

In the Matter of

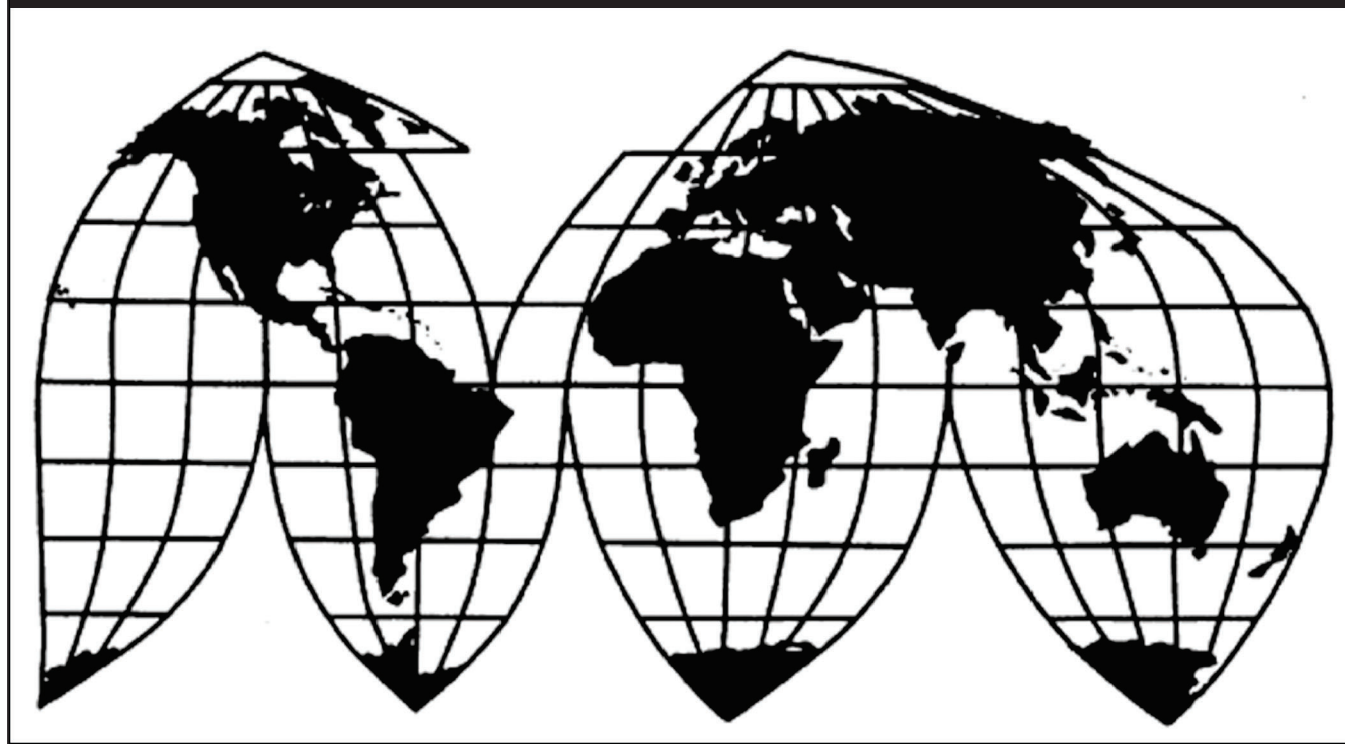
**CERTAIN MOTORIZED VEHICLES AND
COMPONENTS THEREOF**

Investigation No. 337-TA-1132

Publication 5257

February 2022

U.S. International Trade Commission



Washington, DC 20436

U.S. International Trade Commission

COMMISSIONERS

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Randolph J. Stayin, Commissioner
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**Address all communications to
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Washington, DC 20436**

U.S. International Trade Commission

Washington, DC 20436
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In the Matter of

CERTAIN MOTORIZED VEHICLES AND COMPONENTS THEREOF

Investigation No. 337-TA-1132



UNITED STATES INTERNATIONAL TRADE COMMISSION

Washington, D.C.

In the Matter of

**CERTAIN MOTORIZED VEHICLES
AND COMPONENTS THEREOF**

Investigation No. 337-TA-1132

(Modification)

**NOTICE OF COMMISSION DETERMINATION TO MODIFY
REMEDIAL ORDERS; TERMINATION OF MODIFICATION PROCEEDING**

AGENCY: U.S. International Trade Commission.

ACTION: Notice.

SUMMARY: Notice is hereby given that the U.S. International Trade Commission has determined to adopt with modification the findings of the presiding Administrative Law Judge (“ALJ”) in the Recommended Determination (“RD”) and to modify the limited exclusion order (“LEO”) and cease and desist orders (“CDOs”) (collectively, “the remedial orders”) issued in this investigation to exempt the respondents’ redesigned product from the scope of the remedial orders. The modification proceeding is terminated.

FOR FURTHER INFORMATION CONTACT: Houda Morad, Office of the General Counsel, U.S. International Trade Commission, 500 E Street SW, Washington, DC 20436, telephone (202) 708-4716. Copies of non-confidential documents filed in connection with this investigation may be viewed on the Commission’s electronic docket (EDIS) at <https://edis.usitc.gov>. For help accessing EDIS, please email EDIS3Help@usitc.gov. General information concerning the Commission may also be obtained by accessing its Internet server at <https://www.usitc.gov>. The public record for this investigation may be viewed on the Commission's electronic docket (EDIS) at <https://edis.usitc.gov>. Hearing-impaired persons are advised that information on this matter can be obtained by contacting the Commission’s TDD terminal on (202) 205-1810.

SUPPLEMENTARY INFORMATION: The Commission instituted this investigation on September 13, 2018, based on a complaint, as amended, filed by FCA US LLC of Auburn Hills, Michigan (“Complainant”). *See* 83 FR 46517 (Sept. 13, 2018). The complaint alleges violations of section 337 of the Tariff Act of 1930, as amended (19 U.S.C. 1337) (“section 337”) based upon the importation into the United States, the sale for importation, and the sale within the United States after importation of certain motorized vehicles and components thereof by reason of: (1) infringement of U.S. Trademark Registration Nos. 4,272,873; 2,862,487; 2,161,779; 2,794,553; and 4,043,984 (collectively, “the Asserted Trademarks”); (2) trademark dilution and unfair competition in violating the complainant’s common law trademark rights; and (3) trade dress infringement. *See id.* The notice of investigation names Mahindra & Mahindra Ltd. of Mumbai, India and Mahindra Automotive North America, Inc. of Auburn Hills, Michigan

(collectively, “Respondents”) as respondents in this investigation. *See id.* The Office of Unfair Import Investigations is also a party to this investigation. *See id.*

On November 8, 2019, the ALJ issued a final initial determination (“FID”) finding a violation of section 337. Specifically, the FID determined that Respondents’ Roxor vehicle (2018-2019 model) infringes FCA’s asserted trade dress but not its Asserted Trademarks. The FID also determined that Complainant did not establish trademark dilution.

On June 11, 2020, the Commission determined to affirm the FID’s determination of a violation of section 337. *See* 85 FR 36613-14 (June 17, 2020). The Commission issued an LEO barring entry of articles that infringe the asserted trade dress and CDOs against both Respondents. The Commission declined to adjudicate Respondents’ proposed redesigned vehicles and required Respondents to obtain a ruling (via an advisory opinion or a modification proceeding) from the Commission prior to any importation of redesigned vehicles or components thereof.

On June 18, 2020, Respondents filed a petition for an expedited modification proceeding. On July 20, 2020, the Commission determined to institute a modification proceeding under section 337(k) (19 U.S.C. 1337(k)) and Commission Rule 210.76 (19 CFR 210.76) to adjudicate trade dress infringement with respect to respondents’ redesigned vehicle (“the Post-2020 ROXOR”). *See* 85 FR 44923-24 (July 24, 2020).

On October 20, 2020, the ALJ issued his RD finding no trade dress infringement by Respondents’ Post-2020 ROXOR vehicle. On October 30, 2020, Complainant filed comments on the RD requesting that the Commission decline to adopt the RD’s findings. On November 6, 2020, Respondents and the Commission’s Investigative Attorney filed responses in opposition to Complainant’s comments.

Having reviewed the record of the underlying violation investigation, as well as the record of the modification proceeding, including the RD and the parties’ comments and responses thereto, the Commission has determined to modify the LEO and CDOs to include an explicit exemption with respect to Respondents’ Post-2020 ROXOR vehicle adjudicated in this modification proceeding. As explained in the Commission Opinion issued concurrently herewith, the Commission adopts the RD’s findings with modification and affirms the RD’s conclusion that the Post-2020 ROXOR vehicle does not infringe Complainant’s asserted trade dress. The modification proceeding is terminated.

The Commission’s vote on this determination took place on December 22, 2020.

The authority for the Commission’s determination is contained in section 337 of the Tariff Act of 1930, as amended (19 U.S.C. 1337), and in part 210 of the Commission’s Rules of Practice and Procedure (19 CFR part 210).

By order of the Commission.

A handwritten signature in black ink, appearing to read 'Lisa R. Barton'.

Lisa R. Barton
Secretary to the Commission

Issued: December 22, 2020

PUBLIC CERTIFICATE OF SERVICE

I, Lisa R. Barton, hereby certify that the attached **NOTICE** has been served via EDIS upon the Commission Investigative Attorney, **Vu Bui, Esq.** and the following parties as indicated, on **December 23, 2020**.



Lisa R. Barton, Secretary
U.S. International Trade Commission
500 E Street, SW, Room 112
Washington, DC 20436

**On Behalf of Requester Mahindra & Mahindra Ltd. and
Mahindra Automotive North America, Inc.:**

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- Via Express Delivery
- Via First Class Mail
- Other: Email Notification
of Availability for Download

On Behalf of Respondent FCA US LLC:

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- Via Express Delivery
- Via First Class Mail
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**UNITED STATES INTERNATIONAL TRADE COMMISSION
Washington, D.C.**

In the Matter of

**CERTAIN MOTORIZED VEHICLES
AND COMPONENTS THEREOF**

**Investigation No. 337-TA-1132
(Modification)**

MODIFIED LIMITED EXCLUSION ORDER

The United States International Trade Commission (“Commission”) has determined that there is a violation of Section 337 of the Tariff Act of 1930, as amended (19 U.S.C. § 1337), in the unlawful importation, sale for importation, or sale within the United States after importation by respondents Mahindra & Mahindra Ltd. of Mumbai, India and Mahindra Automotive North America, Inc. of Auburn Hills, Michigan (collectively, “Mahindra” or “Respondents”) of motorized vehicles, kits and assemblies for motorized vehicles, and replacement and aftermarket components for motorized vehicles that infringe the asserted trade dress in the above-captioned investigation (“the Jeep Trade Dress”). The Jeep Trade Dress consists of “the overall exterior appearance and styling of the [Jeep CJ and Jeep Wrangler] vehicle design,” including:

- (i) A boxy body shape with flat appearing vertical side and rear body panels ending at about the same height as the hood;
- (ii) Substantially flat hood with curved side edges that tapers to be narrower at the front;
- (iii) Trapezoidal front wheel wells with front fenders or fender flares that extend beyond the front of the grille;
- (iv) Flat appearing grille with vertical elongated grille slots and a trapezoidal outline that curves around round headlamps positioned on the upper part of the grille;
- (v) Exterior hood latches; and
- (vi) Door cutouts above a bottom portion of the side body panels.

Having reviewed the record of this investigation, including the written submissions of the parties, the Commission has made its determination on the issues of remedy, public interest, and bonding. The Commission has determined that the appropriate form of relief includes a limited exclusion order prohibiting the unlicensed entry of covered motorized vehicles, kits and assemblies for motorized vehicles, and replacement and aftermarket components for motorized vehicles, manufactured abroad by or on behalf of, or imported by or on behalf of, Respondents or any of their affiliated companies, parents, subsidiaries, or other related business entities, or their successors or assigns.

The Commission has also determined that the public interest factors enumerated in 19 U.S.C. § 1337(d) do not preclude the issuance of the limited exclusion order, and that the bond during the period of Presidential review shall be in the amount of one hundred (100) percent of the entered value of infringing finished motorized vehicles and ten (10) percent of the entered value of any components thereof. Thereafter, the Commission conducted a modification proceeding to adjudicate Respondents' Post-2020 ROXOR vehicle and determined that it does not infringe the Jeep Trade Dress and is outside the scope of this Order. The Commission therefore modifies this Order to include an exemption with respect to Respondents' Post-2020 ROXOR vehicle.

Accordingly, the Commission hereby ORDERS that:

1. Motorized vehicles, kits and assemblies for motorized vehicles, and replacement and aftermarket components for motorized vehicles that infringe the Jeep Trade Dress and that are manufactured by, or on behalf of, or are imported by or on behalf of Respondents or any of their affiliated companies, parents, subsidiaries, or other related business entities, or their successors or assigns (“covered articles”), are excluded from entry for consumption into the

United States, entry for consumption from a foreign-trade zone, or withdrawal from a warehouse for consumption, until the Jeep Trade Dress has been abandoned or rendered invalid or unenforceable, except under license from, or with the permission of, the trade dress owner or as provided by law, and except for service or repair components imported for use in servicing or repairing covered articles that were imported prior to the effective date of this Order.

2. For the purpose of assisting U.S. Customs and Border Protection (“CBP”) in the enforcement of this Order, and without in any way limiting the scope of the Order, the Commission has attached images of the Jeep CJ and Jeep Wrangler vehicles that feature the Jeep Trade Dress as Exhibit 1.

3. Prior to the importation of covered articles that may be subject to this Order, any of the persons listed in paragraph 1 of this Order must seek a ruling from the Commission to determine whether the covered articles sought to be imported are covered by this Order.

4. This Order does not apply to Respondents’ Post-2020 ROXOR vehicle, which, as the Commission determined in this modification proceeding, does not infringe the Jeep Trade Dress.

5. Notwithstanding paragraph 1 of this Order, the aforesaid covered articles are entitled to entry into the United States for consumption, entry for consumption from a foreign trade zone, or withdrawal from a warehouse for consumption, under bond in the amount of one hundred (100) percent of the entered value of infringing finished motorized vehicles and ten (10) percent of the entered value of any components thereof, pursuant to subsection (j) of section 337 of the Tariff Act of 1930, as amended (19 U.S.C. § 1337(j)), and the Presidential Memorandum for the United States Trade Representative of July 21, 2005, (70 FR 43251), from the day after this Order is received by the United States Trade Representative, and until such time as the

United States Trade representative notifies the Commission that this Order is approved or disapproved but, in any event, not later than sixty (60) days after the date of receipt of this Order. All entries of covered articles made pursuant to this paragraph are to be reported to CBP in advance of the date of the entry, pursuant to procedures CBP establishes.

6. At the discretion of CBP, and pursuant to the procedures it establishes, persons seeking to import covered articles that are potentially subject to this Order may be required to certify that they are familiar with the terms of this Order, that they have made appropriate inquiry, and thereupon state that, to the best of their knowledge and belief, the products being imported are not excluded from entry under paragraph 1 of this Order. At its discretion, CBP may require persons who have provided the certification described in this paragraph to furnish such records or analyses as are necessary to substantiate this certification.

7. The Commission may modify this Order in accordance with the procedures described in Rule 210.76 of the Commission's Rules of Practice and Procedure (19 C.F.R. § 210.76).

8. The Secretary shall serve copies of this Order upon each party of record in this Investigation and upon CBP.

9. Notice of this Order shall be published in the Federal Register.

By order of the Commission.



Lisa R. Barton
Secretary to the Commission

Issued: December 22, 2020

EXHIBIT 1





PUBLIC CERTIFICATE OF SERVICE

I, Lisa R. Barton, hereby certify that the attached **ORDER, COMMISSION** has been served via EDIS upon the Commission Investigative Attorney, **Vu Bui, Esq.** and the following parties as indicated, on **December 23, 2020**.



Lisa R. Barton, Secretary
U.S. International Trade Commission
500 E Street, SW, Room 112
Washington, DC 20436

**On Behalf of Requester Mahindra & Mahindra Ltd. and
Mahindra Automotive North America, Inc.:**

R. David Hosp, Esq.
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- Via Express Delivery
- Via First Class Mail
- Other: Email Notification
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On Behalf of Respondent FCA US LLC:

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Email: FCCimino@venable.com

- Via Hand Delivery
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**UNITED STATES INTERNATIONAL TRADE COMMISSION
Washington, D.C.**

In the Matter of

**CERTAIN MOTORIZED VEHICLES
AND COMPONENTS THEREOF**

**Investigation No. 337-TA-1132
(Modification)**

MODIFIED CEASE AND DESIST ORDER

IT IS HEREBY ORDERED THAT RESPONDENT Mahindra Automotive North America, Inc., cease and desist from conducting any of the following activities in the United States: importing, selling, marketing, advertising, distributing, transferring (except for exportation), soliciting U.S. agents or distributors for, and aiding or abetting other entities in the importation, sale for importation, sale after importation, transfer (except for exportation), or distribution of motorized vehicles, kits and assemblies for motorized vehicles, and replacement and aftermarket components for motorized vehicles that infringe the Jeep Trade Dress or any trade dress confusingly similar thereto or that are otherwise misleading as to source, origin, or sponsorship, in violation of section 337 of the Tariff Act of 1930, as amended (19 U.S.C. § 1337). Thereafter, the Commission conducted a modification proceeding to adjudicate Respondents' Post-2020 ROXOR vehicle and determined that it does not infringe the Jeep Trade Dress and is outside the scope of this Order. The Commission therefore modifies this Order to include an exemption with respect to Respondents' Post-2020 ROXOR vehicle.

**I.
Definitions**

As used in this Order:

- (A) "Commission" shall mean the United States International Trade Commission.
- (B) "Complainant" shall mean FCA US LLC, 1000 Chrysler Drive, Auburn Hills, MI

48321.

(C) “Respondent” shall mean Mahindra Automotive North America, Inc., 275 Rex Boulevard, Auburn Hills, MI 48326.

(D) “Person” shall mean an individual, or any non-governmental partnership, firm, association, corporation, or other legal or business entity other than Respondent or its majority owned or controlled subsidiaries, successors, or assigns.

(E) “United States” shall mean the fifty States, the District of Columbia, and Puerto Rico.

(F) The terms “import” and “importation” refer to importation for entry for consumption under the Customs laws of the United States.

(G) The term “Jeep Trade Dress” shall mean the following: “the overall exterior appearance and styling of the [Jeep CJ and Jeep Wrangler] vehicle design,” including:

- (i) A boxy body shape with flat appearing vertical side and rear body panels ending at about the same height as the hood;
- (ii) Substantially flat hood with curved side edges that tapers to be narrower at the front;
- (iii) Trapezoidal front wheel wells with front fenders or fender flares that extend beyond the front of the grille;
- (iv) Flat appearing grille with vertical elongated grille slots and a trapezoidal outline that curves around round headlamps positioned on the upper part of the grille;
- (v) Exterior hood latches; and
- (vi) Door cutouts above a bottom portion of the side body panels.

Images of the Jeep CJ and Jeep Wrangler vehicles that feature the Jeep Trade Dress are attached as Exhibit 1.

1. (H) The term “covered products” shall mean motorized vehicles, kits and assemblies for motorized vehicles, and replacement and aftermarket components for motorized vehicles that infringe the Jeep Trade Dress or any trade dress confusingly similar thereto or that are otherwise misleading as to source, origin, or sponsorship. The term “covered products” does not include Respondent’s Post-2020 ROXOR vehicle, which, as the Commission determined in this modification proceeding, does not infringe the Jeep Trade Dress.

II. Applicability

The provisions of this Cease and Desist Order shall apply to Respondent and to any of its principals, stockholders, officers, directors, employees, agents, distributors, controlled (whether by stock ownership or otherwise) and majority-owned business entities, successors, and assigns, and to each of them insofar as they are engaging in conduct prohibited by section III, *infra*, for, with, or otherwise on behalf of, Respondent.

III. Conduct Prohibited

The following conduct of Respondent in the United States is prohibited by this Order. Until the Jeep Trade Dress has been abandoned or rendered invalid or unenforceable, Respondent shall not:

- (A) import or sell for importation into the United States covered products;
- (B) market, distribute, sell, or otherwise transfer (except for exportation), in the United States imported covered products;
- (C) advertise imported covered products;
- (D) solicit U.S. agents or distributors for imported covered products; or
- (E) aid or abet other entities in the importation, sale for importation, sale after

importation, transfer, or distribution of covered products.

IV. Conduct Permitted

Notwithstanding any other provision of this Order, Respondent shall be permitted:

(A) to engage in specific conduct otherwise prohibited by the terms of this Order if, in a written instrument, the owner of the Jeep Trade Dress licenses or authorizes such specific conduct; or

(B) to import, sell for importation, advertise, market, distribute, sell, or otherwise transfer in the United States components for use in servicing or repairing covered products that were imported prior to the effective date of this Order.

V. Reporting

For purposes of this requirement, the reporting periods shall commence on January 1 of each year and shall end on the subsequent December 31. The first report required under this section shall cover the period from the date of issuance of this Order through December 31, 2020. This reporting requirement shall continue in force until such time as Respondent has truthfully reported, in two consecutive timely filed reports, that it has no inventory of covered products in the United States.

Within thirty (30) days of the last day of the reporting period, Respondent shall report to the Commission: (a) the quantity in units and the value in dollars of covered products that it has (i) imported and/or (ii) sold in the United States after importation during the reporting period, and (b) the quantity in units and value in dollars of reported covered products that remain in inventory in the United States at the end of the reporting period.

When filing written submissions, Respondent must file the original document

electronically on or before the deadlines stated above and submit eight (8) true paper copies to the Office of the Secretary by noon the next day pursuant to section 210.4(f) of the Commission's Rules of Practice and Procedure (19 C.F.R. § 210.4(f)). Submissions should refer to the investigation number ("Inv. No. 337-TA-1132") in a prominent place on the cover pages and/or the first page. (See Handbook on Filing Procedures, https://www.usitc.gov/documents/handbook_on_filing_procedures.pdf). Persons with questions regarding filing should contact the Office of the Secretary (202-205-2000). If Respondent desires to submit a document to the Commission in confidence, it must file the original and a public version of the original with the Office of the Secretary and must serve a copy of the confidential version on Complainant's counsel.¹

Any failure to make the required report or the filing of any false or inaccurate report shall constitute a violation of this Order, and the submission of a false or inaccurate report may be referred to the U.S. Department of Justice as a possible criminal violation of 18 U.S.C. § 1001.

VI. Recordkeeping and Inspection

(A) For the purpose of securing compliance with this Order, Respondent shall retain any and all records relating to the sale, offer for sale, marketing, or distribution in the United States of covered products, made and received in the usual and ordinary course of business, whether in detail or in summary form, for a period of three (3) years from the close of the fiscal year to which they pertain.

(B) For the purposes of determining or securing compliance with this Order and for

¹ Complainant must file a letter with the Secretary identifying the attorney to receive reports associated with this Order. The designated attorney must be on the protective order entered in the investigation.

no other purpose, subject to any privilege recognized by the federal courts of the United States, and upon reasonable written notice by the Commission or its staff, duly authorized representatives of the Commission shall be permitted access and the right to inspect and copy, in Respondent's principal office during office hours, and in the presence of counsel or other representatives if Respondent so chooses, all books, ledgers, accounts, correspondence, memoranda, and other records and documents, in detail and in summary form, that must be retained under subparagraph VI(A) of this Order.

**VII.
Service of Cease and Desist Order**

Respondent is ordered and directed to:

(A) Serve, within fifteen days after the effective date of this Order, a copy of this Order upon each of its respective officers, directors, managing agents, agents, and employees who have any responsibility for the importation, marketing, distribution, or sale of imported covered products in the United States;

(B) Serve, within fifteen days after the succession of any persons referred to in subparagraph VII(A) of this Order, a copy of this Order upon each successor; and

(C) Maintain such records as will show the name, title, and address of each person upon whom the Order has been served, as described in subparagraphs VII(A) and VII(B) of this Order, together with the date on which service was made.

The obligations set forth in subparagraphs VII(B) and VII(C) shall remain in effect until the Jeep Trade Dress has been abandoned or rendered invalid or unenforceable.

**VIII.
Confidentiality**

Any request for confidential treatment of information obtained by the Commission

pursuant to sections V or VI of this Order should be made in accordance with section 201.6 of the Commission's Rules of Practice and Procedure (19 C.F.R. § 201.6). For all reports for which confidential treatment is sought, Respondent must provide a public version of such report with confidential information redacted.

IX. Enforcement

Violation of this Order may result in any of the actions specified in section 210.75 of the Commission's Rules of Practice and Procedure (19 C.F.R. § 210.75), including an action for civil penalties under section 337(f) of the Tariff Act of 1930 (19 U.S.C. § 1337(f)), as well as any other action that the Commission deems appropriate. In determining whether Respondent is in violation of this Order, the Commission may infer facts adverse to Respondent if it fails to provide adequate or timely information.

X. Modification

The Commission may amend this Order on its own motion or in accordance with the procedure described in section 210.76 of the Commission's Rules of Practice and Procedure (19 C.F.R. § 210.76).

XI. Bonding

The conduct prohibited by Section III of this Order may be continued during the sixty-day period in which this Order is under review by the United States Trade Representative, as delegated by the President (70 FR 43251 (July 21, 2005)), subject to the Respondent's posting of a bond in the amount of one hundred (100) percent of the entered value of infringing finished motorized vehicles and ten (10) percent of the entered value of any components thereof. This bond provision does not apply to conduct that is otherwise permitted by section IV of this Order.

Covered products imported on or after the date of issuance of this Order are subject to the entry bond set forth in the exclusion order issued by the Commission, and are not subject to this bond provision.

The bond is to be posted in accordance with the procedures established by the Commission for the posting of bonds by complainant in connection with the issuance of temporary exclusion orders. (*See* 19 C.F.R. § 210.68). The bond and any accompanying documentation are to be provided to and approved by the Commission prior to the commencement of conduct that is otherwise prohibited by Section III of this Order. Upon the Secretary's acceptance of the bond, (a) the Secretary will serve an acceptance letter on all parties, and (b) Respondent must serve a copy of the bond and any accompanying documentation on Complainant's counsel.²

The bond is to be forfeited in the event that the United States Trade Representative approves this Order (or does not disapprove it within the review period), unless (i) the U.S. Court of Appeals for the Federal Circuit, in a final judgment, reverses any Commission final determination and order as to Respondent on appeal, or (ii) Respondent exports or destroys the products subject to this bond and provides certification to that effect that is satisfactory to the Commission.

The bond is to be released in the event (i) the United States Trade Representative disapproves this Order and no subsequent order is issued by the Commission and approved (or not disapproved) by the United States Trade Representative, (ii) the U.S. Court of Appeals for the Federal Circuit, in a final judgment, reverses any Commission final determination and order as to Respondent on appeal, or (iii) Respondent exports or destroys the products subject to this

² *See* note 1 above.

bond and provides certification to that effect that is satisfactory to the Commission, upon service on Respondent of an order issued by the Commission based upon application therefore made by Respondent to the Commission.

By order of the Commission.

A handwritten signature in black ink, appearing to read 'Lisa R. Barton', written in a cursive style.

Lisa R. Barton
Secretary to the Commission

Issued: December 22, 2020

EXHIBIT 1





PUBLIC CERTIFICATE OF SERVICE

I, Lisa R. Barton, hereby certify that the attached **ORDER, COMMISSION** has been served via EDIS upon the Commission Investigative Attorney, **Vu Bui, Esq.** and the following parties as indicated, on **December 23, 2020**.



Lisa R. Barton, Secretary
U.S. International Trade Commission
500 E Street, SW, Room 112
Washington, DC 20436

**On Behalf of Requester Mahindra & Mahindra Ltd. and
Mahindra Automotive North America, Inc.:**

R. David Hosp, Esq.
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On Behalf of Respondent FCA US LLC:

Frank C. Cimino, Esq.
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Washington, DC 20001
Email: FCCimino@venable.com

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**UNITED STATES INTERNATIONAL TRADE COMMISSION
Washington, D.C.**

In the Matter of

**CERTAIN MOTORIZED VEHICLES
AND COMPONENTS THEREOF**

**Investigation No. 337-TA-1132
(Modification)**

MODIFIED CEASE AND DESIST ORDER

IT IS HEREBY ORDERED THAT RESPONDENT Mahindra & Mahindra Ltd. cease and desist from conducting any of the following activities in the United States: importing, selling, marketing, advertising, distributing, transferring (except for exportation), soliciting U.S. agents or distributors for, and aiding or abetting other entities in the importation, sale for importation, sale after importation, transfer (except for exportation), or distribution of motorized vehicles, kits and assemblies for motorized vehicles, and replacement and aftermarket components for motorized vehicles that infringe the Jeep Trade Dress or any trade dress confusingly similar thereto or that are otherwise misleading as to source, origin, or sponsorship, in violation of section 337 of the Tariff Act of 1930, as amended (19 U.S.C. § 1337). Thereafter, the Commission conducted a modification proceeding to adjudicate Respondents' Post-2020 ROXOR vehicle and determined that it does not infringe the Jeep Trade Dress and is outside the scope of this Order. The Commission therefore modifies this Order to include an exemption with respect to Respondents' Post-2020 ROXOR vehicle.

**I.
Definitions**

As used in this Order:

- (A) "Commission" shall mean the United States International Trade Commission.
- (B) "Complainant" shall mean FCA US LLC, 1000 Chrysler Drive, Auburn Hills, MI

48321.

(C) “Respondent” shall mean Mahindra & Mahindra Ltd., Mahindra Towers, Dr. G.M. Bhosle Marg, P.K. Kurne Chowk, Worli, Mumbai 400018, India.

(D) “Person” shall mean an individual, or any non-governmental partnership, firm, association, corporation, or other legal or business entity other than Respondent or its majority owned or controlled subsidiaries, successors, or assigns.

(E) “United States” shall mean the fifty States, the District of Columbia, and Puerto Rico.

(F) The terms “import” and “importation” refer to importation for entry for consumption under the Customs laws of the United States.

(G) The term “Jeep Trade Dress” shall mean the following: “the overall exterior appearance and styling of the [Jeep CJ and Jeep Wrangler] vehicle design,” including:

- (i) A boxy body shape with flat appearing vertical side and rear body panels ending at about the same height as the hood;
- (ii) Substantially flat hood with curved side edges that tapers to be narrower at the front;
- (iii) Trapezoidal front wheel wells with front fenders or fender flares that extend beyond the front of the grille;
- (iv) Flat appearing grille with vertical elongated grille slots and a trapezoidal outline that curves around round headlamps positioned on the upper part of the grille;
- (v) Exterior hood latches; and
- (vi) Door cutouts above a bottom portion of the side body panels.

Images of the Jeep CJ and Jeep Wrangler vehicles that feature the Jeep Trade Dress are attached as Exhibit 1.

(H) The term “covered products” shall mean motorized vehicles, kits and assemblies

for motorized vehicles, and replacement and aftermarket components for motorized vehicles that infringe the Jeep Trade Dress or any trade dress confusingly similar thereto or that are otherwise misleading as to source, origin, or sponsorship. The term “covered products” does not include Respondent’s Post-2020 ROXOR vehicle, which, as the Commission determined in this modification proceeding, does not infringe the Jeep Trade Dress.

II. Applicability

The provisions of this Cease and Desist Order shall apply to Respondent and to any of its principals, stockholders, officers, directors, employees, agents, distributors, controlled (whether by stock ownership or otherwise) and majority-owned business entities, successors, and assigns, and to each of them insofar as they are engaging in conduct prohibited by section III, *infra*, for, with, or otherwise on behalf of, Respondent.

III. Conduct Prohibited

The following conduct of Respondent in the United States is prohibited by this Order. Until the Jeep Trade Dress has been abandoned or rendered invalid or unenforceable, Respondent shall not:

- (A) import or sell for importation into the United States covered products;
- (B) market, distribute, sell, or otherwise transfer (except for exportation), in the United States imported covered products;
- (C) advertise imported covered products;
- (D) solicit U.S. agents or distributors for imported covered products; or
- (E) aid or abet other entities in the importation, sale for importation, sale after importation, transfer, or distribution of covered products.

IV. Conduct Permitted

Notwithstanding any other provision of this Order, Respondent shall be permitted:

(A) to engage in specific conduct otherwise prohibited by the terms of this Order if, in a written instrument, the owner of the Jeep Trade Dress licenses or authorizes such specific conduct; or

(B) to import, sell for importation, advertise, market, distribute, sell, or otherwise transfer in the United States components for use in servicing or repairing covered products that were imported prior to the effective date of this Order.

V. Reporting

For purposes of this requirement, the reporting periods shall commence on January 1 of each year and shall end on the subsequent December 31. The first report required under this section shall cover the period from the date of issuance of this Order through December 31, 2020. This reporting requirement shall continue in force until such time as Respondent has truthfully reported, in two consecutive timely filed reports, that it has no inventory of covered products in the United States.

Within thirty (30) days of the last day of the reporting period, Respondent shall report to the Commission: (a) the quantity in units and the value in dollars of covered products that it has (i) imported and/or (ii) sold in the United States after importation during the reporting period, and (b) the quantity in units and value in dollars of reported covered products that remain in inventory in the United States at the end of the reporting period.

When filing written submissions, Respondent must file the original document electronically on or before the deadlines stated above and submit eight (8) true paper copies to

the Office of the Secretary by noon the next day pursuant to section 210.4(f) of the Commission's Rules of Practice and Procedure (19 C.F.R. § 210.4(f)). Submissions should refer to the investigation number ("Inv. No. 337-TA-1132") in a prominent place on the cover pages and/or the first page. (*See Handbook on Filing Procedures*, https://www.usitc.gov/documents/handbook_on_filing_procedures.pdf). Persons with questions regarding filing should contact the Office of the Secretary (202-205-2000). If Respondent desires to submit a document to the Commission in confidence, it must file the original and a public version of the original with the Office of the Secretary and must serve a copy of the confidential version on Complainant's counsel.¹

Any failure to make the required report or the filing of any false or inaccurate report shall constitute a violation of this Order, and the submission of a false or inaccurate report may be referred to the U.S. Department of Justice as a possible criminal violation of 18 U.S.C. § 1001.

VI. Recordkeeping and Inspection

(A) For the purpose of securing compliance with this Order, Respondent shall retain any and all records relating to the sale, offer for sale, marketing, or distribution in the United States of covered products, made and received in the usual and ordinary course of business, whether in detail or in summary form, for a period of three (3) years from the close of the fiscal year to which they pertain.

(B) For the purposes of determining or securing compliance with this Order and for no other purpose, subject to any privilege recognized by the federal courts of the United States,

¹ Complainant must file a letter with the Secretary identifying the attorney to receive reports associated with this Order. The designated attorney must be on the protective order entered in the investigation.

and upon reasonable written notice by the Commission or its staff, duly authorized representatives of the Commission shall be permitted access and the right to inspect and copy, in Respondent's principal office during office hours, and in the presence of counsel or other representatives if Respondent so chooses, all books, ledgers, accounts, correspondence, memoranda, and other records and documents, in detail and in summary form, that must be retained under subparagraph VI(A) of this Order.

**VII.
Service of Cease and Desist Order**

Respondent is ordered and directed to:

(A) Serve, within fifteen days after the effective date of this Order, a copy of this Order upon each of its respective officers, directors, managing agents, agents, and employees who have any responsibility for the importation, marketing, distribution, or sale of imported covered products in the United States;

(B) Serve, within fifteen days after the succession of any persons referred to in subparagraph VII(A) of this Order, a copy of this Order upon each successor; and

(C) Maintain such records as will show the name, title, and address of each person upon whom the Order has been served, as described in subparagraphs VII(A) and VII(B) of this Order, together with the date on which service was made.

The obligations set forth in subparagraphs VII(B) and VII(C) shall remain in effect until the Jeep Trade Dress has been abandoned or rendered invalid or unenforceable.

**VIII.
Confidentiality**

Any request for confidential treatment of information obtained by the Commission pursuant to sections V or VI of this Order should be made in accordance with section 201.6 of

the Commission's Rules of Practice and Procedure (19 C.F.R. § 201.6). For all reports for which confidential treatment is sought, Respondent must provide a public version of such report with confidential information redacted.

IX. Enforcement

Violation of this Order may result in any of the actions specified in section 210.75 of the Commission's Rules of Practice and Procedure (19 C.F.R. § 210.75), including an action for civil penalties under section 337(f) of the Tariff Act of 1930 (19 U.S.C. § 1337(f)), as well as any other action that the Commission deems appropriate. In determining whether Respondent is in violation of this Order, the Commission may infer facts adverse to Respondent if it fails to provide adequate or timely information.

X. Modification

The Commission may amend this Order on its own motion or in accordance with the procedure described in section 210.76 of the Commission's Rules of Practice and Procedure (19 C.F.R. § 210.76).

XI. Bonding

The conduct prohibited by Section III of this Order may be continued during the sixty-day period in which this Order is under review by the United States Trade Representative, as delegated by the President (70 FR 43251 (July 21, 2005)), subject to the Respondent's posting of a bond in the amount of one hundred (100) percent of the entered value of infringing finished motorized vehicles and ten (10) percent of the entered value of any components thereof. This bond provision does not apply to conduct that is otherwise permitted by section IV of this Order. Covered products imported on or after the date of issuance of this Order are subject to the entry

bond set forth in the exclusion order issued by the Commission, and are not subject to this bond provision.

The bond is to be posted in accordance with the procedures established by the Commission for the posting of bonds by complainant in connection with the issuance of temporary exclusion orders. (*See* 19 C.F.R. § 210.68). The bond and any accompanying documentation are to be provided to and approved by the Commission prior to the commencement of conduct that is otherwise prohibited by Section III of this Order. Upon the Secretary's acceptance of the bond, (a) the Secretary will serve an acceptance letter on all parties, and (b) Respondent must serve a copy of the bond and any accompanying documentation on Complainant's counsel.²

The bond is to be forfeited in the event that the United States Trade Representative approves this Order (or does not disapprove it within the review period), unless (i) the U.S. Court of Appeals for the Federal Circuit, in a final judgment, reverses any Commission final determination and order as to Respondent on appeal, or (ii) Respondent exports or destroys the products subject to this bond and provides certification to that effect that is satisfactory to the Commission.

The bond is to be released in the event (i) the United States Trade Representative disapproves this Order and no subsequent order is issued by the Commission and approved (or not disapproved) by the United States Trade Representative, (ii) the U.S. Court of Appeals for the Federal Circuit, in a final judgment, reverses any Commission final determination and order as to Respondent on appeal, or (iii) Respondent exports or destroys the products subject to this bond and provides certification to that effect that is satisfactory to the Commission, upon service

² *See* note 1 above.

on Respondent of an order issued by the Commission based upon application therefore made by
Respondent to the Commission.

By order of the Commission.

