

Docket No. 19-16464

In the
United States Court of Appeals
For the
Ninth Circuit

LTTB LLC, a California limited liability company,

Plaintiff-Appellant,

v.

REDBUBBLE, INC., a Delaware corporation,

Defendant-Appellee.

*Appeal from a Decision of the United States District Court for the Northern District of California,
No. 3:18-cv-00509-RS · Honorable Richard Seeborg*

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

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CORPORATE DISCLOSURE STATEMENT

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STATEMENT OF INTEREST OF *AMICUS CURIAE*¹

Founded in 1878, INTA 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 member organizations from 191 countries. Its members include trademark and brand owners, law firms, and other professionals who regularly assist brand owners in the creation, registration, protection, and enforcement of their trademarks. All of INTA's members share the goal of promoting an understanding of the essential role that trademarks play in fostering informed decisions by consumers, effective commerce, and fair competition.

INTA's members are frequent participants, as both plaintiffs and defendants, in litigations brought under the federal trademark statute the Lanham Act and, therefore, are interested in the development of clear, consistent, and equitable principles of trademark, advertising, and unfair competition law. INTA has

¹ Pursuant to Rule 29(a)(2) of the Federal Rules of Appellate Procedure, *amicus curiae* certifies that all parties have consented to the filing of this brief. Additionally, in accordance with Rule 29(a)(4)(E) of the Federal Rules of Appellate Procedure, *amicus curiae* states that this brief was authored solely by INTA and its counsel, and no part of this brief was authored by counsel to a party. 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.

substantial expertise and has participated as *amicus curiae* in numerous cases involving significant Lanham Act issues.²

² Cases in which INTA has filed *amicus* briefs include: *Romag Fasteners, Inc. v. Fossil, Inc.*, 139 S. Ct. 2778 (2019) (granting certiorari); *Peter v. NantKwest, Inc.*, 589 U.S. ___, 2019 WL 6719083 (2019); *Iancu v. Brunetti*, 588 U.S. ___, 139 S. Ct. 2294 (2019); *Mission Prod. Holdings, Inc. v. Tempnology, LLC*, 587 U.S. ___, 139 S. Ct. 1652 (2019); *Fourth Estate Pub. Benefit Corp. v. Wall-Street.com, LLC*, 586 U.S. ___, 139 S. Ct. 881 (2019); *Matal v. Tam*, 582 U.S. ___, 137 S. Ct. 1744 (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 Makeup, 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., Inc.*, 529 U.S. 205 (2000); *Fla. Prepaid Postsecondary Educ. Expense Bd. v. College 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); *Ohio State Univ. v. Redbubble, Inc.*, Case No. 19-3388 (6th Cir. 2019); *Christian Louboutin S.A. v. Yves Saint Laurent Am. Holdings, Inc.*, 696 F.3d 206 (2d Cir. 2012); *Rosetta Stone Ltd. v. Google, Inc.*, 676 F.3d 144 (4th Cir. 2012); *Fleischer Studios, Inc. v. A.V.E.L.A., Inc.*, 654 F.3d 958 (9th Cir. 2011); *Levi Strauss & Co. v. Abercrombie & Fitch Trading Co.*, 633 F.3d 1158 (9th Cir. 2011); *Chloe v. Queen Bee of Beverly Hills, LLC*, 616 F.3d 158 (2d Cir. 2010); *Starbucks Corp. v. Wolfe's Borough Coffee, Inc.*, 588 F.3d 97 (2d Cir. 2009); *ITC Ltd. v. Punchgini, Inc.*, 482 F.3d 135 (2d Cir. 2007), *certified questions accepted*, 870 N.E.2d 151 (N.Y. 2007), *cert. denied*, 552 U.S. 827 (2007), *certified questions answered*, 880 N.E.2d 852 (N.Y. 2007), *later proceedings*, 518 F.3d 159 (2d Cir. 2008); *Louis Vuitton Malletier S.A. v. Haute Diggity Dog, LLC*, 507 F.3d 252 (4th Cir. 2007); *Test Masters Educ. Servs. v. Singh*, 428 F.3d 559 (5th Cir. 2005); *WarnerVision Entm't Inc. v. Empire of Carolina, Inc.*, 101 F.3d 259 (2d Cir. 1996); *Preferred Risk Mut. Ins. Co. v. United States*, 86 F.3d 789 (8th Cir. 1996); *Conopco, Inc. v. May Dep't Stores Co.*, 46 F.3d 1556 (Fed. Cir. 1994); *Ralston Purina Co. v. On-Cor Frozen Foods, Inc.*, 746 F.2d 801 (Fed. Cir. 1984); *Anti-Monopoly, Inc. v. Gen. Mills Fun Grp., Inc.*, 684 F.2d 1316 (9th

INTA (formerly known as the United States Trademark Association) 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 almost all major federal trademark and advertising legislation including the Lanham Act, which is at issue in this appeal.

