

No. 24-637

In the
Supreme Court of the United States

T-MOBILE US, INC., F/K/A T-MOBILE USA, INC., ET
AL.,

Petitioners,

v.

SIMPLY WIRELESS, INC.,

Respondent.

**On Petition for Writ of Certiorari to the United
States Court of Appeals for the Fourth Circuit**

BRIEF IN OPPOSITION

SEAN PATRICK ROCHE

CAMERON/MCEVOY

PLLC

4100 Monument

Corner Dr., Suite 420

Fairfax, VA 22030

JOHN R. GERSTEIN

CLYDE & Co US LLP

1775 Pennsylvania

Ave, NW, 4th Floor

Washington, DC 20006

ROBERT D. LITOWITZ

Counsel of Record

SAUL COHEN

SHELBY A. MCGOWAN

KELLY IP, LLP

1300 19th Street, NW,

Suite 420

Washington, D.C. 20036

(202) 808-3570

robert.litowitz@kelly-ip.com

QUESTION PRESENTED

Under the Lanham Act, a “mark,” expressly defined to include both registered and unregistered (or “common law”) marks, “shall be deemed to be ‘abandoned’ ... [w]hen its use has been discontinued with intent not to resume such use.” 15 U.S.C. § 1127.

The Fourth Circuit rejected T-Mobile’s novel argument that any gap in use of an unregistered mark renders it unprotectable, regardless of the trademark owner’s history of use, its reasons for pausing use, and its intent to resume use. Instead, following the statutory test applied across the circuits, the Fourth Circuit held that once established through bona fide use, trademark rights in *all* marks (common law or registered) persist unless they have been abandoned. That test for abandonment expressly requires nonuse and the intent not to resume use.

The question presented is:

Are unregistered marks subject to a non-statutory “continuous use” requirement?

CORPORATE DISCLOSURE STATEMENT

Respondent Simply Wireless, Inc. has no outstanding shares or debt securities in the hands of the public, and it does not have a parent company. No publicly held company has a 10% or greater ownership interest in Respondent.

TABLE OF CONTENTS

QUESTION PRESENTED.....	i
CORPORATE DISCLOSURE STATEMENT	ii
TABLE OF CONTENTS.....	iii
TABLE OF AUTHORITIES	iv
RELEVANT STATUTORY PROVISIONS	1
INTRODUCTION.....	2
STATEMENT OF THE CASE.....	3
A. Factual background.....	3
B. Proceedings below	5
REASONS FOR DENYING THE PETITION	6
I. The Fourth Circuit faithfully applied the Lanham Act, this Court’s precedent, and common law principles.....	6
A. The Lanham Act’s abandonment test is the sole criterion for loss of rights.	6
B. T-Mobile’s “any gap in use” test conflicts with other provisions of the Lanham Act.	8
C. T-Mobile’s proposed rule has no common law pedigree.....	9
II. There is no genuine circuit split.	10
A. The circuits apply the abandonment test to unregistered marks.....	10
B. T-Mobile’s cases do not establish a genuine split.	11
III. T-Mobile’s policy arguments are not a basis for review.....	15
CONCLUSION	20

TABLE OF AUTHORITIES

Cases	Page
<i>62 Cases, More or Less, Each Containing Six Jars of Jam v. United States,</i> 340 U.S. 593 (1951).....	7
<i>Abitron Austria GmbH v. Hetronic International, Inc.,</i> 600 U.S. 412 (2023).....	16
<i>Airs Aromatics LLC v. Victoria’s Secret Stores Brand Management, Inc.,</i> 744 F.3d 595 (9th Cir. 2014)	14
<i>B&B Hardware, Inc. v. Hargis Industries, Inc.,</i> 575 U.S. 138 (2015).....	9
<i>Blue Bell, Inc. v. Farah Manufacturing Co.,</i> 508 F.2d 1260 (5th Cir. 1975)	11, 12
<i>Casual Corner Associates, Inc. v. Casual Stores of Nevada, Inc.,</i> 493 F.2d 709 (9th Cir. 1974)	11
<i>Commerce National Insurance Services Inc. v. Commerce Insurance Agency, Inc.,</i> 214 F.3d 432 (3d Cir. 2000).....	12
<i>Cumulus Media, Inc. v. Clear Channel Communications, Inc.,</i> 304 F.3d 1167 (11th Cir. 2002).....	10
<i>Department of Parks & Recreation v. Bazaar del Mundo,</i> 448 F.3d 1118 (9th Cir. 2006).....	15