A handwritten signature in black ink, appearing to read 'Lisa R. Barton', with a stylized flourish at the end.

Lisa R. Barton
Secretary to the Commission

Issued: December 22, 2020

EXHIBIT 1





PUBLIC CERTIFICATE OF SERVICE

I, Lisa R. Barton, hereby certify that the attached **ORDER, COMMISSION** has been served via EDIS upon the Commission Investigative Attorney, **Vu Bui, Esq.** and the following parties as indicated, on **December 23, 2020**.



Lisa R. Barton, Secretary
U.S. International Trade Commission
500 E Street, SW, Room 112
Washington, DC 20436

**On Behalf of Requester Mahindra & Mahindra Ltd. and
Mahindra Automotive North America, Inc.:**

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- Via Hand Delivery
- Via Express Delivery
- Via First Class Mail
- Other: Email Notification
of Availability for Download

On Behalf of Respondent FCA US LLC:

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- Via Hand Delivery
- Via Express Delivery
- Via First Class Mail
- Other: Email Notification
of Availability for Download

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UNITED STATES INTERNATIONAL TRADE COMMISSION

Washington, D.C.

In the Matter of

**CERTAIN MOTORIZED VEHICLES
AND COMPONENTS THEREOF**

**Inv. No. 337-TA-1132
(Modification)**

COMMISSION OPINION

On June 11, 2020, the Commission issued a final determination finding a violation of section 337 of the Tariff Act of 1930, as amended (19 U.S.C. § 1337) (“section 337”), based on the infringement of complainant’s asserted trade dress by the named respondents’ ROXOR vehicle (2018-2019 model). *See* 85 Fed. Reg. 36613-14 (June 17, 2020). The Commission issued a limited exclusion order (“LEO”) barring entry of infringing vehicles and components thereof and cease and desist orders (“CDOs”) against both respondents. *See id.* Respondents did not seek adjudication of its proposed redesigned vehicles before the ALJ, and therefore the Commission declined to adjudicate them. The Commission required the respondents to obtain a ruling (via an advisory opinion or a modification proceeding) from the Commission prior to the importation of any redesigned vehicle or component thereof.

On July 20, 2020, the Commission determined to institute a modification proceeding under 19 U.S.C. § 1337(k) and 19 C.F.R. § 210.76 to adjudicate trade dress infringement with respect to respondents’ redesigned vehicle for post-2020 model years (“the Post-2020 ROXOR”). *See* 85 Fed. Reg. 44923-24 (July 24, 2020). The Commission delegated the proceeding to an administrative law judge (“ALJ”) to hold a hearing and issue a recommended determination (“RD”). *Id.* On October 20, 2020, the presiding ALJ issued an RD finding no trade dress infringement by respondents’ Post-2020 ROXOR vehicle.

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Having considered the RD, complainant's comments, responses thereto, and the record in this proceeding as well as the underlying investigation, the Commission has determined to adopt with modification the RD's findings as to non-infringement by respondents' Post-2020 ROXOR vehicle. All other findings in the RD that are consistent with this opinion are also adopted. Accordingly, the Commission has determined to modify the remedial orders to include an explicit carve-out for respondents' Post-2020 ROXOR vehicle.

I. BACKGROUND

A. Procedural Background

The Commission instituted this investigation on September 13, 2018, based on a complaint, as amended, filed by FCA US LLC of Auburn Hills, Michigan ("Complainant" or "FCA"). *See* 83 Fed. Reg. 46517 (Sept. 13, 2018). The complaint, as amended,¹ alleged violations of section 337 based upon the importation into the United States, the sale for importation, and the sale within the United States after importation of certain motorized vehicles and components thereof by reason of: (1) infringement of U.S. Trademark Registration Nos. 2,862,487; 2,161,779; 2,794,553; 4,043,984; and 4,272,873 (collectively, "the Asserted Trademarks"); (2) trade dress infringement; and (3) dilution of the asserted trade dress and trademarks. *See id.* The notice of investigation named Mahindra & Mahindra Ltd. of Mumbai, India and Mahindra Automotive North America, Inc. ("MANA") of Auburn Hills, Michigan (collectively, "Respondents" or "Mahindra") as respondents in this investigation. *See id.* The Office of Unfair Import Investigations was also a party to this investigation. *See id.*

On November 8, 2019, the ALJ issued a final initial determination ("FID") finding a violation of section 337. Specifically, the FID determined that Respondents' ROXOR vehicle

¹ FCA filed an amended complaint on November 19, 2018 ("Am. Compl.").

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(2018-2019 model) infringes Complainant's asserted trade dress but not its Asserted Trademarks. The FID also determined that Complainant did not establish dilution of the asserted trade dress and trademarks.

On June 11, 2020, the Commission determined to affirm the FID's determination of a violation of section 337. *See* 85 Fed. Reg. 36613-14 (June 17, 2020). The Commission issued an LEO barring entry of articles that infringe the asserted trade dress and a CDO against both Respondents. In addition, the Commission set a bond during the period of Presidential review in the amount of ten (10) percent of the entered value of unassembled ROXOR components and one hundred (100) percent of the entered value of finished ROXOR vehicles. As Respondents had not requested adjudication of their proposed redesigned vehicles before the ALJ, the Commission declined to adjudicate them. The Commission required Respondents to obtain a ruling (via an advisory opinion or a modification proceeding) from the Commission prior to any importation of redesigned vehicles or components thereof.

On June 18, 2020, Respondents filed a petition for an expedited modification proceeding. On July 20, 2020, the Commission determined to institute a modification proceeding under 19 U.S.C. § 1337(k) and 19 C.F.R. § 210.76 to adjudicate trade dress infringement with respect to Respondents' Post-2020 ROXOR vehicle. *See* 85 Fed. Reg. 44923-24 (July 24, 2020). The Commission delegated the proceeding to a Commission ALJ to hold a hearing and issue an RD. *Id.* On October 20, 2020, the ALJ issued his RD finding no trade dress infringement by Respondents' Post-2020 ROXOR vehicle.

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On October 30, 2020, Complainant filed comments on the RD requesting that the Commission decline to adopt the RD's findings.² Complainant faults the RD for failing to find likelihood of confusion with respect to Respondents' Post-2020 ROXOR vehicle. Specifically, Complainant contends that the RD erred in: (1) failing to apply the "safe distance rule"; (2) dissecting and analyzing the Jeep Trade Dress in component parts rather than assessing the overall impression of the trade dress as a whole; (3) finding both parties' surveys reliable and failing to analyze which of the parties' control vehicle was proper; (4) failing to give any weight to the strength or fame of the Jeep Trade Dress; and (5) discounting Complainant's evidence of intent, while crediting Respondents' evidence of intent. *See* Complainant's Br. at 3-5, 40.

On November 6, 2020, Respondents and the Commission's Investigative Attorney ("IA") filed responses in opposition to Complainant's comments.³

B. FCA's Asserted Trade Dress

The asserted trade dress (hereinafter "the Jeep Trade Dress") includes:

- (i) A boxy body shape with flat appearing vertical side and rear body panels ending at about the same height as the hood;
- (ii) Substantially flat hood with curved side edges that tapers to be narrower at the front;
- (iii) Trapezoidal front wheel wells with front fenders or fender flares that extend beyond the front of the grille;
- (iv) Flat appearing grille with vertical elongated grille slots and a trapezoidal outline that curves around round headlamps positioned on the upper part of the grille;
- (v) Exterior hood latches; and

² *See* Complainant FCA US LLC's Comments on Recommended Determination (Oct. 30, 2020) (hereinafter, "Complainant's Br.").

³ *See* Requesters' Response to FCA US LLC's Comments to Recommended Determination (Nov. 6, 2020) (hereinafter, "Respondents' Resp."); Response of the Office of Unfair Import Investigations to Complainant FCA US LLC's Comments on Recommended Determination (Nov. 6, 2020) (hereinafter, "IA's Resp.").

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- (vi) Door cutouts above a bottom portion of the side body panels.

See RD at 6-7. For example, the following vehicles are representative of the Jeep Trade Dress.



See *id.* at 7; Am. Compl. at ¶ 43.

C. Mahindra’s Post-2020 ROXOR Vehicle

The product at issue in this modification proceeding is the Post-2020 model of Respondents’ ROXOR Utility Terrain Vehicle (“UTV”). See RD at 7-9.



II. LEGAL STANDARDS

A. Modification Proceeding

The Commission determined to institute a modification proceeding under 19 U.S.C.

§ 1337(k) and 19 C.F.R. § 210.76. Section 337(k) provides that:

- (1) Except as provided in subsections (f) and (j), any exclusion from entry or order under this section shall continue in effect until the Commission finds, and in the case of exclusion

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from entry notifies the Secretary of the Treasury, that the conditions which led to such exclusion from entry or order no longer exist.

- (2) If any person who has previously been found by the Commission to be in violation of this section petitions the Commission for a determination that the petitioner is no longer in violation of this section or for a modification or rescission of an exclusion from entry or order under subsection (d), (e), (f), (g), or (i)—
 - (A) the burden of proof in any proceeding before the Commission regarding such petition shall be on the petitioner; and
 - (B) relief may be granted by the Commission with respect to such petition—(i) on the basis of new evidence or evidence that could not have been presented at the prior proceeding, or (ii) on grounds which would permit relief from a judgment or order under the Federal Rules of Civil Procedure.

19 U.S.C. § 1337(k); *see also* 19 C.F.R. § 210.76.

Commission Rule 210.76 provides that “[t]he Commission may delegate any hearing under this section to the chief administrative law judge for designation of a presiding administrative law judge, who shall certify a recommended determination to the Commission.”

19 C.F.R. § 210.76(b).

The ALJ’s findings in a recommended determination do not become the findings of the Commission unless they are adopted by the Commission. The Commission reviews such findings *de novo*. *See Certain Access Control Systems and Components Thereof*, Inv. No. 337-TA-1016 (Modification), Comm’n Op. at 10-11 (Oct. 1, 2019) (when considering whether to adopt a recommended determination in a modification proceeding, the Commission retains “all the powers it would have in making [an] initial decision.”); 5 U.S.C. § 557(b).

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B. Trade Dress Infringement

To establish infringement of a trademark under the Lanham Act, the party with the burden of proof must show that “(1) it has a valid and legally protectable mark; (2) it owns the mark; and (3) [Respondents’] use of the mark to identify goods or services causes a likelihood of confusion.” *Converse, Inc. v. Int’l Trade Comm’n*, 909 F.3d 1110, 1116 (Fed. Cir. 2018) (citation omitted). Similarly, “to form the basis for an action under the Lanham Act, a trade dress must satisfy three criteria: 1) it must be distinctive; 2) it must be nonfunctional; and 3) there must be a likelihood that it will be confused with the accused product.” *See Aromatique, Inc. v. Gold Seal, Inc.*, 28 F.3d 863, 868 (8th Cir. 1994) (citing *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763 (1992)).

There is no dispute in this proceeding (in view of the Commission’s final determination of June 11, 2020) that the asserted Jeep Trade Dress is distinctive and nonfunctional. As to likelihood of confusion, the following factors (“the *DuPont* factors”) can be considered when supported by evidence in the record:

- (1) The similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression;
- (2) The similarity or dissimilarity and nature of the goods or services as described in an application or registration or in connection with which a prior mark is in use;
- (3) The similarity or dissimilarity of established, likely-to-continue trade channels;
- (4) The conditions under which and buyers to whom sales are made, *i.e.* “impulse” vs. careful, sophisticated purchasing;
- (5) The fame of the prior mark (sales, advertising, length of use);
- (6) The number and nature of similar marks in use on similar goods;

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- (7) The nature and extent of any actual confusion;
- (8) The length of time during and conditions under which there has been concurrent use without evidence of actual confusion;
- (9) The variety of goods on which a mark is or is not used (house mark, “family” mark, product mark);
- (10) The market interface between applicant and the owner of a prior mark . . .;
- (11) The extent to which applicant has a right to exclude others from use of its mark on its goods;
- (12) The extent of potential confusion, *i.e.*, whether de minimis or substantial; and
- (13) Any other established fact probative of the effect of use.

Swagway, LLC v. Int’l Trade Comm’n, 934 F.3d 1332, 1338-39 (Fed. Cir. 2019) (citing *In re E.I.*

DuPont DeNemours & Co., 476 F.2d 1357, 1361 (C.C.P.A. 1973)).⁴

III. DISCUSSION

The RD finds that Respondents’ Post-2020 ROXOR vehicle is not confusingly similar to and thus does not infringe the Jeep Trade Dress. *See* RD at 12-27. The RD finds that “[o]n balance, even considering those *DuPont* factors unchanged from the FID, and giving particular weight to the notable and obvious dissimilarity between the Post-2020 ROXOR and the Jeep Trade Dress, Mahindra has shown that there is no likelihood of consumer confusion.” *See id.* at 28. Specifically, the RD reasons that most *DuPont* factors are unchanged, and thus carry the same weight in this modification proceeding, and that only factors 1, 7, 8, 12, and 13 need to be reevaluated. *See id.* at 12. As to factors 1 (similarity of the marks), 7 (actual confusion), and 13 (other facts, *e.g.*, intent), the RD finds that they weigh against likelihood of confusion. *See*

⁴ As noted in the Commission’s opinion on violation, the FID considered the intent of the alleged infringer under the *DuPont* factor 13 (any other established fact probative of the effect of use). *See* Comm’n Op. at 11 n.12 (citing FID at 15); *see also Swagway*, 934 F.3d. at 1339.

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id. at 13-25. As to factors 8 (length of concurrent use) and 12 (potential confusion), the RD finds them irrelevant because “[t]he Post-2020 ROXOR is not yet on the market.” *See id.* at 25.

As a threshold matter, Complainants dispute the framework of the RD’s analysis by arguing that the RD erred in failing to apply the “safe distance rule.” With respect to the *DuPont* test applied by the RD, Complainant does not dispute the RD’s findings as to *DuPont* factors 8 and 12. Instead, Complainant alleges with respect to factors 1, 5, 7, and 13, that the RD erred in: (1) dissecting and analyzing the Jeep Trade Dress in component parts rather than assessing the overall impression of the trade dress as a whole, and in the “context of the marketplace” (factor 1); (2) failing to give any weight to the strength or fame of the Jeep Trade Dress (factor 5); (3) finding both parties’ surveys reliable and failing to analyze which of the parties’ control vehicle was proper (factor 7); and (4) discounting Complainant’s evidence while crediting Respondents’ evidence on the issue of intent (factor 13).

As discussed below, the Commission adopts with modification the RD’s finding of no likelihood of confusion and therefore no infringement by Respondents’ Post-2020 ROXOR vehicle. The Commission finds that the RD reasonably declined to apply the “safe distance rule” in this proceeding. In addition, while the Commission specifically discusses those *DuPont* factors that are challenged by Complainant, the Commission also considers the evidence as to all other *DuPont* factors and finds that on balance, they weigh against a finding of likelihood of confusion. More specifically, the Commission affirms or finds that factor 1 (similarity of the marks), factor 4 (conditions under which sales are made), factor 7 (actual confusion), and factor 13 (other established fact probative of the effect of use, *e.g.*, intent) weigh against a finding of likelihood of confusion,⁵ while factor 2 (similarity and nature of the products), factor 3

⁵ *See infra*; see also *Certain Motorized Vehicles & Components Thereof*, Inv. No. 337-TA-1132,

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(similarity of established, likely-to-continue trade channels), factor 5 (fame or strength of the trade dress), factor 6 (number and nature of similar marks in use on similar goods), factor 9 (variety of goods on which the mark is used), factor 10 (market interface between applicant and the owner of a prior mark), and factor 11 (extent to which applicant has a right to exclude others from use of its mark on its goods) weigh in favor of likelihood of confusion. As to factor 8 (length of time when there has been concurrent use without evidence of actual confusion) and factor 12 (extent of potential confusion), the Commission finds, as the RD does, that they are neutral with respect to likelihood of confusion. See RD at 25. Importantly, as the Federal Circuit found in *Converse*, “[i]n the context of trade-dress infringement, . . . accused products that are not substantially similar cannot infringe.” See *Converse*, 909 F.3d at 1124 (citing *Versa Prods. Co. v. Bifold Co. (Mfg.)*, 50 F.3d 189, 202 (3d Cir. 1995)). As explained below, the Commission adopts the RD’s finding that Respondents’ Post-2020 ROXOR vehicle is not substantially similar with respect to Complainant’s asserted trade dress.

A. Safe Distance Rule

Complainant argues that the RD should have applied the so-called “safe distance rule” in adjudicating infringement with respect to Respondents’ Post-2020 ROXOR vehicle. See Complainant’s Br. at 51-56 (citing, *inter alia*, *Certain Plastic Food Storage Containers*, Inv. No. 337-TA-152, Comm’n Action & Order, 0084 WL 951885, *7-9 (July 13, 1984); *Certain Cube Puzzles*, Inv. No. 337-TA-112, Comm’n Action & Order, 1982 WL 974906, *11 n.88 (Dec. 30, 1982)). Complainant cites a couple of Commission decisions in which the Commission referred to the so-called “safe distance rule,” which is a principle recited in federal court cases related to

Comm’n Op., 2020 WL 3428211, *13 (June 18, 2020); *Certain Motorized Vehicles & Components Thereof*, Inv. No. 337-TA-1132, Final Initial Determination, 2019 WL 7288994, *23-30 (Nov. 8, 2019).

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crafting injunctive relief. In one of the cited Commission decisions, the Commission explained this principle as follows: “[a] general principle of trademark law is that a party that has engaged in unfair competition should be required to keep a safe distance away from the margin line and avoid all likelihood of confusion.” *Certain Cube Puzzles*, 1982 WL 974906, at *11 n.88.⁶

Complainants rely heavily on the Commission’s decision in *Certain Plastic Food Storage Containers*, which stated that “[h]aving crossed over the line dividing fair from unfair competition, respondents may now be ordered to keep a safe distance from it.” 0084 WL 951885, at *8. That statement was made in the context of discussing proposed remedial relief in response to the respondent’s suggestion that any LEO and CDO should be limited to the specific uses of the marks found to be infringing, and not all uses of complainant’s marks. *See id.* While the Commission did not limit the LEO and CDOs to the specific uses found to infringe, it explained that adjudication of potentially infringing redesigns was a question for subsequent proceedings before the Commission (like the modification at issue here). *See id.* at *9. There is nothing in *Certain Plastic Food Storage Containers* that changes the test for determining infringement, including for purposes of a modification proceeding.

In this proceeding, the Commission did not direct the ALJ to apply the “safe distance rule” in determining whether the Post-2020 ROXOR infringes the Jeep Trade Dress, and he reasonably declined to do so. *See* RD at 10 (“[T]he Commission ordered a determination of infringement in general, not of compliance with the ‘safe distance’ rule.”). Under the Commission’s practice and precedent, petitioners bear the burden to establish non-infringement

⁶ In those Commission investigations where the “safe distance” rule was invoked, it was in the context of the final disposition of the investigations rather than post-order proceedings. *See Certain Plastic Food Storage Containers*, 0084 WL 951885, at *8; *Certain Cube Puzzles*, 1982 WL 974906, at *11 n.88.

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in a modification proceeding, and the test for infringement itself is not altered by the “safe distance rule.” First, the “safe distance rule” is an equitable principle that allows courts “to craft permanent injunctions tailored to the needs of each case.” *See, e.g., Innovation Ventures, LLC v. N2G Distributing, Inc.*, 763 F.3d 524, 544-45 (6th Cir. 2014); *see also Certain Plastic Food Storage Containers*, 0084 WL 951885, at *8 (considering safe distance rule in determining the scope of an effective remedy for the violation found). Second, the Commission’s discussion of the safe distance rule in those investigations cited by Complainant did not alter the test for infringement or likelihood of confusion in any way. *See Certain Plastic Food Storage Containers*, 0084 WL 951885, at *8; *Certain Cube Puzzles*, 1982 WL 974906, at *11 n.88; *accord* Respondents’ Resp. at 40; IA’s Resp. at 18.

Thus, the Commission finds that the RD reasonably declined to apply the “safe distance” rule in this modification proceeding.

B. Likelihood of Confusion

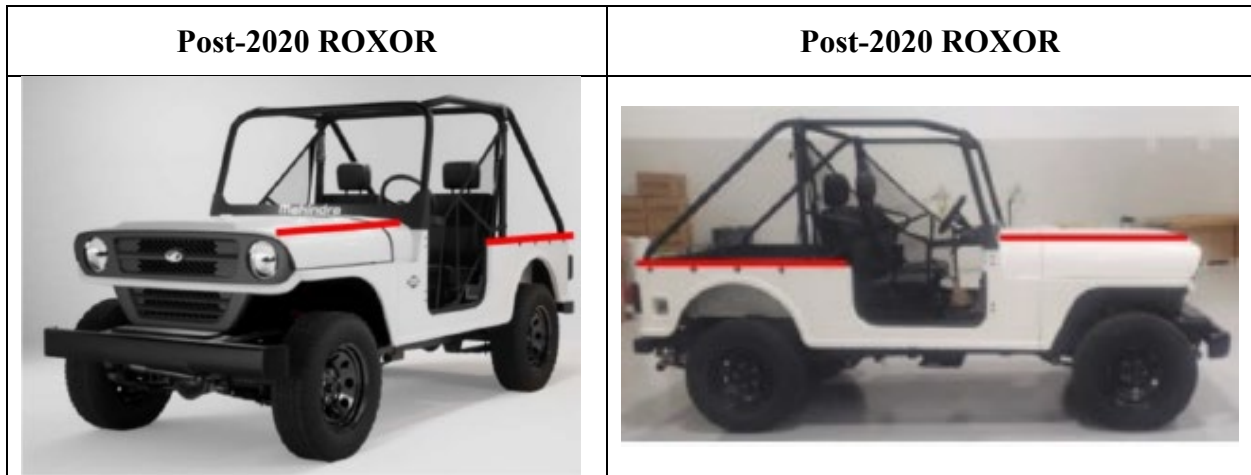
1. Factor 1: Similarity of the Marks

The RD first analyzes the six elements of the Jeep Trade Dress (*see supra* section III(B)) and finds that:

- Element 1 (a boxy body shape with flat appearing vertical side and rear body panels ending at about the same height as the hood) is not missing from the Post-2020 ROXOR vehicle. *See* RD at 15. The RD explains that “a change of only ‘about an inch’ in height between the vertical side and rear body panels and the hood does not result in any appreciable difference.” *See id.*; *see also id.* at 14 (“Mr. John Pacella, Mahindra’s head of design, explained

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that Mahindra raised the hood line “up about an inch” in the Post-2020 ROXOR vehicle.”)
(citing RX-5001C, Pacella⁷ WS at Q/A 45; RDX-5000.7 (reproduced below)).

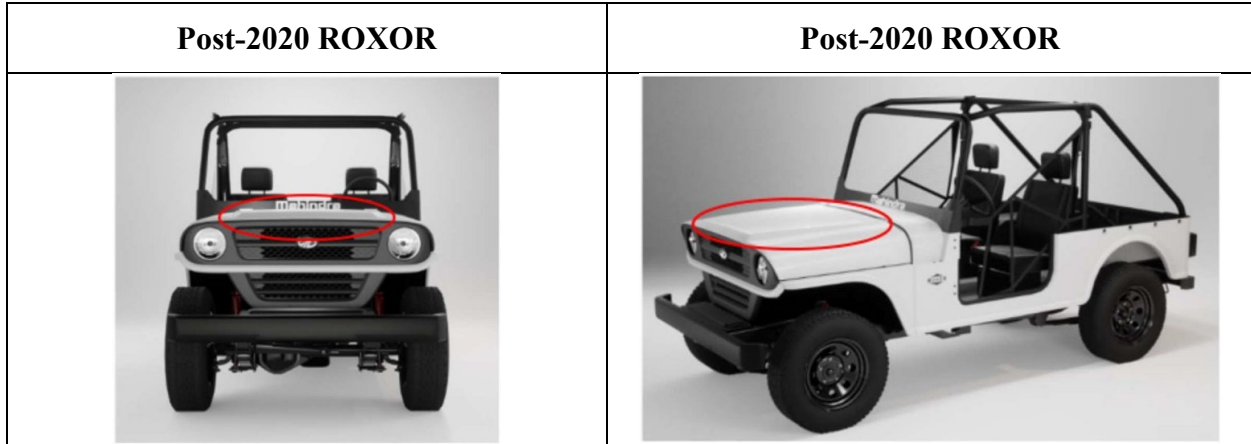


- Element 2 (substantially flat hood with curved side edges that tapers to be narrower at the front) is substantially different from the Post-2020 ROXOR vehicle. *See* RD at 15-16. The RD explains that “[t]he Post-2020 ROXOR hood does not have ‘side edges that taper to be narrower in front’” and “while the difference is small, the hood does have a ‘decorative step-up’ that also differentiates the hood from the Jeep Trade Dress hood, which requires a ‘substantially flat’ hood.” *See id.* at 16 (citing RX-5000C, Haas⁸ WS at Q/A 41; RDX-5001.9 (reproduced below)).

⁷ John Pacella is Head of Studio and Preprogram Engineering at Mahindra North American Technical Center.

⁸ Richard Haas is MANA’s CEO.

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- Element 3 (trapezoidal front wheel wells with front fenders or fender flares that extend beyond the front of the grille) is substantially different from the Post-2020 ROXOR vehicle. *See* RD at 16-17. The RD explains that “[t]he rounded front wheel well and lack of front fenders that extend beyond the front of the grill[e] of the Post-2020 ROXOR are substantially different from element 3 of the Jeep Trade Dress.” *See id.* at 17 (citing RX-5000C, Haas WS at Q/As 42-43; RX-5001C, Pacella WS at Q/As 48-49; RDX-5000.11 (reproduced below)).



- Element 4 (flat appearing grille with vertical elongated grille slots and a trapezoidal outline that curves around round headlamps positioned on the upper part of the grille) is “strikingly dissimilar” to the Post-2020 ROXOR vehicle. *See* RD at 17-18. The RD explains that the Post-2020 ROXOR does not have a “flat appearing grille,” “vertical elongated grille

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slots,” and “a trapezoidal outline that curves around headlamps positioned on the upper part of the grille.” *See id.* at 18 (citing RX-5000C, Haas WS at Q/A 47; RX-5001C, Pacella WS at Q/A 50; RDX-5001.11 (reproduced below)).



- Element 5 (exterior hood latches) is missing from the Post-2020 ROXOR vehicle. *See RD* at 18-19. The RD explains that “[i]t is undisputed that Mahindra removed the exterior hood latches from the Post-2020 ROXOR, which further shifts the Post-2020 ROXOR design away from the Jeep Trade Dress.” *See id.*

- Element 6 (Door cutouts above a bottom portion of the side body panels) is “still part of the Post-2020 ROXOR” as Respondents admit. *See RD* at 19.

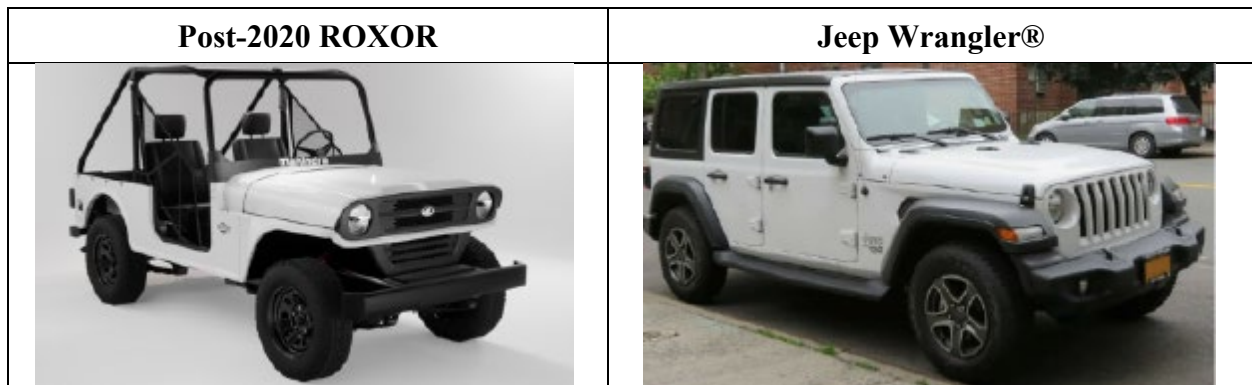
Second, the RD considers overall appearance of the Post-2020 ROXOR vehicle and concludes that “[t]he evidence illustrates so many differences between the [vehicle] and the Jeep Trade Dress that the overall appearance of the Post-2020 ROXOR is not substantially similar to the Jeep Trade Dress.” *See RD* at 19. The RD notes that “there are a few elements of the Post-2020 ROXOR that are similar to the Jeep Trade Dress, such as the door cutouts and flat side

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panels” but that “the overall appearance, even considering these elements, is not substantially similar to the Jeep Trade Dress.” *See id.*

Complainant argues that the RD improperly “focus[ed] on an element-by-element comparison of the written description of the Jeep Trade Dress elements to component parts of the Post-2020 ROXOR” instead of the “overall commercial impression.” *See Complainant’s Br.* at 23. We disagree. Rather, the RD properly analyzed each element of the Jeep Trade Dress as well as the overall appearance of the ROXOR vehicle. Complainant defined the Jeep Trade Dress using the six elements, and it is not improper for the RD to determine whether those elements are present in the Post-2020 ROXOR vehicle. In fact, Complainant itself argued before the Commission that third-party vehicles did not include all six elements of the Jeep Trade Dress. *See Motorized Vehicles, Comm’n Op.*, 2020 WL 3428211, *7 & n.18.

Importantly, the RD’s analysis was not limited to an element-by-element review of the Post-2020 ROXOR vehicle. Rather, as discussed above, the RD also considered the overall appearance of the Post-2020 ROXOR vehicle and concluded that it is not substantially similar to the Jeep Trade Dress. *See RD* at 19 (“The average purchaser certainly will know immediately that this vehicle is not a Jeep by merely looking at it straight on.”); *see also* RX-5000C, Haas WS at Q/A 49 (comparing the overall looks of the Post-2020 ROXOR and the Jeep Wrangler) (citing RDX-5000.16 (reproduced below)); *accord* Respondents’ Resp. at 9-10; IA’s Resp. at 10-11.



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The RD's analysis is also consistent with findings of the presiding ALJ and the Commission opinions in *Certain Footwear Products*, Inv. No. 337-TA-936, Remand Comm'n Op., 2020 WL 5942000, *7 (Sept. 24, 2020) (“[T]he Commission has determined to affirm and adopt the [Remand] ID’s finding that New Balance’s accused PF Flyers shoes are not substantially similar to the CMT and, therefore, do not infringe the CMT, regardless of whether Converse had rights in the mark in 2003. . . . In particular, the [Remand] ID found that the midsole designs of the accused PF Flyers shoes lack two elements of the CMT.”).

Complainant also faults the RD for failing to consider “the overall appearance of the Post-2020 Roxor and the Jeep Trade Dress . . . in the context of Mahindra’s competitive market, not in a vacuum.” *See* Complainant’s Br. at 35 (*Service Ideas, Inc. v. Traex Corp.*, 846 F.2d 1118, 1124 (7th Cir. 1988)). Complainant argues that the Post-2020 Roxor design is closer in appearance to the Jeep Trade Dress relative to the designs of other UTVs in the competitive market. *See id.* (citing CX-5087C:0003). The Commission finds that the relative similarity or dissimilarity of the Post-2020 ROXOR to other UTVs is not dispositive. What controls here is the similarity *vel non* of the Post-2020 ROXOR to the Jeep Trade Dress. Notably, the RD performed an analysis of the vehicles in generally the same manner as the FID, to which the Complainant did not make this objection.

The record also includes additional evidence supporting the RD’s conclusion. In particular, as Respondents argue, “unsolicited press and social media evidence show how consumers perceive the Post-2020 ROXOR, and virtually all of it recognized that the Post-2020 ROXOR is starkly different from earlier models and the Jeep Trade Dress.” *See* Respondents’

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Resp. at 22 (citing RX-5004C, Steckel⁹ WS at Q/As 49-58). Lastly, the Post-2020 ROXOR vehicle prominently displays the “Mahindra” brand name which is “highly probative” (although not dispositive) of likelihood of confusion. See Respondents’ Resp. at 11 n.10 (citing *Converse*, 909 F.3d 1124); RDX-5000.6.

Thus, the Commission finds that the RD correctly analyzes *DuPont* factor 1 and the Commission has determined to adopt the RD’s findings as to this factor with the expanded analysis discussed above.¹⁰

2. Factor 5: Fame of the Jeep Trade Dress

Complainant also faults the FID for failing to consider the strength and fame of the Jeep Trade Dress. See Complainant’s Br. at 28-31. Complainant argues that “[d]espite the FID’s finding that the strength and fame of the Jeep Trade Dress weighs in favor of confusion under *DuPont* factor 5, the Recommended Determination paid it no deference in both its similarity analysis and in its final weighing of the *DuPont* factors.” See *id.* at 28. FCA’s challenge is inconsistent with the RD’s findings. Rather, the RD states that *DuPont* factor 5 was unchanged from the FID, *i.e.*, that the “fame [of the Jeep Trade Dress] weighs in favor of a likelihood of confusion.” See FID at 46; RD at 12. The RD weighs all the *DuPont* factors, those that are unchanged as well as those that have changed with the new Post-2020 ROXOR design, and finds that “[o]n balance, even considering those *DuPont* factors unchanged from the FID, and giving particular weight to the notable and obvious dissimilarity between the Post-2020 ROXOR and

⁹ Prof. Joel H. Steckel was Respondents’ expert in this modification proceeding.

¹⁰ As discussed above, this factor alone is dispositive and supports the RD’s conclusion that the Post-2020 ROXOR vehicle does not infringe the Jeep Trade Dress. See *Converse*, 909 F.3d at 1124 (“In the context of trade-dress infringement, we also hold that accused products that are not substantially similar cannot infringe.”) (citing *Versa Prods. Co. v. Bifold Co. (Mfg.)*, 50 F.3d 189, 202 (3d Cir. 1995)).

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the Jeep Trade Dress, Mahindra has shown that there is no likelihood of consumer confusion.”
See RD at 28.

Thus, the Commission finds that the RD properly considers *DuPont* factor 5.
Accordingly, the Commission has determined to adopt the RD’s findings as discussed above.

3. Factor 7: Actual Confusion

The RD credits both parties’ surveys and finds them both reliable. *See* RD at 20-24.
The RD notes that the parties’ surveys use different controls (reproduced below, *see* RD at 21, 23) but that both “follow[] the Commission’s edict to remove allegedly confusing elements of the Post-2020 ROXOR while keeping constant as many other elements as possible.” *See id.* at 24 (citing *Motorized Vehicles*, Comm’n Op. at 26, 2020 WL 3428211, at *14); CX-5027, Poret¹¹ WS at Q/As 106-07; RX-5002, Van Liere¹² WS at Q/As 63-66. The RD also notes that Complainant’s survey shows a 19 percent net confusion rate while Respondents’ survey resulted in a zero percent net confusion rate. *See id.* at 22, 24 (citing CX-5027, Poret WS at Q/A 113); *see also* RX-5002, Van Liere WS at Q/As 77, 90. The RD, however, concludes that “the overall survey results weigh against a finding of likelihood of confusion.” *See* RD at 24-25.

Complainant’s Control	Respondents’ Control	Test Vehicle
		

¹¹ Mr. Hal Poret was Complainant’s expert in this modification proceeding.

¹² Mr. Kent Van Liere was Respondents’ expert in this modification proceeding.

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Complainant’s Control	Respondents’ Control	Test Vehicle
		

Complainant argues that Respondents’ survey controls are “defective” because they “encompass features too close to the trade dress elements to perform the critical function of a control.” *See* Complainant’s Br. at 11-14. The Commission agrees with Complainant. As Dr. Poret explained, the purpose of the control Group is to “measure the survey ‘noise’ level or ‘false positive’ level—i.e., any tendency of survey respondents to connect the UTV to Jeep for reasons that cannot be attributed to the similarity of the trade dress at issue.” CX-5027, Poret WS at Q/A 23. Dr. Poret’s control “altered only the elements that allegedly fall within the Jeep Trade Dress and retains all other elements, including an overall box-like look and door cutouts.” *See id.* at Q/A 110.

The Commission finds that the controls used by Respondents’ expert, Mr. Van Liere, are flawed because they include substantial portions of the Jeep Trade Dress elements and have “only very minimal changes” compared to the test vehicles. *See Spangler Candy Co. v. Tootsie Roll Indus., LLC*, 372 F. Supp. 3d 588, 598 (N.D. Ohio 2019) (“In designing a survey-experiment, the expert should select a stimulus for the control group that shares as many characteristics with the experimental stimulus as possible, with the key exception of the characteristic whose influence is being assessed.”) (quoting Shari S. Diamond, Reference Guide on Survey Research, in Federal Judicial Center, Reference Manual on Scientific Evidence 359, 401 (3d ed. 2011)); *see id.* (“There is a fine line between finding a control which is similar

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enough to provide accurate results as to likelihood of confusion but not too similar so as to cause confusion itself.”) (citing Jacob Jacoby, Ph.D., *Experimental Design and the Selection of Controls in Trademark and Deceptive Advertising Surveys*, 92 *Trademark Rep.* 890, 931 (July-Aug. 2002)). For example, Respondents’ survey controls do not sufficiently remove the first element of the Jeep Trade Dress, *i.e.*, a boxy body shape with flat appearing vertical side and rear body panels ending at about the same height as the hood. As discussed above, the RD finds (and we agree) that this element is not missing from the Post-2020 ROXOR vehicle. *See supra* section III(B)(1).

Although, Dr. Poret’s survey evidence is more reliable and credible than Mr. Van Liere’s survey evidence and his survey control is more appropriate, the Commission finds that a 19 percent net confusion rate is not significant enough to support likelihood of confusion, particularly in view of the RD and the Commission’s findings as to *DuPont* factor 1 that the Post-2020 ROXOR is not substantially similar to the Jeep Trade Dress. *See* 6 J. Thomas McCarthy, *McCarthy on Trademarks & Unfair Competition* § 32:188 (5th ed. 2020) (“[S]urvey confusion numbers that go below 20% need to be carefully viewed against the background of other evidence weighing for and against a conclusion of likely confusion.”); *accord* Respondents’ Resp. at 25-26. Furthermore, as discussed above, the unsolicited press and social media evidence suggests little evidence of actual confusion between the Post-2020 ROXOR and the Jeep Trade Dress. *See supra* section III(B)(1); *see also* Respondents’ Resp. at 22 (citing RX-5004C, Steckel WS at Q/As 49-58).

Thus, the Commission has determined to adopt with modification the RD’s findings, as discussed above, to clarify that, although Dr. Poret’s survey evidence is more reliable and

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credible than Mr. Van Liere's survey evidence, this factor does not weigh in favor of likelihood of confusion.

