connection between the mark and the associated goods or services" is "antithetical to trademark's goals of fair

competition and consumer protection." Jeanne C. Fromer, *Against Secondary Meaning*, 98 Notre Dame L. Rev. 211, 214 (2022). The "competitive advantages associated with exclusive control of particularly powerful words have real costs for consumers." Christopher Buccafusco et al., *Competition and Congestion in Trademark Law*, 102 Tex. L. Rev. 437, 440 (2024).

Those same considerations, moreover, can trigger First Amendment concerns. To be sure, "when a challenged trademark use functions as 'source-identifying,' trademark rights 'play well with the First Amendment.'" *Jack Daniel's*, 599 U.S. at 159 (quoting *Mattel, Inc. v. MCA Records, Inc.*, 296 F.3d 894, 900 (9th Cir. 2002)). But that proposition necessarily contemplates that First Amendment concerns *are* triggered when a trademark is *not* "source-identifying." Trademarks can also involve "expressive value" beyond (or instead of) source identification, and were courts "to ignore the expressive value that some marks assume, trademark rights would grow to encroach upon the zone protected by the First Amendment." *Mattel*, 296 F.3d at 900; *see* Scholars.Br.27-28 (explaining that "trademark law … can be used to suppress free speech").

These competitive and constitutional concerns underscore the importance of ensuring that trademarks are, in fact, "source-identifying" without stifling competition and raising First Amendment concerns. And they reinforce that judges, rather than lay juries, are best positioned to perform that inquiry. *See Bose Corp. v. Consumers Union of U.S., Inc.*, 466 U.S. 485, 502 (1984) (noting that "the constitutional

values protected by the rule make it imperative that judges … make sure that it is correctly applied"). As the leading organization of intellectual-property owners attests, "plenary judicial determination" of inherent strength "will ensure that free-speech rights are respected at the same time that proper trademark rights are enforced." IPO.Br.12-13.

Indeed, precisely because the determination of a mark's inherent strength will have an "impact on future cases and future conduct"—by establishing the meaning and associations of a word or phrase—the "stakes" are "too great to entrust … to the judgment of the trier of fact." *Bose*, 466 U.S. at 501 n.17; *see* Daryl Lim, *Trademark Confusion Revealed: An Empirical Analysis*, 71 Am. U. L. Rev. 1285, 1288 (2022) (noting that "trademarks last indefinitely, meaning their owners obtain a timeless monopoly"); Barton Beebe & Jeanne C. Fromer, *Are We Running Out of Trademarks?*, 131 Harv. L. Rev. 945, 1025 (2018) (explaining that because "[t]hree-quarters of our word usage consists of words registered as marks and almost nine-tenths consists of words confusingly similar to registered marks … we use all of our language in the shadow of trademark rights").

This Court, moreover, has held that defining the scope of other intellectual property is a legal question. As explained, for example, defining the scope of a patent's claims is "exclusively within the province of the court," *Markman*, 517 U.S. at 372, notwithstanding the potential for "subsidiary factual findings," *Teva*, 574 U.S. at 332. That is so not only because patents are "written instruments," but because of "the importance of uniformity in the

treatment of a given patent," without which "a 'zone of uncertainty' … would discourage invention only a little less than unequivocal foreclosure of the field." *Markman*, 517 U.S. at 390. Similarly, the "obviousness" of a patent is "a legal determination," even though "questions of fact" inform the analysis. *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 427 (2007). So too for the subject-matter eligibility of patents. *See SAP Am., Inc. v. InvestPic, LLC*, 898 F.3d 1161, 1166 (Fed. Cir. 2018).

Copyright law likewise treats the scope of protection as a legal question. In *Feist Publications, Inc. v. Rural Telephone Service Co.*, 499 U.S. 340 (1991), this Court held that factual compilations, while not categorically excluded from copyright protection, are entitled to "thin" (*i.e.*, narrow) protection extending only "to the particular selection or arrangement" of facts, since facts themselves "may not be copyrighted." *Id.* at 349-51. Based on that ruling, courts of appeals hold that whether a copyrighted "work is entitled to 'broad' or 'thin' protection" is a legal question, too. *Apple Comput., Inc. v. Microsoft Corp.*, 35 F.3d 1435, 1443 (9th Cir. 1994); *see also SAS Inst., Inc. v. World Programming Ltd.*, 64 F.4th 1319, 1326 (Fed. Cir. 2023) ("[T]he court is tasked with determining the scope of copyright protection."). And many circuits "hold that copyrightability is always an issue of law" because, although the analysis "is fact-specific," judicial oversight ensures that the existence and scope of intellectual-property rights "not be placed at the mercy of a jury." *Gaiman v. McFarlane*, 360 F.3d 644, 648-49 (7th Cir. 2004) (collecting cases).

In *Google*, this Court addressed the "'fair use' doctrine," which "impose[s] limitations upon the scope of copyright protection even [for] works that are entitled to a copyright." 593 U.S. at 18. Though fair use is "mixed" with "subsidiary factual questions"—such as "how much of the copyrighted work was copied"—the Court held that the "ultimate question whether those facts showed a 'fair use' is a legal question for judges to decide." *Id.* at 23-24. In so holding, the Court underscored that "fair use" was "originally a concept fashioned by judges" and that the doctrine "play[s] an important role in determining the lawful scope of a … copyright." *Id.* at 22, 24.

Like determining the scope of a copyright or patent, determining the scope of a trademark through the inherent-strength inquiry is a question of law. Akin to patent claim construction, judicial evaluation of inherent strength maintains "uniformity in the treatment of a given" trademark. *Markman*, 517 U.S. at 390. Because a trademark "holder should know what he owns, and the public should know what he does not," legal rulings provide necessary guidance to market entrants. *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 535 U.S. 722, 731 (2002). And just as judges decide whether copyright protection is "broad" or "thin," or whether copyright "fair use" has been established, so too should judges decide the intrinsic scope of a trademark through the inherent-strength inquiry—which, like "fair use," evolved from judge-made doctrines.