<i>Dewberry Group, Inc. v. Dewberry Engineers Inc.,</i> 604 U. S. ____ (2025)	16
<i>Electro Source, LLC v. Brandess-Kalt-Aetna Group, Inc.,</i> 458 F.3d 931 (9th Cir. 2006)	17
<i>Emergency One, Inc. v. American FireEagle, Ltd.,</i> 228 F.3d 531 (4th Cir. 2000)	5
<i>General Healthcare Ltd. v. Qashat,</i> 364 F.3d 332 (1st Cir. 2004).....	10
<i>Hall Street Associates, L.L.C. v. Mattel, Inc.,</i> 552 U.S. 576 (2008).....	13
<i>Herb Reed Enterprises, LLC v. Florida Entertainment Management, Inc.,</i> 736 F.3d 1239 (9th Cir. 2013)	10
<i>Homeowners Group, Inc. v. Home Marketing Specialists, Inc.,</i> 931 F.2d 1100 (6th Cir. 1991)	13
<i>Imperial Tobacco Ltd. v. Philip Morris, Inc.,</i> 899 F.2d 1575 (Fed. Cir. 1990).....	18
<i>ITC Ltd. v. Punchgini, Inc.,</i> 482 F.3d 135 (2d Cir. 2007).....	17
<i>Jack Daniel's Properties, Inc. v. VIP Products LLC,</i> 599 U.S. 140 (2023).....	18
<i>Jama v. Immigration & Customs Enforcement,</i> 543 U.S. 335 (2005).....	14
<i>Kars 4 Kids Inc. v. America Can!,</i> 8 F.4th 209 (3d Cir. 2021)	12, 13

<i>Kirtsaeng v. John Wiley & Sons, Inc.</i> , 568 U.S. 519 (2013).....	15
<i>La Societe Anonyme des Parfums le Galion v. Jean Patou, Inc.</i> , 495 F.2d 1265 (2d Cir. 1974).....	18
<i>Larsen v. Terk Technologies Corp.</i> , 151 F.3d 140 (4th Cir. 1998)	12
<i>Marshak v. Treadwell</i> , 240 F.3d 184 (3d Cir. 2001).....	10
<i>Matal v. Tam</i> , 582 U.S. 218 (2017).....	17
<i>Natural Answers, Inc. v. SmithKline Beecham Corp.</i> , 529 F.3d 1325 (11th Cir. 2008)	10, 13
<i>Romag Fasteners, Inc v. Fossil, Inc.</i> , 590 U.S. 212 (2020).....	7, 16
<i>Rust Environment & Infrastructure, Inc. v. Teunissen</i> , 131 F.3d 1210 (7th Cir. 1997)	10
<i>Saxlehner v. Eisner & Mendelson Co.</i> , 179 U.S. 19 (1900).....	9
<i>Silverman v. CBS Inc.</i> , 870 F.2d 40 (2d Cir. 1989).....	10
<i>Simply Wireless, Inc. v. T-Mobile US, Inc.</i> , 877 F.3d 522 (4th Cir. 2017)	3, 5
<i>Southern California Darts Association v. Zaffina</i> , 762 F.3d 921 (9th Cir. 2014)	10
<i>Stilson & Associates, Inc. v. Stilson Consulting Group, LLC</i> , 129 F. App'x 993 (6th Cir. 2005)	10

<i>Tally-Ho, Inc. v. Coast Community College District</i> , 889 F.2d 1018 (11th Cir. 1989)	13
<i>Timothy B. O'Brien LLC v. Knott</i> , No. 3:18-cv-00684, 2018 WL 5456550 (W.D. Wis. Oct. 29, 2018)	14
<i>TRW Inc. v. Andrews</i> , 534 U.S. 19 (2001)	8
<i>Two Pesos, Inc. v. Taco Cabana, Inc.</i> , 505 U.S. 763 (1992)	9, 16
<i>Vais Arms, Inc. v. Vais</i> , 383 F.3d 287 (5th Cir. 2004)	10, 11, 18
<i>Watec Co., v. Liu</i> , 403 F.3d 645 (9th Cir. 2005)	14, 15
<i>West Florida Seafood, Inc. v. Jet Restaurants, Inc.</i> , 31 F.3d 1122 (Fed. Cir. 1994)	11

Statutes	Page
15 U.S.C. § 1052	2, 3, 8
15 U.S.C. § 1065	3, 8
15 U.S.C. § 1115	3, 8
15 U.S.C. § 1117	16
15 U.S.C. § 1125	16
15 U.S.C. § 1127	1, 2, 6, 7, 14, 16, 17, 18

Treatises	Page
Callmann on Unfair Competition, Trademarks and Monopolies (4th ed.)	2

McCarthy on Trademarks and Unfair Competition (5th ed.).....	8, 10, 18
Restatement (Third) of Unfair Competition (1995).....	10

RELEVANT STATUTORY PROVISIONS

Section 45 of the Lanham Act provides, in relevant part:

A mark shall be deemed to be “abandoned” if either of the following occurs:

- (1) When its use has been discontinued *with intent not to resume such use*. Intent not to resume may be inferred from circumstances. Nonuse for 3 consecutive years shall be prima facie evidence of abandonment. “Use” of a mark means the bona fide use of such mark made in the ordinary course of trade, and not made merely to reserve a right in a mark....