4. Factor 13: Other Facts (E.G., Intent)

The RD finds that “the evidence demonstrates that in designing the Post-2020 ROXOR Mahindra did not intend to continue to benefit from infringing the Jeep Trade Dress, and this *DuPont* factor weighs against a likelihood of confusion.” *See* RD at 25-27. The RD credits testimony by Mr. Haas that “Mahindra’s goals were to make the Post-2020 ROXOR design a significant departure from earlier designs, to give the vehicle a new and distinctive look, to make the look more rugged, and to eliminate any question of a possible relationship between Mahindra and FCA.” *See id.* at 26 (citing RX-5000C, Haas WS at Q/A 32; JX-5002C, Haas Tr. at 54:1-11). The RD also credits testimony by Mr. Pacella confirming that “Mr. Haas instructed him to make the design a significant departure from the past and to avoid the Asserted Jeep Trade Dress.” *See id.* (citing RX 5001C, Pacella WS at Q/A29; JX-5003C, Pacella Tr. at 117:22:118:9).

Complainant argues that the RD erred in “crediting the self-serving testimony of Mahindra’s witnesses, and ignoring significant evidence that Mahindra’s intent in evolving the look of the ROXOR was to maintain the brand equity that it obtained by trading on the reputation of the Jeep brand.” *See* Complainant’s Br. at 40-41. Complainant contends that “[a] review of the various iterations of the Roxor vehicle make clear that the Post-2020 Roxor is the result of incremental changes in each prior model while retaining a similar overall impression.” *See id.* at 42.

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The Commission finds that the RD correctly weighs the evidence, and its conclusion is consistent with the finding that the Post-2020 ROXOR vehicle is not substantially similar to the Jeep Trade Dress. *See also* Respondents' Resp. at 35; IA's Resp. at 13.

Complainant also suggests bad intent on the part of Respondents because they "attempt[ed] to ramp up infringing sales." *See id.* at 47-48. But Complainant itself recognizes that infringing articles are entitled to entry under section 337(j)(3) during the Presidential review period under the bond amount determined by the Commission. *See id.* at 47 (citing RD at 27).

Thus, the Commission finds that the RD correctly analyzes *DuPont* factor 13 and the Commission has determined to adopt the RD's findings as to this factor.

IV. CONCLUSION

For the foregoing reasons, the Commission has determined to adopt with modification, as discussed above, the RD's findings as to non-infringement. Accordingly, the Commission finds that Respondents' redesigned Post-2020 ROXOR vehicle does not infringe the Jeep Trade Dress and is not subject to the LEO and CDOs issued in the underlying investigation. The Commission has concurrently issued an order modifying the LEO and CDOs, as well as modified remedial orders.

By order of the Commission.



Lisa R. Barton
Secretary to the Commission

Issued: January 4, 2021

PUBLIC CERTIFICATE OF SERVICE

I, Lisa R. Barton, hereby certify that the attached **COMMISSION OPINION** has been served via EDIS upon the Commission Investigative Attorney, **Vu Bui, Esq.** and the following parties as indicated, on **January 4, 2021**.



Lisa R. Barton, Secretary
U.S. International Trade Commission
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UNITED STATES INTERNATIONAL TRADE COMMISSION
Washington, D.C.

In the Matter of

**CERTAIN MOTORIZED VEHICLES
AND COMPONENTS THEREOF**

**Inv. No. 337-TA-1132
(Modification Proceeding)**

RECOMMENDED DETERMINATION
Administrative Law Judge Cameron Elliot

(October 20, 2020)

Pursuant to the Commission Notice determining to institute this proceeding “to adjudicate infringement with respect to Respondents’ Post-2020 ROXOR vehicle,” 85 Fed. Reg. 44923 (July 24, 2020), this is my Recommended Determination in the matter of *Certain Motorized Vehicles And Components Thereof*, Investigation No. 337-TA-1132 (Modification Proceeding).

TABLE OF ABBREVIATIONS

Am. Comp.	Amended Complaint
Comm'n Op.	Commission Opinion (Doc. ID 712507)(June 11, 2020)
FID	Final Initial Determination on Violation of Section 337 and Recommended Determination on Remedy & Bond (Doc. ID 693831)(Nov. 8, 2019)
CDX	FCA's Demonstrative Exhibit
FIB	FCA's Opening Brief (Modification Proceeding)
FRB	FCA's Reply Brief (Modification Proceeding)
CX	FCA's Exhibit
Dep. Tr.	Deposition Transcript
Hr'g Tr.	Hearing Transcript – Violation Proceeding
JX	Joint Exhibit
RDX	Mahindra's Demonstrative Exhibit
MIB	Mahindra's Opening Brief (Modification Proceeding)
MRB	Mahindra's Reply Brief (Modification Proceeding)
RX	Mahindra's Exhibit
SIB	Staff's Opening Brief (Modification Proceeding)
SRB	Staff's Reply Brief (Modification Proceeding)
WS	Witness Statement



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I. BACKGROUND

On September 13, 2018, the Commission instituted the underlying investigation based on a complaint, as amended, filed by FCA US LLC (“Complainant” or “FCA”). 83 Fed. Reg. 46517 (September 13, 2018). After conducting an evidentiary hearing on August 19-23, 2019, I issued a final initial determination (“FID”) on November 8, 2019, finding, among other things, that Respondents’ ROXOR vehicle (i.e., 2018-2019 ROXOR vehicle) infringes FCA’s asserted trade dress. FID, Conclusions of Law. Respondents are Mahindra & Mahindra Ltd. and Mahindra Automotive North America, Inc. (collectively, “Respondents” or “Mahindra”). On January 22, 2020, the Commission issued a notice determining to review the FID in part, and specifically to review:

(1) the FID’s findings with respect to validity, infringement, and importation in connection with Complainant’s claim of infringement of the asserted trade dress; and

(2) the FID’s findings with respect to infringement and domestic industry in connection with Complainant’s claim of infringement of the asserted registered trademarks.

85 Fed. Reg. 5035 (January 28, 2020).

On June 11, 2020, the Commission issued a notice affirming with modification the FID’s determination of a violation of section 337. 85 Fed. Reg. 36613 (June 17, 2020). The Commission further determined that the appropriate remedy is issuance of (i) a limited exclusion order against Respondents’ articles that infringe Complainant’s trade dress; and (ii) cease and desist orders against both Respondents. *Id.*

In the accompanying Commission Opinion (“Comm’n Op.”), however, the Commission declined to adjudicate whether Respondents’ redesigned vehicles (i.e., 2020 ROXOR vehicle and Post-2020 ROXOR vehicle) infringe the Jeep Trade Dress and required Respondents to obtain a

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ruling (via an advisory opinion or a modification proceeding) from the Commission prior to any importation of redesigned vehicles or components thereof. Comm'n Op., pp. 35-37. On June 18, 2020, Respondents filed a petition for an expedited modification proceeding as to the 2020 ROXOR vehicle and the Post-2020 ROXOR vehicle. Respondents' Petition for Expedited Modification Proceeding ("RPM"). In their petition, Respondents also requested that, to the extent that the Commission determines that the 2020 ROXOR vehicle presents a question requiring more time for review, the Commission institute a modification proceeding only as to the Post-2020 ROXOR vehicle. RPM, pp. 4-5. On June 29, 2020, Complainant filed a Response in Opposition to Respondents' Petition for Modification Proceeding ("CORPM"). On July 20, 2020, the Commission issued a notice determining to institute the present Modification Proceeding "to adjudicate infringement with respect to Respondents' Post-2020 ROXOR vehicle." 85 Fed. Reg. 44923 (July 24, 2020). In its notice, the Commission stated: "The Commission has also determined to delegate the modification proceeding to the Chief ALJ to designate a presiding ALJ to make all necessary factual and legal findings and to issue a recommended determination as to whether the Commission shall modify the remedial orders to explicitly exempt Respondents' Post-2020 ROXOR vehicle." *Id.* The Chief ALJ designated me as presiding ALJ, and on July 23, 2020 I issued Order No. 41, setting a one-day hearing for September 16, 2020, and requiring the parties to submit a proposed procedural schedule by July 28, 2020. Order No. 41 (July 23, 2020), p. 1. On July 28, 2020, the parties submitted a Joint Proposed Procedural Schedule for Modification Proceeding and requested to forego the evidentiary hearing and to submit the matter for resolution based on the written briefing and evidence of record, including witness statements and deposition transcripts. Parties' Joint Proposed Procedural Schedule for Modification Proceeding (July 28, 2020). On July 29, 2020, Order No. 42 issued, adopting the Parties' Joint Proposed Procedural

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Schedule and canceling the one-day evidentiary hearing. Order No. 42 (July 29, 2020), p. 1. The parties submitted opening briefs on September 23, 2020 (FCA “FIB” and Mahindra “MIB”) and September 25, 2020 (Staff “SIB”). All parties submitted reply briefs on September 30, 2020 (“FRB,” “MRB,” and “SRB,” respectively).

II. DISCUSSION

The Commission’s Rules provide that:

Whenever any person believes that changed conditions of fact or law, or the public interest, require that an exclusion order, cease and desist order, or consent order be modified or set aside, in whole or in part, such person may request, pursuant to section 337(k)(1) of the Tariff Act of 1930, that the Commission make a determination that the conditions which led to the issuance of an exclusion order, cease and desist order, or consent order no longer exist. The Commission may also on its own initiative consider such action.

19 C.F.R. § 210.76(a)(1). The Commission may then institute, and delegate to an administrative law judge, a proceeding to modify or rescind the exclusion order, cease and desist order, or consent order. 19 C.F.R. § 210.76(b). The decision of the administrative law judge shall be in the form of a recommended determination. *Id.* Accordingly, pursuant to the Commission Notice determining to institute this Modification Proceeding “to adjudicate infringement with respect to Respondents’ Post-2020 ROXOR vehicle,” 85 Fed. Reg. 44923 (July 24, 2020), the following is my Recommended Determination.

A. The Trade Dress At Issue

The Commission found that the Jeep Trade Dress includes:

- (i) A boxy body shape with flat appearing vertical side and rear body panels ending at about the same height as the hood;
- (ii) Substantially flat hood with curved side edges that tapers to be narrower at the front;
- (iii) Trapezoidal front wheel wells with front fenders or fender flares that extend beyond the front of the grille;

- (iv) Flat appearing grille with vertical elongated grille slots and a trapezoidal outline that curves around round headlamps positioned on the upper part of the grille;
- (v) Exterior hood latches; and
- (vi) Door cutouts above a bottom portion of the side body panels.

Comm’n Op., p. 5 (the “Jeep Trade Dress”). The Amended Complaint, the Final ID, and the Commission’s Limited Exclusion Order also describe the Jeep Trade Dress as consisting of “the overall exterior appearance and styling of the [Jeep CJ and Jeep Wrangler] vehicle design” including the six elements listed above. *See* Am. Comp., ¶42; FID, p. 5; LEO, p. 1.

The Commission further found that “[f]or example, the following vehicles are representative of the Jeep Trade Dress,” which are reproduced below.



Comm’n Op., pp. 5-6 (citing FID, p. 6 and Am. Comp., ¶43).

B. The Product at Issue: The Post-2020 ROXOR

This proceeding solely concerns the adjudication of whether the Post-2020 ROXOR infringes the Jeep Trade Dress. *See* Modification Proceeding Notice at 2. FCA, however, also analyzed the 2020 ROXOR. *See, e.g.,* FIB, pp. 5-6, 26-28. FCA’s expert also conducted surveys



using the 2020 ROXOR to measure the likelihood of confusion between that vehicle and the Jeep Trade Dress. *See* FIB, pp. 29-34.

The Post-2020 ROXOR has not been manufactured yet. However, the evidence includes testimony from Mr. Richard Haas, CEO of Mahindra Automotive North America (“MANA”), that (i) MANA has settled on a final design for the Post-2020 ROXOR vehicle; and (ii) there are no further exterior design changes. Haas WS, Q/A 69. Moreover, the parties appear to agree that the Post-2020 ROXOR is a “fixed design” and no longer hypothetical. Representative images of the Post-2020 ROXOR vehicle are shown below.



RX-5109



RX-5110



RX-5247

III. NON-INFRINGEMENT OF THE JEEP TRADE DRESS

A. Legal Standards

FCA asserts that as Petitioner, Mahindra bears the burden of proving that its activity is no longer in violation of Section 337, and that in order to meet this burden as an adjudicated infringer, Mahindra must show that the Post-2020 ROXOR stays a “safe distance” away from the Jeep Trade Dress. FIB, p. 8. FCA asserts that under the safe distance rule, Mahindra “ha[s] an ongoing duty to select a trade dress which would avoid all possibility of confusion.” *Id.*, p. n. 18 (citing *Service Ideas, Inc. v. Traex Corp.*, 846 F.2d 1118, 1124 (7th Cir. 1988)). FCA further asserts that the Post-2020 ROXOR fails to stay a safe distance from the Jeep Trade Dress. *Id.*, p. 11.

The “safe distance” rule is inapplicable here. First, in the Notice of Commission Determination to Institute Modification Proceeding, the Commission stated: “The Commission has determined to institute a modification proceeding under 19 U.S.C. 1337(k) and 19 CFR 210.76 to adjudicate infringement with respect to Respondents’ Post-2020 ROXOR vehicle.” 85 Fed. Reg. 44923. That is, the Commission ordered a determination of infringement in general, not of compliance with the “safe distance” rule, which it could have done “particularly when Complainant argued for the ‘safe distance rule’ initially in its briefing on remedy and subsequently in its briefing on the petition for modification before the Commission.” SIB, p. 38. Second, the discussions of safe distance in the two ITC cases cited by FCA – *Certain Plastic Food Storage Containers*, No. 337-TA-152, Commission Action and Order, 0084 WL 951885, at *8-9 (July 13, 1984), and *In Re Certain Cube Puzzles*, 4 ITRD 2102 at *11 n.88 (U.S. I.T.C. 1982) – appear to be dicta. Lastly, the idea of safe distance is not a rule so much as a policy consideration, because neither the two cited ITC cases, nor any other authority cited by FCA, establish a clear standard for what constitutes a safe distance.

Therefore, as directed by the Commission, this Modification Proceeding will determine if

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there is a likelihood of consumer confusion as to origin, sponsorship, or approval due to similarity between the asserted Jeep Trade Dress and Mahindra’s Post-2020 ROXOR, by evaluating the relevant factors enumerated in *In re E.I. DuPont DeNemours & Co.*, 476 F.2d 1357 (C.C.P.A. 1973) (“the *Dupont* factors”). The *Dupont* factors are:

- (1) The similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression;
- (2) The similarity or dissimilarity and nature of the goods or services as described in an application or registration or in connection with which a prior mark is in use;
- (3) The similarity or dissimilarity of established, likely-to-continue trade channels;
- (4) The conditions under which and buyers to whom sales are made, i.e. “impulse” vs. careful, sophisticated purchasing;
- (5) The fame of the prior mark (sales, advertising, length of use);
- (6) The number and nature of similar marks in use on similar goods;
- (7) The nature and extent of any actual confusion;
- (8) The length of time during and conditions under which there has been concurrent use without evidence of actual confusion;
- (9) The variety of goods on which a mark is or is not used (house mark, “family” mark, product mark);
- (10) The market interface between applicant and the owner of a prior mark;
- (11) The extent to which applicant has a right to exclude others from use of its mark;
- (12) The extent of potential confusion, i.e., whether *de minimis* or substantial; and
- (13) Any other established fact probative of the effect of use.

Dupont, 476 F.2d at 1361; *see* Comm’n. Op., p. 11.

The Commission “need not consider every *DuPont* factor,” depending on the relevance to a particular case. *Swagway, LLC v. Int’l Trade Comm’n*, 934 F.3d 1332, 1339 (Fed. Cir. 2019). The first *DuPont* factor, pertaining to the similarity of the marks, would normally be expected to

[REDACTED]

be especially significant. *See Certain Strip Lights*, Inv. No. 337-TA-287, Initial Determination, 1989 WL 608725, at *9 (June 27, 1989); 3 *McCarthy on Trademarks and Unfair Competition* § 23:2.1 (4th ed. 2006). Nonetheless, although “accused [trade dress] that [is] not substantially similar cannot infringe,” the Commission recently held that “[n]o single factor is dispositive.” *Converse Inc. v. Int’l Trade Comm’n*, 909 F.3d 1110, 1124 (Fed. Cir. 2018); *In the Matter of Certain Footwear Products*, Inv. No. 337-TA-936 (Remand), Comm’n Op. at 57 (Sept. 24, 2020) (“*Certain Footwear Products*”).

The parties agree that not all of the above factors need to be considered because certain circumstances have not changed since the original FID issued, although they disagree on what those factors are. FCA believes factors 1, 7, 8, 12, and 13 should be evaluated (FIB, p. 17), Mahindra believes factors 1, 2, 3, 6, 7, and 13 should be evaluated (MI, p. 30), and the Staff believes factors 1, 12, and 13 should be evaluated (SIB, p. 25). Factor 2 considers the products and nature of the goods; while Mahindra raises the possibility that its market has shifted to the agricultural and fleet markets, the evidence shows that the Post-2020 ROXOR will be heavily marketed in the recreational off-road market, which is the same as the original ROXOR vehicle. *See CX-5054:004*. Factor 3 compares the similarity of trade channels between the products; there is no evidence that this has changed significantly for the Post-2020 ROXOR. Factor 6 compares the number and nature of the marks; there is no evidence that the Jeep Trade Dress has changed. Therefore, only factors 1, 7, 8, 12, and 13 are relevant.



B. Infringement

Applying the *DuPont* factors, the record evidence shows the Post-2020 ROXOR vehicle is not confusingly similar to the Jeep Trade Dress, and therefore does not infringe.

1. Dupont Factor 1: The Similarity of the Marks in Their Entirety

From a simple visual inspection, there are many dissimilarities between the Post-2020 ROXOR vehicle and Jeep brand vehicles displaying the Jeep Trade Dress, as shown in the images below.



Jeep® CJ	Post-2020 ROXOR
	

Mahindra asserts that it redesigned its Post-2020 ROXOR in order to eliminate or change almost all of the six elements that FCA claims as part of the Jeep Trade Dress. Below is a list of elements that make up the Jeep Trade Dress that Mahindra annotated by marking out in red the

elements it alleges no longer are present in the Post-2020 ROXOR.

1. a boxy body shape with flat appearing vertical sides and rear body panels ~~ending at about the same height as the hood;~~
2. ~~substantially flat hood~~ with curved side edges ~~that tapers to be narrower at the front;~~
3. ~~trapezoidal front wheel wells with front fenders or fender flares that extend beyond the front of the grille;~~
4. ~~flat appearing grille with vertical elongated grille slots and trapezoidal outline that curves around round headlamps positioned on the upper part of the grille;~~
5. ~~exterior hood latches; and~~
6. door cutouts above a bottom portion of the side body panels.

MIB, p. 29. These specific elements of the Jeep Trade dress are discussed below:

Element 1 - A boxy body shape with flat appearing vertical side and rear body panels ending at about the same height as the hood:

Mahindra presented testimony from Mr. Haas, who explained that Mahindra decided to raise the hood line in the Post-2020 ROXOR vehicle so that the “flat appearing vertical side and rear body panels no longer end at about the same height as the hood,” and the front end looks “more aggressive.” Haas WS, Q/A 36. Mr. John Pacella, Mahindra’s head of design, explained that Mahindra raised the hood line “up about an inch” in the Post-2020 ROXOR vehicle. Pacella WS, Q/A 45. Demonstrative Exhibit RDX-5000.7C illustrates this:



RDX-5000.7C

A review of the images of the Jeep CJ that feature the Jeep Trade Dress, shown above, reveals that a change of only “about an inch” in height between the vertical side and rear body panels and the hood does not result in any “appreciable difference.” *Certain Footwear Products*, Comm’n Op., p. 22. And, absent any appreciable difference resulting from Mahindra’s raising the hood line in the Post-2020 ROXOR vehicle, Mahindra has not shown that Element 1 of the Jeep Trade Dress is missing from the Post-2020 ROXOR vehicle.

Element 2 - Substantially flat hood with curved side edges that tapers to be narrower at the front:

Mr. Haas testified that the new hood in the Post-2020 ROXOR vehicle, “does not taper at all” because “the new hood remains the same width, and the lack of taper is further emphasized by the absence of fender flares, such that you can see the side edges of the hood continue down to form the top half of the elongated oval grille” Haas WS, Q/A 41. Mr. Haas further testified that the hood is no longer “substantially flat” because there is a “decorative step-up” running down the center of the hood.” *Id.* Mr. Haas prepared demonstrative RDX-5000.19C, shown below, that contains images of the new hood in the Post-2020 ROXOR vehicle:



RDX-5001.9C





The Post-2020 ROXOR hood does not have “side edges that taper to be narrower in front.” In fact, the Post-2020 ROXOR hood is the same width from the windshield to the front of the vehicle. The shape of the hood, therefore, is different from the Jeep Trade Dress and alters the look of the Post-2020 ROXOR. In addition, while the difference is small, the hood does have a “decorative step-up” that also differentiates the hood from the Jeep Trade Dress hood, which requires a “substantially flat” hood. Thus, element 2 of the Post-2020 ROXOR is substantially different from the second element of the Jeep Trade Dress.

Element 3 – Trapezoidal front wheel wells with front fenders or fender flares that extend beyond the front of the grille:

Mr. Haas and Mr. Pacella testified that the Post-2020 ROXOR vehicle does not have (i) trapezoidal front wheel wells or front flares; or (ii) front fenders that extend beyond the front of the grill. Haas WS, Q/A 42-43; Pacella WS, Q/A 48-49. Moreover, FCA’s designated corporate witness and Head of Design for the Jeep brand, Mark Allen, admitted that the Post-2020 ROXOR vehicle does not have either fender flares or fenders extending beyond the grille front. JX5005C (Allen), 22:20-23:1, 23:18-22. Below is the demonstrative exhibit, RDX-5000.11C, which highlights the front wheel well of the Post-2020 ROXOR:



RDX-5000.11C.

FCA argues that the wheel well actually is a trapezoid, and points to a miniscule area at the front of the wheel well to illustrate the point:



FRB, pp. 15-16.

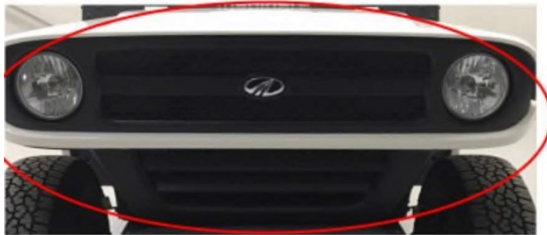
However, the figure clearly illustrates that the wheel well is rounded inside the annotated trapezoid (shown as a blue line). Moreover, the very small “down turned wheel trim” is just that – very small. The overall impression certainly is not a “trapezoidal front wheel well with fender flares that extend beyond the front of the grill.” The rounded front wheel well and lack of front fenders that extend beyond the front of the grill of the Post-2020 ROXOR are substantially different from element 3 of the Jeep Trade Dress.

Element 4 – Flat appearing grille with vertical elongated grille slots and a trapezoidal outline that curves around round headlamps positioned on the upper part of the grille:

Element 4 represents the most drastic change to the Post-2020 ROXOR, and difference between it and the Jeep Trade Dress. Mr. Pacella prepared a demonstrative (RDX5001.11C) containing images of the prototype for the Post-2020 ROXOR vehicle that highlights the changes Mahindra made to the grille of its vehicle. Each aspect of Jeep Trade Dress element 4 is missing:



The Post-2020 ROXOR does not have a “flat appearing grille. Instead, the grill juts forward, which is easily discernable.



The Post-2020 ROXOR does not have vertical elongated grille slots.

Also, as shown above, the Post-2020 ROXOR grille does not have a trapezoidal outline that curves around headlamps positioned on the upper part of the grille. Instead, the outline around the headlamps is oval and the headlamps are not positioned on the grille, but instead are located to either side of the grille. Moreover, both Mr. Haas and Mr. Pacella testified that the Post-2020 ROXOR vehicle (i) does not have a flat-appearing grille due to the “forward angle to it” and “oblong trim” that stands out from the background and makes the upper part of the grille look more dimensional; (ii) does not have any vertical design elements in the grille, including any vertical grille slots; and (iii) does not have a grille with a trapezoidal outline due to the oblong trim that appears to float over the bottom part of the grille. *See* Haas WS, Q/A 47; Pacella WS, Q/A 50. The only similarity between the Post-2020 ROXOR and the Jeep Trade Dress is that the headlamps remain round. Overall, the front grille is strikingly dissimilar to element 4 of the Jeep Trade Dress.

Element 5 - Exterior hood latches:

It is undisputed that Mahindra removed the exterior hood latches from the Post-2020

ROXOR, which further shifts the Post-2020 ROXOR design away from the Jeep Trade Dress. *See* FRB at 18.

Element 6 - Door cutouts above a bottom portion of the side body panels:

Mahindra admits that this feature is still part of the Post-2020 ROXOR. *See* MIB, p. 19.


Conclusions of *Dupont* Factor 1

The evidence illustrates so many differences between the Post-2020 ROXOR and the Jeep Trade Dress that the overall appearance of the Post-2020 ROXOR is not substantially similar to the Jeep Trade Dress. The front grille of the Post-2020 ROXOR is drastically different from the Jeep Trade Dress - the vehicle does not have vertical slots at all, the frame around the lights is oval, not trapezoidal, and the front is not flat, but instead juts forward. The average purchaser certainly will know immediately that this vehicle is not a Jeep by merely looking at it straight on. As Mahindra explains, there are other grille-related differences, as well:

Another clear difference is the negative space around the bottom part of the Post-2020 ROXOR grille, exposing the suspension and wheel wells and giving the appearance that the top part of the grille is floating. The front fascia of the Jeep Wrangler and CJ, however, solidly fill the space up against the fenders and all the way down to the bumper. The negative space gives the Post-2020 ROXOR a distinctly different overall look and feel than Jeep vehicles. *See* RX-5087, RX-5109, RX-1030.

MIB, p. 37, n. 10.

To be sure, there are a few elements of the Post-2020 ROXOR that are similar to the Jeep Trade Dress, such as the door cutouts and flat side panels. However, the overall appearance, even considering these elements, is not substantially similar to the Jeep Trade Dress. Additionally, the side view shows that the hood is lacking latches, the front wheel wells are different, and the front fender is different, even viewed from the side. So the degree of similarity is markedly low, and the first *Dupont* factor weighs heavily against a finding of infringement.



2. Dupont Factor 7 – Actual Confusion

The Post-2020 ROXOR has not been sold to date, so there is no evidence of actual confusion. However, both parties submitted evidence of surveys and expert testimony explaining the survey results. FCA’s expert, Mr. Poret, created a test image using publicly available images of the Post-2020 ROXOR and the body of Mahindra’s earlier design of the 2020 ROXOR. “While the test image is not identical to the Post-2020 ROXOR images produced from Mahindra’s files, FCA and Mahindra have agreed that Mr. Poret’s Post-2020 test image is representative of the Post-2020 ROXOR for purposes of Mr. Poret’s survey and opinions.” FIB, pp. 34-35. The test image and control image are shown below:

Test Image



CDX-5032.001, CDX-5033.001



Control Group



CDX-5035.001, CDX-5035.001



Mr. Poret testified that he had the test and control groups review the images as if they were considering purchasing a utility terrain vehicle (“UTV”), and then were asked what company made the vehicle. *See* CX-5027 (Poret), Q/A 106-07. FCA asserts that the control used by Poret comports with the Commission’s earlier finding that the control group was reliable and credible in

[REDACTED]

that it removed the allegedly confusing elements of the Mahindra ROXOR but kept constant as many other elements as possible. FIB, pp. 35-36. Mr. Poret testified that in the control images he maintained as much of the Post-2020 ROXOR as possible and removed only the elements making up the Jeep Trade Dress. *See* CX-5027 (Poret), Q/A 30.

FCA states that after the survey:

Mr. Poret reported that the Test Group had a gross confusion rate of 27%, the control group had a noise rate of 8%, for a net confusion rate of 19%. This means that 27% (54 out of 200) of the *Test Group* identified Jeep in response to at least one of the confusion questions and 8% (12 out of 150) of the *Control Group* identified Jeep in response to any question in the survey. Subtracting out the noise of the Control Group from the Test Group resulted in a net finding of 19% confusion, again beyond the rate deemed to show confusion as noted above. Mr. Poret therefore concluded that “the ROXOR with a modified front end as shown in the revealed image would create a substantial likelihood of confusion with respect to the Jeep Trade Dress.

FIB, p. 33 (citing CX-5027 (Poret), Q/A 113).



Mahindra submitted two survey results conducted by its expert, Dr. Van Liere. Mahindra submits that:

Dr. Van Liere designed his control cells to alter or remove only those claimed trade dress elements that FCA contends still exist on the Post-2020 ROXOR design, thereby changing the overall look of the control vehicle. RX-5002 (Van Liere), Q/A63-66; RPX-5019; *see also* JX-5008C(Poret), 145:2- 146:10 (admitting that if element of trade dress is already missing, there is no need to further alter or remove it in the control cell). Dr. Van Liere’s controls comply with authoritative teachings as to the proper control design. RX-5263 at 210 (“It should share as many characteristics with the experimental stimulus as possible, with the key exception of the characteristic whose influence is being assessed.”).

MIB, pp. 57-58.

Mahindra presented the controls, with explanations of what was changed:



Control in Survey 1	Changes
  RX-5133	<ul style="list-style-type: none">• Rounded the vehicle body shape and opened the side panel to the frame, and changed the hood opening to extend in a diagonal toward the front of the vehicle.• Rounded the hood and squared off the side edges around the headlamps, while maintaining some curvature to ensure the front of the vehicle appears more curved and less boxy from a side view• Added two V-shaped divots to the hood that extend into the grille on either side near the headlamps• Rounded the front wheel wells and minimized the portion of the grille that can be viewed from the side• Dropped the door cut outs so the side body panels extend to the vehicle frame

Dr. Van Liere modified his second survey slightly to account for the minor modifications made to the aesthetic model tested in Survey 1, as shown below. *See MIB, p. 58.*



RX-5133



Each test respondent was shown a head-on and side profile of the vehicle “simultaneously so respondents could get a more complete sense of the overall look of the vehicle and see all

[REDACTED]

claimed trade dress element locations at once.” MIB, p. 60 (citing RX-5002 (Van Liere), Q/A 54; JX-5007C (Van Liere), 103:5-14). The results were that for both Survey 1 and Survey 2, 20% of respondents were confused as to the source of the Post-2020 ROXOR test vehicle and 20% were confused as to the source of the control vehicle. This, according to Mahindra, resulted in a 0% confusion rate. *See* MIB, p. 61.

Both surveys offer “reliable and credible” evidence. Comm’n Op., p. 26. Both survey control groups followed the Commission’s edict to remove allegedly confusing elements of the Post-2020 ROXOR while keeping constant as many other elements as possible. *Id.* Accordingly, at a high level the survey evidence, which is the only available evidence of record related to actual confusion, is non-conclusive.¹

However, while FCA’s expert found a confusion rate of 19%, Mahindra points out that the surveys run by FCA’s expert Hal Poret show that the door cutouts, which are not substantially different from the Jeep Trade Dress, do not drive any purported consumer confusion. *See* CX-5027(Poret), Q/A47; RX-5003 (Van Liere), Q/A12. When comparing the six elements of the Jeep Trade Dress with the Post-2020 ROXOR model, the door cutouts were the only things that remained entirely unchanged on the Post-2020 ROXOR design. Mr. Poret admitted that the presence or absence of this element has a ‘de minimis’ impact on consumer perception of the trade dress. *See* JX-5008C (Poret), 45:21-46:6. In fact, when FCA tested two vehicles where the only change was the removal of this door cutout trade dress element, there was virtually no change in the rate of “Jeep” responses. *See* CX-5027 (Poret), Q/A 47; MIB, pp. 36-37, n. 9. Therefore,

¹ Mahindra’s briefs also contain articles, which were written only days before the parties’ opening briefs were due, related to the Post-2020 ROXOR. FCA moved to strike these exhibits and arguments pertaining to them on September 30, 2020 (Mot. 1132-0046), and represented that the Staff supported the motion. FCA subsequently moved to file a further reply regarding the striking of these exhibits (Mot. 1132-047). The motion to strike (Mot. 1132-046) is granted and the motion to file a reply (Mot. 1132-047) is denied.

although their inconclusiveness reduces their significance, the overall survey results weigh against a finding of likelihood of confusion.

3. Dupont Factor 8: Length of Time of Concurrent Use

The Post-2020 ROXOR is not yet on the market and there is no evidence of concurrent use without actual confusion. As FCA notes, in such circumstances courts treat this factor as a non-factor, with the absence of such evidence having no adverse impact on infringement. *Nina Ricci S.A.R.L. v. E.T.F. Enters., Inc.*, 12 U.S.P.Q.2d (BNA) 1901, 1903 (Fed. Cir. 1989) (absence of actual confusion had no probative value because no accused products had been sold); *Educational Testing Serv. v. Touchstone Applied Science Assoc., Inc.*, 739 F. Supp. 847, 852 (S.D.N.Y. 1990) (this element is “inapplicable” because “the defendant’s product had not yet entered the stream of commerce.”); see FIB, p. 28. In other words, although the lack of actual confusion during a period of concurrent use might normally weigh against a finding of infringement, here it is irrelevant. McCarthy § 23:18 (4th ed. 2006) (“If the junior user’s mark has not yet appeared on the market, the lack of actual confusion evidence is irrelevant.”).

4. Dupont Factor 12 – Potential Confusion

This factor, like factor 8 (concurrent confusion), is hypothetical, because the Post-2020 ROXOR is not on the market yet. To the extent any potential confusion can be ascertained, it is embedded in the factors discussed above.

5. Dupont Factor 13 - Other Facts Probative of the Effect of Use

Mahindra agrees that its intent in the design of the Post-2020 ROXOR should be part of the likelihood of confusion calculus under *Dupont* factor 13. See MIB, pp. 63-67. FCA argues that “there is significant evidence that Mahindra’s intent in evolving the look of the ROXOR and introducing the Post-2020 ROXOR was to maintain the brand equity it obtained by trading on the reputation of the Jeep® brand in the U.S.” FIB p. 38. Specifically, FCA asserts that Mahindra’s

[REDACTED]

design is not a drastic step away from the Jeep Trade Dress, and thus, the intent is to use the good will of Jeep to market its own vehicle. FCA further alleges that Mahindra’s CEO, Mr. Haas, who made the decision to move forward with the Post-2020 ROXOR design, failed to get advice of counsel before moving forward, did no consumer studies, and relied on his own judgment, all indicating an intent to benefit from the Jeep Dress Trade. *Id.*, p. 40.

However, Mr. Haas testified that Mahindra’s goals were to make the Post-2020 ROXOR design a significant departure from earlier designs, to give the vehicle a new and distinctive look, to make the look more rugged, and to eliminate any question of a possible relationship between Mahindra and FCA. RX-5000C(Haas), Q/A 32; JX-5002C(Haas), 54:1-11. Furthermore, Mr. Pacella, Mahindra’s head of design, confirmed that Mr. Haas instructed him to make the design a significant departure from the past and to avoid the Asserted Jeep Trade Dress. RX 5001C (Pacella), Q/A29; JX-5003C (Pacella), 117:22:118:9. The Post-2020 ROXOR’s appearance is not, in fact, substantially the same as the Jeep Trade Dress, and thus, Mr. Haas’ judgement appears to have been correct. Nor was he under any obligation to get advice of counsel. Overall, therefore, his actions do not indicate bad faith.

FCA further argues that Mahindra’s use of the word “evolution” in its marketing was intended to carry over FCA’s goodwill to the Post-2020 ROXOR. *See* FIB, pp. 13, 43. The use of “evolution,” according to FCA, is similar to Jeep’s poster, “The Evolution of an Icon,” which was discussed in the FID and admitted as RX-1019. However, the evidence to which FCA points, CX-5034C, is an advertisement for the 2020 ROXOR design, not the Post-2020 ROXOR, which greatly undercuts the force of the argument.

FCA also asserts that Mahindra’s continued advertising and sale of its inventory of ROXOR vehicles during the Presidential Review Period shows bad faith and an intent to continue

[REDACTED]

to infringe on the Jeep Trade Dress. *See* FIB, pp. 47-51. FCA further points to Mahindra’s sale of spare parts, and assurances to customers that it was not going out of business and would continue to sell service parts. *Id.* These arguments also fail. The Presidential Review Period specifically allows a respondent the ability to continue to import and sell its products. *See Certain Personal Transporters, Components Thereof*, Inv. No. 337-TA-935, Comm’n Op., p. 17 (Apr. 20, 2016) (“Upon the entry of the remedial orders, a respondent may continue to import and sell its products during the sixty (60) day period of Presidential review subject to posting a bond.”). Moreover, the Commission expressly exempted ROXOR replacement and repair parts from its exclusion order. *See* Comm’n Op., p. 4.

Finally, FCA alleges that Mahindra flooded the market with ROXOR vehicles during the Presidential Review Period, and that this also indicates an intent to continue to infringe the Jeep Trade Dress. FIB, p. 51. Again, Mahindra was allowed to sell its ROXOR vehicles during the Presidential Review period. And Mahindra notes that “FCA knows, moreover, that its ‘flood the market’ theory is baseless given Mahindra has only ever sold, on average, approximately [REDACTED] vehicles per month and only a fraction of that during the 60-day PRP.” MRB, p. 30.

Admittedly, the 2020 ROXOR bears a greater similarity in appearance to the Jeep Trade Dress than the Post-2020 ROXOR, and Mr. Poret’s survey evidence suggests some actual confusion involving the 2020 vehicle. *See generally* FIB, pp. 29-34. But even considering this as evidence of an intent to maintain a “continuity” of design, it is outweighed by the evidence showing a lack of such intent. Thus, the evidence demonstrates that in designing the Post-2020 ROXOR Mahindra did not intend to continue to benefit from infringing the Jeep Trade Dress, and this *Dupont* factor weighs against a likelihood of confusion.


[REDACTED]

IV. CONCLUSION

Mahindra sufficiently shows that its Post-2020 ROXOR is not substantially similar to the Jeep Trade Dress, that the degree of similarity is otherwise very low, that its intent in designing the Post-2020 ROXOR weighs against a finding of likelihood of confusion, and that the survey evidence weighs slightly against such a finding. On balance, even considering those *Dupont* factors unchanged from the FID, and giving particular weight to the notable and obvious dissimilarity between the Post-2020 ROXOR and the Jeep Trade Dress, Mahindra has shown that there is no likelihood of consumer confusion as to origin, sponsorship, or approval. Accordingly, it is my recommended determination that the limited exclusion order and cease and desist orders be modified so as to not apply to Mahindra's Post-2020 ROXOR vehicle. This Recommended Determination is hereby certified to the Commission.