INTA and its members have a particular interest in this case because the district court's application of the aesthetic functionality doctrine is inconsistent with existing case law and, if allowed to stand, risks undermining brand owners' ability to protect their marks against infringing uses that will deceive consumers about the source or sponsorship of products but will nevertheless evade liability under claims of aesthetic functionality. Specifically, the district court failed to apply the two-step test for functionality articulated in *Au-Tomotive Gold, Inc. v. Volkswagen of America, Inc.*, 457 F.3d 1062, 1070-73 (9th Cir. 2006), which includes inquiring into whether the use at issue – here, shirts emblazoned with

Cir. 1982), *cert. denied*, 459 U.S. 1227 (1983); *In re Borden, Inc.*, 92 F.T.C. 669 (1978), *aff'd sub nom. Borden, Inc. v. Fed. Trade Comm'n*, 674 F.2d 498 (6th Cir. 1982), *vacated and remanded*, 461 U.S. 940 (1983); *Redd v. Shell Oil Co.*, 524 F.2d 1054 (10th Cir. 1975), *cert. denied*, 425 U.S. 912 (1976); *Century 21 Real Estate Corp. v. Nev. Real Estate Advisory Comm'n*, 448 F. Supp. 1237 (D. Nev. 1978), *aff'd*, 440 U.S. 941 (1979); *Penguin Grp. (USA) Inc., v. Am. Buddha*, 946 N.E.2d 159 (N.Y. 2011).

appellants' federally registered trademark, "Lettuce Turnip The Beet" – confers a significant non-reputation-related advantage. Instead, the district court held that Redbubble was entitled to summary judgment because, the court found, Redbubble did not use the phrase at issue in a source-identifying manner. Whether the use was source-identifying is not only a question of fact that should have been submitted to a jury, but also the wrong legal test. That is because a usage can be infringing whether it is used in a source-identifying way or in an ornamental fashion. Rather, the court should have considered whether there were any genuine disputes of material fact as to (1) plaintiff LLTB's claim of trademark infringement (assessed in this Circuit under the factors articulated in *AMF Inc. v. Sleekcraft Boats*, 599 F.2d 341 (9th Cir. 1979)) and (2) defendant Redbubble's defense of aesthetic functionality (assessed by considering whether the use confers a significant non-reputation-related advantage pursuant to this Circuit's guidance in *Au-Tomotive Gold*). INTA takes no position on whether Redbubble's use of the phrase is infringing or whether it may be permitted because it is not likely to cause confusion (or is otherwise permissible, such as because it is a fair use). INTA fundamentally disagrees, however, with the district court's analysis and its grant of summary judgment.

ARGUMENT

I. The Court Erred in Its Application of the Aesthetic Functionality Doctrine.

A. History of the Aesthetic Functionality Defense.

The doctrine of functionality is a common law doctrine with two distinct branches that provide defenses to claims of trademark infringement: utilitarian functionality and aesthetic functionality. RESTATEMENT (FIRST) OF TORTS § 742 (AM LAW INST. 1938). The First Restatement of Torts recognized both a utilitarian functionality arising from an “efficiency or economy of manufacturing” or contribution to utility, durability, or effectiveness, as well as an aesthetic functionality of features like a heart-shaped candy box or distinctive printing type face, that would “deprive [] others of something which will substantially hinder them in competition.” *Id.* at cmt. a.

The doctrines of utilitarian and aesthetic functionality have continued to develop with significant aid from Supreme Court jurisprudence providing guidance on the application of each defense. For example, in 1982, the Supreme Court provided guidance on the utilitarian functionality defense, explaining that “a product feature is functional if it is essential to the use or purpose of the article or if it affects the cost or quality of the article.” *Inwood Labs., Inc. v. Ives Labs., Inc.*, 456 U.S. 844, 850 n.10 (1982). Later, the Court elaborated on the underlying purpose of the defense of utilitarian functionality – specifically, to prevent parties

from using trademark law to obtain perpetual monopolies on the trade dress of useful articles that instead should be protected by patent. *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 164-65 (1995). Granting such monopolies would be anti-competitive because it would grant patent-like protection on inventions in perpetuity. *Id.*

In *Qualitex*, the Court also provided guidance on the defense of aesthetic functionality. The Court noted that, although the aesthetic functionality defense is similarly designed to prevent anti-competitive behavior, this branch of functionality focuses on purely aesthetic or ornamental features, as opposed to utilitarian product features and inventions, and applies only when a party's exclusive use of a feature would put others at a "significant non-reputation-related disadvantage." *Id.* at 165; *see also TrafFix Devices v. Mktg. Displays, Inc.*, 532 U.S. 23, 32-33 (2001) (clarifying that, to determine whether a feature is aesthetically functional, courts should inquire into the potential for a "significant non-reputation-related disadvantage" after first considering the test for utilitarian functionality that the Court articulated in *Inwood Labs*); RESTATEMENT (THIRD) UNFAIR COMPETITION § 17, cmt. c (AM. LAW INST. 1995) (explaining that the test is whether the recognition of trademark rights would hinder competition). By "non-reputation-related disadvantage," the Court meant advantages that derive from the aesthetic or ornamental quality of the usage as opposed to the goodwill in

the plaintiff's mark. For example, the Second Circuit determined that a baroque design on silverware was aesthetically functional because other silversmiths had a competitive need to use baroque designs in order to fairly compete in the market. *Wallace Int'l Silversmiths, Inc. v. Godinger Silver Art Co.*, 916 F.2d 76, 81 (2d Cir. 1990); *see also Pagliero v. Wallace China Co.*, 198 F.2d 339 (9th Cir. 1952) (particular china pattern was aesthetically functional because consumers purchased the china for its beauty and not because they believed the design meant the china came from a particular manufacturer).