15 U.S.C. § 1127 (emphasis added).

Section 2 of Lanham Act provides, in relevant part:

No trademark by which the goods of the applicant may be distinguished from the goods of others shall be refused registration on the principal register on account of its nature unless it—

- (d) Consists of or comprises a mark which so resembles a mark registered in the Patent and Trademark Office, *or a mark or trade name previously used in the United States by another and not abandoned*, as to be likely, when used on or in connection with the goods of the

applicant, to cause confusion, or to cause mistake, or to deceive

15 U.S.C. § 1052 (emphasis added).

INTRODUCTION

T-Mobile seeks review of the portion of the Fourth Circuit’s decision rejecting the argument that common law marks are subject to a “continuous use” requirement while registered trademarks are not. T-Mobile concedes that registered marks cannot be taken by another unless abandoned, i.e., discontinued “with intent not to resume ... use.” 15 U.S.C. § 1127. But under T-Mobile’s proposed double standard, common law trademarks can be appropriated during any gap in use, even where the trademark owner maintains the intent to resume use and has not abandoned its mark.

T-Mobile pins its petition on various circuit court decisions mentioning “continuous use” as shorthand for abandonment or as a prerequisite for *establishing* common law trademark rights, an unremarkable principle that the Fourth Circuit acknowledged in the opinion below. But none of those circuit courts has deliberately chosen T-Mobile’s “any gap in use” test over the statutory abandonment test. It is uncontroversial that “once common-law mark rights are established, gaps in use are irrelevant unless they constitute abandonment.” 3 Callmann on Unfair Competition, Trademarks and Monopolies § 20:7 (4th ed.).

As the Fourth Circuit panel recognized, T-Mobile’s theory conflicts with the Lanham Act’s sole provision concerning loss of rights. Under that provision, which

applies to registered and common marks law alike, trademark owners maintain their rights even if they discontinue use for weeks, months, or even years, unless they act with an “intent not to resume such use.” 15 U.S.C. § 1127. Elsewhere in the Lanham Act, Congress provided that common law trademarks remain in force unless abandoned. *See* 15 U.S.C. § 1052(d). It also legislated “continuous use alone” requirements related to trademark incontestability that are absent from the abandonment provision. *See, e.g.*, 15 U.S.C. §§ 1065, 1115(b)(5).

Finally, T-Mobile’s policy arguments do not warrant granting review. Congress legislated many incentives for registration into the Lanham Act, including the presumption of validity and “incontestable” status. But it did not legislate different standards for maintaining rights in registered and unregistered marks.

The Court should decline to review the Fourth Circuit’s decision.

STATEMENT OF THE CASE

A. Factual background

Simply Wireless is a telecommunications company founded in 1997 that has offered, promoted, and sold cellular phones, prepaid airtime, and accessories, including through brick-and-mortar stores, TV sales channels, and the internet. Pet. App. 3a-4a. Simply Wireless has both “compet[e]d in the same industry” as, and “partnered on several projects” with, the telecommunications giant T-Mobile. *Simply Wireless, Inc. v. T-Mobile US, Inc.*, 877 F.3d 522, 524 (4th Cir. 2017).

From 2002 through 2008, Simply Wireless offered prepaid airtime for cell phones under the SIMPLY PREPAID trademark, earning over \$20 million in revenues. Pet. App. 4a. In 2009, Simply Wireless made the strategic decision to pause its sales under that trademark, always intending to resume use. Pet. App. 4a-5a. In the years following its strategic pause, Simply Wireless maintained the SimplyPrepaid.com domain name and took various steps to resume use. Pet. App. 5a. One such step was negotiating with a third party to promote SIMPLY PREPAID offerings on the third party's successful online retail platform. Pet. App. 5a-7a. Those negotiations resulted in resumed use of the mark in commerce beginning in July 2012 and continuing into 2013. Pet. App. 7a. Simply Wireless also later sold prepaid phones under SIMPLY PREPAID through a revamped SimplyPrepaid.com website and through Amazon. Pet. App. 8a.

In or around August 2014, while planning to again resume use of its SIMPLY PREPAID mark, Simply Wireless learned of T-Mobile's plan to open hundreds of stores selling prepaid cell phone products using the exact same SIMPLY PREPAID trademark. Pet. App. 7a-8a. T-Mobile's actions immediately led to questions and confusion about Simply Wireless's involvement. C.A.J.A. 682, 1128-30, 1548-49. T-Mobile refused to stop using SIMPLY PREPAID in response to Simply Wireless's requests. After being put on express notice of Simply Wireless's rights in SIMPLY PREPAID, T-Mobile merely pivoted to using the mark with prepaid cell phone plans instead of brick-and-mortar stores. C.A.J.A. 1217-24.