This Recommended Determination is being issued as confidential, and a public version will be issued pursuant to Commission Rule 210.5(f). Within seven (7) days of the date of this Recommended Determination, the parties shall jointly submit: (1) a proposed public version of this opinion with any proposed redactions bracketed in red; and (2) a written justification for any proposed redactions specifically explaining why the piece of information sought to be redacted is confidential and why disclosure of the information would be likely to cause substantial harm or likely to have the effect of impairing the Commission's ability to obtain such information as is necessary to perform its statutory functions.

SO ORDERED.



Cameron Elliot
Administrative Law Judge

PUBLIC CERTIFICATE OF SERVICE

I, Lisa R. Barton, hereby certify that the attached **Recommended Determination** has been served via EDIS upon the Commission Investigative Attorney, **Vu Bui, Esq.** and the following parties as indicated, on **October 22, 2020**.



Lisa R. Barton, Secretary
U.S. International Trade Commission
500 E Street, SW, Room 112
Washington, DC 20436

**On Behalf of Requester Mahindra & Mahindra Ltd. and
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**UNITED STATES INTERNATIONAL TRADE COMMISSION
Washington, D.C.**

In the Matter of

**CERTAIN MOTORIZED VEHICLES
AND COMPONENTS THEREOF**

Investigation No. 337-TA-1132

**NOTICE OF COMMISSION FINAL DETERMINATION FINDING A VIOLATION OF
SECTION 337; ISSUANCE OF A LIMITED EXCLUSION ORDER AND A CEASE
AND DESIST ORDER; TERMINATION OF THE INVESTIGATION**

AGENCY: U.S. International Trade Commission.

ACTION: Notice.

SUMMARY: Notice is hereby given that the U.S. International Trade Commission has found a violation of section 337 of the Tariff Act of 1930 (“section 337”), as amended, in this investigation. The Commission has issued a limited exclusion order (“LEO”) prohibiting the importation by respondents Mahindra & Mahindra Ltd. (“M&M”) of Mumbai, India and Mahindra Automotive North America, Inc. (“MANA”) of Auburn Hills, Michigan (collectively, “Respondents”) of certain motorized vehicles and components thereof that infringe complainant’s asserted trade dress. The Commission has also issued cease and desist orders (“CDOs”) directed to respondents M&M and MANA. The investigation is terminated.

FOR FURTHER INFORMATION CONTACT: Houda Morad, Office of the General Counsel, U.S. International Trade Commission, 500 E Street SW, Washington, DC 20436, telephone (202) 708-4716. Copies of non-confidential documents filed in connection with this investigation are or will be available for inspection during official business hours (8:45 a.m. to 5:15 p.m.) in the Office of the Secretary, U.S. International Trade Commission, 500 E Street SW., Washington, D.C. 20436, telephone (202) 205-2000. General information concerning the Commission may also be obtained by accessing its Internet server at <https://www.usitc.gov>. The public record for this investigation may be viewed on the Commission’s electronic docket (EDIS) at <https://edis.usitc.gov>. Hearing-impaired persons are advised that information on this matter can be obtained by contacting the Commission’s TDD terminal on (202) 205-1810.

SUPPLEMENTARY INFORMATION: The Commission instituted this investigation on September 13, 2018, based on a complaint, as amended, filed by FCA US LLC of Auburn Hills, Michigan (“Complainant”). *See* 83 *Fed. Reg.* 46517 (Sept. 13, 2018). The complaint alleges violations of section 337 based upon the importation into the United States, the sale for importation, and the sale within the United States after importation of certain motorized vehicles and components thereof by reason of: (1) infringement of U.S. Trademark Registration Nos. 4,272,873; 2,862,487; 2,161,779; 2,794,553; and 4,043,984 (collectively, “the registered trademarks”); (2) trademark dilution and unfair competition in violating the complainant’s common law trademark rights; and (3) trade dress infringement. *See id.* The notice of

investigation names M&M and MANA as respondents in this investigation. *See id.* The Office of Unfair Import Investigations is also a party to this investigation. *See id.*

On November 8, 2019, the ALJ issued the FID finding a violation of section 337. Specifically, the FID finds that Respondents' Roxor vehicle infringes Complainant's Jeep trade dress but not its registered trademarks. The FID also finds that the domestic industry requirement is satisfied with respect to both claims. The RD recommends that the Commission issue an LEO barring entry of Respondents' articles that infringe the asserted trade dress and CDOs against Respondents. In addition, the RD recommends that the Commission set a bond during the period of Presidential review at ten (10) percent on unassembled Roxor components or one (1) percent on the finished Roxor vehicle.

On December 9, 2019, the private parties also filed statements on the public interest pursuant to Commission Rule 210.50. On December 6, 2019, members of the public, including Prime Mold, AdventureVet, Milton Manufacturing, and Midwest Manufacturing LLC, also filed written submissions in response to the Federal Register notice requesting public interest comments. *See 84 Fed. Reg. 63890* (Nov. 19, 2019).

On January 22, 2020, the Commission issued a notice determining to review the FID in part. *See 85 Fed. Reg. 5035* (Jan. 22, 2020). The Commission's notice also requested written submissions on remedy, the public interest, and bonding. On February 7, 2020, the parties, including OUII, filed written submissions in response to the notice, and on February 14, 2020, the parties filed responses thereto.

Having examined the record of this investigation, including the FID, the RD, and the parties' and non-parties' submissions, the Commission has determined to affirm with modification the FID's determination of a violation of section 337. Specifically, as explained in the Commission Opinion filed concurrently herewith, the Commission has determined to affirm with modification the FID's findings with respect to the issues under review, *i.e.*: (1) validity, infringement, and importation in connection with Complainant's trade dress infringement claim; and (2) non-infringement and domestic industry with respect to Complainant's claim of infringement of its registered trademarks. All findings in the FID that are not inconsistent with the Commission's determination are affirmed.

Accordingly, the Commission finds that there is a violation of section 337 with respect to Complainant's trade dress infringement claim. The Commission has determined that the appropriate remedy is an LEO against Respondents' infringing products, and CDOs against respondents M&M and MANA. The Commission has also determined that the public interest factors enumerated in subsections 337(d)(1) and (f)(1) (19 U.S.C. 1337(d)(1), (f)(1)) do not preclude the issuance of the LEO and CDOs. The Commission has further determined to set a bond during the period of Presidential review at ten (10) percent on unassembled Roxor components or one hundred (100) percent on the finished Roxor vehicle (19 U.S.C. 1337(j)).

The Commission's orders and opinion were delivered to the President and to the United States Trade Representative on the day of their issuance.

The authority for the Commission's determination is contained in section 337 of the Tariff Act of 1930, as amended (19 U.S.C. 1337), and in part 210 of the Commission's Rules of Practice and Procedure (19 CFR part 210).

By order of the Commission.

A handwritten signature in black ink, appearing to read 'Lisa R. Barton', written in a cursive style.

Lisa R. Barton
Secretary to the Commission

Issued: June 11, 2020

PUBLIC CERTIFICATE OF SERVICE

I, Lisa R. Barton, hereby certify that the attached **NOTICE** has been served via EDIS upon the Commission Investigative Attorney, **Vu Bui, Esq.** and the following parties as indicated, on **June 11, 2020**.



Lisa R. Barton, Secretary
U.S. International Trade Commission
500 E Street, SW, Room 112
Washington, DC 20436

On Behalf of Complainant FCA US LLC:

Frank C. Cimino, Esq.
VENABLE LLP
600 Massachusetts Avenue NW
Washington, DC 20001
Email: FCCimino@venable.com

- Via Hand Delivery
- Via Express Delivery
- Via First Class Mail
- Other: Email Notification
of Availability to Download

**On Behalf of Respondents Mahindra & Mahindra Ltd. and
Mahindra Automotive North America, Inc.:**

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ORRICK, HERRINGTON & SUTCLIFFE LLP
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- Other: Email Notification
of Availability to Download

**UNITED STATES INTERNATIONAL TRADE COMMISSION
Washington, D.C.**

In the Matter of

**CERTAIN MOTORIZED VEHICLES
AND COMPONENTS THEREOF**

Investigation No. 337-TA-1132

LIMITED EXCLUSION ORDER

The United States International Trade Commission (“Commission”) has determined that there is a violation of Section 337 of the Tariff Act of 1930, as amended (19 U.S.C. § 1337), in the unlawful importation, sale for importation, or sale within the United States after importation by respondents Mahindra & Mahindra Ltd. of Mumbai, India and Mahindra Automotive North America, Inc. of Auburn Hills, Michigan (collectively, “Mahindra” or “Respondents”) of motorized vehicles, kits and assemblies for motorized vehicles, and replacement and aftermarket components for motorized vehicles that infringe the asserted trade dress in the above-captioned investigation (“the Jeep Trade Dress”). The Jeep Trade Dress consists of “the overall exterior appearance and styling of the [Jeep CJ and Jeep Wrangler] vehicle design,” including:

- (i) A boxy body shape with flat appearing vertical side and rear body panels ending at about the same height as the hood;
- (ii) Substantially flat hood with curved side edges that tapers to be narrower at the front;
- (iii) Trapezoidal front wheel wells with front fenders or fender flares that extend beyond the front of the grille;
- (iv) Flat appearing grille with vertical elongated grille slots and a trapezoidal outline that curves around round headlamps positioned on the upper part of the grille;
- (v) Exterior hood latches; and
- (vi) Door cutouts above a bottom portion of the side body panels.

Having reviewed the record of this investigation, including the written submissions of the parties, the Commission has made its determination on the issues of remedy, public interest, and bonding. The Commission has determined that the appropriate form of relief includes a limited exclusion order prohibiting the unlicensed entry of covered motorized vehicles, kits and assemblies for motorized vehicles, and replacement and aftermarket components for motorized vehicles, manufactured abroad by or on behalf of, or imported by or on behalf of, Respondents or any of their affiliated companies, parents, subsidiaries, or other related business entities, or their successors or assigns.

The Commission has also determined that the public interest factors enumerated in 19 U.S.C. § 1337(d) do not preclude the issuance of the limited exclusion order, and that the bond during the period of Presidential review shall be in the amount of one hundred (100) percent of the entered value of infringing finished motorized vehicles and ten (10) percent of the entered value of any components thereof.

Accordingly, the Commission hereby ORDERS that:

1. Motorized vehicles, kits and assemblies for motorized vehicles, and replacement and aftermarket components for motorized vehicles that infringe the Jeep Trade Dress and that are manufactured by, or on behalf of, or are imported by or on behalf of Respondents or any of their affiliated companies, parents, subsidiaries, or other related business entities, or their successors or assigns (“covered articles”), are excluded from entry for consumption into the United States, entry for consumption from a foreign-trade zone, or withdrawal from a warehouse for consumption, until the Jeep Trade Dress has been abandoned or rendered invalid or unenforceable, except under license from, or with the permission of, the trade dress owner or as

provided by law, and except for service or repair components imported for use in servicing or repairing covered articles that were imported prior to the effective date of this Order.

2. For the purpose of assisting U.S. Customs and Border Protection (“CBP”) in the enforcement of this Order, and without in any way limiting the scope of the Order, the Commission has attached images of the Jeep CJ and Jeep Wrangler vehicles that feature the Jeep Trade Dress as Exhibit 1.

3. Prior to the importation of covered articles that may be subject to this Order, any of the persons listed in paragraph 1 of this Order must seek a ruling from the Commission to determine whether the covered articles sought to be imported are covered by this Order.

4. Notwithstanding paragraph 1 of this Order, the aforesaid covered articles are entitled to entry into the United States for consumption, entry for consumption from a foreign trade zone, or withdrawal from a warehouse for consumption, under bond in the amount of one hundred (100) percent of the entered value of infringing finished motorized vehicles and ten (10) percent of the entered value of any components thereof, pursuant to subsection (j) of section 337 of the Tariff Act of 1930, as amended (19 U.S.C. § 1337(j)), and the Presidential Memorandum for the United States Trade Representative of July 21, 2005, (70 FR 43251), from the day after this Order is received by the United States Trade Representative, and until such time as the United States Trade representative notifies the Commission that this Order is approved or disapproved but, in any event, not later than sixty (60) days after the date of receipt of this Order. All entries of covered articles made pursuant to this paragraph are to be reported to CBP in advance of the date of the entry, pursuant to procedures CBP establishes.

5. At the discretion of CBP, and pursuant to the procedures it establishes, persons seeking to import covered articles that are potentially subject to this Order may be required to

certify that they are familiar with the terms of this Order, that they have made appropriate inquiry, and thereupon state that, to the best of their knowledge and belief, the products being imported are not excluded from entry under paragraph 1 of this Order. At its discretion, CBP may require persons who have provided the certification described in this paragraph to furnish such records or analyses as are necessary to substantiate this certification.

6. The Commission may modify this Order in accordance with the procedures described in Rule 210.76 of the Commission's Rules of Practice and Procedure (19 C.F.R. § 210.76).

7. The Secretary shall serve copies of this Order upon each party of record in this Investigation and upon CBP.

8. Notice of this Order shall be published in the Federal Register.

By order of the Commission.



Lisa R. Barton
Secretary to the Commission

Issued: June 11, 2020

PUBLIC CERTIFICATE OF SERVICE

I, Lisa R. Barton, hereby certify that the attached **COMMISSION ORDER** has been served via EDIS upon the Commission Investigative Attorney, **Vu Bui, Esq.** and the following parties as indicated, on **June 11, 2020**.



Lisa R. Barton, Secretary
U.S. International Trade Commission
500 E Street, SW, Room 112
Washington, DC 20436

On Behalf of Complainant FCA US LLC:

Frank C. Cimino, Esq.
VENABLE LLP
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- Other: Email Notification
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**On Behalf of Respondents Mahindra & Mahindra Ltd. and
Mahindra Automotive North America, Inc.:**

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EXHIBIT 1





**UNITED STATES INTERNATIONAL TRADE COMMISSION
Washington, D.C.**

In the Matter of

**CERTAIN MOTORIZED VEHICLES
AND COMPONENTS THEREOF**

Investigation No. 337-TA-1132

CEASE AND DESIST ORDER

IT IS HEREBY ORDERED THAT RESPONDENT Mahindra & Mahindra Ltd. cease and desist from conducting any of the following activities in the United States: importing, selling, marketing, advertising, distributing, transferring (except for exportation), soliciting U.S. agents or distributors for, and aiding or abetting other entities in the importation, sale for importation, sale after importation, transfer (except for exportation), or distribution of motorized vehicles, kits and assemblies for motorized vehicles, and replacement and aftermarket components for motorized vehicles that infringe the Jeep Trade Dress or any trade dress confusingly similar thereto or that are otherwise misleading as to source, origin, or sponsorship, in violation of section 337 of the Tariff Act of 1930, as amended (19 U.S.C. § 1337).

**I.
Definitions**

As used in this Order:

- (A) “Commission” shall mean the United States International Trade Commission.
- (B) “Complainant” shall mean FCA US LLC, 1000 Chrysler Drive, Auburn Hills, MI 48321.
- (C) “Respondent” shall mean Mahindra & Mahindra Ltd., Mahindra Towers, Dr. G.M. Bhosle Marg, P.K. Kurne Chowk, Worli, Mumbai 400018, India.

(D) “Person” shall mean an individual, or any non-governmental partnership, firm, association, corporation, or other legal or business entity other than Respondent or its majority owned or controlled subsidiaries, successors, or assigns.

(E) “United States” shall mean the fifty States, the District of Columbia, and Puerto Rico.

(F) The terms “import” and “importation” refer to importation for entry for consumption under the Customs laws of the United States.

(G) The term “Jeep Trade Dress” shall mean the following: “the overall exterior appearance and styling of the [Jeep CJ and Jeep Wrangler] vehicle design,” including:

- (i) A boxy body shape with flat appearing vertical side and rear body panels ending at about the same height as the hood;
- (ii) Substantially flat hood with curved side edges that tapers to be narrower at the front;
- (iii) Trapezoidal front wheel wells with front fenders or fender flares that extend beyond the front of the grille;
- (iv) Flat appearing grille with vertical elongated grille slots and a trapezoidal outline that curves around round headlamps positioned on the upper part of the grille;
- (v) Exterior hood latches; and
- (vi) Door cutouts above a bottom portion of the side body panels.

Images of the Jeep CJ and Jeep Wrangler vehicles that feature the Jeep Trade Dress are attached as Exhibit 1.

(H) The term “covered products” shall mean motorized vehicles, kits and assemblies for motorized vehicles, and replacement and aftermarket components for motorized vehicles that infringe the Jeep Trade Dress or any trade dress confusingly similar thereto or that are otherwise misleading as to source, origin, or sponsorship.

II. Applicability

The provisions of this Cease and Desist Order shall apply to Respondent and to any of its principals, stockholders, officers, directors, employees, agents, distributors, controlled (whether by stock ownership or otherwise) and majority-owned business entities, successors, and assigns, and to each of them insofar as they are engaging in conduct prohibited by section III, *infra*, for, with, or otherwise on behalf of, Respondent.

III. Conduct Prohibited

The following conduct of Respondent in the United States is prohibited by this Order. Until the Jeep Trade Dress has been abandoned or rendered invalid or unenforceable, Respondent shall not:

- (A) import or sell for importation into the United States covered products;
- (B) market, distribute, sell, or otherwise transfer (except for exportation), in the United States imported covered products;
- (C) advertise imported covered products;
- (D) solicit U.S. agents or distributors for imported covered products; or
- (E) aid or abet other entities in the importation, sale for importation, sale after importation, transfer, or distribution of covered products.

IV. Conduct Permitted

Notwithstanding any other provision of this Order, Respondent shall be permitted:

- (A) to engage in specific conduct otherwise prohibited by the terms of this Order if, in a written instrument, the owner of the Jeep Trade Dress licenses or authorizes such specific conduct; or

(B) to import, sell for importation, advertise, market, distribute, sell, or otherwise transfer in the United States components for use in servicing or repairing covered products that were imported prior to the effective date of this Order.

V. Reporting

For purposes of this requirement, the reporting periods shall commence on January 1 of each year and shall end on the subsequent December 31. The first report required under this section shall cover the period from the date of issuance of this Order through December 31, 2020. This reporting requirement shall continue in force until such time as Respondent has truthfully reported, in two consecutive timely filed reports, that it has no inventory of covered products in the United States.

Within thirty (30) days of the last day of the reporting period, Respondent shall report to the Commission: (a) the quantity in units and the value in dollars of covered products that it has (i) imported and/or (ii) sold in the United States after importation during the reporting period, and (b) the quantity in units and value in dollars of reported covered products that remain in inventory in the United States at the end of the reporting period.

When filing written submissions, Respondent must file the original document electronically on or before the deadlines stated above and submit eight (8) true paper copies to the Office of the Secretary by noon the next day pursuant to section 210.4(f) of the Commission's Rules of Practice and Procedure (19 C.F.R. § 210.4(f)). Submissions should refer to the investigation number ("Inv. No. 337-TA-1132") in a prominent place on the cover pages and/or the first page. (*See Handbook on Filing Procedures*, https://www.usitc.gov/documents/handbook_on_filing_procedures.pdf). Persons with questions regarding filing should contact the Office of the Secretary (202-205-2000). If Respondent desires to submit a document to the

Commission in confidence, it must file the original and a public version of the original with the Office of the Secretary and must serve a copy of the confidential version on Complainant's counsel.¹

Any failure to make the required report or the filing of any false or inaccurate report shall constitute a violation of this Order, and the submission of a false or inaccurate report may be referred to the U.S. Department of Justice as a possible criminal violation of 18 U.S.C. § 1001.

VI. Recordkeeping and Inspection

(A) For the purpose of securing compliance with this Order, Respondent shall retain any and all records relating to the sale, offer for sale, marketing, or distribution in the United States of covered products, made and received in the usual and ordinary course of business, whether in detail or in summary form, for a period of three (3) years from the close of the fiscal year to which they pertain.

(B) For the purposes of determining or securing compliance with this Order and for no other purpose, subject to any privilege recognized by the federal courts of the United States, and upon reasonable written notice by the Commission or its staff, duly authorized representatives of the Commission shall be permitted access and the right to inspect and copy, in Respondent's principal office during office hours, and in the presence of counsel or other representatives if Respondent so chooses, all books, ledgers, accounts, correspondence, memoranda, and other records and documents, in detail and in summary form, that must be retained under subparagraph VI(A) of this Order.

¹ Complainant must file a letter with the Secretary identifying the attorney to receive reports associated with this Order. The designated attorney must be on the protective order entered in the investigation.

VII.
Service of Cease and Desist Order

Respondent is ordered and directed to:

(A) Serve, within fifteen days after the effective date of this Order, a copy of this Order upon each of its respective officers, directors, managing agents, agents, and employees who have any responsibility for the importation, marketing, distribution, or sale of imported covered products in the United States;

(B) Serve, within fifteen days after the succession of any persons referred to in subparagraph VII(A) of this Order, a copy of this Order upon each successor; and

(C) Maintain such records as will show the name, title, and address of each person upon whom the Order has been served, as described in subparagraphs VII(A) and VII(B) of this Order, together with the date on which service was made.

The obligations set forth in subparagraphs VII(B) and VII(C) shall remain in effect until the Jeep Trade Dress has been abandoned or rendered invalid or unenforceable.

VIII.
Confidentiality

Any request for confidential treatment of information obtained by the Commission pursuant to sections V or VI of this Order should be made in accordance with section 201.6 of the Commission's Rules of Practice and Procedure (19 C.F.R. § 201.6). For all reports for which confidential treatment is sought, Respondent must provide a public version of such report with confidential information redacted.

IX.
Enforcement

Violation of this Order may result in any of the actions specified in section 210.75 of the Commission's Rules of Practice and Procedure (19 C.F.R. § 210.75), including an action for

civil penalties under section 337(f) of the Tariff Act of 1930 (19 U.S.C. § 1337(f)), as well as any other action that the Commission deems appropriate. In determining whether Respondent is in violation of this Order, the Commission may infer facts adverse to Respondent if it fails to provide adequate or timely information.

X. Modification

The Commission may amend this Order on its own motion or in accordance with the procedure described in section 210.76 of the Commission's Rules of Practice and Procedure (19 C.F.R. § 210.76).

XI. Bonding

The conduct prohibited by Section III of this Order may be continued during the sixty-day period in which this Order is under review by the United States Trade Representative, as delegated by the President (70 FR 43251 (July 21, 2005)), subject to the Respondent's posting of a bond in the amount of one hundred (100) percent of the entered value of infringing finished motorized vehicles and ten (10) percent of the entered value of any components thereof. This bond provision does not apply to conduct that is otherwise permitted by section IV of this Order. Covered products imported on or after the date of issuance of this Order are subject to the entry bond set forth in the exclusion order issued by the Commission, and are not subject to this bond provision.

The bond is to be posted in accordance with the procedures established by the Commission for the posting of bonds by complainant in connection with the issuance of temporary exclusion orders. (*See* 19 C.F.R. § 210.68). The bond and any accompanying documentation are to be provided to and approved by the Commission prior to the commencement of conduct that is otherwise prohibited by Section III of this Order. Upon the

Secretary's acceptance of the bond, (a) the Secretary will serve an acceptance letter on all parties, and (b) Respondent must serve a copy of the bond and any accompanying documentation on Complainant's counsel.²

The bond is to be forfeited in the event that the United States Trade Representative approves this Order (or does not disapprove it within the review period), unless (i) the U.S. Court of Appeals for the Federal Circuit, in a final judgment, reverses any Commission final determination and order as to Respondent on appeal, or (ii) Respondent exports or destroys the products subject to this bond and provides certification to that effect that is satisfactory to the Commission.

The bond is to be released in the event (i) the United States Trade Representative disapproves this Order and no subsequent order is issued by the Commission and approved (or not disapproved) by the United States Trade Representative, (ii) the U.S. Court of Appeals for the Federal Circuit, in a final judgment, reverses any Commission final determination and order as to Respondent on appeal, or (iii) Respondent exports or destroys the products subject to this bond and provides certification to that effect that is satisfactory to the Commission, upon service on Respondent of an order issued by the Commission based upon application therefore made by Respondent to the Commission.

By order of the Commission.



Lisa R. Barton
Secretary to the Commission

Issued: June 11, 2020

² See note 1 above.

PUBLIC CERTIFICATE OF SERVICE

I, Lisa R. Barton, hereby certify that the attached **COMMISSION ORDER** has been served via EDIS upon the Commission Investigative Attorney, **Vu Bui, Esq.** and the following parties as indicated, on **June 11, 2020**.



Lisa R. Barton, Secretary
U.S. International Trade Commission
500 E Street, SW, Room 112
Washington, DC 20436

On Behalf of Complainant FCA US LLC:

Frank C. Cimino, Esq.
VENABLE LLP
600 Massachusetts Avenue NW
Washington, DC 20001
Email: FCCimino@venable.com

- Via Hand Delivery
- Via Express Delivery
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- Other: Email Notification
of Availability to Download

**On Behalf of Respondents Mahindra & Mahindra Ltd. and
Mahindra Automotive North America, Inc.:**

R. David Hosp, Esq.
ORRICK, HERRINGTON & SUTCLIFFE LLP
222 Berkeley Street
Boston, MA 02116
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of Availability to Download

EXHIBIT 1





**UNITED STATES INTERNATIONAL TRADE COMMISSION
Washington, D.C.**

In the Matter of

**CERTAIN MOTORIZED VEHICLES
AND COMPONENTS THEREOF**

Investigation No. 337-TA-1132

CEASE AND DESIST ORDER

IT IS HEREBY ORDERED THAT RESPONDENT Mahindra Automotive North America, Inc., cease and desist from conducting any of the following activities in the United States: importing, selling, marketing, advertising, distributing, transferring (except for exportation), soliciting U.S. agents or distributors for, and aiding or abetting other entities in the importation, sale for importation, sale after importation, transfer (except for exportation), or distribution of motorized vehicles, kits and assemblies for motorized vehicles, and replacement and aftermarket components for motorized vehicles that infringe the Jeep Trade Dress or any trade dress confusingly similar thereto or that are otherwise misleading as to source, origin, or sponsorship, in violation of section 337 of the Tariff Act of 1930, as amended (19 U.S.C. § 1337).

**I.
Definitions**

As used in this Order:

- (A) “Commission” shall mean the United States International Trade Commission.
- (B) “Complainant” shall mean FCA US LLC, 1000 Chrysler Drive, Auburn Hills, MI 48321.
- (C) “Respondent” shall mean Mahindra Automotive North America, Inc., 275 Rex Boulevard, Auburn Hills, MI 48326.

(D) “Person” shall mean an individual, or any non-governmental partnership, firm, association, corporation, or other legal or business entity other than Respondent or its majority owned or controlled subsidiaries, successors, or assigns.

(E) “United States” shall mean the fifty States, the District of Columbia, and Puerto Rico.

(F) The terms “import” and “importation” refer to importation for entry for consumption under the Customs laws of the United States.

(G) The term “Jeep Trade Dress” shall mean the following: “the overall exterior appearance and styling of the [Jeep CJ and Jeep Wrangler] vehicle design,” including:

- (i) A boxy body shape with flat appearing vertical side and rear body panels ending at about the same height as the hood;
- (ii) Substantially flat hood with curved side edges that tapers to be narrower at the front;
- (iii) Trapezoidal front wheel wells with front fenders or fender flares that extend beyond the front of the grille;
- (iv) Flat appearing grille with vertical elongated grille slots and a trapezoidal outline that curves around round headlamps positioned on the upper part of the grille;
- (v) Exterior hood latches; and
- (vi) Door cutouts above a bottom portion of the side body panels.

Images of the Jeep CJ and Jeep Wrangler vehicles that feature the Jeep Trade Dress are attached as Exhibit 1.

(H) The term “covered products” shall mean motorized vehicles, kits and assemblies for motorized vehicles, and replacement and aftermarket components for motorized vehicles that infringe the Jeep Trade Dress or any trade dress confusingly similar thereto or that are otherwise misleading as to source, origin, or sponsorship.

II. Applicability

The provisions of this Cease and Desist Order shall apply to Respondent and to any of its principals, stockholders, officers, directors, employees, agents, distributors, controlled (whether by stock ownership or otherwise) and majority-owned business entities, successors, and assigns, and to each of them insofar as they are engaging in conduct prohibited by section III, *infra*, for, with, or otherwise on behalf of, Respondent.

III. Conduct Prohibited

The following conduct of Respondent in the United States is prohibited by this Order. Until the Jeep Trade Dress has been abandoned or rendered invalid or unenforceable, Respondent shall not:

- (A) import or sell for importation into the United States covered products;
- (B) market, distribute, sell, or otherwise transfer (except for exportation), in the United States imported covered products;
- (C) advertise imported covered products;
- (D) solicit U.S. agents or distributors for imported covered products; or
- (E) aid or abet other entities in the importation, sale for importation, sale after importation, transfer, or distribution of covered products.

IV. Conduct Permitted

Notwithstanding any other provision of this Order, Respondent shall be permitted:

- (A) to engage in specific conduct otherwise prohibited by the terms of this Order if, in a written instrument, the owner of the Jeep Trade Dress licenses or authorizes such specific conduct; or

(B) to import, sell for importation, advertise, market, distribute, sell, or otherwise transfer in the United States components for use in servicing or repairing covered products that were imported prior to the effective date of this Order.

V. Reporting

For purposes of this requirement, the reporting periods shall commence on January 1 of each year and shall end on the subsequent December 31. The first report required under this section shall cover the period from the date of issuance of this Order through December 31, 2020. This reporting requirement shall continue in force until such time as Respondent has truthfully reported, in two consecutive timely filed reports, that it has no inventory of covered products in the United States.

Within thirty (30) days of the last day of the reporting period, Respondent shall report to the Commission: (a) the quantity in units and the value in dollars of covered products that it has (i) imported and/or (ii) sold in the United States after importation during the reporting period, and (b) the quantity in units and value in dollars of reported covered products that remain in inventory in the United States at the end of the reporting period.

When filing written submissions, Respondent must file the original document electronically on or before the deadlines stated above and submit eight (8) true paper copies to the Office of the Secretary by noon the next day pursuant to section 210.4(f) of the Commission's Rules of Practice and Procedure (19 C.F.R. § 210.4(f)). Submissions should refer to the investigation number ("Inv. No. 337-TA-1132") in a prominent place on the cover pages and/or the first page. (*See Handbook on Filing Procedures*, https://www.usitc.gov/documents/handbook_on_filing_procedures.pdf). Persons with questions regarding filing should contact the Office of the Secretary (202-205-2000). If Respondent desires to submit a document to the

Commission in confidence, it must file the original and a public version of the original with the Office of the Secretary and must serve a copy of the confidential version on Complainant's counsel.¹

Any failure to make the required report or the filing of any false or inaccurate report shall constitute a violation of this Order, and the submission of a false or inaccurate report may be referred to the U.S. Department of Justice as a possible criminal violation of 18 U.S.C. § 1001.

VI. Recordkeeping and Inspection

(A) For the purpose of securing compliance with this Order, Respondent shall retain any and all records relating to the sale, offer for sale, marketing, or distribution in the United States of covered products, made and received in the usual and ordinary course of business, whether in detail or in summary form, for a period of three (3) years from the close of the fiscal year to which they pertain.

(B) For the purposes of determining or securing compliance with this Order and for no other purpose, subject to any privilege recognized by the federal courts of the United States, and upon reasonable written notice by the Commission or its staff, duly authorized representatives of the Commission shall be permitted access and the right to inspect and copy, in Respondent's principal office during office hours, and in the presence of counsel or other representatives if Respondent so chooses, all books, ledgers, accounts, correspondence, memoranda, and other records and documents, in detail and in summary form, that must be retained under subparagraph VI(A) of this Order.

¹ Complainant must file a letter with the Secretary identifying the attorney to receive reports associated with this Order. The designated attorney must be on the protective order entered in the investigation.

VII.
Service of Cease and Desist Order

Respondent is ordered and directed to:

(A) Serve, within fifteen days after the effective date of this Order, a copy of this Order upon each of its respective officers, directors, managing agents, agents, and employees who have any responsibility for the importation, marketing, distribution, or sale of imported covered products in the United States;

(B) Serve, within fifteen days after the succession of any persons referred to in subparagraph VII(A) of this Order, a copy of this Order upon each successor; and

(C) Maintain such records as will show the name, title, and address of each person upon whom the Order has been served, as described in subparagraphs VII(A) and VII(B) of this Order, together with the date on which service was made.

The obligations set forth in subparagraphs VII(B) and VII(C) shall remain in effect until the Jeep Trade Dress has been abandoned or rendered invalid or unenforceable.

VIII.
Confidentiality

Any request for confidential treatment of information obtained by the Commission pursuant to sections V or VI of this Order should be made in accordance with section 201.6 of the Commission's Rules of Practice and Procedure (19 C.F.R. § 201.6). For all reports for which confidential treatment is sought, Respondent must provide a public version of such report with confidential information redacted.

IX.
Enforcement

Violation of this Order may result in any of the actions specified in section 210.75 of the

Commission's Rules of Practice and Procedure (19 C.F.R. § 210.75), including an action for civil penalties under section 337(f) of the Tariff Act of 1930 (19 U.S.C. § 1337(f)), as well as any other action that the Commission deems appropriate. In determining whether Respondent is in violation of this Order, the Commission may infer facts adverse to Respondent if it fails to provide adequate or timely information.

X. Modification

The Commission may amend this Order on its own motion or in accordance with the procedure described in section 210.76 of the Commission's Rules of Practice and Procedure (19 C.F.R. § 210.76).

XI. Bonding

The conduct prohibited by Section III of this Order may be continued during the sixty-day period in which this Order is under review by the United States Trade Representative, as delegated by the President (70 FR 43251 (July 21, 2005)), subject to the Respondent's posting of a bond in the amount of one hundred (100) percent of the entered value of infringing finished motorized vehicles and ten (10) percent of the entered value of any components thereof. This bond provision does not apply to conduct that is otherwise permitted by section IV of this Order. Covered products imported on or after the date of issuance of this Order are subject to the entry bond set forth in the exclusion order issued by the Commission, and are not subject to this bond provision.

The bond is to be posted in accordance with the procedures established by the Commission for the posting of bonds by complainant in connection with the issuance of temporary exclusion orders. (*See* 19 C.F.R. § 210.68). The bond and any accompanying documentation are to be provided to and approved by the Commission prior to the

commencement of conduct that is otherwise prohibited by Section III of this Order. Upon the Secretary's acceptance of the bond, (a) the Secretary will serve an acceptance letter on all parties, and (b) Respondent must serve a copy of the bond and any accompanying documentation on Complainant's counsel.²

The bond is to be forfeited in the event that the United States Trade Representative approves this Order (or does not disapprove it within the review period), unless (i) the U.S. Court of Appeals for the Federal Circuit, in a final judgment, reverses any Commission final determination and order as to Respondent on appeal, or (ii) Respondent exports or destroys the products subject to this bond and provides certification to that effect that is satisfactory to the Commission.

The bond is to be released in the event (i) the United States Trade Representative disapproves this Order and no subsequent order is issued by the Commission and approved (or not disapproved) by the United States Trade Representative, (ii) the U.S. Court of Appeals for the Federal Circuit, in a final judgment, reverses any Commission final determination and order as to Respondent on appeal, or (iii) Respondent exports or destroys the products subject to this bond and provides certification to that effect that is satisfactory to the Commission, upon service on Respondent of an order issued by the Commission based upon application therefore made by Respondent to the Commission.

By order of the Commission.



Lisa R. Barton
Secretary to the Commission

Issued: June 11, 2020

² See note 1 above.

PUBLIC CERTIFICATE OF SERVICE

I, Lisa R. Barton, hereby certify that the attached **COMMISSION ORDER** has been served via EDIS upon the Commission Investigative Attorney, **Vu Bui, Esq.** and the following parties as indicated, on **June 11, 2020**.



Lisa R. Barton, Secretary
U.S. International Trade Commission
500 E Street, SW, Room 112
Washington, DC 20436

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- Via Hand Delivery
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EXHIBIT 1





PUBLIC VERSION

**UNITED STATES INTERNATIONAL TRADE COMMISSION
Washington, D.C.**

In the Matter of

**CERTAIN MOTORIZED VEHICLES
AND COMPONENTS THEREOF**

Inv. No. 337-TA-1132

COMMISSION OPINION

The Commission has determined that there has been a violation of section 337 of the Tariff Act of 1930, as amended, 19 U.S.C. § 1337, based on trade dress infringement, on review of the final initial determination (“FID”) of the presiding administrative law judge (“ALJ”). This opinion sets forth the Commission’s reasoning in support of its determination. In addition, the Commission adopts the findings in the FID that are not inconsistent with this opinion.

I. BACKGROUND

A. Procedural Background

On September 13, 2018, the Commission instituted this investigation based on a complaint, as amended, filed by FCA US LLC of Auburn Hills, Michigan (“Complainant” or “FCA”). *See* 83 Fed. Reg. 46517-18 (Sept. 13, 2018). The complaint, as amended,¹ alleges violations of section 337 of the Tariff Act of 1930, as amended, 19 U.S.C. § 1337 (“section 337”), based upon the importation into the United States, the sale for importation, and the sale within the United States after importation of certain motorized vehicles and components thereof by reason of: (1) infringement of U.S. Trademark Registration Nos. 2,862,487 (“the ’487 trademark”); 2,161,779 (“the ’779 trademark”); 2,794,553 (“the ’553 trademark”); 4,043,984 (“the ’984 trademark”) (collectively, “Registered Trademarks”); and 4,272,873 (“the ’873

¹ FCA filed an amended complaint on November 19, 2018 (“Am. Compl.”).

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trademark”); (2) trade dress infringement; and (3) dilution of the asserted trade dress. *See id.* at 46517-18. The notice of investigation names Mahindra & Mahindra Ltd. (“M&M”) of Mumbai, India and Mahindra Automotive North America, Inc. (“MANA”) of Auburn Hills, Michigan (collectively, “Respondents” or “Mahindra”) as respondents in this investigation. *See id.* at 46518. The Office of Unfair Import Investigations (“OUII”) is also a party to this investigation. *See id.*

The Commission directed the ALJ to “hold an early evidentiary hearing, find facts, and issue an early decision, within 100 days of institution except for good cause shown, as to whether the complainant is contractually barred from enforcing its intellectual property against the named respondents.” *See id.* On December 21, 2018, the ALJ issued an initial determination (“ID”) finding that FCA is not contractually barred from enforcing its intellectual property against Respondents. *See Order No. 18 (Dec. 21, 2018), unreviewed, Comm’n Notice (Feb. 28, 2019).* Accordingly, the ALJ issued a revised procedural schedule and lifted the stay on discovery which was in place during the 100-day proceeding. *See Order No. 19 (Feb. 13, 2019) (lifting stay of discovery); Order No. 20 (Feb 19, 2019) (setting revised procedural schedule).*

The ALJ conducted an evidentiary hearing on August 19-23, 2019.

