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RiseandShine Corporation v. PepsiCo, Inc.

1 **UNITED STATES COURT OF APPEALS**
2 **FOR THE SECOND CIRCUIT**

3
4 August Term, 2021

5
6 (Argued: June 1, 2022 Decided: July 22, 2022)

7
8 Docket No. 21-2786
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13 RISEANDSHINE CORPORATION, DBA Rise Brewing,

14
15 *Plaintiff-Appellee,*

16
17 v.

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19 PEPSICO, INC.,

20
21 *Defendant-Appellant,*
22
23
24 _____

25
26 Before:

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28 LEVAL, CHIN, and MENASHI, *Circuit Judges.*
29

30 In a trademark dispute under the Lanham Act, 15 U.S.C. §§ 1114, 1125(a), and
31 New York law, Defendant-Appellant PepsiCo, Inc., which sold a canned energy
32 drink under the mark “MTN DEW RISE,” appeals from a preliminary injunction
33 imposed by the United States District Court for the Southern District of New
34 York (Schofield, J.), at the instance of Plaintiff-Appellee RiseandShine
35 Corporation, which sells a canned coffee drink under the name “RISE.” Because
36 we find that the district court erred assessing the strength of Plaintiff’s mark and
37 the similarity of the products, we VACATE the preliminary injunction.
38

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20 LEVAL, *Circuit Judge:*

21 In a trademark dispute under the Lanham Act, 15 U.S.C. §§ 1114, 1125(a),
22 and New York’s law of trademark and unfair competition, PepsiCo, Inc., the
23 Defendant, which marketed a canned energy drink under the mark “MTN DEW
24 RISE ENERGY,” appeals from a preliminary injunction imposed on it by the
25 United States District Court for the Southern District of New York (Lorna
26 Schofield, J.) at the instance of the Plaintiff, RiseandShine Corporation, d/b/a Rise
27 Brewing (“Rise Brewing”), which sells nitro-brewed canned coffee (and also
28 canned tea) under the name RISE. It is undisputed that Plaintiff began using the

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1 RISE mark prior to Defendant’s use of its mark. The district court concluded that
2 Defendant’s conduct in using RISE caused a likelihood of confusion and that
3 Plaintiff was likely to succeed on the merits.

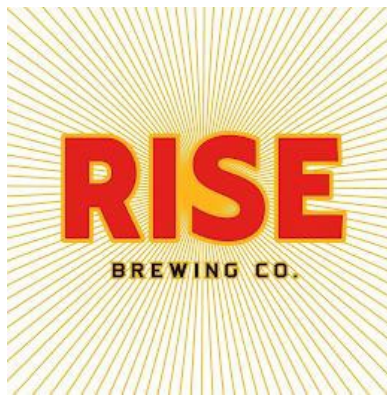
4 We find that the grant of a preliminary injunction was premised on two
5 significant errors. We therefore vacate the preliminary injunction.

6

7

BACKGROUND

8 Founded in 2014, Plaintiff launched its first cans of nitro-brewed coffee in
9 2016. It now sells these canned beverages nationwide in major stores, such as
10 Walmart, Publix, and Kroger. Plaintiff uses “RISE” as a mark referring to its
11 product and has registered “RISE BREWING CO.” as a word mark, Reg. No.
12 5,168,377, and its RISE BREWING CO. logo as a design mark, Reg. No. 5,333,635,
13 shown below.



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1 Plaintiff displays this design mark on every can. The mark consists of the
2 word "RISE" in large, red, regular capital letters in simple, unadorned, sans-serif
3 font on a horizontal line, set against a light background with thin yellow lines
4 radiating from the word "RISE," mimicking rays of sunshine. The words
5 "Brewing Co." appear below "RISE" in a much smaller, similar, simple font on a
6 horizontal line. [A-212]. This design takes up approximately the top third of the
7 7-ounce can, as shown below. The lower part of the can is in a uniform color,
8 with "NITRO COLD BREW COFFEE" in the same simple typeface on a
9 horizontal line.



10
11 In January 2021, Plaintiff learned that Defendant planned to launch a fruit-
12 flavored canned energy drink under the mark MTN DEW RISE ENERGY.
13 Plaintiff sent a demand letter, asking Defendant to "abandon any intent to use
14 the RISE mark, or any confusingly similar RISE mark, in connection with any

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1 canned or caffeinated beverage.” App’x at 356. Defendant’s counsel sent a reply,
2 stating that they did not see “any merit” to Plaintiff’s claims. App’x at 368. The
3 parties were unable to arrive at a resolution.