B. Proceedings below

Simply Wireless sued T-Mobile for trademark infringement in the U.S. District Court for the Eastern District of Virginia in 2015, shortly after it learned of T-Mobile's actions. Pet. App. 8a-9a. T-Mobile successfully moved to dismiss in favor of arbitration. *See Simply Wireless*, 877 F.3d at 526. After an arbitrator determined that Simply Wireless's trademark infringement claims are not subject to arbitration, Simply Wireless again filed suit in 2021. Pet. App. 8a-9a.

T-Mobile moved for summary judgment, arguing that Simply Wireless had lost its trademark rights by failing to make "continuous use" of the SIMPLY PREPAID mark. Pet. App. 51a. The district court found that T-Mobile's "view conflicts with fundamental principles of trademark law." Pet. App. 56a. It noted that "the general rule ... is that the 'deliberate and continuous' test applies only to the initial accrual of trademark rights, not whether a common law owner has maintained such rights." Pet. App. 58a. "Whether a common law trademark owner has retained their property rights in a mark is more properly analyzed through an abandonment analysis." *Id.*

The district court then turned to that statutory abandonment analysis, an argument that T-Mobile had raised in a footnote. Pet. App. 50a n.17, 59a-69a. Under Fourth Circuit precedent, non-use by the trademark owner "for three consecutive years" establishes a rebuttable "inference of intent not to resume use." *Emergency One, Inc. v. American FireEagle, Ltd.*, 228 F.3d 531, 536 (4th Cir. 2000). The

trademark owner rebuts that presumption by “producing evidence of ... intent to resume use” during the three-year “presumption period.” *Id.* Simply Wireless presented a declaration of its CEO and corroborating documents showing that it began making concrete plans to resume use during the presumption period, and that it in fact resumed use mere months later. Pet. App. 4a-7a. The district court nonetheless granted summary judgment on abandonment grounds. Pet. App. 69a.

The Fourth Circuit reversed the district court’s summary judgment order, holding that the evidence “strongly supports Simply Wireless’s essential and timely intent to resume use of its contested trademark.” Pet. App. 22a. It then rejected T-Mobile’s alternative ground for affirmance, i.e., that lack of continuous use alone forfeits trademark rights, holding that “when common law ownership of a trademark has accrued, those rights persist until—and unless—they are legally abandoned.” Pet. App. 30a-31a. T-Mobile seeks this Court’s review only of the latter holding.

REASONS FOR DENYING THE PETITION

I. The Fourth Circuit faithfully applied the Lanham Act, this Court’s precedent, and common law principles.

A. The Lanham Act’s abandonment test is the sole criterion for loss of rights.

T-Mobile seeks to displace the abandonment test with its intent-free “any gap in use” test, but the statute is clear. Under the Lanham Act, “[a] mark

shall be deemed to be ‘abandoned’ if ... [1] its use has been discontinued [2] with intent not to resume such use.” 15 U.S.C. § 1127. “Mark” is a defined term that includes both registered and unregistered trademarks.¹ This Court noted in another trademark case that it does not “usually read into statutes words that aren’t there.” *Romag Fasteners, Inc v. Fossil, Inc.*, 590 U.S. 212, 215 (2020). It is equally true that this Court does not excise words—“with intent not to resume such use,” 15 U.S.C. § 1127—that *are* there.²

Hoping to sidestep this statutory construction conundrum, T-Mobile claims that *both* the abandonment and “any gap in use” tests apply to unregistered marks. Pet. at 12 and n.3. But defendants like T-Mobile would never have reason to assert abandonment if any gap in use were enough to disarm common law trademarks.³ T-Mobile’s test would thus make the statutory abandonment analysis

¹ “Mark” is defined as “any trademark, service mark, collective mark, or certification mark.” 15 U.S.C. § 1127. “Registered mark”—another term defined in the same section of the Lanham Act—is not used in the abandonment test.

² See *62 Cases, More or Less, Each Containing Six Jars of Jam v. United States*, 340 U.S. 593, 596 (1951) (“Congress expresses its purpose by words. It is for us to ascertain—neither to add nor to subtract, neither to delete nor to distort.”).

³ T-Mobile tries to square the circle by positing that its “any gap in use” test becomes irrelevant once a lawsuit is filed while abandonment remains relevant during the pendency of a suit. See Pet. at 12 n.3. It never explains the reason for this inconsistency. Nor does T-Mobile explain the numerous decisions applying the statutory abandonment test to common law marks even where use was discontinued before the lawsuit. See *infra* note 6.

redundant, a result that would defy the “cardinal principle of statutory construction” that “no clause, sentence, or word shall be superfluous, void, or insignificant.” *TRW Inc. v. Andrews*, 534 U.S. 19, 31 (2001).

B. T-Mobile’s “any gap in use” test conflicts with other provisions of the Lanham Act.

Congress deliberately required continuous use in some provisions of the Lanham Act, but not for maintenance of rights. For example, a trademark registration can become incontestable only after it “has been in continuous use for five consecutive years.” 15 U.S.C. § 1065. And a senior user who has “continuously used” its mark has a defense against an incontestable mark. *See* 15 U.S.C. § 1115(b)(5). In the context of those incontestability provisions, “[c]ontinuous’ from a date prior to registration is not the same as a lack of abandonment.” 4 McCarthy on Trademarks and Unfair Competition § 26:44 (5th ed.) (“McCarthy”). Congress thus knew how to impose stricter “continuous use alone” standards when it wanted to.