Between 1938, when the First Restatement of Torts provided comment on the functionality defense, and 1982, when the Supreme Court started issuing its series of modern opinions on utilitarian and aesthetic functionality, circuit courts grappled with how to apply the functionality defenses. During this period, the Ninth Circuit – without the benefit of the Supreme Court's holdings in *Inwood Labs*, *Qualitex*, and *TrafFix Devices* – dramatically enlarged the doctrine of aesthetic functionality through its opinion in *International Order of Job's Daughters v. Lindeburg & Co.*, 633 F.2d 912, 920 (9th Cir. 1980), a controversial case that has since been severely criticized and effectively overruled. In *Job's Daughters*, the Ninth Circuit held that jewelry that copied the trademarked design of the International Order of Job's Daughters' insignia was not infringing because the defendant used the insignia in an ornamental, aesthetically functional manner.

To reach that holding, the court drew an unusual distinction: It held that, when members of the International Order of Job's Daughters wore jewelry displaying the group's insignia, the insignia served as a collective trademark, identifying members of the group; in contrast, when a jeweler, unaffiliated with the group, produced jewelry bearing the insignia, it was aesthetically functional because the inherently appealing insignia served to promote sales rather than to identify the source or membership of the product or individual wearing it. *Id.* at 918. The *Job's Daughters* court held that, because the defendant used the insignia in an aesthetically functional, rather than source-identifying manner, there could be no infringement. *Id.* at 920.

Job's Daughters – on which the district court in this case extensively relied – essentially created a backdoor defense to infringement claims whenever an infringer can claim that it is using the plaintiff's mark only for its ornamental appeal and not for its source-identifying functions. Such a defense, if it were valid, would allow infringers to make, *inter alia*, apparel emblazoned with popular brand names, sports team names, slogans, taglines, and other trademarks and would immunize rampant trademark counterfeiting whenever an infringer could claim that a trademark arguably has some aesthetic appeal. That is not, and never has been the law and is wholly inconsistent with the Lanham Act's protection of trademarks. *See, e.g., Boston Prof. Hockey Ass'n v. Dallas Cap & Emblem Mfg.,*

Inc., 510 F.2d 1004, 1013 (5th Cir. 1975) (rejecting manufacturer’s argument that its use of National Hockey League team symbols on patches for apparel was permissible because the symbols promoted sales through aesthetic appeal).

For these reasons, *Job’s Daughters* has been the subject of significant criticism including from other circuits that have rejected the *Job’s Daughters* holding. For example, in *W.T. Rogers Co. v. Keene*, 778 F.2d 334, 340 (7th Cir. 1985), the Seventh Circuit, in the context of evaluating a district court’s jury instructions on functionality, explicitly rejected *Job’s Daughters* and the notion that a trade name, symbol, or design is functional simply because it is intrinsically pleasing. The Seventh Circuit reasoned that this notion would “swallow up much, perhaps all, of trademark law,” because most manufacturers strive to select a pleasing name, symbol, or design as a trademark. *Id.* at 343 (noting that the Seventh Circuit and most courts believed the pre-1985 Ninth Circuit cases “g[ave] too little protection to pleasing trademarks”). The Seventh Circuit held instead that the proper test was whether competition was possible without copying the plaintiff’s mark – in that case, the hexagonal design of letter stacking trays. *Id.* at 343, 346 (emphasizing that “the fact that people like [the hexagonal design] does not by itself prevent the manufacturer from being able to use it as his trademark”). Similarly, the Tenth Circuit, in considering the functionality of a spin-cast fishing reel, rejected the principle of *Job’s Daughters* that a product feature is functional

simply because it has appeal and contributes to commercial success. *Brunswick Corp. v. Spinit Reel Co.*, 832 F.2d 513, 518, 519-20 (10th Cir. 1987) (affirming that the reel’s distinctive cone shape was not “indispensable to manufacturing a competitive spin-cast reel”). The Eleventh Circuit also has questioned the reasoning of *Job’s Daughters*, characterizing as “unsupported” the court’s conclusion that consumers would not assume jewelry bearing the insignia of the International Order of Job’s Daughters was sponsored by or affiliated with the group. *Univ. of Ga. Athletic Ass’n v. Laite*, 756 F.2d 1535, 1546, n.28 (11th Cir. 1985). The Eleventh Circuit declined to apply *Job’s Daughters* to the use of the University of Georgia’s bulldog mascot on “Battlin’ Bulldog Beer” and noted that “most consumers who purchase products containing the name or emblem of their favorite school or sports team would prefer an officially sponsored or licensed product to an identical non-licensed product.” *Id.* See also *Alpha Tau Omega Fraternity, Inc. v. Pure Country, Inc.*, No. IP 01-1054-C-B/F, 2004 WL 3391781, at *6 (S.D. Ind. Oct. 26, 2004) (rejecting *Job’s Daughters* and the argument that the sorority and fraternity trademarks that defendant applied to afghans were aesthetically functional); Anthony Fletcher, *Defensive Aesthetic Functionality: Deconstructing the Zombie*, 101 TRADEMARK REP. 1687, 1709 (2011) (acknowledging the challenge in separating aesthetic appeal from source-identifying function and arguing that “courts that have embraced defensive

aesthetic functionality have turned a blind eye to the fact that the sale of the articles with the supposed aesthetically functional character is at least in large part the sale of the goodwill and reputation of the plaintiff”).