Finally, in the same way that copyright law asks judges to determine whether a work is "closer to the core of intended copyright protection than others,"

Campbell v. Acuff-Rose Music, Inc., 510 U.S. 569, 586 (1994), the inherent-strength inquiry ensures that enforcement furthers the intended goals of trademark law, including the tradeoffs between source identification and free communication. *See Andy Warhol Found. for the Visual Arts, Inc. v. Goldsmith*, 598 U.S. 508, 526-27 (2023) (explaining that copyright's fair-use doctrine reflects a "balancing act between creativity and availability"). Inherent strength is a legal "check that can help to keep" a trademark "monopoly within its lawful bounds." *Google*, 593 U.S. at 22.

The legal character of the inherent-strength inquiry is confirmed by comparison to the other component of trademark strength: acquired strength. All agree that acquired strength is a factual question, and understandably so, for it contains the markers of a factual question. Whereas inherent strength is "divorced from consumers' actual knowledge of" a mark, *Souza*, 68 F.4th at 111—*i.e.*, is unrelated to consumer perception—acquired strength "evaluates the actual customer recognition value of the mark at the time registration is sought or at the time the mark is asserted in litigation to prevent another's use," McCarthy §11:80. There is nothing "conceptual" about that inquiry; it turns on "'basic' or 'historical' fact[s]," like advertising expenditures, promotional efforts, and other data that establish "public recognition in the marketplace." Pet.App.51a; *U.S. Bank*, 583 U.S. at 394. Determining whether that evidence shows "actual customer recognition value" is a prototypical factfinding exercise that requires no particular expertise and implicates no broader legal concerns. And because the inquiry turns on specific evidence

regarding public recognition in the marketplace at a specific time, acquired-strength findings lack the permanence of inherent-strength determinations, which announce the intrinsic strength of a word or phrase independent of circumstance. In short, the acquired-strength component does the "factual" work of trademark strength, while the inherent-strength component does the "legal" work.

II. RISEANDSHINE ERRS IN CONTENDING THAT INHERENT STRENGTH IS A FACTUAL QUESTION.

RiseandShine's position on the question presented rests on two premises. First, RiseandShine assumes (with essentially no argument) that a mark's inherent strength turns exclusively on its *distinctiveness—i.e.*, its placement on the spectrum between generic and fanciful. Second, RiseandShine contends that distinctiveness is a factual question. Combining those two premises, RiseandShine concludes that *inherent strength* is a factual question.

That argument fails at the threshold because inherent strength is not equivalent to distinctiveness. As explained above, inherent strength includes considerations that are legal—and those considerations were the basis for the inherent-strength determination below. That is enough to foreclose RiseandShine's position on the question presented: because inherent strength is not limited to distinctiveness but instead includes the legal elements properly invoked by the Second Circuit, inherent strength is a question of law in every respect relevant here. That is true regardless of whether *distinctiveness* is properly regarded as a factual

question, and this Court therefore need not reach that issue. In any event, distinctiveness is a question of law, so both of RiseandShine's premises fail and its position on the question presented is doubly wrong.

A. Inherent Strength Is Not Equivalent To Distinctiveness, So It Is Irrelevant Whether Distinctiveness Is Factual.

RiseandShine's entire argument on the question presented turns on the premise that inherent strength is defined exclusively by "where the mark falls on the distinctiveness spectrum." Petr.Br.6. Thus, in RiseandShine's view, inherent strength is "assessed by answering a *single question*: How distinctive is the mark … along the distinctiveness spectrum, from generic to fanciful"? Petr.Br.13 (emphasis added); *see, e.g.*, Petr.Br.15 ("inherent strength … is a question of where a mark falls along the spectrum of distinctiveness"); Petr.Br.24 (equating the "legal standard" for inherent strength with "the distinctiveness spectrum"); Petr.Br.35 (same).

That premise is wrong. Placing a mark on the distinctiveness spectrum does not alone determine a mark's inherent strength. A mark's conceptual power to exclude implicates the additional considerations described above, which are legal rather than factual. As the Second Circuit cogently explained, classifying a mark on the spectrum does not end the inquiry; inherent strength has an "undeniable legal element," which was the basis for the inherent-strength determination in this case. Pet.App.55a; *see* Pet.App.7a. The Court need go no further to affirm.

1. Despite RiseandShine's attempt to conflate them, trademark strength and distinctiveness are

different concepts that play different roles in trademark law. "[D]istinctiveness is an issue of the trademark['s] *validity*," while "[s]trength is an issue of *infringement*." McCarthy §11:75 (emphases in original); *see also* SG.Br.4-7 (describing distinctiveness as part of validity and inherent strength as part of infringement). "Keeping separate" those concepts "is key to a coherent analysis of trademark law questions." McCarthy §11:75.

Start with distinctiveness. As explained above, distinctiveness is the *sine qua non* of trademark protection—*i.e.*, validity. *See* pp.4-6, *supra*. "If a designation is not 'distinctive,' it is not a legally protectable 'mark.'" McCarthy §4:13. Distinctiveness is thus "a yes or no issue: either a designation is distinctive and is a valid trademark or it is not." *Id.* §11:75; *see id.* §4:13 ("No distinctiveness—no validity—no mark."). This Court's trademark decisions from the beginning have treated distinctiveness as relating to whether a mark is "entitled to legal protection." *Clark*, 80 U.S. at 323; *see also Jack Daniel's*, 599 U.S. at 146 (registration system designed to "protect marks"); *Booking.com*, 591 U.S. at 553-54 (describing distinctiveness categories "eligible for" and "ineligible for protection"); *Wal-Mart*, 529 U.S. at 210; *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 171 (1995); *Two Pesos*, 505 U.S. at 768.