Furthermore, under Section 2(d) of the Lanham Act, only a prior unregistered mark that “has not been abandoned” can block registration of a competing trademark.⁴ This is another conclusive example where the statute speaks of “abandonment” rather than

⁴ 15 U.S.C. § 1052(d) (“No trademark ... shall be refused registration ... unless it ... [c]onsists of or comprises a mark which so resembles a mark registered in the Patent and Trademark Office, *or a mark or trade name previously used in the United States by another and not abandoned*, as to be likely ... to cause confusion ...” (emphasis added)).

continuous use. Because the same likelihood-of-confusion test applies to trademark registration and trademark infringement, *see B&B Hardware, Inc. v. Hargis Industries, Inc.*, 575 U.S. 138, 154 (2015), T-Mobile’s “any gap in use” theory would create an anomaly—unless abandoned, a prior common law mark would prohibit registration of an infringing mark, but that same mark could not be enforced during a gap in use falling short of abandonment. The plain language of the Lanham Act precludes such a paradoxical result.⁵ *See Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 768 (1992) (“the general principles qualifying a mark for registration under § 2 of the Lanham Act are for the most part applicable in determining whether an unregistered mark is entitled to protection”).

C. T-Mobile’s proposed rule has no common law pedigree.

Instead of citing the statute, T-Mobile falls back on generalized statements about “the core purpose of trademark law” of protecting against consumer confusion. Pet. at 8. But intent has been a crucial part of the test for maintaining trademark rights since long before the Lanham Act. *See, e.g., Saxlehner v. Eisner & Mendelson Co.*, 179 U.S. 19, 31 (1900) (“To establish the defence of abandonment it is necessary to show not only acts indicating a practical abandonment, but an

⁵ This result would likely materialize here if T-Mobile’s position were adopted, because Simply Wireless is opposing registration of T-Mobile’s SIMPLY PREPAID trademark in addition to pursuing infringement claims. *See Simply Wireless, Inc. v. T-Mobile USA, Inc.*, Opp. No. 91220938 (T.T.A.B. filed Mar. 6, 2015).

actual intent to abandon.”). The common law test for loss of trademark rights is identical to the Lanham Act’s, defining “abandonment in the same two part way as does federal law.” McCarthy § 17:1; *see also* Restatement (Third) of Unfair Competition § 30(2)(a) (1995) (“A trademark ... is abandoned if: (a) the party asserting rights in the designation has ceased to use the designation with an intent not to resume use”).

II. There is no genuine circuit split.

A. The circuits apply the abandonment test to unregistered marks.

Every circuit that T-Mobile claims has adopted its “any gap in use” test has applied the abandonment test to unregistered marks.⁶ For example, in *Vais Arms*, there was no dispute about whether the plaintiff had discontinued use of its unregistered VAIS trademark. 383 F.3d at 293. To assess abandonment, the Fifth Circuit examined the evidence of the plaintiff’s intent to abandon and the plaintiff’s arguments to the contrary before determining that the

⁶ *See, e.g., Southern Cal. Darts Ass’n v. Zaffina*, 762 F.3d 921, 932 (9th Cir. 2014); *Herb Reed Enters., LLC v. Florida Entm’t Mgmt., Inc.*, 736 F.3d 1239, 1247-48 (9th Cir. 2013); *Natural Answers, Inc. v. SmithKline Beecham Corp.*, 529 F.3d 1325, 1329 (11th Cir. 2008); *Stilson & Assocs., Inc. v. Stilson Consulting Grp., LLC*, 129 F. App’x 993, 995 (6th Cir. 2005); *General Healthcare Ltd. v. Qashat*, 364 F.3d 332, 337-38 (1st Cir. 2004); *Vais Arms, Inc. v. Vais*, 383 F.3d 287, 293 (5th Cir. 2004); *Cumulus Media, Inc. v. Clear Channel Commc’ns, Inc.*, 304 F.3d 1167, 1173-78 & n.6 (11th Cir. 2002); *Marshak v. Treadwell*, 240 F.3d 184, 198-200 (3d Cir. 2001); *Rust Env’t & Infrastructure, Inc. v. Teunissen*, 131 F.3d 1210, 1214 (7th Cir. 1997); *Silverman v. CBS Inc.*, 870 F.2d 40, 45 (2d Cir. 1989).

plaintiff had in fact abandoned its rights. *Id.* at 293-95. That analysis would have been unnecessary if T-Mobile’s “any gap in use” test applied.