Job's Daughters was so controversial that, shortly after it was issued, another panel of the Ninth Circuit recognized that its language was too expansive and began to limit the scope of its holding. In *Vuitton et Fils S.A. v. J. Young Enters., Inc.*, 644 F.2d 769 (9th Cir. 1981), the Ninth Circuit reduced the breadth of the aesthetic functionality doctrine by reversing a district court holding that the Louis Vuitton repeating pattern of an LV surrounded by three floral symbols was aesthetically functional simply because it contributed to consumer appeal and salability. The court disagreed with the district court “insofar as it found that any feature of a product which contributes to the consumer appeal and salability of the product is, as a matter of law, a functional element of that product.” *Id.* at 773. Rather, the court pointed to the federal registration of Louis Vuitton’s design and concluded, based on that registration, that the design was “intended, at least in part, to indicate the origin of the products.” *Id.* at 774. The court therefore rejected defendant’s argument that the design was functional simply because it contributed to consumer appeal. *Id.* The Ninth Circuit declined to put much weight on aesthetic appeal, which is dependent on “subjective impulses, difficult to quantify or specify” and, instead, clarified that “a trademark which identifies the source of

goods and incidentally serves another function may still be entitled to protection.” *Id.* at 774-75. The Tenth Circuit subsequently recognized that, with its decision in *Vuitton*, the Ninth Circuit refined its approach to aesthetic functionality and “rejected an interpretation that would define, as a matter of law, any feature of a product that contributes to its consumer appeal and marketability, as a functionality element.” *Brunswick Corp.*, 832 F.2d at 518.

In 2006, the Ninth Circuit, with the benefit of the Supreme Court’s opinions in *Inwood Labs*, *Qualitex* and *TrafFix Devices*, expanded upon its holding in *Vuitton* and essentially overruled *Job’s Daughters*. In *Au-Tomotive Gold, Inc. v. Volkswagen of America, Inc.*, 457 F.3d 1062 (9th Cir. 2006), the court considered whether the doctrine of aesthetic functionality protected Au-Tomotive Gold’s use of Volkswagen and Audi trademarks on key chains and license plate covers. Au-Tomotive Gold, relying on *Job’s Daughters*, argued that because the Volkswagen and Audi marks were the reason consumers wanted to purchase the products at issue, the marks were aesthetically functional. The Ninth Circuit emphatically rejected this argument. *Id.* at 1069 (*citing Vuitton*, 644 F.2d at 773). Instead, the court recognized that any defense of aesthetic functionality must meet the two-step test articulated by the Supreme Court in *Qualitex* and *TrafFix Devices*. *Id.* at 1072 (*citing TrafFix Devices*, 532 U.S. at 32–33). Under that test, courts must first “inquire whether the alleged ‘significant non-trademark function’” is “essential to

the use or purpose of the article [or] affects [its] cost or quality.” *Id.* As a second step, courts must then consider “whether protection of the feature as a trademark would impose a *significant non-reputation-related competitive disadvantage.*” *Id.* at 1072 (citing *Qualitex*, 514 U.S. at 165) (emphasis added). The *Au-Tomotive Gold* court found that it was not possible to distinguish between the aesthetic appeal and source-identifying nature of the Volkswagen and Audi marks and, as a result, Au-Tomotive Gold could not sell products displaying the marks. *Id.* at 1073–74. In other words, the disadvantage claimed by Au-Tomotive Gold was reputation related; it wanted to use these marks on its products in order to capitalize on their goodwill, not because of their aesthetic appeal (like the appeal of a heart-shaped candy box or a baroque-inspired flatware design). As such, Au-Tomotive Gold could not rely on the aesthetic functionality defense.

Since *Au-Tomotive Gold*, this court as well as a number of district courts in this Circuit, have applied the *Au-Tomotive Gold* standard rather than the *Job’s Daughters* standard, to assess aesthetic functionality. For example, in *Millennium Labs., Inc. v. Ameritox, Ltd.*, 817 F.3d 1123 (9th Cir. 2016), the Ninth Circuit considered whether the design of a laboratory’s urine testing report was functional. The court first applied the *Inwood Labs* standard and considered whether the report’s design was essential to the use or purpose of the product or impacted cost or quality. *Id.* at 1128-30. After concluding that the report’s design was non-

functional as a matter of law because testing results could be presented in many different ways, such that no particular design was essential, the court considered whether the laboratory's exclusive use of the design of the reports would impose a significant non-reputation-related disadvantage on competitors. *Id.* at 1131 (citing *Au-Tomotive Gold*, 457 F.3d at 1072). Under this second step, the court held that the design was not aesthetically functional because the appellant had "presented evidence that the graphical format served *in part* a source-identifying function," which was sufficient to survive a motion for summary judgment. *Id.* (emphasis added).