To determine a mark's distinctiveness—and thus its validity—courts use the spectrum of classifications crystallized by Judge Friendly in *Abercrombie*. *See, e.g.*, *Two Pesos*, 505 U.S. at 768; McCarthy §11:1-2. Under that approach, a mark is classified as either

generic, descriptive, suggestive, arbitrary, or fanciful. *Two Pesos*, 505 U.S. at 768-69. A mark's entitlement to protection follows directly from its placement on the spectrum. *See id.* A generic mark is never valid; a descriptive mark is valid only if it has secondary meaning; and a suggestive, arbitrary, or fanciful mark is valid even without secondary meaning. *See id.*; *see also, e.g.*, *Booking.com*, 591 U.S. at 553-54.

Importantly, the distinctiveness determination does not involve any inquiry into a mark's relative position within a particular classification. It does not matter, for example, whether a suggestive mark is closer to the border with a descriptive mark or an arbitrary mark; if the mark is suggestive, then it is valid—with no further questions asked. *E.g.*, McCarthy §11:75.

Trademark strength—of which inherent strength is a component—is a different inquiry. The strength inquiry "*assumes that there is a valid trademark* and evaluates just how strong that trademark is" for purposes of measuring likelihood of confusion in an infringement claim. *Id.* (emphasis added). The inherent-strength inquiry thus does not even begin until the distinctiveness inquiry is complete and validity confirmed. That is why courts have entirely different tests for distinctiveness (*e.g.*, the *Abercrombie* test) and inherent strength (one subfactor in the *Polaroid* test). And that is why the Second Circuit's analysis of inherent strength here did not stop with classifying RiseandShine's mark as "suggestive," which was undisputed. Pet.App.54a.

In stark contrast to distinctiveness, trademark strength—including inherent strength—"is *not* a yes

or no issue." McCarthy §11:75 (emphasis added). It is instead "a question of degree," as a mark's strength "can vary on a spectrum from very weak to very strong," regardless of the distinctiveness classification. *Id.*; *accord* SG.Br.24 (inherent strength is matter of degree). So even within a particular classification on the spectrum, courts refer to marks as relatively weak or strong. *E.g.*, *Variety Stores, Inc. v. Wal-Mart Stores, Inc.*, 888 F.3d 651, 662 (4th Cir. 2018) ("Even if we assume that Variety's marks are suggestive, these marks are conceptually weak."); *Brookfield Commc'ns, Inc. v. West Coast Entm't Corp.*, 174 F.3d 1036, 1058 (9th Cir. 1999) (noting that "[s]ome weak marks are weaker than others"); *John H. Harland Co. v. Clarke Checks, Inc.*, 711 F.2d 966, 974-75 (11th Cir. 1983) (concluding that mark is "not particularly strong").

In light of these different inquiries, RiseandShine errs in assuming that inherent strength can be resolved merely by placing the mark on the distinctiveness spectrum. A distinctiveness "designation does not resolve the mark's conceptual strength" because the discrete category into which a mark falls on the spectrum does not by itself answer how much intrinsic power to exclude the mark carries. *CareFirst*, 434 F.3d at 269-70; *see also A&H Sportswear*, 237 F.3d at 222 (noting that "the particular category of 'distinctiveness' into which a mark falls … is not the only measure of conceptual strength"); *W.W.W. Pharm. Co., Inc. v. Gillette Co.*, 984 F.2d 567, 572 (2d Cir. 1993) (designating a mark as "suggestive[] does not guarantee a determination that the mark is a strong one"). At most, distinctiveness serves as a starting point for determining a mark's

inherent strength—but it is "not the end of the inquiry," as the Second Circuit correctly explained. Pet.App.54a.

Indeed, if RiseandShine were correct that distinctiveness and inherent strength are equivalent, the validity and inherent-strength inquiries would collapse into one, effectively reading inherent strength out of existence. Judge Friendly certainly understood the difference, as he included a "strength" factor in the likelihood-of-confusion analysis in *Polaroid*, but saved the spectrum of distinctiveness for *Abercrombie* where he analyzed validity of marks.

2. RiseandShine's lead authority—*Booking.com*, a case it never cited below—underscores the problem with its position of cabining inherent strength to distinctiveness. From its very first sentence, *Booking.com* emphasizes that its analysis "concerns eligibility for federal trademark registration," not infringement or trademark strength, much less inherent strength. 591 U.S. at 551. Specifically, *Booking.com* concerned the PTO's refusal to register the mark "Booking.com" because the combination of a generic word like "Booking" and the generic term ".com" necessarily resulted in a mark that was generic and thus unprotectable. *Id.* at 552, 557. The Court rejected this "nearly *per se* rule that would render 'Booking.com' ineligible for registration regardless of the specific evidence of consumer perception." *Id.* By its own terms, then, *Booking.com* was an analysis of distinctiveness, not "an example of the inherent strength inquiry," as RiseandShine misreads it. Petr.Br.15.

Indeed, *Booking.com* illustrates the *difference* between determining a mark's validity and determining its protection against infringement. Zeroing in on validity, the Court rejected the PTO's categorical rule because it "would largely disallow *registration* of 'generic.com' terms." 591 U.S. at 564 (emphasis added). The Court expressly recognized that whether a mark is distinctive enough to be registered (validity) is a different question from whether a competitor's use of a mark is likely to cause confusion (infringement). *Id.* at 562. Underscoring the separate inquiries, the Court explained that even if a mark is valid, a similar mark will not necessarily be found infringing. *Id.* The Booking.com markholder even "concede[d]" that its mark, though registrable, would be "weak" for purposes of an infringement claim because it would be "hard[] … to show a likelihood of confusion." *Id.* (citations omitted).