Only one court of appeals besides the Fourth Circuit has squarely addressed the issue implicated by T-Mobile’s petition. In *West Florida Seafood, Inc. v. Jet Restaurants, Inc.*, the Federal Circuit expressly rejected the argument T-Mobile makes here, explaining in a discussion of whether a common law mark had priority over a registration that the Lanham Act “does not speak of ‘continuous use,’ but rather whether the mark or trade name has been ‘previously used in the United States by another *and not abandoned.*’” 31 F.3d 1122, 1128 (Fed. Cir. 1994) (emphasis in original).

B. T-Mobile’s cases do not establish a genuine split.

T-Mobile seeks to manufacture a circuit split where none exists.

For example, T-Mobile claims (at 11-12) that the Ninth Circuit adopted its “any gap in use” test in *Casual Corner Associates, Inc. v. Casual Stores of Nevada, Inc.*, 493 F.2d 709, 712 (9th Cir. 1974). But *Casual Corner* was interpreting the statutory prerequisites to a prior use defense to an incontestable trademark. *See id.* (addressing “continuing use” in the context of 15 U.S.C. §§ 1115 and 1065); *see also supra* at 8. Absence of a similar requirement from the statutory test for abandonment means that *Casual Corner* supports Simply Wireless, not T-Mobile.

T-Mobile’s citation to *Blue Bell, Inc. v. Farah Manufacturing Co.*, 508 F.2d 1260, 1265 (5th Cir.

1975), is misleading for a different reason. There, the Fifth Circuit held that the plaintiff's one instance of use—attaching tags to a single shipment of goods already bearing a different mark—was a “bad faith attempt to reserve a mark” and thus insufficient to “*create* trademark rights.” *Id.* at 1267 (emphasis added). Thus, the Fifth Circuit's statement that “even a single use in trade may sustain trademark rights if followed by continuous commercial utilization,” *id.*, concerned the standard for establishing trademark rights in the first place, not maintaining existing rights. As the district court noted below, “the ‘deliberate and continuous’ test applies only to the initial accrual of trademark rights, not whether a common law owner has maintained such rights.” Pet. App. 58a (discussing *Larsen v. Terk Techs. Corp.*, 151 F.3d 140, 146 (4th Cir. 1998)). *Blue Bell* is thus consistent with the Fourth Circuit's case law.

To be sure, courts sometimes note the unremarkable truth that loss of trademark rights requires a lack of continuous use. But that is not the same as holding that non-use alone is sufficient.

For example, both of T-Mobile's Third Circuit cases merely remark that, “[w]ith respect to ownership of an unregistered mark, the first party to adopt a mark can assert ownership so long as it continuously uses the mark in commerce.” *Kars 4 Kids Inc. v. America Can!*, 8 F.4th 209, 219 (3d Cir. 2021); *Commerce Nat'l Ins. Servs., Inc. v. Commerce Ins. Agency, Inc.*, 214 F.3d 432, 438 (3d Cir. 2000). The Fourth Circuit recognized that its own precedent contains similar statements but found them

consistent with the statutory abandonment test.⁷ In *Kars 4 Kids*, the prior user had continuously used its mark, thus precluding any defense based on non-use as a threshold matter. *See* 8 F.4th at 219. The Third Circuit did not suggest, much less hold, that infringers can escape liability based on any gap in use by a plaintiff that has established common law rights through years of continuous and successful prior use.

Other cases state in dicta that prior continuous use is a requirement of a claim for infringement of an unregistered mark, using “continuous use” as shorthand for non-abandonment. *See, e.g., Homeowners Grp., Inc. v. Home Mktg. Specialists, Inc.*, 931 F.2d 1100, 1105 (6th Cir. 1991); *Tally-Ho, Inc. v. Coast Cmty. Coll. Dist.*, 889 F.2d 1018, 1022-23 (11th Cir. 1989) (per curiam). Indeed, the Eleventh Circuit later quoted its dicta from *Tally-Ho* that “actual and continuous use is required” before applying the abandonment test to a common law mark. *Natural Answers*, 529 F.3d at 1329-30. Using shorthand for an established statutory doctrine is not the same as adopting a new one. *See Hall St. Assocs., L.L.C. v. Mattel, Inc.*, 552 U.S. 576, 585 (2008). And even if those decisions had endorsed T-Mobile’s rule, none actually applied it. Such “[d]ictum settles nothing, even in the court that utters it.” *Jama v. Immigration*

⁷ *See* Pet. App. 30a (“We ... ruled that the putative owner of a common law trademark (such as Simply Wireless) is entitled to assert priority over a junior user (such as T-Mobile) ‘so long as that owner continues to make use of the mark.’ ... But that decision did not preclude the district court from applying the statutory abandonment inquiry.”).

& Customs Enforcement, 543 U.S. 335, 352 n.12 (2005).