Similarly, in *Moldex-Metric, Inc. v. McKeon Products, Inc.*, 891 F.3d 878 (9th Cir. 2018), the court rejected a defense of aesthetic functionality related to the color of foam earplugs. Moldex, which made lime green earplugs, sued McKeon for selling earplugs of a similar hue. Moldex lost on summary judgment in the district court because the court ultimately found that the bright green color was essential to the use and purpose of the earplugs and therefore functional under the *Inwood Labs* test. *Moldex-Metric, Inc. v. McKeon Products, Inc.*, No. CV 11-1742-GHK, 2016 WL 6272452, at *4–5 (C.D. Cal. Mar. 31, 2016). On appeal, the Ninth Circuit reversed, holding, in part, that aesthetic functionality is limited to "product features that serve an aesthetic purpose wholly independent of any source identifying function." *Moldex-Metric, Inc.*, 891 F.3d at 885 at 1131 (internal

quotations omitted). Because a reasonable jury could have found, under the two-step *Au-Tomotive Gold* test, that the lime green color was not functional, the Ninth Circuit overturned the lower court's grant of summary judgment against Moldex and remanded the case for trial so that a jury could assess the parties' competing factual assertions. *Id.* at 887. *See also K and N Engineering, Inc. v. Bulat*, 259 Fed. Appx. 994, 995 (9th Cir. 2007) (“[b]ecause the K&N mark does not serve an aesthetic purpose wholly independent from its function of identifying K&N, Bulat and Wandel’s aesthetic functionality defense fails.”) (citing *Au–Tomotive Gold*, 457 F.3d at 1073); *Dr. Ing. h.c.F. Porsche AG v. Universal Brass, Inc.*, No. C94-792C, 1995 WL 420816 at *4 (W.D. Wa. Feb. 23, 1995) (rejecting the application of *Job’s Daughters* to the use of the Porsche trademark on accessories because *Job’s Daughters*’ interpretation of aesthetic functionality applied in the limited context of collective marks; collecting cases criticizing or rejecting *Job’s Daughters*; and finding that the aesthetic functionality defense did not apply to defendant’s use as “the aesthetic appeal of the mark [could] not be allowed to overtake the primary function of the mark as a designation of origin”).

B. The District Court Misapplied This Circuit’s Precedents on Aesthetic Functionality.

Although the district court acknowledged that *Au-Tomotive Gold* had narrowed the scope of the aesthetic functionality defense, it failed to account for those limitations in its analysis. *See, LTTB, LLC v. Redbubble, Inc.*, 385 F. Supp.

3d 916, 920 (N.D. Cal. 2019) (citing *Au-Tomotive Gold* but conclusively holding that the “present case presents circumstances undeniably calling for application of the aesthetic functionality doctrine”). Instead, the district court applied the outdated formulation of the aesthetic functionality doctrine set forth in *Job’s Daughters*. *Id.* at 921-22 (citing to *Job’s Daughters*, 633 F.2d at 918-20). Rather than asking whether protection of the LTTB mark would “put competitors at a significant non-reputation-related disadvantage,” *Au-Tomotive Gold*, 457 F.3d at 1072, the court held that the LTTB mark is aesthetically functional because “[t]he products are simply the vehicle for distributing the claimed ‘trademark,’ rather than the other way around, where a trademark is used to identify the source of the goods.” *LTTB*, 385 F. Supp. 3d at 921. The court failed to apply the two-step test articulated in *Au-Tomotive Gold*, which itself was based on the Supreme Court’s decisions in *Inwood Labs*, *Qualitex*, and *TrafFix Devices*. *Id.*

This is not the first time the continued potential viability of *Job’s Daughters* has caused confusion and error despite subsequent cases that have demonstrated that *Job’s Daughters* is no longer good law and is inconsistent with the Supreme Court’s decisions in *Inwood Labs*, *Qualitex*, and *TrafFix Devices*.³ In *Fleischer*

³ Because these Supreme Court decisions changed the mode of analysis for assessing aesthetic functionality, these decisions effectively abrogated *Job’s Daughters’* approach to analyzing aesthetic functionality. See Antonin Scalia, *The Rule of Law as a Law of Rules*, U. CHI. L. REV. 1175, 1177 (1989) (“when the Supreme Court . . . decides a case, not merely the outcome of that decision,

Studios, Inc. v. A.V.E.L.A., Inc., 636 F.3d 1115, 1123 (9th Cir. 2011), a panel of the Ninth Circuit, relying heavily on *Job’s Daughters*, found that the sale of merchandise bearing the BETTY BOOP trademark and imagery was aesthetically functional. After the plaintiff sought rehearing or rehearing *en banc*, with amicus support from INTA and numerous other amici, *see, e.g.*, Brief of Amicus Curiae INTA in Support of Rehearing or Rehearing En Banc, available at <http://www.inta.org/Advocacy/Documents/INTAFleischerAVELA.pdf>, the panel withdrew the opinion and issued a new decision that made no reference to *Job’s Daughters* or aesthetic functionality. *Fleischer Studios, Inc. v. A.V.E.L.A., Inc.*, 654 F.3d 958 (9th Cir. 2011). INTA respectfully suggests that, in light of *Inwood Labs*, *Qualitex*, *TrafFix Devices*, and *Au-Tomotive Gold*, the time has come for the Ninth Circuit to definitively rule that *Job’s Daughters* has been overruled, and that the *Job’s Daughters* standard for assessing aesthetic functionality no longer is good law.⁴

but the mode of analysis that it applies will thereafter be followed by the lower courts within that system, and even by the Supreme Court itself”).