Recognizing the difference between a mark's validity and its scope of protection ensures that trademark law fosters competition rather than prevents it. As this Court explained in *Booking.com*, the likelihood-of-confusion inquiry for infringement "guard[s] against the anticompetitive effects" that might otherwise arise from registering marks that are not particularly distinctive. *Id.* So although a mark that is not particularly distinctive may be valid for registration, "trademark law hems in the scope of such marks short of denying trademark protection altogether" through the likelihood-of-confusion inquiry for infringement. *Id.* Without that safeguard, a markholder might be able to "prevent competitors" from using common words like "'booking' to describe their own services." *Id.* at 562-63.

RiseandShine attempts just such a maneuver here. In seeking to register "RISE COFFEE CO.," RiseandShine argued to the PTO that the word "rise"—while distinctive enough to support registering RiseandShine's overall mark—was inherently weak and thus would not create confusion with other uses of "rise" marks for coffee. *See* p.10, *supra*. It reiterated this assertion in response to a cease-and-desist letter, contending a "Rise" mark is "afforded only a narrow scope of protection." C.A.App.988-89. RiseandShine nevertheless brought this suit accusing PepsiCo of infringement based on PepsiCo's inclusion of the word "rise" for a different kind of beverage.[1] And now, despite acknowledging the inherent weakness of the term "rise," RiseandShine seeks to avoid the consequences of that concession by contending that inherent strength for purposes of its infringement suit reduces only to distinctiveness. *See* Petr.Br.13. RiseandShine cannot bootstrap the distinctiveness determination in that way.

The difference between distinctiveness and inherent strength is dispositive here because RiseandShine's argument that inherent strength is a question of fact depends on its assumption that inherent strength is defined to mean solely distinctiveness. Because RiseandShine's "premise is faulty," *Booking.com*, 591 U.S. at 559, the rest of its argument collapses. Its extensive reliance on *Hana Financial, Inc. v. Hana Bank*, 574 U.S. 418 (2015), for

[1] To be clear, RiseandShine's registered trademark is "RISE BREWING CO.," not merely "RISE." Its suggestion that its mark is "RISE" highlights its attempt to monopolize a common word through its infringement claim.

example, is misplaced. RiseandShine invokes *Hana Financial* to argue that *inherent strength* is a question of fact because *distinctiveness* is measured from the perspective of consumers, and determinations made from the perspective of consumers are purportedly always factual. Petr.Br.21-22. But because inherent strength is not equivalent to distinctiveness, it does not matter whether distinctiveness is measured from the perspective of consumers or whether determinations made from the perspective of consumers are necessarily factual (although *Hana Financial* does not support these propositions either, *see* pp.43-47, *infra*). Also irrelevant is RiseandShine's reliance on various trademark provisions and their legislative history, Petr.Br.18-21, none of which addresses the judge-made subfactor of inherent strength. In short, RiseandShine's brief is almost entirely misdirected: because inherent strength is not equivalent to distinctiveness, whether distinctiveness is factual does not answer the question presented.[2]

3. It is no mystery why RiseandShine tries to narrow inherent strength to distinctiveness: the considerations that the Second Circuit invoked in determining that RiseandShine's mark is "inherently weak and commands a narrow scope of protection" are undisputedly legal rather than factual. Pet.App.57a; pp.24-31, *supra.* Distinctiveness was not even in dispute in the Second Circuit; all agreed that RiseandShine's mark fit in the "suggestive" category. Pet.App.54a. The court began with a single sentence finding no error in this distinctiveness determination

[2] The Court accordingly may wish to dismiss this case as improvidently granted.

before explaining in detail why RiseandShine's mark is a "weak suggestive mark[]" for inherent strength. *Id.*; *see* Pet.App.54a-59a. So as RiseandShine acknowledges, it was not distinctiveness but "the Second Circuit's *legal* conclusion that 'RISE' was inherently weak" that "was *the dispositive factor* that led to summary judgment for PepsiCo." Petr.Br.35 (emphases added).

The only way for RiseandShine to prevail is thus to persuade this Court that the Second Circuit was not permitted to invoke those legal considerations in assessing inherent strength. As noted, however, RiseandShine does not make any "legal argument" that inherent strength is limited only to distinctiveness; it "simply assumes the conclusion." *United States v. Apel*, 571 U.S. 359, 370 (2014). That is unpersuasive. The Second Circuit's understanding of inherent strength is well-supported, *see* pp.24-31, *supra*, and its reliance on concededly legal elements to resolve inherent strength illustrates why inherent strength is a question of law.