Airs Aromatics LLC v. Victoria's Secret Stores Brand Management, Inc., 744 F.3d 595 (9th Cir. 2014), likewise falls short of establishing a genuine circuit split. There, the plaintiff did not use its mark for seven years, far longer than necessary to establish the statutory presumption of abandonment. *Id.* at 599-600; *see also* 15 U.S.C. § 1127 (“3 consecutive years shall be prima facie evidence of abandonment”). The plaintiff asserted no facts showing an intent to resume use that could have rebutted the presumption. 744 F.3d at 599-600; *see also infra* at 17. Because *Airs Aromatics* would thus have come out the same way even if the court had expressly applied abandonment, it does not stand for the proposition that T-Mobile’s test is the law in the Ninth Circuit. Subsequent courts have interpreted *Airs Aromatics* as finding abandonment. *See Timothy B. O’Brien LLC v. Knott*, No. 3:18-cv-00684, 2018 WL 5456550, at *4 (W.D. Wis. Oct. 29, 2018).

Even assuming *Airs Aromatics* adopted T-Mobile’s position, it fails to establish a mature circuit split that warrants review. The court’s ruling on the viability of the plaintiff’s trademark rights was based on an argument made for the first time in a reply brief. 744 F.3d at 599. The Ninth Circuit’s statement that “the owner must ‘establish not only that he or she used the mark before the mark was registered, but also that such use has continued to the present,’” relied solely on a quote from *Watec Co. v. Liu*, 403 F.3d 645, 654 (9th Cir. 2005), which in turn quoted *Casual Corner*. Like *Casual Corner*, *Watec* was a case involving

incontestable trademark rights, where the Lanham Act does prescribe continuous use alone as a requirement. *See id.* at 652-54; *see also supra* at 8.⁸

Thus, the only decisions T-Mobile cites that even arguably applied its “any gap in use” rule relied on a misreading of the court’s own precedent, addressing arguments for which it did not have the benefit of adversarial briefing. One court’s plainly incorrect decisions weighed against unambiguous statutory text and otherwise unanimous practice—including in the same court—does not warrant this Court’s review. *Cf. Kirtsaeng v. John Wiley & Sons, Inc.*, 568 U.S. 519, 548 (2013) (declining to give significant “legal weight” to a statement on an issue that “was not ... fully argued”).

III. T-Mobile’s policy arguments are not a basis for review.

T-Mobile spends much of its petition on policy arguments—asserting, for example, that the Fourth Circuit’s approach encourages “opportunistic lawsuits” or undermines “public-notice considerations.” Pet. at 3. As noted below, public policy favors Simply Wireless’s approach. But either way, these arguments are immaterial, because “the place for reconciling competing and incommensurable policy goals like these is before policymakers.” *Romag*

⁸ *Department of Parks & Recreation v. Bazaar del Mundo*, 448 F.3d 1118, 1127 (9th Cir. 2006), also incorrectly relied on *Casual Corner*.

Fasteners, 590 U.S. at 219.⁹ As the Court recently reiterated in *Dewberry Group, Inc. v. Dewberry Engineers Inc.*, the text of the Lanham Act—there, the “defendant’s profits,” 15 U.S.C. § 1117(a), here “with intent not to resume such use,” 15 U.S.C. § 1127—controls over any policy concerns, no matter how legitimate they may be. 604 U. S. ____, slip op. at 4 (2025).

In this case, however, T-Mobile’s concerns are unfounded. For example, T-Mobile asserts that applying the statutory abandonment analysis to common law marks disincentivizes registration. Pet. at 18. Yet Congress made registration optional and included in the Lanham Act a statutory cause of action for infringement of unregistered marks. See 15 U.S.C. § 1125(a). Indeed, this Court has recognized that, under the Lanham Act, “an unregistered trademark ... should receive essentially the same protection as those that are registered.” *Two Pesos*, 505 U.S. at 776 (Stevens, J., concurring) (describing majority opinion); *see also Abitron Austria GmbH v. Hetronic Int’l, Inc.*, 600 U.S. 412, 416 (2023) (the Lanham Act “prohibits the ‘us[e] in commerce’ of a protected mark, whether registered or not, that ‘is likely to cause confusion’”) (alteration in original).

⁹ T-Mobile had ample notice of Simply Wireless’s prior rights here. First, T-Mobile executives were aware of the prior SIMPLY PREPAID mark from T-Mobile’s long association with Simply Wireless and its owners, who they referred to as the “Simply Guys.” C.A.J.A. 2087. Second, Simply Wireless promptly notified T-Mobile that its SIMPLY PREPAID stores were infringing. C.A.J.A. 682-83, 968-69. Rather than stop, T-Mobile expanded its infringement.

The benefits of registration are not imperiled by the Fourth Circuit’s rejection of T-Mobile’s proposed test. This Court in prior cases has listed such benefits, including the presumption of validity, the opportunity to attain “incontestable” status, and the ability to stop the importation of infringing articles into the United States. *See Matal v. Tam*, 582 U.S. 218, 226-27 (2017). Neither this nor any other court lists a less strict standard for maintaining trademark rights, i.e., the right to pause use, as one of the advantages of registration. Yet the volume of applications and registrations on record at the USPTO evidences the ample incentive for registration.