⁴ The Manual of Model Civil Jury Instructions for the District Courts of the Ninth Circuit incorrectly states that “[f]unctional features of a product are features ‘which constitute the actual benefit that the consumer wishes to purchase, as distinguished from an assurance that a particular entity made, sponsored, or endorsed a product’ . . . [a] functional design has aesthetic appeal, or increases the utility or practicality of the product, or saves the consumer or producer time or money.” Manual of Model Civil Jury Instructions for the District Courts of the Ninth Circuit, p. 343-44 (2019) (citing *Job’s Daughters*, 633 F.2d at 917).

The failings of the district court’s analysis are underscored by the court’s failure to support its summary judgment finding with respect to the source-identifying nature of LTTB’s uses. Though it stated that source confusion was the test for whether LTTB could preclude others from using the LTTB mark, *LTTB*, 385 F. Supp. 3d at 922, the district court did not apply a likelihood of confusion analysis pursuant to the factors this Circuit articulated in *Sleekcraft*, 599 F.2d at 348–49. Instead, the district court pointed to the trademark prosecution history for the LTTB mark, in which the U.S. Patent and Trademark Office (“PTO”) characterized some uses of the LTTB mark on garments as ornamental and non-source identifying. As discussed in section II below, the reliance on the PTO prosecution history was error, but, in any event, this type of “analysis” lacks the nuance of a thorough likelihood of confusion inquiry, as scholars critical of *Job’s Daughters* have recognized. As Professor J. Thomas McCarthy explained:

The theory of defensive aesthetic functionality is much too blunt a weapon to serve as a device to solve problems that arise when a trademark is used by defendant in an arguably ‘decorative’ sense, such as on T-shirts, baseball caps[,] and other paraphernalia. In such cases the question is the familiar but difficult one of whether there is a likelihood of confusion as to source, sponsorship, affiliation[,] or connection. No notions of ‘defensive

Under *Au-Tomotive Gold*, however, the mere presence of aesthetic appeal is not sufficient to render a design functional. *Au-Tomotive Gold*, 457 F.3d at 1069 (citing *Vuitton*, 644 F.2d at 773).

aesthetic functionality’ are proper to serve as an escape from facing head-on the question of likelihood of confusion.

1 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 7:82 (5th ed. Supp. 2019).

Professor McCarthy’s criticism of *Job’s Daughters* highlights the importance of separately analyzing likelihood of confusion and aesthetic functionality. This court’s *Sleekcraft* and *Au-Tomotive Gold* tests are, respectively, the proper tests for thoroughly analyzing these two distinct issues. The district court failed to apply either of those standards; instead, it relied improperly on *Job’s Daughters* and failed entirely to engage in the analyses for which this Circuit’s current jurisprudence calls.

The district court’s error was exacerbated by its apparent findings of fact with respect to the strength of the LTTB mark as contrasted with the Volkswagen and Audi marks at issue in *Au-Tomotive Gold*. Whether the LTTB mark is a pun or not, and whether it is as famous as the Volkswagen and Audi marks or not, it is a registered trademark and, as such, carries a presumption of validity and distinctiveness. 15 U.S.C. § 1115(a) (2002). The court apparently was influenced by its view – unsupported by record evidence – that the LTTB mark lacks brand loyalty and that consumers are attracted to products bearing the mark solely because of the pun and not at all because of the reputation of LTTB products. *See*

LTTB, 385 F. Supp. 3d at 920-21 (“Volkswagen, and Audi . . . have at least arguably gained brand loyalty for those products, as opposed to mere consumer interest in the specific names, independent of the reputation the companies developed when selling the products.”). Not only is the registered nature of *LTTB*’s mark alone sufficient to overcome that challenge at the summary judgment stage, but also, whether this use is likely to cause confusion or is likely to be seen as a non-source identifying use is a uniquely fact-dependent assessment that should be resolved by a jury at trial unless the court has explicitly determined there are no material issues of fact, which was not the case here.

To be clear, *INTA* expresses no view as to whether *LTTB* can succeed at trial in proving confusion under the *Sleekcraft* factors or whether *Redbubble* will succeed at trial in proving it is entitled to the aesthetic functionality defense based on the two-step *Au-Tomotive Gold* test or some other defense. At this stage of the proceedings, *INTA*’s only view is that the district court erred in bypassing these tests entirely and finding, as a matter of law, that *Redbubble*’s use of *LTTB*’s mark on products serves merely an “aesthetic purpose wholly independent of any source identifying function.” *Au-Tomotive Gold*, 457 F.3d at 1073.

II. The Court Erred in Finding that Redbubble Could Not Be Liable for Infringement Because It Used the Phrase LETTUCE TURNIP THE BEET Ornamentally and Not as a Mark.