RiseandShine disparages the Second Circuit's decision as a "subjective, fact-free assessment of the mark" based on "judicial supposition" that "[d]epart[ed] from the evidentiary record." Petr.Br.8, 11. That is an unfounded caricature of the court's analysis. Far from applying its "own subjective impression," Petr.Br.32, the court relied on the "ordinary usage" of the word "Rise" in association with "the perceived virtue[s] of coffee," as reflected in the extensive third-party use of "Rise" on coffee drinks and similar products, Pet.App.56a-57a. The court also relied on RiseandShine's own admissions to the PTO

that the term "rise" was rendered weak by this crowded field, reasoning that "[i]f there was room" for RiseandShine to use "Rise" in "the already-crowded coffee field," there "would also be room" for PepsiCo's use, especially on a product "distinct from coffee." Pet.App.58a-59a. Finally, the court applied the established trademark principles of competition and free expression, explaining that trademark law does not offer "robust protection" to marks that "use words that describe or suggest a product or its virtues," like RiseandShine's use of "Rise" for a caffeinated beverage. Pet.App.56a, 59a.[3]

RiseandShine's position would mean that all of this careful legal analysis is improper for inherent strength, even though the concerns the Second Circuit evaluated are foundational to trademark law. That position is untenable. Indeed, leading trademark scholars agree that inherent strength has a legal component and urge that "[n]o resolution of this case should treat … trademark strength as a purely factual question." *See* Scholars.Br.3, 7-8. They highlight that inherent strength entails legal considerations beyond distinctiveness, undercutting RiseandShine's assumption. *Id.* at 13-14. And they warn that reducing trademark strength to "pure adjudicative

[3] Although this Court is reviewing the judgment in the Second Circuit's unpublished decision, RiseandShine's argument turns on the proposition that the inherent-strength analysis in the published decision at the preliminary-injunction stage is the core issue, to the extent it led to the subsequent district court and appellate decisions. Petr.Br.8-10. If the Second Circuit's inherent-strength reasoning in the published decision is correct, therefore, the unpublished decision's judgment is necessarily correct.

fact" not subject to "[m]eaningful appellate review" would "hamper courts' ability to develop the law of trademark," including the consideration of "free competition and free speech." *Id.* at 9, 29.

In sum, distinctiveness alone does not resolve the inherent strength of RiseandShine's mark; the legal considerations that the Second Circuit invoked have a role to play as well. Inherent strength contains a "legal element," just as the Second Circuit held. Pet.App.55a. That suffices to affirm.

B. In Any Event, Distinctiveness Is Not A Factual Question.

Although this Court can affirm without reaching the central argument in RiseandShine's brief—that distinctiveness is a question of fact—RiseandShine is wrong on that argument, too. Distinctiveness is a question of law, not of fact. Accordingly, RiseandShine would be wrong on the question presented even if it were somehow right that inherent strength is defined to mean the same thing as distinctiveness.

1. RiseandShine builds its argument that distinctiveness is a factual question around *Booking.com* and *Hana Financial*, but it overreads both cases.

At the outset, *Booking.com* cuts heavily against RiseandShine's position because its analysis centered on registration and validity, not infringement or trademark strength. *See* pp.36-38, *supra*. Furthermore, *Booking.com* did not purport to address—let alone resolve—whether distinctiveness is a legal or factual question. That was not the question presented in the case, nor did the parties

brief it. *Booking.com* thus does not support RiseandShine's position.[4]

Hana Financial does not help RiseandShine either. That case, which involved a design mark (*i.e.*, logo) rather than a word mark, held "only" that the doctrine of trademark tacking presents a factual question. 574 U.S. at 423. Tacking provides a way for a markholder "in limited circumstances" to "clothe a new mark with the priority position of an older mark" when "the original and revised marks … create the same, continuing commercial impression." *Id.* at 419-20. It is no surprise this Court found that the tacking inquiry—which is directed expressly at consumers and can be answered with a straightforward yes or no—involves a factual question. *Id.* at 422.

Tacking, however, bears no meaningful resemblance to the distinctiveness inquiry (let alone the broader considerations in the inherent-strength inquiry, which RiseandShine does not even try to compare to the tacking inquiry in *Hana Financial*). While tacking simply requires a factfinder to compare two versions of the same mark and decide whether they present the same commercial impression,

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[4] RiseandShine notes that *Booking.com*'s discussion of distinctiveness referred to how "consumers *in fact* perceive" a term in a mark. Petr.Br.15 (quoting *Booking.com*, 591 U.S. at 560) (RiseandShine's emphasis); *see* Petr.Br.11, 13. But that phrasing, used in a case that did not involve any dispute over whether distinctiveness is a legal or factual question, does not suggest that the Court was implicitly deciding that distinctiveness is a factual question. *See, e.g.*, *Reiter v. Sonotone Corp.*, 442 U.S. 330, 341 (1979) ("[T]he language of an opinion is not always to be parsed as though we were dealing with language of a statute.").

distinctiveness involves the far different task of placing a word into one of the five different classifications on the judge-made *Abercrombie* spectrum based on its source-identifying characteristics. That determination can have far-reaching consequences for trademarks (and words in general) that courts are better positioned to determine. *See Ty Inc. v. Softbelly's Inc.*, 353 F.3d 528, 531-32 (7th Cir. 2003) (noting the "fateful step" of deeming a mark generic); McCarthy §12:12 (explaining that "a court should not find genericness without persuasive and clear evidence that the contested term has become generic"); *see also* Scholars.Br.13 (explaining that "placement of a mark" on the spectrum is not "a pure question of adjudicative fact"). *Hana Financial*'s holding that tacking presents a factual question thus hardly compels the same result as to distinctiveness.

Hana Financial, moreover, applied its holding specifically in the context of a jury trial, explaining 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." 574 U.S. at 423. Although it is easy to see how a tacking inquiry could be presented to a jury ("do these two marks create the same commercial impression?"), RiseandShine does not explain how a jury could comparably be asked to resolve the distinctiveness inquiry (let alone the broader inherent-strength inquiry) as one half of one factor in a multi-factor likelihood-of-confusion analysis.

2. Straining to extend *Hana Financial*, RiseandShine makes the broader argument that *any* issue resolved from the perspective of consumers necessarily presents a question of fact. Petr.Br.21-25. But neither *Hana Financial* nor any other authority supports that sweeping rule. While *Hana Financial* observed 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," 574 U.S. at 422, the Court did not make any categorical pronouncement that questions resolved from the perspective of consumers are *always* factual. That was for good reason: the law is filled with examples of determinations that are made from the perspective of consumers or ordinary observers yet present legal questions.