On November 8, 2019, the ALJ issued the FID finding a violation of section 337. Specifically, the FID finds that Respondents’ Roxor vehicle infringes FCA’s asserted trade dress but not its asserted Registered Trademarks. The FID further finds no dilution of the asserted trade dress. The FID also finds that the domestic industry requirement is satisfied. The FID also includes a Recommended Determination (“RD”) recommending that the Commission issue a limited exclusion order (“LEO”) barring entry of articles that infringe the asserted trade dress and cease and desist orders (“CDOs”) against all Respondents. In addition, the RD recommends

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that the Commission set a bond during the period of Presidential review in the amount of ten percent on unassembled components of infringing articles or one percent on complete infringing articles.

On November 25, 2019, both FCA and Mahindra filed petitions for review of the FID.² FCA petitioned for review of the FID's finding that the accused product does not infringe FCA's asserted Registered Trademarks.³ In addition, FCA contingently petitioned for review of the FID's findings according no weight to FCA's survey and market research evidence as relevant to trade dress infringement. Mahindra petitioned for review of the FID's finding that its accused product infringes FCA's asserted trade dress. Mahindra also petitioned for review of the FID's findings with respect to the domestic industry requirement and particularly, the injury requirement under 19 U.S.C. § 1337(a)(1)(A)(i). On December 9, 2019, the private parties filed responses to each other's petitions.⁴

On December 9, 2019, the private parties also filed statements on the public interest pursuant to Commission Rule 210.50(a)(4) (19 C.F.R. § 210.50(a)(4)).⁵ On December 6, 2019, members of the public, including Prime Mold, AdventureVet, Milton Manufacturing, and

² See Complainant FCA US LLC's Petition for Review of Initial Determination and Contingent Petition (Nov. 25, 2019) (hereinafter, "Complainant's Pet."); Respondents' Petition for Review (Nov. 25, 2019) (hereinafter, "Respondents' Pet.>").

³ FCA did not petition for review with respect to the FID's findings of no dilution of the asserted trade dress. Nor did FCA petition for review with respect to the FID's finding that Respondent does not infringe the '873 trademark.

⁴ See Complainant FCA US LLC's Response to Respondents' Petition for Review of the Initial Determination (Dec. 9, 2019) (hereinafter, "Complainant's Pet. Resp."); Respondents' Response to Complainant FCA US LLC's Petition for Review of Initial Determination and Contingent Petition (Dec. 9, 2019) (hereinafter, "Respondents' Pet. Resp.>").

⁵ See Complainant's Statement on the Public Interest (Dec. 9, 2019) (hereinafter, "Complainant's PI Br."); Respondents' Public Interest Statement (Dec. 9, 2019) (hereinafter, "Respondents' PI Br.>").

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Midwest Manufacturing LLC, also filed written submissions in response to the Commission's Federal Register notice requesting public interest comments.⁶ *See* 84 Fed. Reg. 63890 (Nov. 19, 2019).

On January 22, 2020, the Commission issued a notice determining to review the FID in part. *See* 85 Fed. Reg. 5035-36 (Jan. 28, 2020) ("the WTR/Remedy Notice"). Specifically, the Commission determined to review: (1) the FID's findings with respect to the validity and infringement of the asserted trade dress, as well as importation findings relating to Complainant's trade dress infringement claim; and (2) the FID's findings on infringement and domestic industry in connection with Complainant's claim of infringement of the Registered Trademarks. *See id.* The notice also invited written submissions from the parties, interested government agencies, and any other interested parties on the issues of remedy, the public interest, and bonding. *See id.*

On February 7, 2020, the parties, including OUII, filed written submissions in response to the WTR/Remedy Notice,⁷ and on February 14, 2020, the parties filed responses to each other's

⁶ *See* Public Interest Comments from Prime Mold (Dec. 6, 2019) (hereinafter, "Prime Mold PI Br."); Public Interest Comments from AdventureVet (Dec. 6, 2019) (hereinafter, "AdventureVet PI Br."); Public Interest Comments from Milton Manufacturing (Dec. 6, 2019) (hereinafter, "Milton Mfg. PI Br."); Public Interest Comments from Midwest Manufacturing LLC (Dec. 6, 2019) (hereinafter, "Midwest Mfg. PI Br.>").

⁷ *See* Complainant's Submission on Remedy, Bonding, & Public Interest (Feb. 7, 2020) (hereinafter, "Complainant's Remedy Br."); Respondents' Corrected Initial Brief on the Issues of Remedy, the Public Interest, and Bonding (Feb. 7, 2020) (hereinafter, "Respondents' Remedy Br."); Response of the Office of Unfair Import Investigations to the Commission's Request for Written Submissions on Remedy, the Public Interest, and Bonding (Feb. 7, 2020) (hereinafter, "IA's Remedy Br.>").

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submissions.⁸ On February 7, 2020, members of the public, including Black Hills Harley-Davidson and Ultimate Cycle, also filed written submissions in response to the WTR/Remedy Notice.⁹

A. FCA's Asserted Trade Dress and Trademarks

The asserted trade dress (hereinafter “the Jeep Trade Dress”) includes:

- (i) A boxy body shape with flat appearing vertical side and rear body panels ending at about the same height as the hood;
- (ii) Substantially flat hood with curved side edges that tapers to be narrower at the front;
- (iii) Trapezoidal front wheel wells with front fenders or fender flares that extend beyond the front of the grille;
- (iv) Flat appearing grille with vertical elongated grille slots and a trapezoidal outline that curves around round headlamps positioned on the upper part of the grille;
- (v) Exterior hood latches; and
- (vi) Door cutouts above a bottom portion of the side body panels.

See FID at 5. For example, the following vehicles are representative of the Jeep Trade Dress.

⁸ *See* Complainant’s Reply Submission on Remedy, Bonding, & Public Interest (Feb. 14, 2020) (hereinafter, “Complainant’s Remedy Resp.”); Respondents’ Reply Brief on the Issues of Remedy, the Public Interest, and Bonding (Feb. 14, 2020) (hereinafter, “Respondents’ Remedy Resp.”); Reply of the Office of Unfair Import Investigations to the Written Submissions on Remedy, the Public Interest, and Bonding (Feb. 14, 2020) (hereinafter, “IA’s Remedy Resp.”).





⁹ *See* Letter from Jim Burgess to the International Trade Commission (Feb. 7, 2020) (hereinafter, “Black Hills’ Remedy Br.”); Letter from Peter Daniel to the International Trade Commission (Feb. 7, 2020) (hereinafter, “Ultimate Cycle’s Remedy Br.”).

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See id. at 6; Am. Compl. at ¶ 43.

The Registered Trademarks include the Jeep grille design marks (reproduced below).

Reg. No.	Mark
'779	
'553	
'487	
'984	

See FID at 8; Am. Compl. at ¶¶ 47-52.

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B. FCA’s Domestic Industry Products and Mahindra’s Accused Product

The asserted domestic industry products are the Jeep Wrangler, the CJ5 to CJ8,¹⁰ and the CJ66 vehicles. See FID at 8.

The accused product in this investigation is Respondents’ Roxor Utility Terrain Vehicle (“UTV”). See *id.* at 8-9. Below is a side-by-side comparison of the accused product and a domestic industry product:

Domestic Industry Product	Accused Product
	
	

See *id.* at 8-9; Am. Compl. at ¶ 60.

¹⁰ FCA asserts consistent and continuous use of the asserted Jeep Trade Dress beginning with the CJ5 model in 1955. See FID at 23.

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II. LEGAL STANDARDS

A. Standard on Review

Commission Rule 210.45(c) provides that, with respect to the issues under review, “the Commission may affirm, reverse, modify, set aside or remand for further proceedings, in whole or in part, the initial determination of the administrative law judge” and that “[t]he Commission also may make any findings or conclusions that in its judgment are proper based on the record in the proceeding.” *See* 19 C.F.R. § 210.45(c). In addition, as explained in *Certain Polyethylene Terephthalate Yarn and Products Containing Same*, “[o]nce the Commission determines to review an initial determination, the Commission reviews the determination under a *de novo* standard.” *Inv. No. 337-TA-457, Comm’n Op.*, 2002 WL 1349938, *5 (June 18, 2002) (citations omitted). This is “consistent with the Administrative Procedure Act which provides that once an initial agency decision is taken up for review, ‘the agency has all the powers which it would have in making the initial decision except as it may limit the issues on notice or by rule.’” *Id.* (citing 5 U.S.C. § 557(b)).

B. Trademark and Trade Dress Infringement

To establish infringement of a trademark under the Lanham Act, the complainant must prove that “(1) it has a valid and legally protectable mark; (2) it owns the mark; and (3) [Respondents’] use of the mark to identify goods or services causes a likelihood of confusion.” *Converse, Inc. v. ITC*, 909 F.3d 1110, 1116 (Fed. Cir. 2018) (citation omitted). Similarly, “to form the basis for an action under the Lanham Act, a trade dress must satisfy three criteria: 1) it must be distinctive; 2) it must be nonfunctional; and 3) there must be a likelihood that it will be confused with the accused product.” *See Aromatique, Inc. v. Gold Seal, Inc.*, 28

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F.3d 863, 868 (8th Cir. 1994) (citing *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763 (1992)).

A trademark or trade dress is valid if it is distinctive and non-functional. *See id.* at 869. Registered marks are presumed valid, *i.e.*, distinctive and non-functional. *See id.* On the other hand, the owner of an unregistered mark or trade dress must show that it is distinctive and non-functional. *See id.*; *see also Wal-Mart Stores v. Samara Bros., Inc.*, 529 U.S. 205, 210 (2000).

All trademarks and trade dresses must be distinctive. *See Converse*, 909 F.3d at 1116. Specifically, they can be inherently distinctive or they can acquire distinctiveness, *i.e.*, secondary meaning. *See id.* For a common law or unregistered product-design trade dress, “[t]he Supreme Court has held that . . . [it] can never be inherently distinctive.” *See id.* (citing *Wal-Mart Stores*, 529 U.S. at 216). Therefore, the complainant must show that its product design trade dress has acquired secondary meaning. *See id.* The Federal Circuit considers six factors in determining whether a mark has acquired secondary meaning:

- (1) association of the trade dress with a particular source by actual purchasers (typically measured by customer surveys¹¹);
- (2) length, degree, and exclusivity of use;
- (3) amount and manner of advertising;
- (4) amount of sales and number of customers;
- (5) intentional copying; and
- (6) unsolicited media coverage of the product embodying the mark.

¹¹ The Commission considers the following factors (collectively, “the Survey Factors”) in assessing the credibility and reliability of survey evidence: “(1) examination of the proper universe; (2) a representative sample drawn from the proper universe; (3) a correct mode of questioning interviewees; (4) recognized experts conducting the survey; (5) accurate reporting of data gathered; (6) sample design, questionnaire, and interviewing in accordance with generally accepted standards of objective procedure and statistics in the field of surveys; (7) sample design and interviews conducted independently of the attorneys; and (8) the interviewers, trained in this field, have no knowledge of the litigation or the purpose for which the survey is to be used.” *See Certain Digital Multimeters, and Prods. with Multimeter Functionality*, Inv. No. 337-TA-588, Order No. 22, Initial Determination, 2008 WL 332382, *5 (Jan. 14, 2008), *unreviewed*, Comm’n Notice, 2008 WL 11388167 (Feb. 12, 2008) (“*Digital Multimeters*”).

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See id. at 1120.

In addition, “[t]he Commission has adopted the test set forth in *In re Morton-Norwich*

Products to determine functionality:

Morton-Norwich listed the following factors as relevant consideration[s] in determining functionality: (1) whether the utilitarian advantages of the design are touted in advertising; (2) whether the particular design results from a comparatively simple or cheap method of manufacture; (3) whether there exists a utility patent which discloses the utilitarian advantage of the design for which production is sought; and (4) whether commercial alternatives are available. The foregoing factors are aids in determining functionality; no single factor is dispositive.”

Certain Ink Markers and Packaging Thereof, Inv. No. 337-TA-522, Order No. 30, USITC Pub. No. 3971, 2007 WL 4861333, *29 (July 25, 2005) (“*Ink Markers*”), *unreviewed*, Comm’n Notice, 2007 WL 4861333, *16 (Sept. 8, 2005) (citing *In re Morton-Norwich Prods., Inc.*, 671 F.2d 1332 (C.C.P.A. 1982)).

As to likelihood of confusion, the following factors (“the *Dupont* factors”) can be considered when supported by evidence in the record:

- (1) The similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression;
- (2) The similarity or dissimilarity and nature of the goods or services as described in an application or registration or in connection with which a prior mark is in use;
- (3) The similarity or dissimilarity of established, likely-to-continue trade channels;
- (4) The conditions under which and buyers to whom sales are made, *i.e.* “impulse” vs. careful, sophisticated purchasing;
- (5) The fame of the prior mark (sales, advertising, length of use);
- (6) The number and nature of similar marks in use on similar goods;

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- (7) The nature and extent of any actual confusion;
- (8) The length of time during and conditions under which there has been concurrent use without evidence of actual confusion;
- (9) The variety of goods on which a mark is or is not used (house mark, “family” mark, product mark);
- (10) The market interface between applicant and the owner of a prior mark . . .;
- (11) The extent to which applicant has a right to exclude others from use of its mark on its goods;
- (12) The extent of potential confusion, *i.e.*, whether de minimis or substantial; and
- (13) Any other established fact probative of the effect of use.

Swagway, LLC v. ITC, 934 F.3d 1332, 1338-39 (Fed. Cir. 2019) (citing *In re E.I. DuPont DeNemours & Co.*, 476 F.2d 1357, 1361 (C.C.P.A. 1973)).¹²

III. DISCUSSION

The Commission determines to make the findings, conclusions, and supporting analysis set forth below. Any findings, conclusions, and supporting analysis in the FID regarding issues that are under review that are not inconsistent with these findings, conclusions, and supporting analysis are affirmed and adopted herein.

¹² The ID’s analysis examined the evidence presented by the parties by applying the *Dupont* test for likelihood of confusion in view of the Federal Circuit’s endorsement of the *Dupont* factors in the recent *Swagway* decision. *See* FID at 14-15. The ID considered the intent of the alleged infringer under *Dupont* factor 13 (any other established fact probative of the effect of use). *See id.* at 15. The ID also considered the strength of a mark to be essentially equivalent to *Dupont* factor 5 (fame of the mark). *See id.* No party petitioned for review of the legal test applied by the ID. The Commission takes no position as to the propriety of other tests or factors for determining likelihood of confusion.

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A. Trade Dress Infringement

The FID finds that Mahindra’s Roxor vehicle infringes FCA’s Jeep Trade Dress. *See* FID at 21-58. Mahindra disputes the FID’s findings with respect to: (1) the ownership of the trade dress; (2) the validity of the trade dress, including genericness, functionality, and secondary meaning; and (3) likelihood of confusion. As discussed below, the Commission has determined to affirm with modification the FID’s finding of trade dress infringement.

1. Validity

(i) Genericness

The FID finds that the Jeep Trade Dress is not generic. *See* FID at 36-37. The Federal Circuit has explained the governing legal standard as follows:

A generic term is the common descriptive name of a class of goods or services. . . . The critical issue in genericness cases is whether members of the relevant public primarily use or understand the term sought to be protected to refer to the genus of goods or services in question. . . . Under *Ginn* a two-step test is applied to determine whether a given term is generic. “First, what is the genus of goods or services at issue? Second, is the term sought to be registered or retained on the register understood by the relevant public primarily to refer to that genus of goods or services?”

In re Cordua Restaurants, Inc., 823 F.3d 594, 599 (Fed. Cir. 2016) (citing, *inter alia*, *H. Marvin Ginn Corp. v. Int’l Ass’n of Fire Chiefs, Inc.*, 782 F.2d 987, 989 (Fed. Cir. 1986)); *see also* FID at 36. The FID notes that “[o]nce an accused infringer asserts that a mark is generic, the burden shifts to the accuser to prove the mark is not generic.” *See id.* (citing *T. Marzetti Co. v. Roskam Baking Co.*, 680 F.3d 629, 633 (6th Cir. 2012)).

As to the genus of the goods associated with the asserted Jeep Trade Dress, the FID agrees with FCA that “the [Jeep] Wrangler is an SUV” and notes that Mahindra’s expert, “Dr. Steckel[,] determined that none of the [third-party] vehicles he analyzed—at least some of which

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appear to be SUVs—had all six elements of the Jeep Trade Dress.” *See* FID at 36 (citing RX-1907C; Hr’g Tr. (Steckel¹³) at 1084:9-12, 1127:3-1129:10). The FID also notes that Mahindra’s expert, “Mr. Hill[,] admitted that the Wrangler is an SUV by current standards,” and that “his ‘family tree’ of such vehicles does not identify any non-Jeep vehicles with all six elements of the Jeep Trade Dress.” *See id.* (citing RX-1010C, Hill¹⁴ DWS¹⁵ at Q/As 17, 99; RX-1882 (family tree); Hr’g Tr. (Hill) at 828:8-12, 845:15-22).

The FID rejects Mahindra’s argument that the Jeep Trade Dress is generic in view of the first version of a “Jeep” from the 1940s. *See id.* at 37. The FID finds no evidence that “the public understood the Jeep Trade Dress, which was not even introduced until 1955, to refer primarily to a ‘type’ of vehicle.” *See id.* The FID also disagrees with Mahindra’s assertion that the decision by the Federal Trade Commission (“FTC”)¹⁶ in the 1940s shows that the Jeep Trade Dress is generic. *See id.* The FID reasons that “the FTC’s determination says nothing about the Jeep Trade Dress specifically, which, again, was introduced in 1955.” *See id.*

First, Mahindra faults the FID for placing the burden of establishing genericness on Mahindra rather than FCA. *See* Respondents’ Pet. at 14-15. The Commission disagrees and finds that the FID properly placed the burden on FCA and that FCA satisfied its burden. For instance, FCA argued that “the Wrangler® falls into the SUV category” and “[e]ven Respondents’ expert Mr. Hill agrees that the Wrangler®, which embodies the asserted Jeep

¹³ Prof. Joel H. Steckel was retained as an expert by Mahindra in this investigation.

¹⁴ Jason C. Hill was retained as an expert by Mahindra in this investigation.

¹⁵ “DWS” means “Direct Witness Statement.”

¹⁶ In 1948, the FTC ruled against Willys-Overland in a false advertising case where the FTC determined that Willys-Overland’s claim to have designed and created the “Jeep” vehicle was an unfair and deceptive act and practice in commerce. *See* RX-2107. The FTC’s ruling relates to a non-commercial four-wheel drive vehicle designed by FCA’s predecessor, Willys-Overland, for the U.S. military during World War II.

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Trade Dress, falls into the SUV category.” See CIB¹⁷ at 90 (citing Hr’g Tr. at 828:3-12, 829:10-15 (Hill)). In addition, as FCA argued (and the Commission agrees), the “Jeep Trade Dress is not generic for a genre of vehicles, but is a single SUV with a unique, source-identifying design.” *Id.* Furthermore, the Commission agrees that “it cannot be said that the Jeep Trade Dress is so common as to be generic” and that none of the third-party vehicles includes all six elements of the Jeep Trade Dress.¹⁸ See *id.* at 91-92; accord SIB¹⁹ at 53 (citing RX-1907C).

Second, Mahindra suggests that the genus is the sub-category of “small, boxy, military-style SUVs—referred to generically as ‘jeeps,’” not the broad genus of SUVs. See Respondents’ Pet. at 16 (citing *Royal Crown Co., Inc. v. The Coca-Cola Co.*, 892 F.3d 1358, 1367 (Fed. Cir. 2018)). Mahindra alleged that, under *Royal Crown*, “a term is generic if the relevant public understands the term to refer to part of the claimed genus of goods or services, even if the public does not understand the term to refer to the broad genus as a whole.” See *id.* at 15-16. The Commission disagrees that the principle of *Royal Crown* is directly applicable to the facts of the present case. In *Royal Crown*, which involved the use of the term “ZERO” on beverages, the Federal Circuit found that the Trademark Trial and Appeal Board erred in its genericness analysis because “it failed to examine whether [the term] ZERO identified a key aspect of the genus at issue, and it failed to examine how the relevant public understood the brand name at issue when used with the descriptive term ZERO.” See *Royal Crown*, 892 F.3d at 1366. The Federal Circuit found that “ZERO” was a descriptive term for low caloric content

¹⁷ “CIB” refers to “Complainant FCA US LLC’s Post-Hearing Brief” (Sept. 13, 2019).

¹⁸ Nor does the original Willys MB vehicle include all six elements of the Jeep Trade Dress. See RX-1906C. In fact, no auto manufacturer other than FCA (and Mahindra) use or have used the Jeep Trade Dress for commercial non-military vehicles. See RX-1907C; CX-1006C, Baker DWS at Q/A 19.

¹⁹ “SIB” refers to “Commission Investigative Staff’s Post-Hearing Brief” (Sept. 13, 2019).

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and that “the Board must examine whether the term ZERO, when appended to a beverage mark, refers to a key aspect of the genus” even if “ZERO [is] not equated by the general public with the entire broad genus.” *See id.* at 1367-68. *Royal Crown* is distinguishable because, here, the term “Jeep” is neither descriptive of, nor generic for, either the entire SUV genus or even a sub-category or aspect of such genus. Indeed, as discussed above, FCA presented substantial evidence that consumers associate the Jeep Trade Dress with a single source, the Jeep or Wrangler brands of SUVs. *See* JX-1090C.18-20; CX-1007, Isaacson²⁰ DWS at Q/As 63-64.

The Commission further finds that the 1948 FTC decision and the dictionary definitions cited by Mahindra relate to a non-commercial four-wheel drive vehicle designed by FCA’s predecessor, Willys-Overland, for the U.S. military during World War II.²¹ *See, e.g.,* RX-2107; RX-2122.12-13; RX-1595. Such evidence does not support a finding that the Jeep Trade Dress is generic in the context of FCA’s non-military commercial SUVs.²²

As noted in McCarthy,

Buyers or users of a product may sometimes use a trademark in a generic sense in casual conversation even though when questioned, those persons are fully aware of the trademark significance of the term. For example, a person may use the trademark TYLENOL when saying “I took a Tylenol for my headache” even though what they took was a house brand of acetaminophen. Or a person may use the trademark KLEENEX when asking a friend for “a Kleenex” from a box of store brand tissues. These persons are using trademarks in an informal “generic” sense even though when going to purchase an analgesic or a box of tissues, they are fully aware that

²⁰ Dr. Bruce Isaacson was retained as an expert by FCA.

²¹ Ford also manufactured an identical version of the original vehicle for the U.S. military during World War II, pursuant to a license provided by Willys-Overland, but Ford ceased such manufacturing in 1945. *See* CX-1791C.2.

²² In any event, the original Willys MB vehicle does not include all six elements of the Jeep Trade Dress. *See* RX-1906C. In fact, no auto manufacturer other than FCA (and Mahindra) use or have used the Jeep Trade Dress for commercial non-military vehicles. *See* RX-1907C; CX-1006C, Baker DWS at Q/A 19.

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TYLENOL and KLEENEX are brands that identify the commercial source of those products. Such casual, non-purchasing uses of terms are not evidence of generic usage. As the Restatement observes: “It is the use and understanding of the term in the context of purchasing decisions, however, that determines the primary significance of a designation.”

2 McCarthy, § 12:8 (citing Restatement Third, Unfair Competition § 15, comment c (1995)).

Here, there is no evidence that the Jeep Trade Dress is used or perceived as generic in the context of purchasing decisions. Rather, FCA presented substantial evidence that consumers associate the Jeep Trade Dress with a single source. *See* JX-1090C.18-20; CX-1792; CX-1004C, Spano²³ DWS at Q/As 69, 72. Thus, the Commission has determined to affirm the FID’s finding that the Jeep Trade Dress is not generic.²⁴

(ii) Functionality

The FID finds that “FCA has proven that the Jeep Trade Dress is non-functional.” *See* FID at 37-40. The FID applies the factors of *Morton-Norwich* (*see supra* section IV(B)) and finds that each of them supports a finding of non-functionality. *See id.* The FID also properly considers whether “the whole collection of elements taken together are functional” and finds that collection of features making up the Jeep Trade Dress are not functional. *See id.* at 37-38 (citing *Int’l Jensen Inc. v. Metrosound U.S.A., Inc.*, 4 F.3d 819, 823 (9th Cir. 1993)).²⁵

²³ Kristen Spano is Senior Trademark Counsel for FCA.

²⁴ In the context of analyzing whether the Jeep Trade Dress is generic, the FID states that “[t]here is evidence that the term ‘Jeep’ is generic, and refers to ‘a small, sturdy, four-wheel-drive army vehicle, used chiefly for reconnaissance,’ or ‘a similar vehicle in non-military use.’” *See* FID at 36. FCA argues that the FID errs in finding the term “Jeep” generic and “ignores the fact that Jeep® is an incontestable trademark associated by consumers with FCA and its predecessors since at least 1949.” *See* Complainant’s Pet. at 29 (citing CX-1792C; CX-1004C, Spano DWS at Q/As 69, 72). The genericness of the term “Jeep” is not particularly relevant to the genericness of the Jeep Trade Dress. Thus, the Commission does not reach the question of whether the term “Jeep” is generic and therefore vacates and takes no position on the FID’s statement that “[t]here is evidence that the term ‘Jeep’ is generic.” *See* FID at 36.

²⁵ “In evaluating functionality as well as the other elements of a trade dress claim, it is crucial

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As to the first *Morton-Norwich* factor (whether the utilitarian advantages of the design are touted in advertising), the FID finds that FCA advertises the “styled” vehicle not the military functionality. *See id.* at 38 (citing CX-1001C, Allen²⁶ DWS at Q/A 40). The FID also finds that the second *Morton-Norwich* factor (whether the particular design results from a comparatively simple or cheap method of manufacture) weighs in favor of FCA. *See id.* at 38-39. The FID finds no evidence that “the Jeep Trade Dress overall results in a simple method of manufacture.” While “one element may be easier to manufacture than others,” the FID finds that “other elements of the Jeep Trade Dress, including the boxy shape, the flat hood with rounded edges, and the trapezoidal wheel wells extending beyond the grille, actually make vehicle design more challenging.” *See id.* at 39 (citing CX-1001C, Allen DWS at Q/As 55, 58, 63).

With respect to the third *Morton-Norwich* factor (whether there exists a utility patent which discloses the utilitarian advantage of the design for which production is sought), the FID finds that “none of the[] patents [cited by Mahindra] explicitly teach the functionality of any of the elements of the claimed trade dress” and “[a]t most, some elements are shown in the figures and mentioned in the specifications of the various patents.” *See id.* Importantly, the FID states, “the question is whether the whole collection of Jeep Trade Dress elements is functional, not whether disparate utility patents disclose each element separately.” *See id.* As to the fourth and last element (whether commercial alternatives are available), the FID finds that Mahindra’s

that [the tribunal] focus[es] not on the individual elements, but rather on the overall visual impression that the combination and arrangement of those elements create.” *Millennium Labs., Inc. v. Ameritox, Ltd.*, 817 F.3d 1123, 1130 (9th Cir. 2016) (citation omitted). Indeed, “functional elements that are separately unprotectable can be protected together as part of a trade dress.” *Id.* (quoting *Fuddruckers, Inc. v. Doc’s B.R. Others, Inc.*, 826 F.2d 837, 842 (9th Cir. 1987)).

²⁶ Mark T. Allen is FCA’s Head of Design for the Jeep® brand.

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“own evidence shows that other automobile companies make and sell alternatives that do not possess the Jeep Trade Dress.” *See id.* (citing RX-1882C).

Mahindra first faults the FID for placing the burden of establishing non-functionality on Mahindra rather than FCA. *See* Respondents’ Pet. at 50-51. The Commission disagrees and finds that the FID properly placed the burden on FCA and that FCA satisfied that burden. For instance, FCA and the IA argued that the CJ-5 vehicle was different from the WWII military vehicles and was designed to provide a “styled” vehicle. *See* CIB at 88 n.343 (citing CX-1001C, Allen DWS at Q/A 40); *accord* SIB at 49; *see also* CIB at 88 (arguing that “the Jeep Trade Dress is not necessary to compete”) (citing RX-1882)²⁷; *see id.* at 19 (arguing that some of the design elements of the Jeep Trade Dress are more complicated to make than are alternatives from a manufacturing standpoint) (citing CX-1001C, Allen DWS at Q/As 63, 67, 73).

Mahindra also argues that FCA touts the functionality of the Jeep Trade Dress in its advertising. *See* Respondents’ Pet. at 52. For example, Mahindra states that FCA advertises the “versatility and off-road capability of the vehicles.” *See id.* The Commission is persuaded by FCA’s response that such statements relate to the performance of the vehicle and do not establish the functionality of the Jeep Trade Dress. *See* Complainant’s Pet. Resp. at 56 (citing *Bodum USA, Inc. v. A Top New Casting Inc.*, 927 F.3d 486, 493 (7th Cir. 2019)). The Commission also agrees with FCA that the patents cited by Mahindra (*see* Respondents’ Pet. at 53) do not disclose the functionality of the Jeep Trade Dress. *See* Complainant’s Pet. Resp. at 57. While the patents disclose certain elements of the Jeep Trade Dress, they do not show the

²⁷ Mahindra does not dispute that alternative designs are available but argues that “if functionality is shown, ‘there is no need to consider the availability of alternative designs.’” *See* Respondents’ Pet. at 54 (citing *In re Becton, Dickinson and Co.*, 675 F.3d 1368, 1376 (Fed. Cir. 2012)). As discussed herein, however, the Jeep Trade Dress is not functional.

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functionality for the design elements, much less for the entire Jeep Trade Dress. *See id.* at 54 (citing *Converse*, 909 F.3d at 1124); *see also Millennium Labs.*, 817 F.3d at 1130.

Nor does the FID err in considering the manufacturing and cost advantages of the Jeep Trade Dress as Mahindra alleges. *See* Respondents' Pet. at 54-55. The FID correctly finds no evidence that "the Jeep Trade Dress overall results in a simple method of manufacture" and in fact, certain "elements of the Jeep Trade Dress, including the boxy shape, the flat hood with rounded edges, and the trapezoidal wheel wells extending beyond the grille, actually make vehicle design more challenging." *See* FID at 39 (citing CX-1001C, Allen DWS at Q/As 55, 58, 63); *accord* Complainant's Pet. Resp. at 58 ("[R]ather than focusing on function or cost-efficiency, the undisputed evidence shows that FCA designers seek to create a vehicle that does 'not depart from the heritage look.'" (citing CX-1001C, Allen DWS at Q/As 28, 41).

Lastly, Mahindra faults the FID for failing to consider aesthetic functionality. *See* Respondents' Pet. at 55-56. The Commission disagrees and finds that, while the FID did not explicitly articulate its consideration of aesthetic functionality, it recites the test for finding such functionality. *See* FID at 37 ("Functional features of a product are those which are 'essential to the use or purpose of the article or . . . affect the cost or quality of the article, that is, if exclusive use of the feature[s] would put competitors at a significant non-reputation related disadvantage.'" (citing *TrafFix Devices, Inc. v. Mktg. Displays, Inc.*, 532 U.S. 23, 32 (2001); *Qualitex Co. v. Jacobson Products Co., Inc.*, 514 U.S. 159, 165 (1995))). As the FID finds in the context of the *Morton-Norwich* factors, "other automobile companies make and sell alternatives that do not possess the Jeep Trade Dress." *See id.* at (citing RX-1882C); *accord* Complainant's Pet. Resp. at 59 n.299 (citing McCarthy § 7:81 (noting that "[m]ost modern courts that mention 'aesthetic functionality'" have adopted the competitive necessity test of *TrafFix* and *Qualitex*)).

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Thus, because the exclusive use of the Jeep Trade Dress does not put competitors at a significant non-reputation-related disadvantage, aesthetic functionality is not established.

Accordingly, the Commission has determined to affirm the FID's findings that the Jeep Trade Dress is not functional.

(iii) Secondary Meaning



The FID finds that the Jeep Trade Dress has acquired secondary meaning. *See* FID at 25-35. The FID applies the factors recited in *Converse* (*see supra* section IV(B)) and determines that they each support a finding of secondary meaning. *See id.* The Commission has determined to affirm the FID's conclusion as to secondary meaning but modifies the FID's findings with respect to the first *Converse* factor (*i.e.*, association of the trade dress with a particular source by actual purchasers, which is typically measured by customer surveys).

The FID analyzes the survey evidence in accordance with the Survey Factors considered by the Commission (*see supra* note 11) but discounts the survey evidence presented by both experts on the ground that the controls were improper and either magnified or minimized distinctiveness.²⁸ *See id.* at 28. However, the FID finds that "FCA's own relatively informal, course-of-business survey evidence weighs in favor of finding secondary meaning, and that only weakly." *See id.*

²⁸ The FID also rejects the expert survey evidence on the basis that "[b]oth experts presumably communicated with counsel subject to attorney work product protections, so it is impossible to know how truly independent the experts were from the attorneys who retained them, and both experts were well aware of the litigation and the purpose of their surveys, with the entirely foreseeable result that both surveys were tendentious." *See* FID at 27-28. The Commission has determined to strike this sentence because it is inconsistent with the practice of the courts and the Commission and ignores the widespread and valuable use of surveys in trademark litigation. *See, e.g., Yankee Candle Co., Inc. v. Bridgewater Candle Co.*, 259 F.3d 25, 43 (1st Cir. 2001) ("Although survey evidence is not required, "it is a valuable method of showing secondary meaning.").

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The Commission finds that the FID erred in assigning no weight to Dr. Isaacson’s survey evidence. The FID finds that FCA’s survey evidence suffered from poor controls and thus failed under the sixth Survey Factor. See FID at 27. Specifically, the FID finds that FCA’s survey included a “curvy” control²⁹ (reproduced below) which resulted in low consumer association for the control (weak control) and magnified the level of consumer association with the Jeep brand when the control is subtracted. See *id.* (citing CX-1007 (Isaacson) at Q/As 23 (showing image of control vehicle), 32); see also CX-1007 (Isaacson) at Q/A 67 (showing a low level (5.6%) of respondents indicating that they associate the overall appearance of the control vehicle with Jeep and a high net percentage (55.7%) of respondents who associate the overall appearance of the test vehicle with Jeep). Dr. Isaacson, however, explained that the control is curvy because the asserted trade dress includes a boxy shape and it is “plausible in part because there are lots of other curvy SUV’s on the U.S. market, such as the Porsche Cayenne or BMW X1 today.” See *id.* at Q/A 32.





FCA’s Control Vehicle	FCA’s Test Vehicle
	

²⁹ By “curvy,” the FID explains that the “control vehicle . . . looks nothing like a CJ or a Wrangler” but instead was designed “to inappropriately magnify any results showing an association between the Jeep Trade Dress and its source.” See FID at 27.

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Dr. Isaacson also conducted a second survey to address some of the criticism by Mahindra, and the results showed that the changes did not affect the high level of consumer association of the Jeep Trade Dress with the Jeep brand. *See id.* at Q/As 34 (showing image of revised control vehicle), 35-37.

On the other hand, the Commission finds that the FID was correct to assign no weight to Mahindra’s survey evidence because of at least two critical flaws. First, Mahindra’s expert, Ms. Sarah Butler, used improper controls (reproduced in part below) in that they include substantial portions of the Jeep Trade Dress elements and have “only very minimal changes” compared to the test vehicles. *See CX-1007 (Isaacson) at Q/As 78, 79; RX-1006, Butler DWS at Q/A 137, 146.*

Mahindra’s Control Vehicle	Mahindra’s Test Vehicle
	
	

This resulted in a very high consumer association with the Jeep brand for the controls and minimized the association with Jeep when the control level was subtracted. *See RX-1006,*

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Butler DWS at Q/A 169; *see also Spangler Candy Co. v. Tootsie Roll Indus., LLC*, 372 F. Supp. 3d 588, 598 (N.D. Ohio 2019) (“In designing a survey-experiment, the expert should select a stimulus for the control group that shares as many characteristics with the experimental stimulus as possible, with the key exception of the characteristic whose influence is being assessed.”) (quoting Shari S. Diamond, Reference Guide on Survey Research, in Federal Judicial Center, Reference Manual on Scientific Evidence 359, 401 (3d ed. 2011) (“Diamond”)); *see id.* (“There is a fine line between finding a control which is similar enough to provide accurate results as to likelihood of confusion but not too similar so as to cause confusion itself.”) (citing Jacob Jacoby, Ph.D., Experimental Design and the Selection of Controls in Trademark and Deceptive Advertising Surveys, 92 Trademark Rep. 890, 931 (July-Aug. 2002)); *see also* CX-1155.10 (Diamond).

Second, Ms. Butler’s surveys included an improper universe of purchasers and potential purchasers which were qualified only on the basis of having a driver’s license rather than the correct demographics of purchasers of 2-door SUVs (which Dr. Isaacson used). RX-1006 (Butler) at Q/As 180-181 (“The respondents were men and women who were 16 years or older, who have a valid driver’s license and reside in the United States.”); *compare* CX-1007 (Isaacson) at Q/A 46 (showing that the demographics of Dr. Isaacson’s survey database was consistent with purchasers of 2-door SUVs). This had the effect of skewing the results of Ms. Butler’s survey. *See id.* at Q/As 72-74.

Thus, the Commission finds that Dr. Isaacson’s survey evidence is more reliable and credible than Ms. Butler’s survey evidence, and therefore the Commission assigns more weight to Dr. Isaacson’s survey evidence. Accordingly, the Commission finds that the *Converse*

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factors support a finding of secondary meaning, and the Commission has determined to affirm the FID with modification, as discussed above.

2. Likelihood of Confusion

The Commission finds that the FID correctly applies the *Dupont* factors (*see supra* section II(B)) for likelihood of confusion except as to factor seven (actual confusion). The Commission also finds that the FID correctly concludes that, on balance, the factors favor a finding of likelihood of confusion. As to factor seven (actual confusion), the Commission has determined to affirm the FID with modification.

The FID finds that factor seven (actual confusion) weighs in favor of a likelihood of confusion. *See* FID at 46-49. The FID states that “a number of consumers and dealers wrote online to Mahindra about the Roxor, either thinking that the product was a Jeep vehicle or suggesting that it had some association with the Jeep brand.” *See id.* at 47 (citing CX-1078C; CX-1079C; CX-1080C; CX-1092C.1 ([

]); CX-1093C.1). The FID further finds that “[a] number of magazine and newspaper articles illustrate actual confusion regarding either the source of the Roxor vehicle or Mahindra’s right to manufacture a Jeep.” *See id.* (citing CX-1297C.1 (“The Mahindra Roxor Is A Tiny Offroad Jeep That You Can Totally Buy In America.”); CX-1575; CX-1576; CX-1577; CX-1578; CX-1001C (Allen) at Q/As 94-96 (citing CX-1700, CX-1701); CX-1012C (Carvallo³⁰) at Q/As 53-54; CX-1212; CX-1213; CX-1214; CX-1215; CX-1216). The FID, however, assigns little weight to FCA’s expert survey evidence on the basis that “it did not use an effective control.” *See id.* at 49 (citing CX-1010; SIB at 64-67).