4 In March 2021, Defendant launched its MTN DEW RISE ENERGY product.
5 MTN DEW RISE ENERGY came in a variety of sweet, fruity flavors, such as
6 Pomegranate Blue Burst, Tropical Sunrise, and Strawberry Melon Spark. The 16-
7 ounce cans were sold in over 170,000 retailers across the country, including
8 convenience stores, gas stations, and drug stores.

9 Defendant’s packaging, as depicted below, features a variety of bright
10 colors corresponding to its various flavors. The word “RISE” appears on the top
11 third of the cans in a large, stylized jagged font in ornate letters displayed in an
12 arc, followed by the word “ENERGY” running vertically up its side in a much
13 smaller font. The MTN DEW house mark, consisting of the words “MTN DEW,”
14 slants diagonally toward the upper right above the word “RISE.” Below “RISE”
15 is a stylized lion logo composed of geometric shards.

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Plaintiff brought this suit in the U.S. District Court for the Northern

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District of Illinois. On motion of Defendant, the suit was transferred to the U.S.

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District Court for the Southern District of New York. Plaintiff moved for, and the

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district court granted, a preliminary injunction, enjoining Defendant from using

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or displaying the challenged mark in the market, pending trial.

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DISCUSSION

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I. Preliminary Injunction

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A party seeking a preliminary injunction must show “(1) irreparable harm;

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(2) either a likelihood of success on the merits or both serious questions on the

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merits and a balance of hardships decidedly favoring the moving party; and (3)

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that a preliminary injunction is in the public interest.” *N. Am. Soccer League, LLC*

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v. United States Soccer Fed’n, Inc., 883 F.3d 32, 37 (2d Cir. 2018). Where a mark

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warrants protection under the Lanham Act, “both the likelihood of success on

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the merits and the potential for irreparable harm in the absence of preliminary

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1 relief may be demonstrated by a showing that a significant number of consumers
2 are likely to be misled or confused as to the source of the products in question.”

3 *Bristol-Myers Squibb Co. v. McNeil-P.P.C., Inc.*, 973 F.2d 1033, 1038 (2d Cir. 1992).

4

5 **II. Likelihood of Confusion**

6 To prevail in a federal trademark infringement claim, a plaintiff “must
7 demonstrate that . . . the defendant’s actions are likely to cause confusion with
8 [that] mark.” *Tiffany & Co. v. Costco Wholesale Corp.*, 971 F.3d 74, 84 (2d Cir. 2020)
9 (internal quotation marks omitted). Here, Plaintiff argues that Defendant’s use of
10 the word “Rise” created a likelihood of *reverse* confusion. Reverse confusion
11 occurs when consumers “believe, erroneously, that the goods marketed by the
12 prior user are produced by the subsequent user.” *Lang v. Ret. Living Pub. Co.*, 949
13 F.2d 576, 583 (2d Cir. 1991).

14 Plaintiff contends that Defendant’s use of the word “Rise” was likely to
15 result in consumers mistakenly concluding that Plaintiff’s coffee drink was a
16 Mountain Dew product, thus creating consumer confusion in the marketplace.
17 To evaluate claims of consumer confusion, this court employs the eight factors
18 set out in *Polaroid Corp. v. Polarad Electronics Corp.*, 287 F.2d 492 (2d Cir. 1961):

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1 “[T]he strength of [the plaintiff’s] mark, the degree of similarity between the two
2 marks, the proximity of the products, the likelihood that the [plaintiff] will
3 bridge the gap, actual confusion, and the reciprocal of defendant’s good faith in
4 adopting its own mark, the quality of defendant’s product, and the sophistication
5 of the buyers.” *Id.* at 495.

6 In general, this court reviews the grant of a preliminary injunction for an
7 abuse of discretion. *Bristol-Myers Squibb*, 973 F.2d at 1038. “Applying legal
8 standards incorrectly or relying upon clearly erroneous findings of fact may
9 constitute an abuse of discretion.” *Id.* Where “the determination of whether one
10 of the *Polaroid* factors favors one party or another involves a legal judgment—
11 which it often does—we must review that determination *de novo*.” *Tiffany & Co.*,
12 971 F.3d at 86.