Consider, for example, a claim for false advertising under the Lanham Act. 15 U.S.C. §1125(a). Courts agree that an allegedly false advertisement must be analyzed based on how it would be "received by the consumer." *InSinkErator, LLC v. Joneca Co.*, 163 F.4th 608, 616 (9th Cir. 2025); *see, e.g.*, *FedEx Ground Package Sys., Inc. v. Route Consultant, Inc.*, 97 F.4th 444, 454 (6th Cir. 2024). Yet courts also agree that multiple aspects of a false-advertising claim can be resolved as "a matter of law," including whether the statement is literally false, whether it is ambiguous, or whether it is puffery. *Allsup, Inc. v. Advantage 2000 Consultants Inc.*, 428 F.3d 1135, 1138 (8th Cir. 2005); *I Dig Texas, LLC v. Creager*, 98 F.4th 998, 1010 (10th Cir. 2024); *Cook, Perkiss & Liehe, Inc. v. N. Cal. Collection Serv. Inc.*, 911 F.2d 242, 245 (9th Cir. 1990).

Similarly, this Court regularly interprets statutes—a paradigmatic legal exercise—based on the meaning of words to "[o]rdinary people" in "ordinary usage." *Mullin v. Doe*, 609 U.S. 324, 342-43 (2026); *see USPS v. Konan*, 607 U.S. 391, 400 (2026) (similar). This Court also considers as a matter of law whether a "statute or regulation" is void for vagueness because "it fails to provide a person of ordinary intelligence fair notice of what is prohibited." *FCC v. Fox Television Stations, Inc.*, 567 U.S. 239, 253 (2012) (cleaned up and citation omitted). And it reviews as a legal question whether a defendant is "in custody," although the determination considers "would a reasonable person have felt he or she was not at liberty to terminate the interrogation and leave." *Thompson v. Keohane*, 516 U.S. 99, 112 (1995). So too for probable-cause and reasonable-suspicion findings, which evaluate the "historical facts" from "the standpoint of an objectively reasonable police officer." *Ornelas v. United States*, 517 U.S. 690, 696 (1996).

Of particular relevance here, the Court has repeatedly treated as legal even "largely factual questions" that implicate free expression, because the "impact on future cases and future conduct" is "too great to entrust them finally to the judgment of the trier of fact." *Bose*, 466 U.S. at 501 n.17 (actual malice). For example, although the obscenity test requires determining whether "the average person, applying contemporary community standards, would find that the work … appeals to the prurient interest," courts review this question as a matter of law. *Free Speech Coal., Inc. v. Paxton*, 606 U.S. 461, 472-73 (2025) (cleaned up); *see Miller v. California*, 413 U.S. 15, 25 (1973). Those principles apply to doctrines

involving commercial speech, such as a product-disparagement "dispute about the sound quality of a loudspeaker." *Bose*, 466 U.S. at 514.

Like the product-disparagement claim in *Bose*, a distinctiveness inquiry in the context of trademark infringement implicates important First Amendment concerns because a successful plaintiff may suppress the defendant's speech. To be sure, the Court has indicated that there is a particularly "strong presumption" of "*de novo* review"—and thus treatment as a legal question—when a particular determination involves application of "a constitutional standard." *Bufkin v. Collins*, 604 U.S. 369, 384 (2025). But the Court has never held that *only* applications of constitutional standards can be questions of law. In any event, an infringement inquiry is intertwined with a constitutional standard—the First Amendment's protection of speech.

3. Consistent with those principles, this Court's decisions and those of lower courts have addressed a mark's distinctiveness without any suggestion that the inquiry is purely factual.

In *Hamilton-Brown Shoe*, for example, the Court considered an infringement claim asserted by a company that manufactured shoes with the trademark "The American Girl." 240 U.S. at 253. The company claimed infringement by the petitioner's use of "American Lady" and sought an injunction and profits. *Id.* The court of appeals held that "The American Girl" was "descriptive" and thus "not the subject of a valid trademark." *Id.* at 253-54. This Court was "unable to concur" in that determination, holding the trademark was not "descriptive" but

"fanciful." *Id.* at 256-57. The Court accorded no deference to the lower court's determination, simply making its own contrary determination.

Moreover, the Court in *Hamilton-Brown Shoe declined* to modify the trial court's findings regarding profits because they were "matters of fact," demonstrating that the Court was well aware of the fact/law distinction. *Id.* at 262. The straightforward conclusion is that the Court considered a mark's placement on the "distinctiveness" spectrum a question at least in part (if not all) for resolution by the court, not solely a factual question. *See also, e.g.*, *Standard Paint Co. v. Trinidad Asphalt Mfg. Co.*, 220 U.S. 446, 457-58 (1911) (independently reviewing the term "Rubberoid" and deeming it "descriptive").

Likewise, although RiseandShine cites decisions labeling distinctiveness a factual question, *see* Petr.Br.27-31, courts in practice often resolve distinctiveness independently, akin to a legal question. *See, e.g.*, *Yuga Labs, Inc. v. Ripps*, 144 F.4th 1137, 1168 (9th Cir. 2025) (holding that marks, "[f]ar from describing [the products], … are arbitrary, if not entirely fanciful"); *Kellogg Co. v. Toucan Golf, Inc.*, 337 F.3d 616, 624 (6th Cir. 2003) ("We find the 'Toucan Sam' word mark and logo each to be fanciful."); *Sara Lee Corp. v. Kayser-Roth Corp.*, 81 F.3d 455, 465 (4th Cir. 1996) (disagreeing with the district court that mark is "generic" and deeming it "suggestive"); *Henri's Food Prods. Co. v. Tasty Snacks, Inc.*, 817 F.2d 1303, 1304-05 (7th Cir. 1987) (disagreeing with district court "that 'tasty' is generic" and holding "tasty" "descriptive"); *see* IPO.Br.10-11.