The district court made a second error that infected its grant of summary judgment: It found, as a matter of law, that Redbubble could not be liable for trademark infringement because it used the “Lettuce Turnip the Beet” phrase ornamentally, and not as a trademark. That decision reflects a fundamental error of law. It is true that a plaintiff must own trademark rights in order to succeed on a claim of trademark infringement, but it is not true that a defendant’s use must have been a trademark use. Rather, *any* use by a defendant that is likely to cause confusion – whether use ornamentally or as a mark, descriptive phrase, or pun – may give rise to a claim for trademark infringement (subject to applicable legal defenses like descriptive fair use). The question is whether consumers are likely to be confused by Redbubble’s use into believing that the apparel at issue comes from, or is sponsored or approved by, the plaintiff – here, LTTB.

This proposition necessarily follows from the language of the Lanham Act, which requires only that a defendant have advertised, distributed, or sold the accused product “in commerce” to give rise to a possible claim for trademark infringement. 15 U.S.C. § 1114(1)(a)-(b) (2005). That “use in commerce” requirement is met if the mark “is placed *in any manner* on the goods or their containers or the displays associated therewith or on the tags or labels affixed

thereto . . . and . . . the goods are sold or transported in commerce.” 15 U.S.C. § 1127 (2006) (emphasis added); *Kelly-Brown v. Winfrey*, 717 F.3d 295, 305 (2d Cir. 2013). The Lanham Act does not distinguish between uses placed on goods for ornamental reasons, or pun reasons, or source-identifying reasons, or for any other reasons; for purposes of establishing that defendant made “use in commerce,” any of these types of uses will suffice. *Id.* at 305-06 (“A plaintiff is not required to demonstrate that a defendant made use of the mark in any particular way to satisfy the ‘use in commerce’ requirement.”).

In *Kelly-Brown*, the owner of a motivational business built around the concept “Own Your Power” sued Oprah Winfrey for using the phrase, on grounds of reverse confusion. Winfrey argued that, unless Kelly-Brown could prove that Winfrey had used the phrase “as a mark” – that is, in a source-identifying way – her claim would fail as a matter of law. *Id.* at 305. The Second Circuit rejected this argument.⁵ It explained that imposing such a threshold requirement would distort the likelihood of confusion test and conflate “use in commerce,” an element

⁵ In so doing, the Second Circuit explicitly rejected the Sixth Circuit’s doctrine requiring a threshold showing of use “as a mark.” *Kelly-Brown*, 717 F.3d at 307. Only the Sixth Circuit has adopted this view, which has been criticized as “eccentric and peculiar,” with “no support either in the Lanham Act or in precedent.” 4 MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION (5th ed. Supp. 2019), § 23:11.50. Indeed, the Sixth Circuit recently acknowledged these criticisms and noted that “[it] might wish to reconsider whether [its] test respects the language of the statute.” *Sazerac Brands, LLC v. Peristyle, LLC*, 892 F.3d 853, 859 (6th Cir. 2018) (affirming on fair use grounds).

of all trademark infringement claims, with “use as a mark,” the first prong of the fair use defense. *Id.* at 305-10 (citing 15 U.S.C. §§ 1114, 1127). The court held that, to proceed with its claim, a plaintiff need only show that the defendant “displayed” plaintiff’s mark “in connection with a commercial transaction.” *Kelly-Brown*, 717 F.3d at 306.

In *VersaTop Support Sys., LLC v. Ga. Expo, Inc.*, 921 F.3d 1364 (Fed. Cir. 2019), the Federal Circuit, applying Ninth Circuit law, agreed that a plaintiff need not show that a defendant used its mark in a source-identifying way, but arrived at this conclusion by a different path. Instead of distinguishing between “use in commerce” and “use as a mark,” the Federal Circuit looked to Ninth Circuit law and *McCarthy* to hold that the “use in commerce” definition found in 15 U.S.C. § 1127 applies not to trademark infringement, but to trademark registration. *Id.* at 1369-70.

In that case, VersaTop asserted claims for trademark infringement against Georgia Expo for using its PIPE & DRAPE 2.0 marks in marketing brochures. The district court held that, because Georgia Expo had not affixed the VersaTop trademarks to goods “sold or transported in commerce” under 15 U.S.C. § 1127, it had not used the marks “in commerce” under the Lanham Act. *VersaTop Support Sys., LLC v. Ga. Expo, Inc.*, No. 3:15-cv-02030-JE, 2017 WL 1364617, at *4-5 (D. Or. Feb. 16, 2017).

The Federal Circuit reversed, finding that the district court had erred by applying the “use in commerce” standard of trademark *registration* – defined in § 1127 – to the question of trademark *infringement*. *VersaTop Support Sys., LLC*, 921 F.3d, at 1370 (citing *Playboy Enters., Inc. v. Netscape Commc’ns Corp.*, 354 F.3d 1020, 1024, n.11 (9th Cir. 2004); *Network Automation v. Advanced Sys. Concepts*, 638 F.3d 1137, 1144–45 (9th Cir. 2011); *Hasbro, Inc. v. Sweetpea Ent’mt, Inc.*, No. 13-3406, 2014 WL 12586021, at *9 (C.D. Cal. Feb. 25, 2014)). The definition of “use in commerce” found in 15 U.S.C. § 1127, the court held, “does not apply to trademark infringement.” *Id.* The Federal Circuit therefore agreed with the Second Circuit that a defendant need not have used plaintiff’s mark in a source-identifying way to be liable for infringement.