13 Having considered these eight factors, the district court found that Plaintiff
14 had met its burden of showing a sufficient likelihood of success on the merits to
15 warrant a preliminary injunction. We disagree and find that the district court
16 erred in its evaluation of what is often the most important factor—the strength of
17 Plaintiff’s mark—as well as in its finding of similarity in the appearance of the
18 products.

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1 **A. Strength of the Mark**

2 In considering the first factor, the strength of the plaintiff’s mark, the
3 district court found that it slightly favored Plaintiff. *RiseandShine Corp. v. PepsiCo,*
4 *Inc.*, 2021 WL 5173862, at *7 (S.D.N.Y. Nov. 4, 2021). We disagree. The district
5 court failed to recognize the inherent weakness of Plaintiff’s mark. Its
6 determination that this factor favored Plaintiff was affected by that failure, as
7 was its ultimate conclusion that Plaintiff was likely to succeed on the merits.

8 “[T]he strength of a mark depends ultimately on its distinctiveness, or its
9 ‘origin-indicating’ quality, in the eyes of the purchasing public.” *McGregor–*
10 *Doniger Inc. v. Drizzle Inc.*, 599 F.2d 1126, 1131–32 (2d Cir. 1979), *superseded on*
11 *other grounds by* Fed. R. Civ. P. 52(a). The strength of a trademark is assessed
12 based on either or both of two components: (1) the degree to which it is
13 inherently distinctive; and (2) the degree to which it has achieved public
14 recognition in the marketplace, sometimes called acquired strength. *W.W.W.*
15 *Pharm. Co., Inc. v. Gillette Co.*, 984 F.2d 567, 572 (2d Cir. 1993).

16 We turn first to inherent strength. Inherent strength or weakness of a mark
17 is frequently an important factor because strong marks command a wider scope
18 of protection than weak marks. The trademark law allows every marketer to

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1 identify itself as a product's source by use of a distinctive mark, which will allow
2 the public to recognize it as the source of the product, rewarding the marketer if
3 it has earned a good public reputation and punishing it if the public's prior
4 experience has been disappointing. In this manner, the trademark law serves the
5 purposes of both marketers and the consuming public. So long as marketers
6 select words or signs that have no logical relationship to the products or services
7 on which they are used, there will never be a shortage of marks. Trademark law
8 favors the use of marks that are arbitrary or fanciful in relation to the products
9 on which they are used. This is because such distinctive marks make it easier for
10 the public to avoid confusion and because allowing the owner a broad
11 exclusivity for such a mark detracts little from free expression, as other marketers
12 of similar products have no justified interest in using such words to identify their
13 products. *See discussion at Pierre N. Leval, Trademark: Champion of Free Speech,*
14 *27 COLUM. J.L. & ARTS 187, 194 (2004).* In contrast, trademark law offers a much
15 narrower scope of protection to marketers who seek to bar others from using
16 words that describe or suggest the products or the virtues of their products. *See*
17 *Virgin Enterprises Ltd. v. Nawab, 335 F.3d 141, 147-48 (2d Cir. 2003)* (“[A]s a matter
18 of policy, the trademark law accords broader protection to marks that serve

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1 exclusively as identifiers and lesser protection where a grant of exclusiveness
2 would tend to diminish the access of others to the full range of discourse relating
3 to their goods.”).

4 To describe different degrees of inherent distinctiveness, the trademark
5 law utilizes four categories. In order of ascending strength, they are: (1) generic,
6 (2) descriptive, (3) suggestive, and (4) arbitrary or fanciful.

7 A generic mark is a common name, such as automobile or aspirin, that
8 identifies a kind of product. *Gruner + Jahr USA Pub., a Div. of Gruner + Jahr*
9 *Printing & Pub. Co. v. Meredith Corp.*, 991 F.2d 1072, 1075 (2d Cir. 1993). A mark
10 that consists of a generic identifier of the product receives no protection from the
11 law of trademark, even if the mark has acquired public recognition as identifying
12 the source of the product. *Abercrombie & Fitch Co. v. Hunting World, Inc.*, 537 F.2d
13 4, 9 (2d Cir. 1976). Neither prior use, nor public recognition as a source identifier
14 can justify denying others the right to refer to their product as what it is.