These decisions were not couched in terms of clear error or the absence of a genuine factual issue but were essentially *de novo* determinations. In reality, therefore, circuits are treating as "legal" what they may outwardly characterize as "factual," indicating an implicit understanding that even the antecedent step of placing a mark on the spectrum of distinctiveness is legal. Indeed, some of RiseandShine's own cases fit that model, demonstrating that the circuits are not actually as uniform on this question as RiseandShine suggests. *See, e.g.*, *Welding Servs., Inc. v. Forman*, 509 F.3d 1351, 1356-59 (11th Cir. 2007) (concluding that "Welding Services" mark "is generic"). Regardless, as this Court has not hesitated to hold when appropriate, sometimes a majority position in the lower courts is just wrong. *See, e.g.*, *Royal Canin U.S.A., Inc. v. Wullschleger*, 604 U.S. 22, 30 (2025).

C. RiseandShine's Remaining Arguments Further Undermine Its Position.

Veering beyond the question presented, RiseandShine asserts that the inherent-strength determination should be treated as a factual question because the overall likelihood-of-confusion determination should be treated as a factual question. *See* Petr.Br.34-35; *see also* SG.Br.27-30. But the Second Circuit squarely rejected the latter proposition, Pet.App.10a-11a, and RiseandShine declined to seek review of that issue. This Court should therefore "take it as given" here that the likelihood-of-confusion test overall is a legal question. *Bondi v. VanDerStok*, 604 U.S. 458, 467 (2025); *see,*

e.g., *Warner Chappell Music, Inc. v. Nealy*, 601 U.S. 366, 371 (2024).[5]

In another distraction, RiseandShine and its amici invoke the Seventh Amendment's jury right. *See* Petr.Br.25-26; INTA.Br.20-21; AIPLA.Br.10-11. But the Seventh Amendment has no relevance to the question presented. *See* Shahshahani.Br.16-18. If inherent strength is a legal question, courts can resolve it without a jury. *See, e.g.*, *Georgia v. Brailsford*, 3 U.S. 1, 4 (1794). By contrast, if inherent strength is a factual question, it *may* be a question for the jury to decide in some postures but not others—and the difference has nothing to do with the question presented. For example, if a trademark-infringement suit seeking damages proceeds to a jury trial, the jury can resolve factual questions. *See Dairy Queen, Inc. v. Wood*, 369 U.S. 469, 479 (1962). But if a plaintiff seeks only equitable relief, the court must resolve factual questions. *See City of Monterey v. Del Monte Dunes*, 526 U.S. 687, 719 (1999); *see also Nat'l Presto Indus., Inc. v. U.S. Merchs. Fin. Grp., Inc.*, 121 F.4th 671, 677 (8th Cir. 2024) (noting "the Lanham Act provides no statutory right to a jury trial" for trademark-infringement claim).

While the Seventh Amendment plays no role in resolving whether inherent strength is a legal or factual question, RiseandShine's contention that

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[5] Other circuits agree that the ultimate likelihood-of-confusion conclusion is a legal question. *See Naterra Int'l, Inc. v. Bensalem*, 92 F.4th 1113, 1116 (Fed. Cir. 2024); *Progressive Distrib. Servs., Inc. v. United Parcel Serv., Inc.*, 856 F.3d 416, 427 (6th Cir. 2017). This Court, moreover, has declined to review the question. *See, e.g.*, *Kibler v. Hall*, 583 U.S. 820 (2017).

inherent strength is factual will have important consequences for courts and juries. If RiseandShine is correct, it will be more difficult for courts to grant summary judgment because the presence of an additional factual question increases the likelihood of a "genuine dispute as to any material fact," precluding summary judgment. Fed. R. Civ. P. 56(a). That development could significantly disrupt trademark litigation by increasing its cost and unpredictability and encouraging opportunistic plaintiffs. *See* Scholars.Br.9; IPO.Br.8-10. RiseandShine's rule will also make it more difficult for intellectual-property holders to clear marks—particularly in crowded fields—if prospective challengers know they can tie up a mark in costly and unpredictable litigation. Trademark policy thus provides another reason to reject RiseandShine's position. *See* Beebe & Fromer, *supra*, at 1021-29.

III. THE COURT SHOULD AFFIRM SUMMARY JUDGMENT FOR PEPSICO REGARDLESS.

Even if inherent strength were purely factual, affirmance for PepsiCo remains warranted on two grounds. First, the Second Circuit's decision supports the conclusion that no reasonable jury could find that "rise" is inherently strong. Second, the other *Polaroid* factors and the unchallenged aspects of the decisions below support summary judgment of no likelihood of confusion. *See, e.g.*, *Monasky v. Taglieri*, 589 U.S. 68, 85-86 (2020) (affirming rather than vacating after correcting lower court's standard); *Global-Tech Appliances, Inc. v. SEB S.A.*, 563 U.S. 754, 770-71 (2011) (same).

A. The Second Circuit's Reasoning Supports The Conclusion That No Reasonable Jury Could Find RiseandShine's Mark Inherently Strong.

RiseandShine acknowledges that if inherent strength is a factual issue, summary judgment may still be appropriate. Indeed, RiseandShine concedes that *Hana Financial* allowed for summary judgment in the consumer-perception context. *See* Petr.Br.32-33; *accord* SG.Br.30-32. Should the Court hold that inherent strength is factual, affirmance remains warranted because the Second Circuit's analysis supports the conclusion that no reasonable jury could find that "rise" is inherently strong. *See* CVSG.Br.19 (Government's invitation brief stating the Second Circuit's reasoning "may simply reflect the … view that no reasonable factfinder could have found RiseandShine's mark to be inherently strong").