Ninth Circuit precedent supports the Federal Circuit’s interpretation of “use in commerce.” In *Playboy Enterprises*, Playboy sued Netscape for allowing (and even requiring) advertisers to purchase its PLAYBOY and PLAYMATE marks as advertising keywords. *Playboy Enters., Inc.*, 354 F.3d at 1023. After briefly stating that the defendant had used the marks, the Ninth Circuit explained that “use in commerce,” as defined in 15 U.S.C. § 1127, refers to the use a plaintiff must make to accrue rights in a mark, as defined in 15 U.S.C. § 1051. *Id.* at 1024, n.11. This statement implies that 15 U.S.C. § 1127 does not apply to determine whether a defendant used a mark in a manner sufficient to support liability.

In *Network Automation*, the Ninth Circuit held that Network’s use of Advanced System’s trademark as a search engine keyword constituted “use in commerce” under 15 U.S.C. § 1114 even though Network did not use the keywords in a source-identifying manner. *Network Automation*, 638 F.3d at 1144–45 (“We now agree with the Second Circuit that [Google’s sale of trademarks as search engine keywords] is a ‘use in commerce’ under the Lanham Act.”) (citing to *Rescuecom Corp. v. Google Inc.*, 562 F.3d 123, 127 (2d Cir. 2009) (holding that Google’s sale of trademarks as search engine keywords is a use in commerce)); 4 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION (4th ed. 2010), §§ 23:11.50, 25:70.25 (suggesting that cases taking a more restrictive view of “use” in this context are based on an erroneous interpretation of the Lanham Act). *Network Automation* therefore rejects the rule applied by the district court in the instant case and does not require a plaintiff to show that defendant’s use of its mark was source-identifying or use “as a mark.”

A related error was the district court’s reliance on the prosecution history of LTTB’s marks at the PTO to establish that Redbubble’s use of “LETTUCE TURNIP THE BEET” on the front of T-shirts could not be an infringing use. The district court suggested that, because the PTO initially refused registration of LTTB’s mark on the ground that, “on the specimen of record,” the mark was “merely a decorative or ornamental feature of the goods,” and because the PTO

only granted rights once LTTB submitted evidence of use of the mark on tags and labels, LTTB can only enforce its registered mark when an alleged infringer is using the mark in a source-identifying manner. *LTTB*, 385 F. Supp. 3d at 919 (citing Dkt. 37-2, p. 3). That approach is incorrect as a matter of law.

This prosecution history is not relevant to whether Redbubble's use is infringing. The PTO assesses an applicant's use of a mark to determine whether it is eligible *for trademark registration*, the requirements for which are different from a court's assessment of whether use of a registered mark by a third party *is trademark infringement*. Whether a defendant's use is infringing is governed by a different section of the Lanham Act and a different standard.

First, as shown above, a plaintiff's claim may proceed to the question of likelihood of confusion whether or not a defendant is using the mark in a source-identifying way. Second, when evaluating a plaintiff's application for a registration, the PTO requires specific types of proof of use in the form of specimens, which must be labels, tags, containers, or displays. *See* 15 U.S.C. § 1051(a)(1) (2002) ("The owner of a trademark used in commerce may request registration of its trademark on the principal register hereby established by . . . filing . . . such number of specimens or facsimiles of the mark as used as may be required by the Director."); 37 C.F.R. § 2.56(b)(1) (2015). No such proof of defendant's use is required for a plaintiff to state a trademark infringement claim.

Accordingly, the PTO's standard for use that will support registration should not be applied as the standard for use that will support a claim for infringement. Rather, LTTB's claims against Redbubble should be reviewed according to the standard for liability for infringement under 15 U.S.C. § 1114 (a)-(b) – whether there is a likelihood of confusion as to the source of products. As noted, INTA takes no position on whether Redbubble can avail itself of other defenses like fair use. That simply underscores, however, why the standard for infringement need not be altered or ignored.

In sum, this Circuit's precedents indicate that the standard applied to evaluate "use in commerce" for purposes of *federal registration* under 15 U.S.C. §§ 1127 and 1051 and the broader "uses" of a mark that trigger *infringement liability* under the Lanham Act are distinct. *See, e.g.*, 15 U.S.C. § 1114. The district court here erred in conflating the two standards. Accordingly, INTA urges the court to reverse and remand for reconsideration of whether Redbubble's display of LTTB's mark on its website in connection with the sale of goods constituted "use in commerce" under 15 U.S.C. § 1114, and further whether this use infringed LTTB's registered trademark under the Ninth Circuit's *Sleekcraft* factors.

CONCLUSION

The district court judgment should be vacated and remanded for consideration of whether Redbubble's use of LTTB's mark is infringement under the *Sleekcraft* factors and for assessment of the two-step test for the functionality defense that this court articulated in *Au-Tomotive Gold*, regardless of whether Redbubble used the LETTUCE TURNIP THE BEET mark as a trademark.

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Respectfully submitted,

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The undersigned hereby certifies that on January 16, 2020, an electronic copy of the Brief of amicus curiae International Trademark Association was filed with the Clerk of the Court for the United States Court of Appeals for the Ninth Circuit by using the CM/ECF system. The undersigned also certifies that all participants are registered CM/ECF users and will be served via the CM/ECF system.

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