15 One rung above the unprotectable generic marks are descriptive marks.
16 These are marks that “tell[] something about a product, its qualities, ingredients
17 or characteristics.” *Gruner*, 991 F.2d at 1076. Descriptive marks are presumptively
18 unprotectable, but can acquire a degree of protection if they have acquired

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1 secondary meaning, *i.e.* an acquired public recognition as a mark identifying the
2 source. *Id.*

3 Suggestive marks occupy the next higher rung. Suggestive marks suggest
4 (rather than directly describe) the product on which they are employed, or its
5 attributes, sometimes requiring imagination to grasp the linkage. *Id.* They are the
6 weakest marks that are protectable without need to show acquired secondary
7 meaning. They receive a narrower scope of protection than the protection
8 accorded to arbitrary or fanciful marks—those at the top of the ladder. *Id.* at 1075

9 Arbitrary and fanciful marks – *i.e.*, those that make no logical reference to
10 the product or service on which they are used, such as Google for a search
11 engine, Kodak for cameras, or Quilted Giraffe for a restaurant, receive the
12 strongest protection. *Id.* This is because other marketers of the same products or
13 services have no justification or cognizable interest in using the same terms in
14 referring to their own market offerings.

15 The district court determined that Plaintiff’s mark was “suggestive,”
16 noting that the word “Rise” “evokes images of morning, which ‘suggest[s] a
17 quality or qualities of the product through the use of imagination, thought, and
18 perception.’” *RiseandShine*, 2021 WL 5173862, at *7 (quoting *Star Indus., Inc. v.*

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1 *Bacardi & Co.*, 412 F.3d 373, 385 (2d Cir. 2005)). We find no error in the district
2 court's determination that Rise Brewing's mark is "suggestive." But labeling a
3 mark as "suggestive" is not the end of the inquiry. *See Lang*, 949 F.2d at 581
4 ("[S]uggestiveness is not necessarily dispositive of the issue of the strength of
5 the mark.").

6 "[A] finding of suggestiveness does not guarantee a determination that the
7 mark is a strong one." *W.W.W. Pharm. Co.*, 984 F.2d at 572. Because suggestive
8 marks, by their nature, seek to suggest the qualities of the product, it can be
9 difficult to distinguish weak suggestive marks from descriptive ones. Like
10 descriptive marks, instead of focusing on the favored goal of source
11 identification, suggestive marks aim to secure the exclusive right to an
12 advertising message that is built into the trademark. *See Leval, Trademark:
13 Champion of Free Speech* at 193. The district court failed to note that the strong
14 logical associations between "Rise" and coffee represent weakness and place the
15 mark at the low end of the spectrum of suggestive marks. *See, e.g., Star Indus.*, 412
16 F.3d at 385 ("Star's mark is suggestive, but just barely.").

17 This mistake constituted legal error. While this Court has said, at times,
18 that the classification of a mark is a factual matter, *Bristol-Myers Squibb*, 973 F.2d

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1 at 1039-40, we have also stated that there is an undeniable legal element in the
2 determination of how much strength a given mark commands, *Patsy's Brand, Inc.*
3 *v. I.O.B. Realty, Inc.*, 317 F.3d 209, 216 (2d Cir. 2003) (“[T]here is a considerable
4 component of law in the determination whether a mark has the degree of
5 strength necessary to weigh in favor of the party claiming
6 infringement.”), *abrogated on other grounds by 4 Pillar Dynasty LLC v. New York &*
7 *Co., Inc.*, 933 F.3d 202 (2d Cir. 2019).¹

8 In its ordinary usage, “Rise” suggests waking up and “rising” from bed.
9 Rising is generally associated with the morning, a time when many crave a cup
10 of coffee, relying on its caffeine to jumpstart their energy for the day. The
11 intended and achieved reference of the RISE mark is illustrated by Plaintiff’s
12 company name—RiseandShine—something that a morning cup of coffee helps

