

## Gorilla Glue Back in a Sticky Trade Dress Situation

*J-B Weld Company, LLC v. The Gorilla Glue Company, Case No. 18-14975 (11th Cir. 2020)*

By: Lisa Holubar & Peggy Herrmann | October 26, 2020

On October 20, 2020, the Eleventh Circuit resuscitated J-B Weld’s (“J-B”) action for trade dress infringement and trade dress dilution against Gorilla Glue (“Gorilla”) by reversing the lower court’s grant of Gorilla Glue’s motion for summary judgment. The Court found that the lower court failed to discuss all of the likelihood of confusion factors, conducted impermissible fact finding, and conflated the requirements of trade dress dilution and infringement. The Court did, however, uphold the lower court’s conclusion that use of the phrase “steel bond epoxy” on Gorilla’s packaging was not material to purchasing decisions and therefore did not constitute false advertising under state or federal law.

J-B described its trade dress as: “(1) two squeezable tubes...angled inwardly to create a ‘V-shape;’ (2) a black-bannered tube on the left side...and a red-bannered tube on the right side...; (3) black and white caps on each respective tube; (4) a clear “blister” style protective package that angles inward in the same manner as the tubes; (5) a background card with a width of five inches; (6) a ‘technical information box,’ located in between the two tubes on the background card, including four lines of information separated by white lines; (7) colored banners stretching across the top and bottom portions of the background card; (8) the capitalized/ emphasized word ‘WELD’ inside the upper banner...; (9) a list of potential uses for the product in the bottom-right corner of the background card.”



In the Eleventh Circuit, a seven-factor analysis determines if there is a likelihood of confusion between two trade dresses (which is the key element of a trade dress infringement claim): (1) the strength of the trade dress; (2) the similarity of the designs; (3) the similarity of the products; (4) the similarity of the retail outlets and purchasers; (5) the similarity of advertising media used; (6) the defendant’s intent; and (7) actual confusion. The Court held that the lower court failed to discuss the first, third, fourth, and fifth factors. Although the lower court addressed the remaining three factors, it failed to do so in a light most favorable to J-B, the nonmovant as required at summary judgment.

Regarding the similarity of the designs, the lower court acknowledged certain shared elements, such as the v-shape configuration of the tubes and the product specification provided between that configuration. Nonetheless, the lower court found that no reasonable person could find similarity in the overall impressions created by the two designs. The Court, however, held that reasonable people could disagree as to which features contributed the most of the overall impression such that two reasonable people could arrive at different conclusions. Additionally, J-B offered substantial evidence that Gorilla intended to copy J-B’s trade dress, including email communications of Gorilla’s design team discussing J-B’s packaging and how to mirror it. The lower court surmised that the defendant’s intent to copy did not rise to an intent to confuse consumers. However, the Court held that a reasonable jury could infer that Gorilla’s mirroring of J-B’s design could be intended to capitalize on J-B’s goodwill. Finally, the Court rejected the lower court’s finding of no actual confusion. J-B’s evidence was that industry professionals inquired whether there was a connection between the two products, and it was reasonable to infer that, even if the industry professionals knew the two products were different, they were confused as to whether GorillaWeld was the product of a collaboration between the two companies.

Also an issue requiring remand was the lower court’s abbreviated consideration of the state law dilution claim. The lower court’s remarks about the “indistinguishability of the applicable standards” indicated that it applied the elements of the federal trade dress infringement claims to the state trade dress dilution claim. Because the state dilution claim did not require actual confusion, the lower court may have thus conflated the two different sets of requirements.

Finally, the Court agreed that the term “steel bond epoxy” was not false advertising. Although J-B’s survey evidence asked how consumers understood the terms “epoxy” and “steel bond,” the survey did not ask whether respondents’ understanding of the chemical makeup of an epoxy or the presence of steel in the product would have affected their decision to purchase one product or the other. Without evidence that consumers care whether GorillaWeld uses actual epoxy chemistry, or whether GorillaWeld actually contains steel, the claim was not material.