The uncontroverted record and the reasoning of the published opinion amply support that conclusion. While acknowledging RiseandShine's claim to being the only "single-serving canned caffeinated beverage" using "'RISE' as the principal term"—a gerrymandered description RiseandShine repeats here, *see* Petr.Br.3—the Second Circuit nevertheless described, *inter alia*, (i) "the strong logical associations between 'Rise' and coffee"; (ii) the "direct[]" connection between "[t]he word 'Rise'" and "energy itself"; and (iii) the "over 100 uses of the term 'Rise' in connection with coffee, tea, bottled beverages, energy drinks" and other breakfast-related products "allud[ing] to increased energy, particularly in the morning hours." Pet.App.56a, 58a. The court also noted

RiseandShine's founders' acknowledgment that "Rise" "symbolizes the start of a new day and getting up and on the go" and being "energetic"—*i.e.*, its ordinary meaning—and that they even named their company after a phrase connoting the same. C.A.App.977; Pet.App.56a. The Second Circuit further highlighted RiseandShine's prior acknowledgment to the PTO that the "term 'Rise' is extremely weak" and should receive "a narrow scope of protection," Pet.App.57a-58a, an admission RiseandShine reiterated in defending against a potential infringement claim, *see* pp.10-11, *supra*. RiseandShine cannot leverage the inherent weakness of "Rise" in selecting and defending its trademark, yet then assert that "Rise" is inherently strong when seeking to prevent others from using the word.

Notably, RiseandShine has never identified any "evidence of consumer perception" (including consumer surveys) regarding the inherent strength of "rise," Petr.Br.32—much less evidence creating a genuine factual dispute that consumers consider "rise" inherently strong. If anything, that telling omission reinforces that inherent strength is a legal question. At a minimum, it shows that no reasonable jury could find "rise" strong, as the Second Circuit's decision supports.

B. The Other *Polaroid* Factors Support Summary Judgment For PepsiCo Regardless.

Even assuming a genuine factual dispute on inherent strength, summary judgment of no likelihood of confusion remains appropriate given the Second

Circuit's unchallenged determinations regarding the other *Polaroid* factors.

For one, the Second Circuit held that RiseandShine had not "raised triable issues of fact regarding the acquired strength of its mark." Pet.App.8a. RiseandShine cites advertising expenditures and other branding efforts. Petr.Br.3, 10. But the Second Circuit "agree[d] with the district court" that such evidence did not create a genuine factual dispute, "especially in the absence of any consumer studies that link the 'RISE' mark to RiseandShine," which is "probative" in the Second Circuit. Pet.App.8a-9a; *see Centaur Commc'ns, Ltd. v. A/S/M Commc'ns, Inc.*, 830 F.2d 1217, 1223 (2d Cir. 1987) ("[The] test of secondary meaning is not the size of the expenditure used to create it but its effectiveness[.]"). RiseandShine does not challenge those determinations in this Court.

For another, in granting summary judgment, the district court held that the "similarity" factor "weighs strongly against" RiseandShine. Pet.App.34a-35a. RiseandShine did not appeal that ruling, and the Second Circuit's decision affirming summary judgment reiterated that RiseandShine's mark "does not resemble PepsiCo's mark." Pet.App.12a. The Second Circuit also noted that, under circuit precedent, the "similarity-of-marks factor" is "dispositive … when the marks are sufficiently dissimilar." Pet.App.12a. RiseandShine does not contest that precedent here, or the Second Circuit's determination that its mark "does not resemble

PepsiCo's mark," thus rendering this factor "dispositive" under Second Circuit law.[6]

There is more. RiseandShine cites a "pattern" of "actual customer confusion," another *Polaroid* factor. Petr.Br.4, 10. But the Second Circuit held that RiseandShine's evidence "centered on the perceptions of industry professionals," thereby doing "little to show likelihood of *consumer* confusion," and that RiseandShine "failed" to "provid[e] consumer surveys" demonstrating "that consumers were confused." Pet.App.12a-13a. Again, RiseandShine does not dispute those determinations. And while RiseandShine suggests bad faith (another *Polaroid* factor) because PepsiCo supposedly "admired" RiseandShine and "considered acquiring" it, Petr.Br.3, RiseandShine cites no evidence regarding the former and the Second Circuit rejected the latter, stating in yet another uncontested observation that RiseandShine "sought a 'partnership' with PepsiCo, which PepsiCo declined," Pet.App.13a; *see* p.11, *supra*.

In short, even if RiseandShine could raise a genuine factual dispute on inherent strength, the Second Circuit's unchallenged conclusions regarding the other *Polaroid* factors justify summary judgment of no likelihood of confusion. Affirmance of the Second

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[6] RiseandShine suggests that the first Second Circuit opinion's inherent-strength reasoning "dictated" its "similarity" analysis. Pet.Br.8-9. That assertion ignores the many differences in appearance the Second Circuit's clear-error determination recounted. *See* p.15, *supra*. Regardless, RiseandShine does not contest the Second Circuit's subsequent holding that RiseandShine's mark "does not resemble" PepsiCo's mark.

Circuit's judgment is thus warranted on this basis as well.[7]

CONCLUSION

The judgment should be affirmed.

Respectfully submitted,

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[7] At a minimum, if the Court disagrees with the Second Circuit on the question presented, it should vacate the judgment below and allow the Second Circuit to consider these alternative grounds for affirmance. *See* SG.Br.32.