T-Mobile also overstates the threat of “opportunistic litigation over sporadically used trademarks.” Pet. at 18. The law already contains safeguards that balance the rights of prior common law trademark owners against those of newcomers.

For example, Congress legislated a statutory presumption that “[n]onuse for 3 consecutive years shall be prima facie evidence of abandonment.” 15 U.S.C. § 1127. That presumption has teeth. As the Fourth Circuit explained below, “a trademark owner ‘cannot defeat an abandonment claim ... by simply asserting a vague, subjective intent to resume use of a mark at some unspecified future date.’” Pet. App. 22a (quoting *Emergency One*, 228 F.3d at 537).¹⁰ The

¹⁰ *See also ITC Ltd. v. Punchgini, Inc.*, 482 F.3d 135, 150 (2d Cir. 2007) (“a trademark owner cannot rebut a presumption of abandonment merely by asserting a subjective intent to resume use of the mark at some later date”); *Electro Source, LLC v. Brandess-Kalt-Aetna Grp., Inc.*, 458 F.3d 931, 937 (9th Cir. 2006)

Lanham Act also instructs courts to disregard use “made merely to reserve a right in a mark.” 15 U.S.C. § 1127; *see, e.g., La Societe Anonyme des Parfums le Galion v. Jean Patou, Inc.*, 495 F.2d 1265, 1272 (2d Cir. 1974) (plaintiff’s sale of 89 bottles of perfume over 20 years to block imports did not create trademark rights).

Additionally, “the law’s central purpose of preventing consumer confusion,” about which T-Mobile claims to be concerned, Pet. at 13, is enforced through the longstanding likelihood-of-confusion test applied by every circuit and the USPTO. *See* McCarthy § 24:30.

T-Mobile fails to mention the other of the Lanham Act’s “twin goals”—namely, “protecting producers’ good will.” *Jack Daniel’s Props., Inc. v. VIP Prods. LLC*, 599 U.S. 140, 147 (2023). In addition to penalizing trademark owners like Simply Wireless that are forced to pause use of their common law marks due to market conditions, T-Mobile’s proposed test would impede businesses’ ability to maintain protectable goodwill in trademarks through use in

(“In cases where there is a presumption of abandonment from nonuse, ... a mere statement declaring an intent not to abandon, or an intent to resume, use is not dispositive.”); *Vais Arms*, 383 F.3d at 294 (“At most, [the mark owner’s] affidavit establishes only his subjective, uncommunicated desire not to abandon the mark, without any indication of when or how he intended to resume its commercial use; it does not establish a genuine issue as to his intent to abandon.”); *Imperial Tobacco Ltd. v. Philip Morris, Inc.*, 899 F.2d 1575, 1581 (Fed. Cir. 1990) (“An averment of no intent to abandon is little more than a denial in a pleading, which is patently insufficient to preclude summary judgment on the ground the facts are disputed.”).

connection with seasonal businesses (e.g., boardwalk ice cream stands), limited-time promotional releases (e.g., the McDonald's McRib sandwich), expensive offerings sold at irregular intervals (e.g., construction services for skyscrapers), and other endeavors that necessarily involve gaps in use. T-Mobile's rule would thus encourage the same "token use" that Congress sought to prohibit.

T-Mobile uses this case as the poster child for its parade of horrors, repeatedly and gratuitously denigrating Simply Wireless's motives. Pet. at 3, 13, 17-18. But the Fourth Circuit saw it differently, noting that under the summary judgment standard, the evidence "*strongly supports* Simply Wireless's essential and timely intent to resume use of its contested trademark," including by negotiating with specific third parties to engage in a sales campaign that came to fruition shortly thereafter. Pet. App. 22a-23a. (emphasis added). And T-Mobile has never disputed that these activities occurred long before Simply Wireless had any inkling that T-Mobile planned to use SIMPLY PREPAID.

This case involves one of the most sophisticated and profitable companies in the world choosing to use the exact mark of a known competitor for the same types of prepaid cell phone products for which Simply Wireless used the mark. If anything, it demonstrates precisely why trademark law has always required more than mere discontinuance of use before trademark rights are forfeited.

CONCLUSION

For the foregoing reasons, the Court should deny the petition for certiorari.

March 4, 2025, Respectfully submitted,

SEAN PATRICK ROCHE CAMERON/MCEVOY PLLC 4100 Monument Corner Dr., Suite 420 Fairfax, VA 22030	ROBERT D. LITOWITZ <i>Counsel of Record</i> SAUL COHEN SHELBY A. MCGOWAN KELLY IP, LLP 1300 19th Street, NW, Suite 420 Washington, D.C. 20036 (202) 808-3570 robert.litowitz@kelly-ip.com
JOHN R. GERSTEIN CLYDE & Co US LLP 1775 Pennsylvania Ave, NW, 4th Floor Washington, DC 20006	

Counsel for Respondent