¹ If a marketer chose “Toothpaste” as a mark for a toothpaste and sought to prevent other toothpaste makers from use of the word “toothpaste,” the factfinder would not have discretion to find that the plaintiff’s mark was anything other than generic and unprotected. By the same token, if the marketer took the mark “Green Hippopotamus” for its toothpaste, factfinders would not be at liberty to find that such a mark was anything other than arbitrary or fanciful, belonging in the highest rung entitled to the strongest protection. Between descriptive and suggestive marks, there may be some room for difference of opinion; nonetheless, the discretion allowed to a factfinder in finding inherent strength is minimal at best. *See Cross Com. Media, Inc. v. Collective, Inc.*, 841 F.3d 155, 162 (2d Cir. 2016) (holding that the district court’s classifying of a mark as descriptive as opposed to suggestive was clear error and error as a matter of law). If the toothpaste mark was “Pure White” or “Fresh Breath,” the descriptive or suggestive relationship of such marks to the product are so clear that it would be error for the factfinder to place such marks in either the highest (arbitrary or fanciful) category or the lowest generic category.

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1 us to do. The proposition that one isn't fully awake until one has had one's
2 morning coffee is a cliché.

3 The word "Rise" may also refer directly to energy itself; after consuming
4 caffeine, one's energy levels can be expected to "rise." The trademark law does
5 not favor giving one marketer an exclusive right to prevent others from using
6 such valuable marketing terms in their own marketing campaigns. When a mark
7 so clearly evokes the claimed virtues of the product it references, that mark,
8 although perhaps muscular as a marketing tool, is weak under the trademark
9 law. *See Star Indus.*, 412 F.3d at 385; *see also Procter & Gamble Co. v. Johnson &*
10 *Johnson Inc.*, 485 F. Supp. 1185, 1196-97 (S.D.N.Y. 1979) (finding that a word used
11 as a mark "to convey, through that word's primary meaning, a quality of the
12 product or of a promised consumer reaction to its use," "lack[ed] originality and
13 uniqueness."), *aff'd*, 636 F.2d 1203 (2d Cir. 1980). The close associations between
14 the word "Rise" and coffee constituted a weakness of the mark under the
15 trademark law, which reduced, rather than advanced, Plaintiff's likelihood of
16 success on the merits. Because the word "Rise" is so tightly linked with the
17 perceived virtues of coffee, the mark is inherently weak and commands a narrow
18 scope of protection.

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1 Although the suggestive category is higher than the descriptive category
2 because a descriptive association between mark and product is more direct than
3 a suggestive association, it does not necessarily follow that every suggestive
4 mark is stronger than every descriptive mark. If the suggestion conveyed by a
5 suggestive mark conjures up an essential or important aspect of the product,
6 while the description conveyed by a descriptive mark refers to a relatively trivial
7 or insignificant aspect of the product, the particular suggestive mark could be
8 deemed weaker than the descriptive. Coffee's capacity to wake one up and lift
9 one's energy, which is what the "RISE" mark suggests, is such an important part
10 of the perceived virtue of coffee in the eyes of the consuming public as to render
11 this suggestive mark decidedly weak.

12 A survey of the use of the term "Rise" in the beverage market further
13 underlines the weakness of the mark. Extensive third-party usage of a mark in
14 related products generally weighs against a finding that a trademark is strong.
15 *See, e.g., Lang, 949 F.2d at 581. "[I]n a 'crowded' field of similar marks, each*
16 *member of the crowd, is relatively 'weak' in its ability to prevent use by others in*
17 *a crowd."* J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR
18 COMPETITION § 11:85, at 11-163 (4th ed. 2001). This is especially true where both

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1 the plaintiff's product and the other products use the word to signify the same
2 ordinary meaning. *See, e.g., Plus Prod. v. Plus Disc. Foods, Inc.*, 722 F.2d 999, 1005
3 (2d Cir. 1983); *Streetwise Maps, Inc. v. VanDam, Inc.*, 159 F.3d 739, 744 (2d Cir.
4 1998).

5 Although, as the district court points out, Plaintiff appears to have been
6 "the exclusive user of the principal term 'RISE' to identify a single-serving,
7 canned caffeinated beverage," *RiseandShine*, 2021 WL 5173862, at *7, there were
8 already a number of marks using "Rise" on coffee drinks and other similar
9 products when Plaintiff began to use its mark. Defendant presented evidence of
10 over 100 uses of the term "Rise" in connection with coffee, tea, bottled beverages,
11 energy drinks, soft drinks, drinkable health supplements, cafes, yogurts, and
12 granolas. App'x at 334-345. Many of these products use "Rise" in the same way
13 as Plaintiff does—to allude to increased energy, particularly in the morning
14 hours.