³⁰ Anthony David Carvallo was previously employed by FCA as Product Planning Manager for Jeep Wrangler.

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FCA asserts that the FID “properly found that the evidence of actual confusion ‘strongly suggests that consumers are confused about the origin of the Roxor vehicle.’” *See* Complainant’s Pet. Resp. at 70 (citing FID at 46). FCA further noted that “the Lanham Act expressly protects against source confusion as well as confusion as to ‘affiliation, connection, or association’ between companies and ‘origin, sponsorship, or approval’ of a product.” *See id.* (citing 15 U.S.C. § 1125(a)(1)(A) (emphasis in original); McCarthy § 23:5 (“Source confusion is not the boundary, for actionable confusion includes confusion as to affiliation, connection or sponsorship.”)). FCA, however, faults the FID for assigning little weight to its expert survey. *See id.* at 71-72. FCA argues that the control used by its expert is proper and explains that “Mr. Poret³¹ retained or ‘kept constant’ the vast majority of the non-infringing elements, which allowed him effectively and properly to control for all possible noise, including the UTV category, Mahindra badging and logos, the front bumper and tow hook, tires, lights on top of the vehicle, side mirrors, seating and head rests, the American flag seal and angled awning.” *See id.* at 72 (citing CX-1010 (Poret) at Q/A 22, 41, 45).

The Commission finds that the record evidence supports the FID’s finding that factor seven (actual confusion) weighs in favor of likelihood of confusion. However, the Commission finds that the FID errs in assigning little weight to FCA’s survey evidence based on a finding that the control is not effective. Instead, the Commission finds that the control image used by FCA’s expert (reproduced below) is adequate and properly filters out the effect of the Jeep Trade Dress,

³¹ Hal Poret was retained as an expert for FCA in this investigation.

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i.e., the infringing elements.³² See CX-1010C (Poret) at Q/As 19, 22, 41.

FCA’s Control Vehicle	FCA’s Test Vehicle
	

As explained by FCA’s expert, “The UTV shown to the control group was an ideal control in that it removed the allegedly confusing elements of the Mahindra Roxor but kept constant as many other elements as possible.” See CX-1010 (Poret) at Q/A 22. FCA’s survey evidence showed a net confusion rate of 44.7 percent. See *id.* at Q/A 45. Mahindra offers no competing survey evidence in connection with this factor. Thus, the Commission finds that Mr. Poret’s survey evidence is reliable and credible and should have been assigned more weight.

Accordingly, while the FID correctly concludes that the *Dupont* factors support a finding of likelihood of confusion, the Commission has determined to affirm the FID with modification as to factor seven (actual confusion). Specifically, the Commission has determined to assign

³² However, as discussed *infra* section V(B), this survey evidence is not reliable to assess the effect of the grille component alone because the test vehicle does not sufficiently remove the other components of the Jeep Trade Dress making it difficult to measure the effect attributable to the grille component as opposed to the effect attributable to the other elements of the trade dress, or the trade dress as a whole.

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more weight to Mr. Poret’s survey evidence, which shows a high level of actual confusion (44.7 percent) and further supports a finding that this factor weighs in favor of likelihood of confusion.

Accordingly, the Commission finds that FCA has shown by a preponderance of the evidence that Mahindra’s accused vehicles infringe the Jeep Trade Dress.

B. Trademark Infringement

The FID finds that Respondents’ Roxor vehicle does not infringe FCA’s Registered Trademarks, *i.e.*, the Jeep grille design marks. *See* FID at 62-68. As discussed below, the Commission has determined to affirm with modification the FID’s finding of non-infringement of the Registered Trademarks.

The FID considers the *Dupont* factors and finds that they weigh against a finding of likelihood of confusion. *See id.* Specifically, the FID finds that “the lack of evidence of actual confusion is particularly significant” and “[e]ven more significant is the degree of dissimilarity between the registered marks and the Roxor grille.” *See id.* at 67-68. The Commission finds that the FID correctly concludes against likelihood of confusion but errs in its analysis of the seventh factor (actual confusion). The Commission also supplements the FID’s analysis as to the first factor (similarity of the marks).

As to the first factor (similarity or dissimilarity of the marks), the Commission agrees with the FID that it weighs against likelihood of confusion. *See* FID at 62-64. While FCA argues that the FID fails to analyze this factor from the perspective of consumers, FCA presented no “consumer perception” evidence to support its position. Specifically, FCA does not measure the consumer’s perception as to the similarity of the Jeep Grille marks because FCA’s evidence does not filter out the effect of the other elements of the Jeep Trade Dress. *Accord*

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Respondents' Pet. Resp. at 7; *see also* Respondents' Pet. at 78-79; RX-1007 (Franklyn³³) at Q/A 45 (finding a net actual confusion of 2%).

As to the seventh factor (actual confusion), the FID finds that "this factor is neutral." *See* FID at 66. The FID reasons that "[n]either party's survey evidence on this issue is particularly reliable" because "FCA's expert, Mr. Hal Poret, did not focus his testing on the Jeep Grille Design Marks" and "Respondents' expert, Mr. Franklyn, did not use a proper test image." *See id.* (citing CX-1010C (Poret) at Q/As 74-100; RX-2606). The Commission disagrees and finds that the control images (reproduced below) used by both parties' experts were adequate in that they filter out the effect of the Jeep Trade Dress. *See* CX-1010C (Poret) at Q/A 22; RX-1007 (Franklyn) at Q/A 154. However, as to the test vehicles (also reproduced below), unlike Mahindra's expert, FCA's expert did not sufficiently remove the other components of the Jeep Trade Dress making it difficult to measure the effect attributable to the grille component as opposed to the effect attributable to the other elements of the Jeep Trade Dress. CX-1010C (Poret) at Q/A 15; RX-1007 (Franklyn) at Q/A 141.

³³ David Franklyn was retained as an expert by Mahindra in this investigation.

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FCA's Control Vehicle	FCA's Test Vehicle
 <p>The image shows the Mahindra Roxor logo, which is a diamond-shaped emblem with 'MAHINDRA' at the top, 'ROXOR' in large letters in the center, and 'OFFROAD' at the bottom. Below the logo is a white Mahindra Roxor utility vehicle with a black roll-over protection structure and a roof-mounted light bar.</p>	 <p>The image shows the Mahindra Roxor logo. Below it is a white Jeep Wrangler utility vehicle with a black roll-over protection structure and a roof-mounted light bar, presented as FCA's test vehicle.</p>
Mahindra's Control Vehicle	Mahindra's Test Vehicle
 <p>The image shows a grey Mahindra utility vehicle with a black roll-over protection structure and a cargo bed at the rear.</p>	 <p>The image shows a grey Jeep Wrangler utility vehicle with a black roll-over protection structure and a cargo bed at the rear, presented as Mahindra's test vehicle.</p>

In addition, FCA's expert argued that Mahindra's test vehicle is flawed because it does not use the Roxor vehicle and therefore, it does not "replicate the relevant marketplace conditions by showing the 'mark' as it would be encountered in the actual marketplace by potential consumers." CX-1010C (Poret) at Q/A 98. However, the Commission finds that Mahindra's test vehicle replicates the marketplace conditions as much as possible while

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removing the other elements of the Jeep Trade Dress which is necessary to single out the effect of the grille component. *See* RX-1007 (Franklyn) at Q/As 141, 154, 169 (using a Kubota RTV 500 vehicle with and without the Roxor grille component).

Thus, the Commission finds that Mr. Franklyn’s survey evidence is more reliable and credible (for measuring the effect of the grille component alone) and should be assigned more weight. Accordingly, the Commission finds that the actual confusion factor is not neutral but weighs against a finding of likelihood of confusion. *Accord* Respondents’ Pet. at 78-79; RX-1007 (Franklyn) at Q/As 45, 166 (finding a net actual confusion of 2 percent).

Accordingly, the Commission finds that the FID correctly concluded that FCA did not establish likelihood of confusion as to the Jeep Grille Registered Trademarks but that the FID erred in its analysis of factor seven (actual confusion). Thus, the Commission has determined to affirm the FID’s finding of non-infringement of the Registered Trademarks with modification, as discussed above.

C. Importation

The FID finds that the importation requirement is satisfied as to the Roxor vehicle (trade dress infringement claims) but not the grille component (trademark infringement claim). *See* FID at 19, 74. The FID notes that “[i]t is undisputed that the Roxor grille is not imported,” and finds that “this provides an alternative ground³⁴ for a finding of no violation with respect to the Roxor grille.” *See id.* at 74 (citing Joint Stipulation Regarding Importation (June 21, 2019)). The FID, however, determines that “[t]his finding does not preclude the finding that Respondents’ Roxor vehicle as a whole is ‘imported.’” *See id.* The Commission has

³⁴ As discussed supra section V(B), the FID also finds no violation with respect to the Roxor grille based on a finding of no trademark infringement.

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determined to affirm with modification the FID’s finding that the importation requirement is satisfied as to the Roxor vehicle and FCA’s claim of infringement of the (unregistered) Jeep Trade Dress under section 337(a)(1)(A). Further, the Commission did not review (and thereby affirms) the FID’s finding that the importation requirement is not met as to the grille component with regard to FCA’s registered trademark claims.

Mahindra argued that the FID exceeded its authority in finding that the importation requirement is satisfied as to the trade dress infringement claim because the Roxor vehicle is assembled in the United States and [

]. *See* Respondents’ Pet. at 82. Mahindra further argues that *Suprema*, in which the *en banc* Federal Circuit held that the Commission may find a violation based on induced patent infringement where the underlying direct infringement occurs after importation, is inapposite because there is no indirect infringement in this case. *See id.* at 83-84 (citing *Suprema, Inc. v. ITC*, 796 F.3d 1338 (Fed. Cir. 2015) (*en banc*)). In response, FCA asserts that Mahindra waived its importation arguments with respect to the Roxor vehicle. *See* Complainant’s Pet. Resp. at 81-82. FCA further argues that, under section 337, “articles that infringe cover goods that were used by an importer to directly infringe post-importation.” *See id.* at 82 (citing *Suprema*, 796 F.3d at 1349).

The Commission finds that the FID correctly concludes that the importation requirement is satisfied as to the Roxor vehicle and FCA’s claim of infringement of the (unregistered) Jeep Trade Dress under section 337(a)(1)(A). In response to the parties’ arguments concerning *Suprema*, the Commission clarifies that the Federal Circuit’s analysis in *Suprema* is not directly applicable to the facts of this investigation. Indeed, section 337(a)(1)(A) does not include the language “articles that infringe” which was construed in *Suprema*. *See* 19 U.S.C.

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§ 1337(a)(1)(A); *compare Suprema*, 796 F.3d at 1345 (quoting 19 U.S.C. § 1337(a)(1)(B)(i)). Rather, the test for unfair acts under section 337(a)(1)(A) requires a “nexus between the imported articles and the unfair methods of competition.” *See TianRui Group Co. v. ITC*, 661 F.3d 1322, 1325 (Fed. Cir. 2011); *see also Certain Activity Tracking Devices, Systems, & Components Thereof*, Inv. No. 337-TA-963, Initial Determination, 2016 WL 11596099, *9 (Aug. 23, 2016) (“If there is some nexus between the unfair methods or acts and importation, the Commission’s jurisdiction is established.”) (citing *Certain Molded-in Sandwich Panel Inserts*, Inv. No. 337-TA-99, Comm’n Op., 1982 WL 61887, at *2 (Apr. 1982), *aff’d*, *Young Eng’rs, Inc. v. ITC*, 721 F.2d 1305 (Fed. Cir. 1983)).

The Commission finds that a nexus is readily apparent in the context of trade dress infringement by the Roxor vehicle given that [

]. *See* FID at 20.

D. Domestic Industry

The FID finds that FCA has satisfied the domestic industry requirement. *See* FID at 75-78. Given that the Commission has determined to find no violation of section 337 on FCA’s trademark infringement claim based on no importation and no likelihood of confusion, as discussed *supra*, the Commission has determined to take no position on the domestic industry issue with respect to the Registered Trademarks. *See Beloit Corp. v. Valmet Oy*, 742 F.2d 1421, 1423 (Fed. Cir. 1984).

With regard to the Jeep Trade Dress, the FID also finds that FCA has shown injury to a domestic industry as required under section 337(a)(1)(A), a finding the Commission adopted without review. *See* FID at 78-84; *see* 85 Fed. Reg. at 5035.

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Based on the preceding discussion, the Commission finds that FCA has demonstrated a violation of section 337 in the importation of Mahindra's vehicles and components thereof that infringe the Jeep Trade Dress.

IV. REMEDY, PUBLIC INTEREST, AND BONDING

A. Limited Exclusion Order

The Commission has "broad discretion in selecting the form, scope, and extent of the remedy." *Viscofan, S.A. v. US. Int'l Trade Comm'n*, 787 F.2d 544, 548 (Fed. Cir. 1986).

Section 337(d)(1) provides that "[i]f the Commission determines, as a result of an investigation under this section, that there is a violation of this section, it shall direct that the articles concerned, imported by any person violating the provision of this section, be excluded from entry into the United States, unless, after considering the [public interest], it finds that such articles should not be excluded from entry." 19 U.S.C. § 1337(d)(1).

The RD recommends that the Commission issue an LEO excluding Respondents' infringing ROXOR motor vehicles and components thereof. *See* RD at 87. Although Mahindra did not dispute the scope of the LEO before the ALJ, *see id.*, Mahindra now argues that the LEO should be limited to Mahindra's 2018-2019 model and should not include the 2020 ROXOR or the next generation ROXOR (the "Post 2020 ROXOR") because they "are missing key elements of the claimed trade dress and cannot infringe." *See* Respondents' Remedy Br. at 2. Mahindra additionally requests that the effective date of any LEO issued by the Commission should be delayed to permit Mahindra time to obtain a ruling from U.S. Customs and Border Protection ("CBP") that neither the 2020 ROXOR nor the Post 2020 ROXOR should be subject to exclusion. *Id.* at 13-14. Mahindra also seeks "an exemption for the importation of parts necessary to service and repair vehicles already in the possession of consumers and the standard

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certification provision to facilitate CBP's administration of the order." *See id.* at 12. FCA does "not oppose Respondents' request to certify that the importation of certain components is for service and repair of existing Roxor vehicles already in the possession of customers," but FCA rejects Mahindra's request to exempt Mahindra's newer models or to delay the effective date of the remedial orders. *See Complainant's Remedy Resp.* at 3-4 and 8-9; *accord IA's Remedy Resp.* at 5-6.

The Commission has determined to issue an LEO in this investigation barring the entry of Respondents' vehicles and components thereof that infringe the Jeep Trade Dress. *Cf.* RD at 87; IA's Remedy Br. at 3-4. The Commission has also determined that the LEO should include an exemption for service and repair of vehicles already in the possession of consumers. The exemption is uncontested and consistent with Commission practice. *See, e.g., Certain Automated Teller Machines, ATM Modules, Components Thereof, & Prods. Containing the Same*, Inv. No. 337-TA-972, Comm'n Op., 2017 WL 11198798, *16 (June 12, 2017) ("*Automated Teller Machines*"). The Commission has further determined that the LEO should include the standard certification provision. The certification provision is justified because it may not be readily apparent by inspection whether a component is covered or exempted by the LEO. *See Certain Graphics Sys., Components Thereof, & Consumer Prods. Containing the Same*, Inv. No. 337-TA-1044, Comm'n Op. at 65-66 (Sept. 18, 2018). The Commission directs that CBP accept certifications only as to Mahindra's vehicles and components thereof that are subject to the exemption for service and repair or that have been determined by the Commission not to infringe. *See Automated Teller Machines*, 2017 WL 11198798, at *17 ("The standard certification language does not apply to redesigns that have not been adjudicated as non-infringing.") (quotation omitted); *see also Eaton Corp. v. United States*, 395 F. Supp. 2d 1314,

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1320-21 (Ct. Int'l Trade 2005) (enjoining CBP from accepting a self-certification as to unadjudicated redesigned products).

The Commission disagrees that the LEO should exempt Mahindra's newer models or be delayed until such time that those models are adjudicated as outside the scope of the LEO. Mahindra did not seek adjudication of its newer models before the ALJ and therefore cannot seek adjudication of its newer models at this stage of the investigation. Mahindra can obtain such adjudication in Commission modification (under Commission Rule 210.76, 19 C.F.R. § 210.76) or advisory proceedings (under Commission Rule 210.79, 19 C.F.R. § 210.79). Significantly, once the Commission determines that Mahindra violates section 337 and that an LEO is warranted, the exclusion order is not limited to the model(s) determined to be infringing but extends to cover other infringing products including redesigns thereof. *See Certain Optical Disk Controller Chips & Chipsets & Prods. Containing Same, Including DVD Players & PC Optical Storage Devices*, Inv. No. 337-TA-506, Comm'n Op., 2007 WL 4713920, *64 (Sept. 28, 2005) ("Optical Disk Controller") ("[W]hile individual models may be evaluated to determine importation and infringement, the Commission's jurisdiction extends to all models of infringing products that are imported at the time of the Commission's determination and to all such products that will be imported during the life of the remedial orders.") (internal quotation omitted).

Under the specific facts of this case involving a trade dress related to an assembled motor vehicle—where Mahindra assembles the infringing Roxor vehicle (including any future redesigns thereof, *e.g.*, the 2020 ROXOR and the Post 2020 ROXOR vehicles) in the United States [], and where it is not readily apparent by inspection at the border whether a component forms a part of a vehicle that

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infringes the Jeep Trade Dress—the Commission has determined to require Mahindra to obtain a ruling (via an advisory opinion or a modification proceeding) from the Commission prior to the importation of any component for the infringing Roxor vehicle, including for any future redesign thereof (subject to the exemption for service and repair parts for vehicles already in the possession of consumers as discussed above). *See Canadian Tarpoly Co. v. USITC*, 640 F.2d 1322, 1326 (C.C.P.A. 1981) (affirming the Commission’s authority to require an advisory opinion); *see also* 19 C.F.R. § 210.79 (advisory opinions); 19 C.F.R. § 210.76 (modification proceedings). If the Commission determines in a proceeding under Commission Rule 210.76 or 210.79 (19 C.F.R. §§ 210.76, 210.79) that any of Mahindra’s newer models is outside the scope of the LEO, Mahindra may then certify to CBP that the imported components relate to vehicles that were adjudicated as non-infringing by the Commission in such a proceeding. Mahindra bears the burden of establishing that the newer models are not within the scope of the LEO. *See Hyundai Elecs. Indus. Co. v. USITC*, 899 F.2d 1204, 1210 (Fed. Cir. 1990) (upholding the Commission’s practice of “shift[ing] to would-be importers of potentially infringing articles, as a condition of entry, the burden of establishing noninfringement”); *see also* 19 U.S.C. § 1337(k)(2)(A) (“If any person who has previously been found by the Commission to be in violation of this section petitions the Commission for a determination that the petitioner is no longer in violation of this section or for a modification or rescission of an exclusion from entry or order under subsection (d), (e), (f), (g), or (i)[,] . . . the burden of proof in any proceeding before the Commission regarding such petition shall be on the petitioner.”).

Thus, the Commission has determined to: (1) issue an LEO covering “motorized vehicles, kits and assemblies for motorized vehicles, and replacement and aftermarket components for motorized vehicles that infringe the Jeep Trade Dress”; (2) include an exemption

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for service and repair parts for vehicles already in the possession of consumers; (3) include the standard certification provision in the LEO; and (4) require Respondents to obtain a ruling from the Commission under Commission Rules 210.76 or 210.79 (19 C.F.R. §§ 210.76, 210.79) prior to the importation of any component for the infringing Roxor vehicle, including for any future redesign thereof.³⁵

B. Cease and Desist Order

Section 337 provides that in addition to, or in lieu of, the issuance of an exclusion order, the Commission may issue a CDO as a remedy for violation of section 337. *See* 19 U.S.C. § 1337(f)(1). The Commission generally issues CDOs with respect to the imported infringing products when “respondents maintain commercially significant inventories in the United States or have significant domestic operations that could undercut the remedy provided by an exclusion

³⁵ The Commission notes that, unlike remedial orders directed to articles that infringe patents, copyrights, mask works, or vessel hull designs, the remedial orders issued in this investigation do not include an exemption for articles imported by or for the use of the United States. The absence of that exemption is appropriate because the relevant statutory language, pursuant to 19 U.S.C. § 1337(l), exempts from exclusion articles imported by or for the use of the United States “in cases based on a proceeding involving a patent, copyright, mask work, or design under subsection (a)(1).” The statutory language does not include within the ambit of the exemption cases involving other intellectual property rights, such as a trademark or trade dress. Subsection 337(l) explicitly states that a patent, copyright, mask work, or design owner who is adversely affected by the importation of an article by or for the government that would otherwise have been excluded “shall be entitled to reasonable and entire compensation in an action before the United States Court of Federal Claims pursuant to the procedures of section 1498 of title 28.” *See* 19 U.S.C. § 1337(l). Section 1498, however, is limited to claims based on patents, copyrights, protected plant varieties, mask works, and boat hull designs and does not provide an avenue for claimants to seek compensation for infringing use of a trademark or trade dress by or for the United States. *See* 28 U.S.C. § 1498(a), (b), (d), (e). Finally, the legislative history of section 337 also demonstrates that Congress considered and subsequently declined to provide a government exemption for other intellectual property cases not enumerated in section 337(l) and for which no remedy under section 1498 is available, such as cases involving a trademark or trade dress. *See, e.g.*, S. Rep. No. 100-71, 351 (1987) (indicating the inclusion of trademark and trade secret cases within the scope of the exemption in section 337(l) in draft amendments that were later removed before the legislation’s passage).

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order.”³⁶ See, e.g., *Certain Table Saws Incorporating Active Injury Mitigation Technology & Components Thereof* (“Table Saws”), Inv. No. 337-TA-965, Comm’n Op. at 4-6 (Feb. 1, 2017); *Certain Protective Cases & Components Thereof*, Inv. No. 337-TA-780, USITC Pub. No. 4405, Comm’n Op. at 28 (Nov. 19, 2012) (citing *Certain Laser Bar Code Scanners & Scan Engines, Components Thereof & Prods. Containing Same*, Inv. No. 337-TA-551, Comm’n Op. at 22 (June 24, 2007)). Complainants bear the burden on this issue. “A complainant seeking a cease and desist order must demonstrate, based on the record, that this remedy is necessary to address the violation found in the investigation so as to not undercut the relief provided by the exclusion order.” *Table Saws*, Comm’n Op. at 5 (citing *Certain Integrated Repeaters, Switches, Transceivers, & Prods. Containing Same*, Inv. No. 337-TA-435, USITC Pub. No. 3547 (Oct. 2002), Comm’n Op. at 27 (Aug. 16, 2002); see also H.R. REP. No. 100-40, at 160 (1987)).

The RD recommends that the Commission issue CDOs against all Respondents because “Respondents maintain a commercially significant inventory of infringing articles in the U.S.” See RD at 87-88 (citing CX-1011C (Vander Veen³⁷) at Q/A 131; CX-1035C). In briefing before the Commission, Mahindra argues that “[t]he Commission should not issue a CDO because Mahindra does not maintain a ‘commercially significant’ inventory of ROXOR vehicles to circumvent any LEO.” See Respondents’ Remedy Br. at 19 (citing RX-1008C (Green³⁸) at

³⁶ When the presence of infringing domestic inventory or domestic operations is asserted as the basis for a CDO under section 337(f)(1), Commissioner Schmidtlein does not adopt the view that the inventory or domestic operations needs to be “commercially significant” in order to issue the CDO. See, e.g., *Certain Magnetic Tape Cartridges and Components Thereof*, Inv. No. 337-TA-1058, Comm’n Op. at 65, n.24 (Mar. 25, 2019); *Table Saws*, Comm’n Op. at 6-7, n.2 (Feb. 1, 2017). In Commissioner Schmidtlein’s view, the presence of some infringing domestic inventory or domestic operations, regardless of its commercial significance, provides a basis to issue a CDO. See *id.*

³⁷ Dr. Thomas D. Vander Veen was retained as an expert for FCA.

³⁸ Philip Green was retained as an expert for Mahindra.

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Q/A 255). Mahindra further argues in its briefing to the Commission that “only the domestic respondent, MANA, maintained any inventory of accused ROXOR vehicles and components thereof” and “[t]here is no evidence that the foreign respondent maintains any inventory of accused products in the United States.” *See id.* at 21. FCA responds that “[t]he ALJ correctly found that [

] were commercially significant.” *See* Complainant’s Remedy Resp. at 11. FCA further argues that “Respondents have failed to substantiate their new claim that the inventory belongs only to Respondent MANA.” *See id.* at 10.

The Commission finds that CDOs are warranted against both Respondents. FCA’s expert, Dr. Vander Veen, testified that both Respondents maintained the existing domestic inventory of infringing articles. *See* CX-1011C at Q/A 130-131 (citing CX-1035C and CX-1339C). Mahindra’s expert, Mr. Green, did not dispute FCA’s contentions and evidence. In fact, Mr. Green’s testimony confirms that both Respondents maintain the inventory. Notably, Mr. Green’s testimony acknowledged that “[

]” RX-1008C at Q/A at 262 (emphasis added); *see also* Q/A at 29 ([]). Mr. Green only disputed the level of the inventory and whether the inventory was commercially significant. Based on this record, and the assessment that Dr. Vander Veen’s testimony was “reliable,” the ALJ recommended CDOs as to both Respondents. *See* RD at 87-88.

In their remedy briefing before the Commission, Respondents for the first time argued that M&M does not maintain the domestic infringing inventory. *See* Respondents’ Remedy Br. at 21. Respondents’ argument was not raised before the ALJ and is therefore waived. In

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addition, Respondents make no attempt to reconcile their new position with Mr. Green’s acknowledgement that “[

].”

Under these circumstances, the Commission finds that the record evidence supports a finding that both Respondents maintain the existing inventory. *See Certain Magnetic Tape Cartridges and Components Thereof*, Inv. No. 337-TA-1058, Comm’n Op. at 67 (March 25, 2019) (“[I]n discussing the issuance of a CDO order, the RD and the parties refer to Fujifilm collectively (both foreign and domestic entities) Accordingly, the Commission has determined to issue CDOs directed to all Fujifilm respondents.”).

The Commission also agrees with the RD that the inventory held by Respondents is commercially significant and supports the issuance of the CDOs. Mahindra does not dispute the RD’s findings that “[

],” *see* RD at 88 (citing RX-1007C (Green) Q/As 262-66) and that “[

],” *see id.* (citing RX-1007C (Green) at Q/A 267).³⁹ *Accord* IA’s Remedy Resp. at 6-7.

Thus, the Commission has determined to issue CDOs against both Respondents. In addition, for the same reasons discussed *supra* section IV(A) in connection with the LEO, the Commission has determined that the CDOs should include an exemption for service and repair parts for vehicles already in the possession of consumers.

³⁹ Commissioner Schmidlein agrees that the record evidence supports finding that both Respondents maintain the existing inventory and therefore supports issuing CDOs against both MANA and M&M, regardless of the commercial significance of the domestic inventory.

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C. The Public Interest

Section 337 requires the Commission, upon finding a violation of section 337, to issue an LEO “unless, after considering the effect of such exclusion upon the public health and welfare, competitive conditions in the United States economy, the production of like or directly competitive articles in the United States, and United States consumers, it finds that such articles should not be excluded from entry.” 19 U.S.C. § 1337(d)(1). Similarly, the Commission must consider these public interest factors before issuing CDOs. 19 U.S.C. § 1337(f)(1).

1. Public Health and Welfare

Mahindra argues that “[a]n order banning the importation of parts used in the manufacture and repair of the ROXOR would have a severe detrimental impact on the welfare of thousands of Americans.” *See* Respondents’ Remedy Br. at 26. Mahindra reasons that “untailored remedial orders would dramatically and negatively affect the welfare of the American workforce by hindering the company responsible for hundreds of existing jobs and thousands of expected new jobs, an aberrant result for an ITC remedy, which is intended to protect, rather than hinder, U.S. industries.” *See id.* Mahindra further argues that “[t]he entry of a remedial order would also negatively affect [] power sports distributors and dealerships, ROXOR parts and equipment suppliers, and other entities (and their respective employees) throughout the United States who have invested in the success of the ROXOR.” *See id.; supra* section I(A) (written submissions and public interest statements filed by non-parties in support of Mahindra).

FCA responds that Mahindra’s arguments are “nonsensical because it is fully within Respondents’ control to protect these employees’ jobs simply by steering clear of FCA’s Jeep Trade Dress.” *See* Complainant’s Remedy Resp. at 12. Moreover, FCA continues, “the

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public has a compelling interest in protecting FCA’s Jeep Trade Dress, which is linked to a substantial domestic industry,” including thousands of employees, and hundreds of millions of dollars invested.” *See id.* The IA further responds that “[w]hile the elimination of jobs resulting from the entry of the requested remedial orders may cause concern for Respondents and their affiliated third-parties, that concern does not appear to OUII to be unique to this investigation.” *See IA’s Remedy Resp.* at 8.

The Commission finds that the evidence presented by the parties and third parties does not weigh against the issuance of the requested remedial orders based on public health and welfare concerns. Mahindra itself can choose to make business decisions that would avoid any harm to its workforce and to others (including the non-parties who filed written submissions and public interest statements in support of Mahindra, *see supra* section I(A)) by steering clear of the Jeep Trade Dress and promptly seeking an adjudication of whether its redesigns infringe the Jeep Trade Dress pursuant to procedures available under Commission Rules 210.76 and 210.79, 19 C.F.R. §§ 210.76, 210.79. Mahindra could have sought an earlier adjudication of its redesign before the ALJ, and thereby avoided any harm it now claims, but Mahindra failed to do so at the appropriate juncture in the investigation.

Thus, based on the record, the Commission has determined that public health and welfare considerations do not weigh against the remedial orders discussed *supra* sections IV(A)-(B).

2. Competitive Conditions in the United States Economy

Mahindra argues that “if the ROXOR vehicle directly competes with the Wrangler, then *a fortiori* the exclusion of the ROXOR vehicle from the United States would harm competitive conditions in the U.S. economy, which weighs against the issuance of a broad exclusion order.” *See Respondent’s Remedy Br.* at 27. FCA identifies “two non-infringing alternative off-road

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motorized vehicles manufactured and sold throughout the United States by third parties Polaris and Can-Am, as well as a vehicle produced by Complainant.” *See* Complainant’s Remedy Br. at 17 (citing <https://www.off-road.com/blog/2018/03/05/how-much-does-the-mahindra-roxor-cost/>). The IA argues that there is no “evidence that the requested remedial orders would adversely affect competitive conditions in the United States economy.” *See* IA’s Remedy Br. at 8. The IA reasons that “Respondents themselves could redesign the ROXOR vehicle and introduce a non-infringing alternative that serves as a substitute product in a commercially reasonable time.” *See id.* at 8-9.

The Commission agrees with FCA and the IA that the presence of suppliers providing alternative non-infringing vehicles (including Mahindra should its purported redesigns be found non-infringing under appropriate Commission proceedings) negate any conclusion that the remedial orders would have an adverse effect on the competitive conditions in the United States economy.

3. The Production of Like or Directly Competitive Articles

As to this factor, Mahindra repeats its argument that the remedial orders “would adversely affect the domestic production and U.S. workers who make these parts.” *See* Respondents’ Remedy Br. at 28. However, for the same reasons discussed *supra* section IV(D)(1)-(2), the Commission finds that, based on the record evidence, the public interest consideration relating to the production of like or directly competitive products in the United States does not weigh against issuance of the remedial orders discussed *supra* sections IV(A)-(B). *Accord* IA’s Remedy Br. at 9-10; Complainant’s Remedy Br. at 17.

4. United States Consumers

Mahindra argues that the remedial orders “would deprive the consumer of a valuable purchasing option without providing a reasonable replacement” because “[n]o other off-road-

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only vehicle has the power and versatility of the ROXOR, and it would take others years to launch a product that would fulfill public demand for the ROXOR.” *See* Respondents’ Remedy Br. at 28. As discussed above, however, the Commission finds that the presence of suppliers providing alternative non-infringing vehicles (including Mahindra should its purported redesigns be found non-infringing under appropriate Commission proceedings) negate any conclusion that the remedial orders would have an adverse effect on U.S. consumers. *Accord* Complainants’ Remedy Br. at 17-18; IA’s Remedy Br. at 11-12.

5. Conclusion

Based on the record evidence, as to the public health and welfare, the competitive conditions in the United States economy, the production of like or directly competitive products in the United States, and United States consumers, the Commission finds it appropriate to issue an LEO directed against infringing products and CDOs directed against both Respondents, with such orders including an exemption for service and repair parts for products already in the possession of consumers. Thus, the Commission has determined that the public interest factors do not preclude the issuance of remedial orders in this investigation.

D. Bonding

When the Commission enters an exclusion order or a cease and desist order, a respondent may continue to import and sell its products during the 60-day period of Presidential review under a bond in an amount determined by the Commission to be “sufficient to protect the complainant from any injury.” 19 U.S.C. § 1337(j)(3); see also 19 C.F.R. § 210.50(a)(3). When reliable price information is available in the record, the Commission has often set the bond in an amount that would eliminate the price differential between the domestic product and the imported, infringing product. *See Certain Microsphere Adhesives, Processes for Making Same, & Prods. Containing Same, Including Self-stick Repositionable Notes*, Inv. No. 337-TA-366,

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USITC Pub. No. 2949, Comm'n Op. at 24 (Jan. 16, 1996). The Commission also has used a reasonable royalty rate to set the bond amount where a reasonable royalty rate could be ascertained from the evidence in the record. *See, e.g., Certain Audio Digital-to-Analog Converters & Prods. Containing Same*, Inv. No. 337-TA-499, Comm'n Op. at 25 (Mar. 3, 2005). Where the record establishes that the calculation of a price differential is impractical or there is insufficient evidence in the record to determine a reasonable royalty, the Commission has imposed a 100 percent bond. *See, e.g., Certain Liquid Crystal Display Modules, Prods. Containing Same, & Methods Using the Same*, Inv. No. 337-TA-634, Comm'n Op. at 6-7 (Nov. 24, 2009). The complainant, however, bears the burden of establishing the need for a bond. *Certain Rubber Antidegradants, Components Thereof & Prods. Containing Same*, Inv. No. 337-TA-533, USITC Pub. No. 3975, Comm'n Op. at 40 (July 21, 2006).

Consistent with Mahindra and the IA's proposal, the RD recommends a "bond of 10 percent based on unassembled Roxor components imported into the U.S., or a bond of 1 percent based on the finished Roxor vehicle" during the period of Presidential review. *See* RD at 89-90; *accord* Respondents' Remedy Br. at 24; IA's Remedy Br. at 13. FCA argues that "[a] bond rate of 100% of the entered value of the imported articles is appropriate." *See* Complainant's Remedy Br. at 14-15. FCA provides no evidentiary support for its argument that "it is impractical if not impossible to undertake a price comparison to determine underselling of the components as compared to FCA's Wrangler® brand vehicles." *See id.* at 14-15; *see also* FID at 89. However, FCA provides a price comparison between the assembled Roxor and a Wrangler® brand vehicle showing a price differential range of [] of the price of the Roxor. *See* Complainant's Remedy Br. at 14-15. FCA also argues that a bond rate set at a reasonable royalty would be inappropriate, as FCA has never licensed the Jeep Trade Dress to

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any third party for use on motor vehicles or UTVs. *See id.* at 15. FCA does not address bonding in its reply submission.

The Commission finds that the record evidence supports the RD’s ten (10) percent bond recommendation as to unassembled Roxor components. The RD determined that “[

].” *See* RD at 89 (citing RX-1008C (Green), at Q/A 281 (citing JX-1115C)).

Thus, the Commission finds it appropriate to impose a bond in the amount of ten (10) percent of the entered value of unassembled Roxor components. With respect to any finished Roxor vehicles imported in the United States, the Commission has determined to set the bond at one hundred (100) percent, rather than the recommended one (1) percent bond. The one (1) percent bond assessment recommended in the RD for finished Roxor vehicles is based on evidence showing that FCA has entered into royalty agreements for use of its Jeep trademarks with companies that make battery-operated toy vehicles. *See* RD at 89 (citing RX-1008C (Green) Q/A 281). The record also indicates that [

]. *See* FID at 89. There is no evidence that FCA has ever licensed the Jeep Trade Dress to any third party, or that if it did, that it would license the Jeep Trade Dress for use on assembled motor vehicles at the rates it licensed the Jeep trademarks for use on toys and Go-Karts. Because FCA presented evidence showing that the price differential between the Roxor and Wrangler vehicles varies between [] of the price of the Roxor (*see* Complainant’s Post-Hr’g Br. at 155-156; CX-1011C (Vander Veen) at Q/A 133; CX-1340C), the Commission determines that a bond in the amount of 100 percent of the entered value (supported by the price differential evidence in the record) of any imported finished Roxor vehicles is warranted.

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V. CONCLUSION

For the reasons set forth herein, the Commission determines that complainant FCA has established a violation of section 337 by Respondents based on infringement of the Jeep Trade Dress. Accordingly, the investigation is terminated with a finding of violation of section 337. The Commission determines that: (1) the appropriate remedy is an LEO directed against infringing motorized vehicles and components thereof and CDOs directed against both Respondents; (2) the public interest does not preclude this remedy; and (3) the bond during the period of Presidential review is set in the amount of ten (10) percent on the entered value of unassembled Roxor components and one hundred (100) percent on the entered value of finished Roxor vehicles.

By order of the Commission.



Lisa R. Barton
Secretary to the Commission

Issued: June 18, 2020

PUBLIC CERTIFICATE OF SERVICE

I, Lisa R. Barton, hereby certify that the attached **COMMISSION ORDER** has been served via EDIS upon the Commission Investigative Attorney, **Vu Bui, Esq.** and the following parties as indicated, on **June 18, 2020**.



Lisa R. Barton, Secretary
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UNITED STATES INTERNATIONAL TRADE COMMISSION

Washington, D.C.

In the Matter of

CERTAIN MOTORIZED VEHICLES
AND COMPONENTS THEREOF

Investigation No. 337-TA-1132

NOTICE OF COMMISSION DECISION TO REVIEW IN PART A FINAL INITIAL
DETERMINATION FINDING A VIOLATION OF SECTION 337; SCHEDULE FOR
FILING WRITTEN SUBMISSIONS; EXTENSION OF THE TARGET DATE
FOR COMPLETION OF THE INVESTIGATION

AGENCY: U.S. International Trade Commission.