15 Plaintiff itself acknowledged this crowded field in its application to the
16 United States Patent and Trademark Office ("PTO"). It initially attempted to
17 register the mark "RISE COFFEE CO." but was rejected by the PTO on the basis
18 that there was a likelihood of confusion between "RISE COFFEE CO." and prior

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1 registrations that also used the word “Rise” for coffee, such as “Rise Up Coffee
2 Roasters” and “Rise Up Organic Coffee.” Plaintiff objected to the PTO’s
3 determination, arguing that the presence of multiple marks using the word
4 “Rise” indicated the mark’s weakness: “[M]any entities have used the word
5 ‘Rise’ in relation to the Applicant’s goods, making it unlikely that consumers
6 would give significant weight to this term in ascertaining the source of such
7 goods.” App’x at 349. Plaintiff further elaborated, “The fact that there are
8 multiple Rise-formulated coffee marks owned by different registrants peacefully
9 coexisting without confusion shows that there is room for another Rise-
10 formulated mark....” *Id.* After Plaintiff modified its application to register “RISE
11 BREWING CO.” rather than “RISE COFFEE CO.,” the PTO agreed to register the
12 mark.

13 Now, having registered its trademark, Plaintiff argues that there is no such
14 room for multiple “Rise” marks to coexist peacefully, even outside the coffee
15 sector. That is not persuasive. If there was room for Plaintiff’s use of “Rise” in the
16 already crowded coffee field, there would also be room for Defendant’s,
17 especially on a product that is distinct from coffee.² Trademark law does not

² The district court discounted the weight of the statements Plaintiff made to the PTO on the basis that “courts do not bind parties to their statements made or positions taken in ex parte application

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1 offer robust protection to those who demand the exclusive right to use words
2 that describe or suggest a product or its virtues. Given the inherent weakness of
3 “Rise” for coffee, the first factor does not favor Plaintiff.

4 Finally, as a factor supporting acquired strength in Plaintiff’s mark, the
5 district court noted that Plaintiff “ha[d] invested more than \$17.5 million in
6 promoting its ‘RISE’ marks.” *RiseandShine*, 2021 WL 5173862, at *7. The holders of
7 senior marks that are not inherently strong but have achieved a measure of
8 consumer recognition through longevity of use or through publicity often
9 reasonably point to that acquired public recognition as fostering a likelihood that
10 customers will believe, to the senior user’s detriment, that a product sold by an
11 allegedly infringing junior user under a similar mark came from the plaintiff.
12 Defendant argues, however, that where a plaintiff claims it will be the victim of
13 reverse confusion—in that consumers will believe that its product comes from
14 the junior user—a plaintiff’s showing of acquired strength of its mark does not
15 support its claim.

proceedings in front of the PTO.” *RiseandShine*, 2021 WL 5173862, at *7 (quoting *Alpha Media Grp., Inc. v. Corad Healthcare, Inc.*, No. 13 Civ. 5438, 2013 WL 5912227, at *3 (S.D.N.Y. Nov. 4, 2013)). In our view the question is not whether Plaintiff is bound by its previous position. If the RISE mark for coffee was sufficiently weak for the PTO to allow Plaintiff to enter as a new user in spite of numerous prior users, it is also sufficiently weak to now allow Defendant as still another user.

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1 We see some merit in Defendant’s argument. Just as, in cases of forward
2 confusion, increased consumer awareness of a plaintiff as the source of the
3 plaintiff’s products bearing its mark tends to increase the likelihood that
4 consumers will believe that another product bearing a confusingly similar mark
5 also comes from the plaintiff, in cases of reverse confusion that same consumer
6 awareness of a plaintiff as the source of its products bearing its mark tends to
7 diminish the likelihood that consumers, on seeing another product bearing a
8 similar mark, will believe that the plaintiff’s products come from the source of
9 the other product. On the other hand, where, as here, the junior user is a much
10 larger company, consumers might believe that the senior user’s success in
11 promoting its brand had led the larger junior user to acquire the senior.

12 We are aware of no court decisions on the question, and we need not
13 resolve it for this case. Notwithstanding Plaintiff’s expenditure of \$17.5 million in
14 publicity, Plaintiff has not shown that its RISE mark has achieved sufficient
15 acquired strength to counterbalance the inherent weakness of its mark.

16 Although we “generally do not treat any one *Polaroid* factor as dispositive
17 in the likelihood of confusion inquiry,” *Nabisco, Inc. v. Warner-Lambert Co.*, 220
18 F.3d 43, 46 (2d Cir. 2000), “the evaluation of the *Polaroid* factors is not a

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1 mechanical process where the party with the greatest number of factors
2 weighing in its favor wins,” *Paddington Corp. v. Attiki Importers & Distributors,*
3 *Inc.*, 996 F.2d 577, 584 (2d Cir. 1993) (internal quotation marks omitted). Weak
4 marks are entitled to only an “extremely narrow scope” of protection, “unless a
5 convincing combination of other *Polaroid* factors militates strongly in favor of
6 likelihood of confusion.” *Plus Prod.*, 722 F.2d at 1006 (2d Cir. 1983). No such
7 circumstances exist here.

8 **B. Similarity of the Marks**

9 The district court further found that the general appearance of Defendant’s
10 mark and trade dress on its canned energy drink was “confusingly similar” to
11 Plaintiff’s cans. *RiseandShine*, 2021 WL 5173862, at *8. We believe that finding was
12 clear error. The district court noted that, on both of the parties’ products, the
13 word “RISE” was printed in “large typeface, in all-capital letters, in a bright color
14 against a light background and [was] the dominant feature occupying the top
15 third of the can.” *Id.* While these observations are accurate, they are so general
16 that they likely also describe many other products in the canned beverage
17 market.

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1 The only notable similarity is the shared use of the term “Rise” in large
2 bold letters. However, as explained above, the word “Rise” in this context is not
3 distinctive. Therefore, without more striking visual similarities, the shared use of
4 this ordinary word, used to signify a virtue of the product, is not enough to
5 render the two products “confusingly similar.” *See, e.g., Nabisco*, 220 F.3d at 47
6 (holding that the shared use of the word “Ice” was unlikely to cause confusion
7 given the differences in the overall appearance of the products). Nor is there
8 anything distinctive about the use of large bold letters to present a drink’s brand
9 name.

10 Comparing the two products, the differences appear far more notable than
11 the similarities. The two cans are different in size, proportion, style, color, and
12 artwork. Even the word “RISE” is presented in very different manners. On
13 Plaintiff’s can, it appears in a simple sans-serif font—its “R” and “S” evenly
14 curved. Defendant’s can, in contrast, uses an angular and jagged font.
15 Furthermore, while “RISE” on Plaintiff’s can is written on a horizontal line, the
16 letters on Defendant’s can are arranged in an arc.

17 Beyond the presentations of the shared word, the overall appearances of
18 the cans are very dissimilar. Plaintiff’s seven-ounce can is less than half the size

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1 of Defendant’s sixteen-ounce can. Plaintiff’s can features warm or neutral colors,
2 in stark contrast to the bright, bold colors of Defendant’s cans. The word “RISE”
3 on Defendant’s can is partially covered at the top by Defendant’s prominently
4 displayed house mark, “MTN DEW.” And perhaps most plainly, while the lower
5 half of Plaintiff’s can shows simple, regular, white writing against a calm,
6 uniform background, the lower half of Defendant’s can depicts a large, stylized
7 lion’s head, composed of jagged shards that complement the can’s angular font.
8 There is little about the appearance of the two cans that would suggest to a
9 consumer that they come from the same source.

10 The district court granted Plaintiff a preliminary injunction based in part
11 on the conclusion that Plaintiff was likely to succeed on the merits. This rested in
12 substantial part on the court’s conclusion that Plaintiff’s mark was strong—both
13 in inherent and acquired strength—as well as its determination that the two
14 products were “confusingly similar.” To the extent that Defendant’s use of its
15 marks caused any likelihood of confusion, this was because Plaintiff chose a
16 weak mark in a crowded field. For this reason, the balance of hardships did not
17 favor Plaintiff. Plaintiff did not demonstrate a likelihood of success on the merits,
18 and we must overturn the grant of the preliminary injunction.

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1

2

CONCLUSION

3

For the foregoing reasons, the grant of the preliminary injunction is

4

VACATED.