ACTION: Notice.

SUMMARY: Notice is hereby given that the U.S. International Trade Commission has determined to review in part a final initial determination (“FID”) of the presiding administrative law judge (“ALJ”) finding a violation of section 337 of the Tariff Act of 1930, as amended. The Commission also extends the target date for completion of this investigation by five business days to March 20, 2020.

FOR FURTHER INFORMATION CONTACT: Houda Morad, Office of the General Counsel, U.S. International Trade Commission, 500 E Street SW., Washington, DC 20436, telephone (202) 708-4716. Copies of non-confidential documents filed in connection with this investigation are or will be available for inspection during official business hours (8:45 a.m. to 5:15 p.m.) in the Office of the Secretary, U.S. International Trade Commission, 500 E Street SW., Washington, D.C. 20436, telephone (202) 205-2000. General information concerning the Commission may also be obtained by accessing its Internet server at <https://www.usitc.gov>. The public record for this investigation may be viewed on the Commission’s electronic docket (EDIS) at <https://edis.usitc.gov>. Hearing-impaired persons are advised that information on this matter can be obtained by contacting the Commission’s TDD terminal on (202) 205-1810.

SUPPLEMENTARY INFORMATION: The Commission instituted this investigation on September 13, 2018, based on a complaint, as amended, filed by FCA US LLC of Auburn Hills, Michigan (“Complainant”). *See* 83 *Fed. Reg.* 46517 (Sept. 13, 2018). The complaint alleges violations of section 337 based upon the importation into the United States, the sale for importation, and the sale within the United States after importation of certain motorized vehicles and components thereof by reason of: (1) infringement of U.S. Trademark Registration Nos. 4,272,873; 2,862,487; 2,161,779; 2,794,553; and 4,043,984 (collectively, “the registered trademarks”); (2) trademark dilution and unfair competition in violating the complainant’s common law trademark rights; and (3) trade dress infringement. *See id.* The notice of investigation names Mahindra & Mahindra Ltd. of Mumbai, India and Mahindra Automotive

North America, Inc. of Auburn Hills, Michigan (collectively, "Respondents") as respondents in this investigation. *See id.* The Office of Unfair Import Investigations is also a party to this investigation. *See id.*

On November 8, 2019, the ALJ issued the FID finding a violation of section 337. Specifically, the FID finds that Respondents' Roxor vehicle infringes Complainant's asserted trade dress but not its registered trademarks. The FID also finds that the domestic industry requirement is satisfied. The RD recommends that the Commission issue a limited exclusion order barring entry of Respondents' articles that infringe the asserted trade dress and a cease and desist order against Respondents. In addition, the RD recommends that the Commission set a bond during the period of Presidential review at ten percent on unassembled Roxor components or one percent on the finished Roxor vehicle.

The Commission has determined to review the FID in part. Specifically, the Commission has determined to review the FID's findings with respect to the validity and infringement of the asserted trade dress, as well as importation findings relating to Complainant's trade dress infringement claim. With respect to Complainant's claim of infringement of its registered trademarks, the Commission has determined to review the FID's findings on infringement and domestic industry. The Commission has further determined not to review the remainder of the FID.

The Commission has also determined to extend the target date by five business days to March 20, 2020.

At this time, the Commission does not request briefing from the parties on the issues under review. The Commission is requesting briefing on the issues of remedy, the public interest, and bonding solely with respect to Complainant's trade dress infringement claim.

In connection with the final disposition of this investigation, the Commission may (1) issue an order that could result in the exclusion of the subject articles from entry into the United States, and/or (2) issue one or more cease and desist orders that could result in the respondent(s) being required to cease and desist from engaging in unfair acts in the importation and sale of such articles. Accordingly, the Commission is interested in receiving written submissions that address the form of remedy, if any, that should be ordered. If a party seeks exclusion of an article from entry into the United States for purposes other than entry for consumption, the party should so indicate and provide information establishing that activities involving other types of entry either are adversely affecting it or likely to do so. For background, *see Certain Devices for Connecting Computers via Telephone Lines*, Inv. No. 337-TA-360, USITC Pub. No. 2843 (Dec. 1994) (Comm'n Op.).

If the Commission contemplates some form of remedy, it must consider the effects of that remedy upon the public interest. The factors the Commission will consider include the effect that an exclusion order and/or cease and desist orders would have on (1) the public health and welfare, (2) competitive conditions in the U.S. economy, (3) U.S. production of articles that are like or directly competitive with those that are subject to investigation, and (4) U.S. consumers.

The Commission is therefore interested in receiving written submissions that address the aforementioned public interest factors in the context of this investigation.

If the Commission orders some form of remedy, the U.S. Trade Representative, as delegated by the President, has 60 days to approve, disapprove, or take no action on the Commission's determination. *See* Presidential Memorandum of July 21, 2005, 70 FR 43251 (July 26, 2005). During this period, the subject articles would be entitled to enter the United States under bond, in an amount determined by the Commission and prescribed by the Secretary of the Treasury. The Commission is therefore interested in receiving submissions concerning the amount of the bond that should be imposed if a remedy is ordered.

WRITTEN SUBMISSIONS: Parties to the investigation, interested government agencies, and any other interested parties are encouraged to file written submissions on the issues of remedy, the public interest, and bonding. Such submissions should also address the recommended determination by the ALJ on remedy and bonding. Complainant is also requested to submit proposed remedial orders for the Commission's consideration with its initial written submission. Complainant is further requested to state the HTSUS numbers under which the accused products are imported, and to supply the names of known importers of the products at issue in this investigation.

Written submissions and proposed remedial orders must be filed no later than close of business on **February 7, 2020**. Reply submissions must be filed no later than the close of business on **February 14, 2020** and must be limited to issues raised in the initial written submissions. No further submissions on any of these issues will be permitted unless otherwise ordered by the Commission.

Persons filing written submissions must file the original document electronically on or before the deadlines stated above and submit eight (8) true paper copies to the Office of the Secretary by noon the next day pursuant to section 210.4(f) of the Commission's Rules of Practice and Procedure (19 CFR 210.4(f)). Submissions should refer to the investigation number ("Inv. No. 337-TA-1132") in a prominent place on the cover page and/or the first page. (*See* Handbook for Electronic Filing Procedures, https://www.usitc.gov/documents/handbook_on_filing_procedures.pdf). Persons with questions regarding filing should contact the Secretary (202-205-2000).

Any person desiring to submit a document to the Commission in confidence must request confidential treatment. All such requests should be directed to the Secretary to the Commission and must include a full statement of the reasons why the Commission should grant such treatment. *See* 19 CFR 201.6. Documents for which confidential treatment by the Commission is properly sought will be treated accordingly. All information, including confidential business information and documents for which confidential treatment is properly sought, submitted to the Commission for purposes of this Investigation may be disclosed to and used: (i) by the Commission, its employees and Offices, and contract personnel (a) for developing or maintaining the records of this or a related proceeding, or (b) in internal investigations, audits, reviews, and evaluations relating to the programs, personnel, and operations of the Commission including under 5 U.S.C. Appendix 3; or (ii) by U.S. government employees and contract

personnel^[1], solely for cybersecurity purposes. All non-confidential written submissions will be available for public inspection at the Office of the Secretary and on EDIS.

The authority for the Commission's determination is contained in section 337 of the Tariff Act of 1930, as amended (19 U.S.C. 1337), and in part 210 of the Commission's Rules of Practice and Procedure (19 CFR part 210).

By order of the Commission.

A handwritten signature in black ink, appearing to read "Lisa R. Barton".

Lisa R. Barton
Secretary to the Commission

Issued: January 22, 2020

^[1] All contract personnel will sign appropriate nondisclosure agreements.

PUBLIC CERTIFICATE OF SERVICE

I, Lisa R. Barton, hereby certify that the attached **NOTICE** has been served by hand upon the Commission Investigative Attorney, **Vu Bui, Esq.** and the following parties as indicated, on **January 22, 2020**.



Lisa R. Barton, Secretary
U.S. International Trade Commission
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UNITED STATES INTERNATIONAL TRADE COMMISSION
Washington, D.C.

In the Matter of

CERTAIN MOTORIZED VEHICLES

AND COMPONENTS THEREOF

Inv. No. 337-TA-1132

**INITIAL DETERMINATION ON VIOLATION OF SECTION 337 AND
RECOMMENDED DETERMINATION ON REMEDY AND BOND**

Administrative Law Judge Cameron Elliot

(November 8, 2019)

Pursuant to the Notice of Investigation and Rule 210.42(a) of the Rules of Practice and Procedure of the United States International Trade Commission, this is my Initial Determination in the matter of *Certain Motorized Vehicles And Components Thereof*, Investigation No. 337-TA-1132.

TABLE OF ABBREVIATIONS

Am. Comp.	Amended Complaint
CDX	Complainant's Demonstrative Exhibit
CIB	Complainant's Initial Post-Hearing Brief
CPB	Complainant's Pre-Hearing Brief
CPX	Complainant's Physical Exhibit
CRB	Complainant's Reply Post-Hearing Brief
CX	Complainant's Exhibit
Dep. Tr.	Deposition Transcript
Hr'g Tr.	Hearing Transcript
JX	Joint Exhibit
RDX	Respondents' Demonstrative Exhibit
RIB	Respondents' Initial Post-Hearing Brief
RPB	Respondents' Pre-Hearing Brief
RPX	Respondents' Physical Exhibit
RRB	Respondents' Reply Post-Hearing Brief
RX	Respondents' Exhibit
SDX	Staff's Demonstrative Exhibit
SIB	Staff's Initial Post-Hearing Brief
SPB	Staff's Pre-Hearing Brief
SPX	Staff's Physical Exhibit
SRB	Staff's Reply Post-Hearing Brief
SX	Staff's Exhibit

[REDACTED]

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I. INTRODUCTION

A. Procedural Background

Complainant, FCA US LLC (“FCA” or “Complainant”), filed a Complaint with the Commission on August 1, 2018. 83 Fed. Reg. 40,336 (Aug. 14, 2018).¹ On August 23, 2018, Respondents, Mahindra & Mahindra Ltd. (“M&M”) and Mahindra Automotive North America (“MANA”)(collectively “Respondents” or “Mahindra”), submitted a letter requesting institution of an expedited hearing pursuant to Commission Rule 210.10(b)(3), asserting that FCA is contractually barred from filing its Complaint. Mahindra’s Request for 100-Day Proceeding, EDIS Doc. ID 653800 (August 23, 2018).

By publication of a notice in the *Federal Register* on September 13, 2018, the Commission ordered that:

(1) Pursuant to subsection (b) of section 337 of the Tariff Act of 1930, as amended, an investigation be instituted to determine:(a) Whether there is a violation of subsection (a)(1)(A) of Section 337 in the importation into the United States, the sale for importation, or the sale within the United States after importation of certain products identified in paragraph (2) by reason of trade dress infringement, trademark dilution, or infringement of common law trademarks, the threat or effect of which is to destroy or substantially injure an industry in the United States;(b) whether there is a violation of subsection (a)(1)(C) of section 337 in the importation into the United States, the sale for importation, or the sale within the United States after importation of certain products identified in paragraph(2) by reason of infringement of one or more of the ’873 mark; the ’487 mark; the ’779 mark; the ’553 mark; and the’984 mark, and whether an industry in the United States exists as required by subsection (a)(2) of section 337[.]

83 Fed. Reg. 46,517 (Sept. 13, 2018). The Commission further ordered the presiding Administrative Law Judge (“ALJ”) to “hold an early evidentiary hearing, find facts, and issue an

¹ The Commission issued a Notice of Solicitation of Comments Relating to the Public Interest on August 2, 2018, and this Notice was published on August 14, 2018. 83 Fed. Reg. 40,336-40,337. The Commission received public interest comments from Matthew Hamm and Mahindra. See Public Comment from Matthew Hamm, EDIS Doc. ID 652410 (Aug. 8, 2018); Respondents’ Statement on the Public Interest, EDIS Doc. ID 653664 (Aug. 22, 2018).

[REDACTED]

early decision, within 100 days of institution except for good cause shown, as to whether the complainant is contractually barred from enforcing its intellectual property against the named respondents.” 83 Fed. Reg. 46517 (Sept. 13, 2018).

Following limited discovery and an evidentiary hearing on the 100-day issue, the Chief ALJ issued an initial determination finding that FCA was not contractually barred from filing its Complaint. Order No. 18, EDIS Doc. ID 664927, at 15 (Dec. 21, 2018). The Commission denied Mahindra’s petition for review of the Chief ALJ’s determination on February 28, 2019. *See* Commission Determination, EDIS Doc. ID 668661 (Feb. 28, 2019).

FCA filed an amended complaint on November 19, 2018. In February 2019, the Chief ALJ lifted a discovery stay on all matters not related to the issue to be decided in the 100-day hearing and issued a revised procedural schedule. *See* Order No. 19, EDIS Doc. ID 667031 (Feb. 13, 2019); Order No. 20, EDIS Doc. ID 667418 (Feb. 19, 2019). On April 2, 2019, the Chief ALJ reassigned this Investigation to me. Notice, EDIS Doc. ID 671951 (April 2, 2019).

On June 4, 2019, Mahindra filed a motion for summary determination that its Roxor vehicle does not infringe the ’873 Mark. Mahindra’s Motion for Summary Determination, EDIS Doc. ID 677755 (June 4, 2019). The motion was denied. Order No. 34, EDIS Doc. ID 679715 (June 28, 2019).

An evidentiary hearing in this Investigation was held August 19-23, 2019. Following the evidentiary hearing, and pursuant to the procedural schedule, the parties submitted initial and reply post-hearing briefs on September 13, 2019 (EDIS Doc. 688236 (Complainant), EDIS Doc. 688235 (Respondents), EDIS Doc. 688193 (Commission Staff)), and September 27, 2019 (EDIS Doc. 689605 (Complainant), EDIS Doc. 689602 (Respondents), EDIS Doc. 689519

[REDACTED]

(Commission Staff)), respectively. As of the date of this initial determination, no motions remain pending.

B. The Parties

Complainant FCA is a Delaware limited liability company having its headquarters at 1000 Chrysler Drive, Auburn Hills, Michigan. FCA is a vehicle manufacturer in the United States, selling vehicles under several brands, including the Jeep brand. FCA's corporate roots relate back to the Chrysler Corporation, which was first organized in 1925. FCA is the asserted owner of the Jeep brand, Jeep Trade Dress, and Jeep Design Marks ("the Jeep IP") as the assignee and successor-in-interest, to the extent applicable with respect to the Jeep IP, of Chrysler Group LLC, Chrysler LLC, DaimlerChrysler Company LLC, DaimlerChrysler Corporation, Chrysler Corporation, American Motors Corporation, Jeep Corporation, Kaiser Jeep Corporation, Willys Motors, Inc., and Willys-Overland Motors, Inc.

Respondent Mahindra & Mahindra, Ltd. ("M&M") is an Indian multinational federation of diversified companies that include vehicle manufacturing and distribution entities. M&M's principal place of business is in Mumbai, Maharashtra, India. Mahindra Automotive North America, Inc. ("MANA") is a Delaware corporation with its principal place of business in Auburn Hills, Michigan. MANA is a U.S. subsidiary of M&M that, through its affiliates, manufactures and assembles off-road only vehicles in the United States.

C. The Asserted Trade Dress and Trademarks

FCA asserts intellectual property directed to certain aspects of its Jeep branded products, which can be divided into three categories: (1) an asserted common law "Jeep Trade Dress" right, directed to the overall exterior appearance and styling of the Jeep CJ and Wrangler vehicles; (2) the federally registered "Jeep Grille Design Marks," directed to a seven-slot grille design for a

[REDACTED]

vehicle (the '487, '779, '553, and '984 Marks); and (3) the '873 Mark, directed to a silhouette logo of what appears to be a historic version of a vehicle made by FCA's predecessors in interest to the Jeep brand. Am. Compl., ¶¶ 42-55.

1. The Jeep Trade Dress

FCA asserts that it has common law trade dress rights in "key design features that constitute the Jeep Trade Dress and that distinguish them from other commercially available vehicles." Am. Compl., ¶ 42. FCA's Amended Complaint describes the Jeep Trade Dress as consisting of:

the overall exterior appearance and styling of the [Jeep CJ and Jeep Wrangler] vehicle design, including:

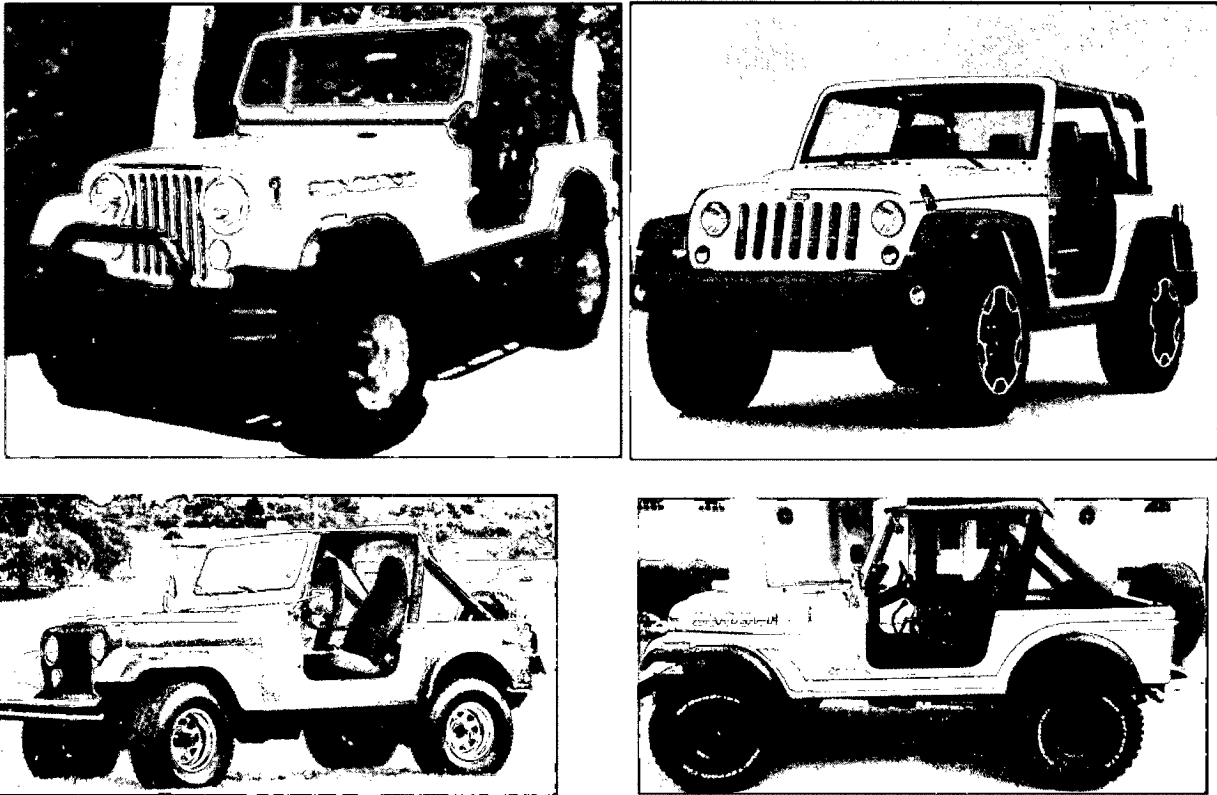
- (i) A boxy body shape with flat appearing vertical side and rear body panels ending at about the same height as the hood;
- (ii) Substantially flat hood with curved side edges that tapers to be narrower at the front;
- (iii) Trapezoidal front wheel wells with front fenders or fender flares that extend beyond the front of the grille;
- (iv) Flat appearing grille with vertical elongated grille slots and a trapezoidal outline that curves around round headlamps positioned on the upper part of the grille;
- (v) Exterior hood latches; and
- (vi) Door cutouts above a bottom portion of the side body panels.

Am. Compl., ¶ 42.

FCA alleges that the Jeep Trade Dress is distinctive, has achieved an "iconic level" of recognition, and has acquired secondary meaning through sales, advertising, and media attention. Am. Compl., ¶ 44. FCA asserts that it or its predecessors have been using the Jeep Trade Dress exclusively for decades in the United States. *Id.* According to FCA's Complaint, the Jeep Trade Dress has been used in at least the Jeep "CJ-5," "CJ-6," "CJ-7," and "CJ-8" vehicles (collectively, "CJ" or "CJs"). *Id.*, ¶¶ 16-17. FCA's Complaint also alleges the Jeep Trade Dress has been used

[REDACTED]

in the Jeep “Wrangler” “YJ,” “TJ,” “JK,” and “JL” vehicles (collectively, “Wrangler”). *Id.*, ¶¶ 21-24. FCA’s Complaint identifies the following exemplars and representative vehicles of the Jeep Trade Dress.



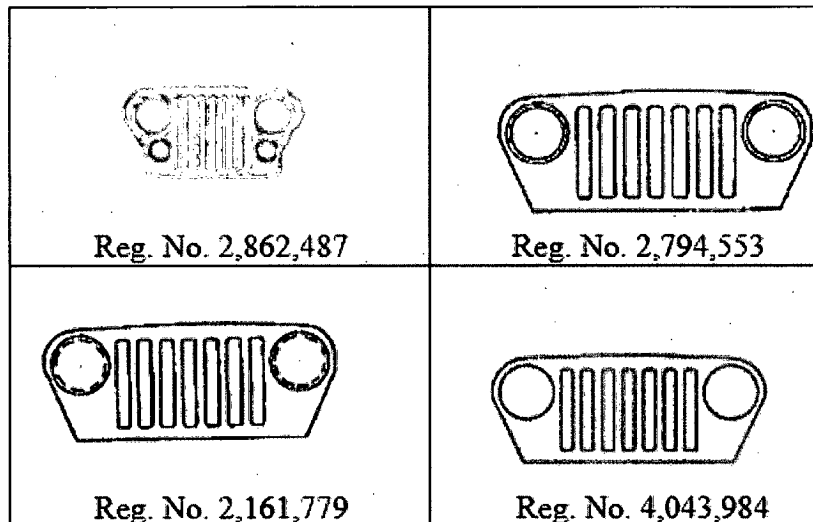
Id., ¶ 43; *Id.*, Ex. 25.

2. The Jeep Grille Design Marks

The asserted Jeep Grille Design Marks include the '487, '779, '553, and '984 Marks, which are directed to the grille designs on FCA’s vehicles. FCA’s predecessors-in-interest filed the applications for each of the Jeep Grille Design Marks. Daimler Chrysler Corporation filed the trademark application for the '487 Mark on June 25, 2002. JX-1002. The U.S. Patent and Trademark Office (“USPTO”) issued the '487 Mark on July 13, 2004. *Id.* Chrysler Corporation filed the trademark application for the '779 Mark on April 15, 1997. JX-1003. The USPTO issued the '779 Mark on June 2, 1998. *Id.* Daimler Chrysler Corporation filed the trademark application

for the '553 Mark on October 17, 2001. JX-1004. The USPTO issued the '553 Mark on December 16, 2003. *Id.* Daimler Chrysler Corporation filed the trademark application for the '984 Mark on August 25, 2010. JX-1005. The USPTO issued the '984 Mark on October 25, 2011. *Id.*

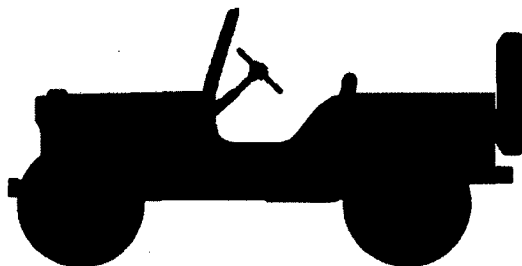
The Jeep Grille Design Marks are shown below.



Am. Compl., ¶49-52.

3. The '873 Mark

FCA also asserts the '873 Mark. The federal registration states that “the mark consists of a stylized representation of the silhouette of a Jeep land vehicle.” JX-0005:0002 (FCA00000075). FCA’s predecessors-in-interest, Chrysler Group LLC, filed the trademark application for the '873 Mark on May 12, 2011. JX-1001. The USPTO issued the '873 Mark on January 8, 2013. *Id.* The '873 Mark is shown below:


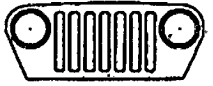





Am. Compl., ¶47.

D. Products at Issue

1. Domestic Industry Products

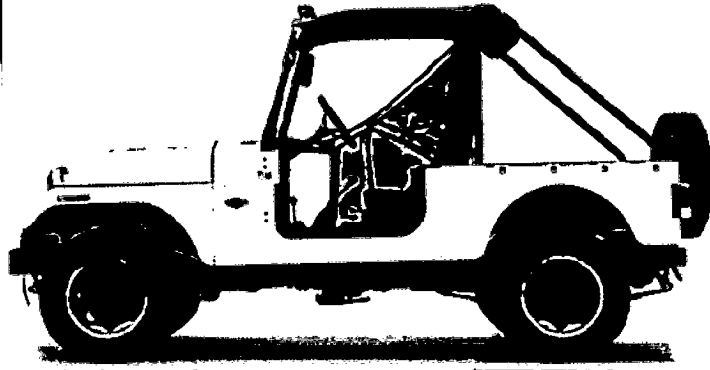
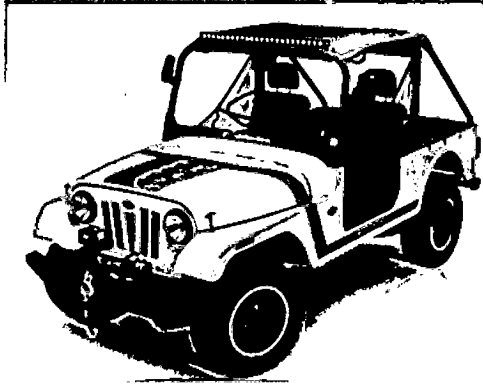
The alleged domestic industry in this case consists of the Wrangler, the CJ5-8, and the CJ66, a limited production “Concept Vehicle” (collectively, the “Domestic Industry Products”), all practicing the asserted trade dress, and practicing the registered trademarks as follows:

Reg. Number	Mark	Protects
2,161,779		JK and JL Wrangler
2,794,553		JK and JL Wrangler
2,862,487		At least Jeep CJ-5 through CJ-8 and CJ-66; JK and JL Wrangler
4,043,984		JK and JL Wrangler
4,272,873		JK and JL Wrangler

CIB at 135.

2. Accused Product

FCA alleges that Mahindra’s “Roxor” vehicle, including its grille, infringes the Jeep IP. Am. Compl., ¶ 30. The Roxor is a “side-by-side” or Utility Terrain Vehicle (“UTV”) for use in off-highway or off-road settings. Images of the Roxor are shown below:



Am. Compl., Ex. 19.

II. STANDARDS OF LAW

Trade dress and trademarks are separate and distinct causes of action under the Lanham Act. 15 U.S.C. § 1050 *et seq.*; *Gibson Guitar Corp. v. Paul Reed Smith Guitars LP*, 423 F.3d 539, 547 (6th Cir. 2005)(*cert. denied*, 547 U.S. 1179 (2006)). Thus, where appropriate, they will be discussed separately.

A. Trade Dress

Trade dress “originally included only the packaging or ‘dressing,’ of a product, but in recent years has been expanded by many courts of appeal to encompass the design of the product.” *Wal-Mart Stores, Inc. v. Samara Brothers, Inc.*, 529 U.S. 205, 209 (2000). With respect to trade dress, the Sixth Circuit explained:

Trade dress refers to the image and overall appearance of a product. It embodies that arrangement of identifying characteristics or decorations connected with a product, whether by packaging or otherwise, [that] make[s] the source of the product distinguishable from another and promote[s] its sale. Trade dress involves the total image of a product and may include features such as size, shape, color or color combinations, texture, graphics, or even particular sales techniques.

General Motors Corp. v. Lanard Toys, Inc., 468 F.3d 405, 414 (6th Cir. 2006)(*cert. denied*, 552 U.S. 819 (2007))(quoting *Gibson Guitar*, 423 F.3d at 547, n.10 (6th Cir. 2005)).

Section 337 provides in pertinent part:

(a) Unlawful activities; covered industries; definitions

[REDACTED]

(1) Subject to paragraph (2), the following are unlawful, and when found by the Commission to exist shall be dealt with, in addition to any other provisions of law, as provided in this section:

(A) Unfair methods of competition and unfair acts in the importation of articles (other than articles provided for in subparagraphs (B), (C) (D), and (E)) into the United States, or in the sale of such articles by the owner, importer, or consignee, the threat or effect of which is—

- (i) to destroy or substantially injure an industry in the United States;
- (ii) to prevent the establishment of such an industry; or
- (iii) to restrain or monopolize trade and commerce in the United States.

19 U.S.C. § 1337(a).

Within the meaning of Section 337(a)(1)(A), “unfair methods of competition” include claims based on common law trade dress infringement. *See Certain Electric Power Tools, Battery Cartridges & Battery Chargers*, Inv. No. 337-TA-284, USITC Publ. No. 2389 at 199 (1991) (“*Power Tools*”). To prevail on a claim of trade dress infringement a complainant must show: (1) that it actually possesses legal rights in its trade dress; and (2) that the respondents' use of that trade dress has created a likelihood of confusion regarding the source or sponsorship of the accused products. *See id.* at 199-200; *Certain Chemiluminescent Compositions*, Inv. No. 337-TA-285, USITC Pub. 2370, Comm'n Op., at 5; 0091 WL 11732560, at *6-7 (Mar. 1991). Section 337 also requires that a complainant establish that the infringement of its trade dress has the threat or effect of destroying or substantially injuring the domestic industry, preventing the establishment of such an industry, or restraining or monopolizing trade and commerce in the United States. *See* 19 U.S.C. § 1337(a)(1)(A).

1. Legal Rights in Trade Dress

The rights to a mark go to the party that uses the mark in commerce. *See Hana Fin., Inc. v. Hana Bank*, 574 U.S. 418, 420 (2015); *B & B Hardware, Inc. v. Hargis Indus., Inc.*, 135 S. Ct.

[REDACTED]

1293, 1299 (2015); *In re Int'l Flavors & Fragrances Inc.*, 183 F.3d 1361, 1366 (Fed. Cir. 1999) (noting that a mark's owner has its property right established by prior use). To establish that it has legal rights in its trade dress, a complainant must show that the trade dress has acquired distinctiveness. *Certain Ink Markers & Packaging Thereof*, Inv. No. 337-TA-522, Order No. 30 at 26 (July 25, 2005) (“*Ink Markers*”). Trade dress is distinctive “if it has developed secondary meaning, which occurs when, ‘in the minds of the public, the primary significance of a [mark] is to identify the source of the product rather than the product itself.’” *Wal-Mart*, 529 U.S. at 211 (quoting *Inwood Laboratories v. Ives Laboratories, Inc.*, 456 U.S. 844, 851 (1982)).

Complainants also must establish that the trade dress is nonfunctional. *Ink Markers* at 26; 15 U.S.C. § 1125(a)(3). Trade dress is functional and therefore not entitled to protection where “the exclusive use of [the feature] would put competitors at a significant non-reputation-related disadvantage.” *TrafFix Devices, Inc. v. Marketing Displays, Inc.*, 523 U.S. 23, 32 (2001)(citing *Qualitex Co. v. Jacobson Products Co.*, 514 U.S. 159, 165 (1995)). An alleged trade dress is also deemed functional where “it is essential to the use or purpose of the device or when it affects the cost or quality of the device.” *TrafFix*, 523 U.S. at 33, (citing *Qualitex*, 514 U.S. at 165 and *Inwood Laboratories*, 456 U.S. at 850, n.10).

a. Trade Dress Must Possess Secondary Meaning

When considering whether trade dress has acquired secondary meaning, the Federal Circuit has directed the Commission to consider a variety of factors, including:

- (1) Association of the trade dress with the source by purchasers (customer surveys);
- (2) Length, degree, and exclusivity of use;
- (3) Amount and manner of advertising;
- (4) Amount of sales and number of customers;

[REDACTED]

(5) Intentional copying; and

(6) Unsolicited media coverage of the product embodying the mark.

Converse, Inc. v. ITC, 909 F.3d 1110, 1120 (Fed. Cir. 2018). As to the first factor, to evaluate the credibility and reliability of consumer survey evidence, the Commission relies upon the following eight factors set forth in the Judicial Conference of the United States' *Handbook of Recommended Procedures for the Trial of Protracted Cases* (West Ed. 1970) ("Survey Factors"):

(1) Examination of the proper universe;

(2) A representative sample drawn from the proper universe;

(3) A correct mode of questioning interviewees;

(4) Recognized experts conducting the survey;

(5) Accurate reporting of data gathered;

(6) Sample design, questionnaire, and interviewing in accordance with generally accepted standards of objective procedure and statistics in the field of surveys;

(7) Sample design and interviews conducted independently of the attorneys; and

(8) The interviewers, trained in this field, have no knowledge of the litigation or the purpose for which the survey is to be used.

See Certain Digital Multimeters, and Products with Multimeter Functionality, Inv. No. 337-TA-588, Order No. 22 at 9-10 (Jan. 14, 2008) ("*Digital Multimeters*").

The Commission has in the past recognized that "[c]ourts have held that the strongest and most relevant evidence regarding whether a mark has acquired secondary meaning and, therefore, is entitled to trademark protection, is evidence by a public opinion survey or poll." *Certain Luggage Products*, Inv. No. 337-TA-243, U.S.I.T.C. Pub. 1969, 1987 WL 450863, at *9 (Mar. 27, 1987) (Views of Commissioners Brunsdale, Eckes, Lodwick and Rohr). However, the Federal Circuit recently reiterated that all six factors "are to be weighed together in determining the

[REDACTED]

existence of secondary meaning.” *Converse*, 909 F.3d at 1120. That is, “absence of consumer surveys need not preclude a finding of acquired distinctiveness.” *Yamaha Int’l Corp. v. Hoshino Gakki Co.*, 840 F.2d 1572, 1583 (Fed. Cir. 1988). And unless a survey “affirmatively shows a lack of secondary meaning,” a lack of the converse—survey evidence affirmatively showing a presence of secondary meaning—“is a neutral factor favoring neither party.” 909 F.3d at 1123.

b. Trade Dress Must Be Nonfunctional

The test for trade dress functionality is set forth in *In re Morton-Norwich Products, Inc.*, 671 F.2d 1332 (C.C.P.A. 1982). Specifically:

- (1) whether the utilitarian advantages of the design are touted in advertising;
- (2) whether the particular design results from a comparatively simple or cheap method of manufacture;
- (3) whether there exists a utility patent disclosing the utilitarian advantage of the design; and
- (4) whether commercial alternatives are available.

Valu Engineering, Inc. v. Rexnord Corp., 278 F.3d 1268, 1274 (Fed. Cir. 2002). These factors are aids to determining functionality, and no one factor is dispositive. *Digital Multimeters, Comm’n Op.*, U.S.I.T.C. Pub. 4210, 2010 WL 5642165, at *28 (Dec. 2010).

2. Infringement of Trade Dress

In addition to showing that the trade dress in suit is not functional and has acquired secondary meaning, Complainant must prove that the trade dress of the accused product is “confusingly similar” to the asserted trade dress. *Wal-Mart*, 529 U.S. at 210-11. To prove infringement, that is, FCA must establish a likelihood of consumer confusion as to origin, sponsorship, or approval due to similarity between the asserted trade dress and the accused product. *Al-Site Corp. v. VSI Intern., Inc.* 174 F.3d 1308, 1326 (Fed. Cir. 1999). FCA must also show that the Jeep Trade Dress possessed secondary meaning prior to the first infringement by


[REDACTED]

Respondents. *Converse*, 909 F.3d at 1116.

The parties do not agree on the applicable test for likelihood of confusion. *Compare* CIB at 45 (citing *In re E.I. DuPont DeNemours & Co.*, 476 F.2d 1357, 1361 (C.C.P.A. 1973)) with SIB at 55 (citing *DuPont* only for examples of “additional factors”) and RRB at 46 (arguing *DuPont* is inappropriate because it does not consider the strength of the asserted mark). The Federal Circuit recently endorsed *DuPont* as reciting the test for likelihood of confusion of trademarks. *Swagway, LLC v. ITC*, 934 F.3d 1332, 1338-39 (Fed. Cir. 2019). And although the Commission has not always applied *DuPont*, it has applied the same test for likelihood of confusion to both trademarks and trade dress. *E.g., Digital Multimeters, Comm’n Op.*, U.S.I.T.C. Pub. 4210, 2010 WL 5642165, at *30-*31 (Dec. 2010). I accordingly adopted *DuPont* in denying summary determination of noninfringement. *See* Order 34 at 1-2 (citing *Swagway*).

Therefore, likelihood of confusion will be determined using the *DuPont* factors:

- (1) The similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression;
- (2) The similarity or dissimilarity and nature of the goods or services as described in an application or registration or in connection with which a prior mark is in use;
- (3) The similarity or dissimilarity of established, likely-to-continue trade channels;
- (4) The conditions under which and buyers to whom sales are made, i.e. “impulse” vs. careful, sophisticated purchasing;
- (5) The fame of the prior mark (sales, advertising, length of use);
- (6) The number and nature of similar marks in use on similar goods;
- (7) The nature and extent of any actual confusion;
- (8) The length of time during and conditions under which there has been concurrent use without evidence of actual confusion;
- (9) The variety of goods on which a mark is or is not used (house mark, “family” mark, product mark);

- 
- (10) The market interface between applicant and the owner of a prior mark;
 - (11) The extent to which applicant has a right to exclude others from use of its mark;
 - (12) The extent of potential confusion, i.e., whether *de minimis* or substantial; and
 - (13) Any other established fact probative of the effect of use.

476 F.2d at 1361.

However, as additional factors FCA urges consideration of the intent of the accused infringer, and Respondents urge consideration of the strength of the mark; the Staff endorses considering both. *See* RIB at 116-17; CIB at 81; SIB at 55. These suggestions are reasonable because, as the parties note, such factors have been examined in other cases. So the intent of the accused infringer, which is not clearly encompassed within the first twelve factors will be considered under category (13). The strength of the mark, however, is essentially the fifth factor, which *DuPont* refers to as “fame.” The statutory prohibition on dilution of famous marks was established by the Federal Trademark Dilution Act of 1995, and, therefore, postdates *DuPont*. *Moseley v. V Secret Catalogue Inc.*, 537 U.S. 418, 431 (2003). Accordingly, “[f]ame for likelihood of confusion and fame for dilution are distinct concepts,” with fame for likelihood of confusion “a matter of degree along a continuum.” *Coach Svcs., Inc., v. Triumph Learning LLC*, 668 F.3d 1356, 1373 (Fed. Cir. 2012). Fame for likelihood of confusion purposes does not necessarily equate to strength. *Compare Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondée en 1772*, 396 F.3d 1369, 1375 (Fed. Cir. 2005)(“fame for confusion purposes arises as long as a significant portion of the relevant consuming public . . . recognizes the mark as a source indicator”) *with Swagway*, 934 F.3d at 1337 (describing the “strength” of a mark as encompassing both “conceptual and commercial strength”). Nonetheless, “fame” and “strength” are close enough in principle that the strength of the Jeep Trade Dress will be examined as a matter of fame, that is, under the fifth

[REDACTED]

DuPont factor.

The first few *DuPont* factors are especially significant, and their analysis may proceed by a judicial comparison of the conflicting marks themselves and the context of their use in the marketplace. *Certain Strip Lights*, Inv. No. 337-TA-287, Initial Determination, 1989 WL 608725, at *9 (June 27, 1989); see 3 *McCarthy on Trademarks and Unfair Competition* § 23:2.1. The first factor is crucial in a trade dress case: “accused [trade dress] that [is] not substantially similar cannot infringe.” *Converse*, 909 F.3d at 1124. Otherwise, however, the Commission “need not consider every *DuPont* factor,” depending on the relevance to a particular case. *Swagway*, 934 F.3d at 1339.

B. Trademark

1. Validity and Ownership

The parties do not dispute that FCA owns the trademarks at issue. See Joint Stipulation Regarding Ownership of Trademarks, EDIS Doc. ID No. 679183 (June 21, 2019). FCA contends that the Jeep Grille Design Marks and the '873 Mark became incontestable—that is, FCA has exclusive rights to their use—on the following dates, all prior to the launch of the Respondents' product in March 2018: (1) '873 mark – January 8, 2013; (2) '487 mark– July 13,2004; (3) '779 mark – June 2, 1998; (4) '553 mark – December 16, 2003; and (5) '984 mark –October 25, 2011. See JX-0001; JX-0002; JX-0003; JX-0004; JX-0005; 15 U.S.C. §§ 1065, 1115(b). Respondents do not dispute the validity of the marks.

2. Infringement of Trademarks

As with trade dress, the parties do not agree on the applicable test for likelihood of confusion of trademarks. Compare CIB at 107 (citing *DuPont*) with SIB at 77 (citing *DuPont* only secondarily) and RRB at 68 n.36 (incorporating its earlier argument that *DuPont* is inappropriate).

[REDACTED]

And for the same reasons as with trade dress, I find *DuPont* recites the applicable test, with the strength of the mark treated as fame and the intent of the accused infringer as an additional factor.

3. Domestic Industry with Respect to Trade Dress and Trademark

Section 337 requires FCA to prove that an industry in the United States (*i.e.*, domestic industry) exists that is subject to injury as a result of unfair acts. *See* 19 U.S.C. § 1337(a)(1)(A). FCA also must prove that the “threat or effect” of Respondents’ unfair acts is “to destroy or substantially injure” a domestic industry. *See id.*; *TianRui Group Co. v. Int’l Trade Comm’n*, 661 F.3d 1322, 1335 (Fed. Cir. 2011). Thus, FCA must prove the existence of a domestic industry, and must prove that the unfair acts of the Respondents cause either an actual injury or a future threatened injury to that domestic industry. Moreover, where federally registered and common law trademark rights are at issue, as they are in this Investigation, and the Complainant alleges the same products are covered by both the registered trademarks and the common law trade dress, “the domestic industry involved in the trademarks and trade dress in issue is one industry.” *Ink Markers*, Order No. 30 at 55-56; *see also Digital Multimeters*, Order No. 22 at 14 (holding that “[b]ecause the same devices are covered by Fluke’s registered trademark and its trade dress, one industry exists for the purposes of Section 337.”).

Proof of a domestic industry that satisfies §1337(a)(3)(A)-(B) is divided into (i) a “technical prong” (which requires FCA’s articles be covered by the asserted trade dress and trademarks) and (ii) an “economic prong” (which requires certain levels of activity with respect to the protected articles or trade dress and trademark itself). *Certain Hair Irons and Packaging Thereof*, Inv. No. 337-TA-637, Order No. 14, at 10 (March 10, 2009) (“*Hair Irons*”). Evidence of actual injury can include: (1) respondent's products being priced substantially lower than the domestic industry product; (2) the similarity between respondent's products and the complainant's

[REDACTED]

products; and (3) the channels of commerce in which the respondent sells the accused products. *Power Tools*, Initial Determination at 246, 248. Evidence of future threatened injury must be “substantive and clearly foreseen” and may include: (1) harm to goodwill and business reputation; (2) foreign cost advantages and production capacity; (3) the ability of the imported product to undersell the domestic product; or (4) substantial foreign manufacturing capacity combined with the respondent's intention to penetrate the U.S. market. *Id.* at 248.

a. Technical Prong

The technical prong of the domestic industry requirement is satisfied when the complainant establishes that it is practicing or exploiting the trade dress at issue. *See* 19 U.S.C. §§ 1337 (a)(2), (3); *Certain Microsphere Adhesives, Process for Making Same and Prods. Containing Same, Including Self-Stick Repositionable Notes*, Inv. No. 337-TA-366, Comm’n Op. at 8 (U.S.I.T.C. Jan. 16, 1996). As noted, “[t]he test for determining whether the technical prong is met through the practice of a trademark is plain use of the trademark on products and packaging.” *Certain Protective Cases*, Inv. No. 337-TA-780, Initial Determination, at 90 (June 29, 2012).

b. Economic Prong

An industry under Section 337(a)(2) shall be considered to exist if there is, with respect to the articles protected by the trademark concerned:

- (A) significant investment in plant and equipment;
- (B) significant employment of labor or capital; or
- (C) substantial investment in its exploitation, including engineering, research and development, or licensing.

19 U.S.C. § 1337(a)(3); *see Hair Irons*, Order No. 14 at 10-11.

FCA must satisfy only one of the three groups of activities listed in Section 337(a)(3) to meet the domestic industry requirement. *Hair Irons*, Order No. 14 at 12. Moreover, the

[REDACTED]

Commission has emphasized that “there is no minimum monetary expenditure that a complainant must demonstrate to qualify as a domestic industry.” *Certain Stringed Musical Instruments and Components Thereof*, Inv. No. 337-TA-586, Comm’n Op. at 25 (May 16, 2008). Reasonable and appropriate allocation methodologies, such as sales-based allocations, have routinely been employed and accepted by the Commission for purposes of satisfying the economic prong. *See, e.g., Certain Toner Cartridges and Components Thereof*, Inv. No. 337-TA-918, Order No. 22, at innov3-5 (Jan. 16, 2015); *Certain Protective Cases*, Initial Determination at 105-108.

III. IMPORTATION AND SALE

The private parties entered into a stipulation regarding importation, and Respondents do not dispute that (i) M&M sold for importation into the United States certain components of the Roxor (the “Mahindra Non-U.S. Components”), within the meaning of 19 U.S.C. § 1337(a)(1); (ii) MANA imported into the United States the Mahindra Non-U.S. Components within the meaning of 19 U.S.C. § 1337(a)(1); and (iii) the importation requirement under 19 U.S.C. § 1337(a)(1) is satisfied with respect to the Mahindra Non-U.S. Components. *See Joint Stipulation Regarding Importation*, EDIS Doc. ID 679183, ¶ 2 (June 21, 2019). (“Importation Stipulation”). The Mahindra Non-U.S. Components are combined with domestically manufactured parts by M&M’s subsidiary MANA to form the Roxor vehicle, which is sold within the United States. Hr’g Tr. at 711:17-712:17. The Roxor “launched” on March 2, 2018, although the first importation of record in the Importation Stipulation has an August 2018 arrival date. RX-1012C (Haas), Q/A 23; Importation Stipulation, Ex. B.

[REDACTED]

IV. JURISDICTION

The scope of the Commission's *in rem* jurisdiction is directed to articles that are imported into the United States. *See* 19 U.S.C. § 1337(a)(1)(C). In view of the private parties' stipulation and the facts identified in the previous section, the Commission has *in rem* jurisdiction. Section 337 confers subject matter jurisdiction on the Commission to investigate, and if appropriate, to provide a remedy for, unfair acts and unfair methods of competition in the importation, the sale for importation, or the sale after importation of articles into the United States. *See* 19 U.S.C. § 1337(a)(1)(A), (a)(1)(C), (a)(2). FCA filed a complaint alleging a violation of Section 337, and the Commission therefore has subject matter jurisdiction. *See Amgen, Inc. v. U.S. Int'l Trade Comm'n*, 902 F.2d 1532, 1535-37 (Fed. Cir. 1990) ("Amgen's complaint alleged that Chugai was importing rEPO and that the rEPO was made by a process covered by the [IP]; thus, on its face the complaint came within the jurisdiction of the Commission."). The Respondents appeared through counsel and are participating in this Investigation. Accordingly, the Commission has personal jurisdiction over the Respondents. *See, e.g., Certain Optical Disk Controller Chips*, Inv. No. 337-TA-506, Initial Determination, at 4-5, 2005 WL 1901371, at *5 (May 16, 2005) (unreviewed in relevant part).

Respondents argue that the Roxor's grille is not imported. RIB at 22. However, the trade dress aspect of this Investigation relates to the entire Roxor vehicle, and [REDACTED]

[REDACTED] CX-1018C (Hass Dep. Tr.) at 52:7-13; Hr'g Tr. at 711:22-712:5. These imported parts are then assembled into the Roxor vehicle, which is accused of infringing Complainant's trade dress rights. Thus, there exists jurisdiction over the Roxor vehicle, regardless of whether the Roxor grille is made in the United States.

[REDACTED]

V. THE ASSERTED TRADE DRESS

A. Legal Rights to Trade Dress

FCA alleges that it and its predecessors, including Chrysler Corporation and Willys-Overland, have sold vehicles displaying the Jeep Trade Dress for nearly 70 years, and that “it is among the most visually distinctive and recognizable looks in the motor vehicle industry.” CIB at 8. The vehicles that allegedly display the trade dress at issue are the Jeep CJ and Wrangler vehicles, and the CJ66. FCA further urges that “[w]hile the vehicles displaying the Jeep Trade Dress have evolved over the years, they have conveyed the same overall commercial impression through careful stewardship of the core design features to preserve the iconic styling.” CIB at 8-9.

1. Ownership

As explained below, the totality of the evidence shows that FCA owns the Jeep Trade Dress and has used it exclusively within the past five years. *Converse*, 909 F.3d at 1120-21 (holding that uses within the past five years are most relevant for evaluating secondary meaning). Respondents nonetheless present multiple arguments that FCA does not own the Jeep Trade Dress. *See generally* RIB at 24-56. Respondents’ principal contention is that FCA did not inherit rights in the body design of the World War II jeep vehicle. Respondents argue that the original jeep, from which the commercial vehicles originated, was not designed by Willys-Overland, and thus, Willys-Overland did not create or own the body design in that vehicle. RIB at 27.

Whether Willys-Overland created the original vehicle has little bearing on the issue of ownership of trade dress. To establish legal rights in its trade dress, FCA has to show that it currently uses the Jeep Trade Dress in commerce. *Hana Fin*, 135 S. Ct. at 909; *Int’l Flavors*, 183 F.3d at 1366 (Fed. Cir. 1999) (noting that a mark’s owner has its property right established by prior use). The evidence shows that FCA and its predecessors have been producing vehicles that

display the Jeep Trade Dress not just currently, but continuously for decades. See RX-1019; CX 1003C (Adams House), Q/A 10, 21; JX-1035C:0026-43 (FCA00017101-18). FCA's vehicle designers carefully created the present Wrangler design to have the vertically slotted grille, the boxy body shape, the trapezoidal wheel wells, the flat hood, the exterior hood latches, and the door cutouts, which is FCA's definition of its Jeep Trade Dress. CX 1001C (Allen), Q/A 44-50. FCA presented the "Evolution of an Icon" poster, that shows that the overall commercial impression of the vehicles, from the Jeep CJ-5 to the most recent version of the Wrangler, basically remains the same:

SINCE 1941

EVOLUTION OF AN ICON

The poster displays the following models in its grid:

- 1941 CJ-2A
- 1942 CJ-2B
- 1943 CJ-2C
- 1944 CJ-2D
- 1945 CJ-2E
- 1946 CJ-2F
- 1947 CJ-2G
- 1948 CJ-2H
- 1949 CJ-2I
- 1950 CJ-2J
- 1951 CJ-2K
- 1952 CJ-2L
- 1953 CJ-2M
- 1954 CJ-2N
- 1955 CJ-2O
- 1956 CJ-2P
- 1957 CJ-2Q
- 1958 CJ-2R
- 1959 CJ-2S
- 1960 CJ-2T

At the bottom of the poster, the following logos are displayed:

- WILLIS
- PLYMOUTH
- CHRYSLER
- RAM
- RAMBLER
- CHRYSLER
- CHRYSLER
- Jeep

[REDACTED]

RX-1019.

Over the years, FCA's predecessors produced at least the following models, all of which displayed the Jeep Trade Dress.

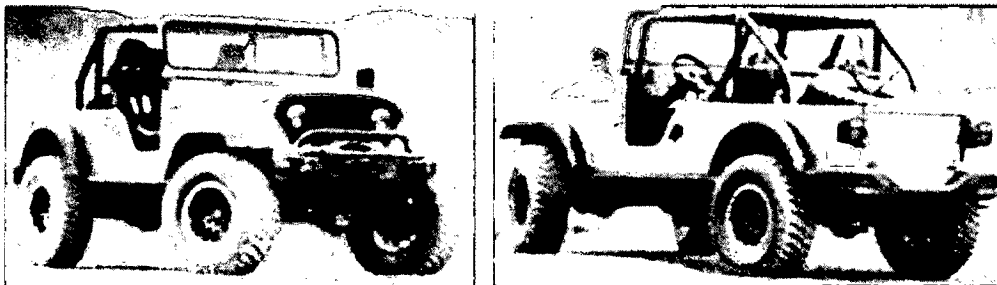
- CJ-5 from 1955 to 1983;
- CJ-6 from 1955 to 1981;
- CJ-7 from 1976 to 1986;
- CJ-8 from 1976 to 1986;
- Wrangler YJ from 1986 to 1995;
- Wrangler TJ from 1996 to 2006;
- Wrangler JK from 2006 to 2018; and
- Wrangler JL from 2018 to present.

RX-1019; CX-1004C (Spano), Q/A 46, 90; CX-1860C; *see also* CX-1008C (Carpenter), Q/A 33; CX-1005C (Tallon), Q/A 8-10; CX-1678C (JX-1114C) (showing annual Wrangler sales since 1986, [REDACTED])

More recently, FCA made the CJ66, which is a "CJ-inspired" concept vehicle. CX-1001C (Allen), Q/A 77-89; CX-1673C (JX-1103C); CX-1368. [REDACTED]

[REDACTED] *Id.* Below are

images of the CJ66:



[REDACTED]

CX-1683C:0001-2 (FCA00007319-20). This vehicle also has the vertically slotted grille, the boxy body shape, the trapezoidal wheel wells, the flat hood, the exterior hood latches, and the door cutouts—in short, the asserted Jeep Trade Dress.

Respondents' other arguments regarding ownership are similarly unavailing. Undoubtedly, the specific design details of the asserted Jeep Trade Dress have evolved over the years, but the "Evolution of an Icon" poster shows that FCA has maintained a "continuous commercial impression" for decades; I discuss this further below. *Jack Wolfskin Ausrüstung Fur Draussen GmbH & Co. KGAA v. New Millennium Sports, S.L.U.*, 797 F.3d 1363, 1368 (Fed. Cir. 2015)(*cert. denied*, 136 S. Ct. 982 (2016)); RX-1019. Even though its advertising often harkens back to pre-1955 vehicles not necessarily associated with FCA or its predecessors, FCA asserts the Jeep Trade Dress was first introduced in 1955, and the record supports this. CX-1004C (Spano), Q/A 46; RX-1019. Some elements of the Jeep Trade Dress appeared on pre-1955 vehicles, but even the one pre-1955 civilian vehicle sold in the U.S. identified by Respondents' expert Mr. Jason Hill as possessing closest to the Jeep Trade Dress, the Toyota FJ-20, failed to display all of the Jeep Trade Dress elements. Hr'g Tr. at 779:5-780:13; *see also* Hr'g Tr. (Baker) at 368:15-16 ("I don't see the trapezoidal fender" on the pre-1955 CJ-2A).

[REDACTED]

[REDACTED] and that its advertising does not urge customers to "look for" the Jeep Trade Dress. *See* RIB at 50-55. [REDACTED]

[REDACTED]

[REDACTED] and the nature of its advertising may be relevant to distinctiveness, but it is not relevant to ownership. *See* CX-1004C (Spano), Q/A 121-40 (describing FCA's licensing practices). [REDACTED]

[REDACTED]

[REDACTED] and Respondents' own recitation of FCA's litigations and cease-and-desist letters reinforces FCA's evidence that it enforces its intellectual property rights when needed. See RIB at 52-55; JX-1039C:0105 (FCA00007733) [REDACTED]

[REDACTED] CX-1004C (Spano), Q/A 146-91 (describing FCA's enforcement efforts). And although Respondents contend that FCA owns, if at all, only the asserted Jeep Trade Dress, there is no dispute about that fact as it relates to this Investigation; that FCA might assert other trade dress in another case is immaterial. See RIB at 56-60.

In sum, FCA has proven that it owns whatever Jeep Trade Dress rights may exist.

2. The Jeep Trade Dress Has Acquired Secondary Meaning

Respondents argue that those Jeep Trade Dress rights do not exist, because the Jeep Trade Dress has not acquired secondary meaning. As described above, there are a number of factors to consider in evaluating the existence of secondary meaning.

a. Survey Evidence

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED] CX-1001C (Allen), Q/A 47-53; see also CX-1687C; CX-1004C (Spano), Q/A 78-84; CX-1406C; CX-1454C.

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED] CX-1687C:0002-6, 0069-70 (FCA00010009-14, FCA00010077-78). [REDACTED]

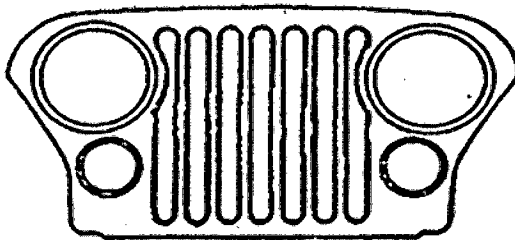
[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED] CX- 1687C:0021, 0039-41 (FCA00010029, FCA00010047-49); *see also* CX-1003C (Adams House), Q/A 2, 13.

Other survey-type evidence offered during the hearing showed that very early on, Jeep vehicles developed an association with a single source, although only tenuously in connection with the Jeep Trade Dress. A study performed in 1949, in connection with an FCA predecessor's registration of a Jeep brand trademark, suggested that the public already had begun to recognize that the Jeep brand was acquiring a unique or distinguishable identity. CX-1004C (Spano), Q/A 2, 68, 69, 72; CX- 1792C. Another study performed in 1998, which was subsequently submitted to the USPTO in connection with trademark applications for grille design marks, indicated recognition of the Jeep brand's flat-appearing, vertical, and seven-slot grilles. CX-1004C (Spano), Q/A 73-76; CX- 1405C. The 1998 study indicated that a majority of survey participants recognized the '088 mark, shown below. CX-1004C, Q/A 73-76; CX-1405C; *see also* CX-1405C:0013 (FCA00010262).



As for the customer survey evidence, FCA asserts that it is the “overall” appearance of the designs that should be tested in each survey. *E.g.*, CIB at 29. This “makes the task of selecting control stimuli especially difficult . . . [because] many characteristics of the experimental stimulus are being assessed.” *Spangler Candy Co. v. Tootsie Roll Industries, LLC*, 372 F. Supp. 3d 588,

[REDACTED]

598 (N.D. Ohio 2019)(citing Jacob Jacoby, Ph.D., “Experimental Design and the Selection of Controls in Trademark and Deceptive Advertising Surveys”, 92 *Trademark Rep.* 890, 894-95, 908-12 (July-August 2002)). Thus, in performing a customer survey, the control should account for factors irrelevant to the features being tested, so that the impact of the tested features can be isolated. *See* 372 F. Supp. 3d at 598; *see also* CX-1155:0010, p. 210 (FCA00078895).

Even considering that “selecting control stimuli [is] especially difficult,” I generally agree with the Staff that the survey evidence introduced by both FCA and Respondents suffers from poor controls, which falls under the sixth Survey Factor. *See* SIB at 42-45; *Spangler Candy*, 372 F. Supp. 3d at 598. The survey evidence collected by FCA’s expert, Dr. Bruce Isaacson, employed a control that Dr. Isaacson conceded was “curvy.” CX-1007 (Isaacson), Q/A 23, 32. In fact, a simple visual examination of his control vehicle shows that it looks nothing like a CJ or a Wrangler. *See id.* The effect of this, given the design of the survey, is to inappropriately magnify any results showing an association between the Jeep Trade Dress and its source. *See* RX-1006 (Butler), Q/A 55, 59-62. At the same time, Respondents’ expert, Ms. Sarah Butler, employed three controls, one purporting to correspond to a CJ, one purporting to correspond to a Wrangler, and one real world vehicle (the Toyota FJ), that did not effectively remove all the Jeep Trade Dress. *See id.* at Q/A 136-52. For instance, the two fictional controls retained a boxy body with vertical side and rear panels, with only a slightly lowered back portion of the body. *See* JX-1026 at 30-36. And on the Wrangler control the door cutouts and hood, when seen from the side, have only insubstantial differences from the real Wrangler used. *See id.* The effect of Ms. Butler’s controls is to inappropriately minimize and measured distinctiveness. *See* Hr’g Tr. (Isaacson) at 529:12-24.

Moreover, the seventh and eighth Survey Factors undermine the conclusions of both experts’ results. Both experts presumably communicated with counsel subject to attorney work

[REDACTED]

product protections, so it is impossible to know how truly independent the experts were from the attorneys who retained them, and both experts were well aware of the litigation and the purpose of their surveys, with the entirely foreseeable result that both surveys were tendentious. *See* CX-1007 (Isaacson), Q/A 2-4; RX-1006 (Butler), Q/A 25. Respondents criticize Dr. Isaacson's work on other grounds, FCA does the same as to Ms. Butler's work, and the Staff criticizes Ms. Butler's survey with respect to other Survey Factors. *See* CRB at 31-34; RIB at 68-72; SIB at 44-45. However, these other complaints are of little weight compared to the poor survey controls, which were alone enough to effectively nullify both expert opinions, and particularly in view of the self-serving approach both experts took.

On balance, therefore, no weight is accorded to either expert survey. Only FCA's own relatively informal, course-of-business survey evidence weighs in favor of finding secondary meaning, and that only weakly.

b. Length, Degree, and Exclusivity of Use

FCA also presented credible evidence related to the degree, manner, exclusivity, and length of use of the asserted trade dress. For instance, the "Evolution of an Icon" shows that various products manufactured and sold by FCA and its predecessors, each vehicle having the Jeep Trade Dress, have been produced and sold in the U.S. for decades. RX-1019. One method by which FCA maintains exclusive use of the Jeep Trade Dress in the U.S. is through enforcement, by sending cease and desist letters to parties that FCA believes is improperly using distinctive elements of the Jeep Trade Dress. JX-1118; CX-1729C (JX-1118) (RX-1236); CX-1755; Hr'g Tr. 309:3-23. FCA also has filed lawsuits against parties who have allegedly used the Jeep Trade dress. *See FCA US LLC v. Yu*, No. 5:18-2256, Dkt. 23 (C.D. Cal. Mar. 18, 2019); *Moab Indus.*,

[REDACTED]

LLC v. FCA US, LLC, No. 3:12-cv-8247, 2016 U.S. Dist. LEXIS 139816, *26 (D. Ariz. Oct. 6, 2016); *AM Gen. Corp. v. Daimler Chrysler Corp.*, 311 F.3d 796, 821-822 (7th Cir. 2002).

Respondents did not present credible evidence to the contrary. One of Respondents' experts, Dr. Joel Steckel, testified that "[n]ot only are 'boxy' body shapes common in many SUVs or off-road-style vehicles, but other more specific elements of the Asserted Trade Dress appear in numerous other vehicles." RX-1011C (Steckel), Q/A 178. But the vast majority of Dr. Steckel's "numerous other vehicles" are not offered for sale in the United States. *See, e.g.*, CX-1006C (Baker), Q/A 30 (explaining that the Suzuki "Jimny" has never been offered in the United States and was discontinued in 1995); RX-1011C. Even more significant, however, is that Dr. Steckel determined that none of the vehicles he analyzed had all six elements of the Jeep Trade Dress. RX-1011C (Steckel), Q/A 206; Tr. (Steckel), 1084:9-12, 1125:8-1129:10. RX-1907C, a table of third party vehicles and the listed trade dress elements each contain, is particularly probative—no vehicle contains all elements, and very few vehicles listed have been manufactured in the last five years. "The most relevant evidence will be the trademark owner's and third parties' use in the recent period before first use or infringement" and "the ITC should rely principally on uses within the last five years." *Converse*, 909 F.3d at 1120.

Furthermore, Dr. Steckel admitted during the hearing that he had no basis on which to opine that any of the U.S. vehicles he listed "have or have not impacted consumer impression in the U.S. of the Jeep Trade Dress." Tr. (Steckel), 1089:5-23. Dr. Steckel also admitted that he did not have any opinion on whether the vehicles he listed are "substantially similar" to the Wrangler or the Jeep CJ. Tr. (Steckel), 1132:14-1133:13; *see Converse*, 909 F.3d at 1122 (relevant comparisons with competitors for analyzing exclusivity of use must involve "substantially similar" uses).

[REDACTED]

Another of Respondents' witnesses, Mr. Hill, provided testimony on this subject that demonstrates such a lack of substantial similarity. Mr. Hill opined that "individually, and collectively, the 6 elements FCA claims as the Asserted Trade Dress can be found on a wide variety of vehicles and specifically within the category, species, or genre of 4x4 off-road utility type vehicles that could include SUVs for purposes of comparing design elements." RX-1010C, (Hill) Q/A 17. In support of his testimony, Mr. Hill illustrated his "category, species, or genre" of vehicles in RX-1882 (i.e., Mr. Hill's "family tree" chart). *See* RX-1010C, (Hill) Q/A 99. The evidence shows, however, that Mr. Hill did not use reliable criteria for including or excluding vehicles on his family tree chart. For example, Mr. Hill included vehicles that "as far as appearance" had "nothing to do with the CJ or a Wrangler," other than having a "boxy body." Hr'g Tr. (Hill), 848:13-17. Whether the vehicles included trapezoidal wheel wells beyond the front of a grille, an express term in the Jeep Trade Dress, "was not really a major consideration" in the formulation of his family tree. Hr'g Tr. (Hill), 850:4-15. The family tree also included, for example, a vehicle that was not directly tied to the military, did not have all the Jeep Trade Dress elements, and was never sold in the United States (e.g., the Peugeot vehicle). Hr'g Tr. (Hill), 851:6-17. In fact, Mr. Hill admitted that most of the vehicles on his family tree either (1) were never sold in the United States, (2) were only sold decades ago, or (3) lacked several material features that are expressly listed in the Jeep Trade Dress. *See, e.g.*, Hr'g Tr. (Hill), 830:17-851:17.

c. Amount and Manner of Advertising

Admittedly, FCA does not employ "look for" advertising in connection with the Jeep Trade Dress. *See* RIB at 96-99. But such advertising is not required to establish secondary meaning; as one court noted, "the Coca-Cola Company does not say in its advertising to 'look for the hourglass-

[REDACTED]

shaped bottle,' and yet it is one of the most recognizable trade dresses in the world.” *Adidas-Salomon AG v. Target Corp.*, 228 F.Supp.2d 1192, 1208 (D. Or. 2002).

More to the point, FCA has dedicated considerable resources to advertising that includes some or all of the Jeep Trade Dress elements. [REDACTED]

[REDACTED] CX-1008C (Carpenter), Q/A 36; see also CX-1003C (Adams House), Q/A 82-93 [REDACTED]

[REDACTED] CX 1704C (JX-1117C); CX-1759C; CX-1763C; CX-1722C; CX-1933C. FCA runs print advertising for the Wrangler in USA Today, Rolling Stone, Outdoor Magazine, 4 Wheel Drive & Sport Utility Magazine, 4 wheel & Off-Road, Back Packer, ESPN, Four Wheeler, Men’s Fitness, Men’s Health, and Popular Science, [REDACTED]

[REDACTED] CX-1003C (Adams House), Q/A 42-47; CX-1707C [REDACTED] FCA’s advertising of the Wrangler includes marketing in movies and television shows, and FCA has run television advertising in multiple Super Bowls, which, for three of the advertisements, [REDACTED]

[REDACTED] CX-1003C (Adams House), Q/A 48-57; CX-1715C; CX-1713C; CX-1712C; CX-1714C; CX-1008C (Carpenter), Q/A 34-48; CX-1538C. FCA’s internet marketing efforts include hosting a website that resulted in millions of “followers” and “likes” on Twitter and Facebook. CX-1003C (Adams House), Q/A 60, 61, 87, 88; CX-1919C; CX-1722C.

d. Amount of Sales and Number of Customers

Complainant has sold a very large number of CJ and Wrangler vehicles over the years. FCA’s witness, Ms. Spano, testified that [REDACTED]

[REDACTED]

[REDACTED] CX-1004C (Spano), Q/A 90. FCA's director for the Jeep brand testified

[REDACTED]

[REDACTED] CX-1005C (Tallon), Q/A 2, 10; CX-1678C;

CX-1008C (Carpenter), Q/A 53; CDX-1032 (summarizing CX-1678). As the oldest vehicle in the

Jeep portfolio, "the Wrangler is also the first vehicle that comes to many people's minds when you

ask them about the Jeep brand." CX-1005C (Tallon), Q/A 8. Even assuming that most of what

motivates such impressive sales numbers is something other than the Jeep Trade Dress, it stands

to reason that they are at least partially "attributable to the source-identifying power of the [Jeep

Trade Dress]." RIB at 100.

e. Intentional Copying

The fifth factor that the Commission considers in determining secondary meaning is

whether there has been deliberate copying of the trade dress. *Digital Multimeters*, Order No. 22

at 8. The evidence shows that Mahindra intended the Roxor to look similar to the CJ. Specifically,

the Roxor's design arose from an idea to repurpose the design of a THAR vehicle, which,

according to a Mahindra witness, "looked like an old army jeep." RX-1003C (Pacella Opening),

Q/A 30; *see also* CX-1042C:0002 [REDACTED] As

Mahindra's Chief Executive Officer testified, [REDACTED]

[REDACTED]

[REDACTED] RX-1012C (Haas), Q/A 125. That is, from studies that predate

the Roxor's launch, [REDACTED]

[REDACTED]

[REDACTED] Mahindra proceeded with

launching and marketing the Roxor to consumers in the United States. RX-1012C (Haas), Q/A

[REDACTED]


135. And as part of its promotion of the Roxor, [REDACTED]
[REDACTED] CX 1058C:0001-2 (MAH0184536-7). Mahindra's
Vice President of Marketing, Richard Ansell, stated in a 2016 email that [REDACTED]
[REDACTED]
[REDACTED] CX 1047:0002 (MAH0080479). Mahindra also sought
to promote the Roxor, [REDACTED]
[REDACTED] *See, e.g.*, CX-1045C:0001 (MAH0081045) (JX-1135C); Tr. (Ansell), 976:15-22,
977:8-11, 981:1-25, 978:4-979:7, 990:6-11, 993:18-24, 988:13-20; Tr. (Haas), 685:17-21; CX-
1047:0002 (MAH0080479); CX-1271C:0001.

f. Unsolicited Media Coverage of the Product

The final consideration in determining whether a mark has acquired secondary meaning is “unsolicited media coverage of the product embodying the mark.” *Converse*, 909 F.3d at 1120. In support of this feature, FCA presented a list of numerous awards that the Jeep Wrangler received over the past 20 years. *See* CX-1709C. Moreover, articles about the Jeep Wrangler from various publications discuss the Wrangler’s popularity, “iconic design,” and “traditional styling.” For example, CX-1355 is a 2017 article that discusses how the 2018 Jeep Wrangler’s “look hasn’t changed in over 70 years, meaning the same traits that make the Jeep Wrangler an icon”:

2018 Jeep Wrangler: How Does Jeep Redesign The World's Most Iconic Off-Road SUV? Prudently



Karl Brauer Contributor 
Autos
I am the Executive Publisher at Autotrader and Kelley Blue Book



Crossing rivers was among the many adventures the 2018 Jeep Wrangler provided. KELLEY BLUE BOOK

For an automaker like Jeep the opportunity to redesign its Wrangler must be both exciting and intimidating. The Jeep Wrangler is arguably the most recognized vehicle on American -- if not international -- roads. It's fundamental look hasn't changed in over 70 years, meaning the same traits that make the Jeep Wrangler an icon also present a compressed canvas to the automaker's stylists.

CX-1355:0001. And as the Staff points out, “much of the attention that FCA has received also highlights the ‘iconic’ look or appearance of its vehicles. This logically suggests that the third party media attention is the result of the CJ’s and Wrangler’s designs, not so much other factors such as performance characteristics.” SRB at 37.

Respondents, on the other hand, assert that the awards and articles discussing FCA’s products are not focused on the Asserted Trade Dress in a way that promotes source identification, and thus do not illustrate secondary meaning. RIB at 101. Respondents further submit that there “are no articles that identify the Six Claimed Elements [of the Jeep Trade Dress], much less even suggest they are source identifying.” *Id.* Respondents state that “the combination of the Six Claimed Elements has never been the subject of a single article.” RPB at 40. Respondents cite

[REDACTED]

Aromatique, Inc. v. Gold Seal, Inc., 28 F.3d 863, 872 (8th Cir. 1994), for the proposition that “[m]ere mentions of the product reveal nothing about the public’s understanding of the purpose of the Six Claimed Elements.” *Id.*

In *Aromatique*, the Court did not find secondary meaning, noting that “most of the articles [presented as evidence of media coverage] do not depict the trade dress, and none adequately describes it. Furthermore, as I have said, in order to be the basis for an inference of secondary meaning, the articles must in some way indicate a connection in the minds of consumers between the trade dress and *Aromatique*.” *Aromatique*, 28 F.3d at 872. This is not the case here. The relevant articles actually focus on the Jeep Trade Dress. For example, CX-1688, entitled, “Jeep’s Chief Designer Explains How Vintage Design Inspired the 2018 Wrangler,” discusses the Wrangler’s trapezoidal grille and the flat hood. Moreover, as discussed above, FCA presented a number of other unsolicited articles that include pictures of the Jeep Wranglers, which clearly show the Jeep Trade Dress, and many of the articles discuss the “iconic” design of the vehicle. *See, e.g.*, CX-1355; CX-1688; *see also* CX-1693:0003 (“Retaining the boxy exterior, slotted grilled and rugged off-road ability, the Wrangler. . .” (Autotrader.com, March 2016)); CX-1693:0004 (“highlighting Wrangler’s “keystone shape” of the grille, the way the headlights invade the outer grille slats. . .” (Car and Driver, Yahoo.com, Nov. 29, 2017)).

Accordingly, FCA has presented credible evidence of significant unsolicited media coverage of the Jeep Trade Dress.

g. Conclusion

Every single factor the Commission considers supports a finding of secondary meaning to at least some degree. In sum, the balance of the evidence shows that the Jeep Trade Dress acquired secondary meaning prior to 2018.

3. The Jeep Trade Dress Is Not Generic

A generic term “is the common descriptive name of a class of goods or services.” *Princeton Vanguard, LLC v. Frito-Lay N. Am., Inc.*, 786 F.3d 960, 965 (Fed. Cir. 2015); *see also T. Marzetti Co. v. Roskam Baking Co.*, 680 F.3d 629, 634 (6th Cir. 2012) (“If a mark is primarily associated with a type of product rather than with the producer, it is generic.”). In determining whether a mark is generic, courts follow a two-step inquiry: “First, what is the genus of goods or services at issue? Second, is the [mark] understood by the relevant public primarily to refer to that genus of goods or services?” *In re Cordua Restaurants, Inc.*, 823 F.3d 594, 599 (Fed. Cir. 2016)(citation omitted). Once an accused infringer asserts that a mark is generic, the burden shifts to the accuser to prove the mark is not generic. *Marzetti*, 680 F.3d at 633.

There is evidence that the term “jeep” is generic, and refers to “a small, sturdy, four-wheel-drive army vehicle, used chiefly for reconnaissance,” or “a similar vehicle in non-military use.” RX-1598:0003. But what is asserted here is the Jeep Trade Dress, not the term “jeep,” and even Respondents’ evidence clearly proves that the Jeep Trade Dress is not generic. FCA asserts that the Wrangler is an SUV, and as explained above, Dr. Steckel determined that none of the vehicles he analyzed—at least some of which appear to be SUVs—had all six elements of the Jeep Trade Dress. RX-1907C; Hr’g Tr. (Steckel), 1084:9-12, 1127:3-1129:10. Mr. Hill admitted that the Wrangler is an SUV by current standards. Tr. (Hill), 828:8-12. More to the point, Mr. Hill’s opinion pertained to a “category, species, or genre of 4x4 off-road utility type vehicles that could include SUVs,” but his “family tree” of such vehicles does not identify any non-Jeep vehicles with all six elements of the Jeep Trade Dress. RX-1010C (Hill), Q/A 17, 99; RX-1882C; Tr. (Hill), 845:15-22. And even assuming that the relevant genus is the UTV or side-by-side category, the

[REDACTED]

six elements of the Jeep Trade Dress do not appear together on any such vehicles. RX-1701C; RX-1907C.

Respondents advance a number of other unpersuasive arguments. For instance, Respondents assert that the first version of a “jeep” was touted by its manufacturer, Willys-Overland, as a “pattern” for a “type” in the 1940s. RIB at 29-30. But such promotional language does not mean that the public understood the Jeep Trade Dress, which was not even introduced until 1955, to refer primarily to a “type” of vehicle. CX-1004C (Spano), Q/A 44-47. As another example, Respondents assert that the Federal Trade Commission (FTC) in the 1940s found the design of the wartime “jeep” to “denote[] a type of vehicle.” RIB at 30-31. But the FTC’s determination says nothing about the Jeep Trade Dress specifically, which, again, was introduced in 1955. CIB at 87. Respondents also assert that third parties have used some or all of the six elements of the Jeep Trade Dress. RIB at 31-34. But they do not identify any third party vehicle possessing all six elements, and as explained above, their own witnesses failed to identify any such third party civilian vehicles sold in the United States. And although it is true, as Respondents demonstrate, that the Jeep Trade Dress has evolved over time, that fact has no bearing on whether the public understands the Jeep Trade Dress to refer to a genus of vehicles. *See* RIB at 39-50.

On balance, therefore, FCA has proven that the Jeep Trade Dress is not generic.

B. The Jeep Trade Dress is Not Functional

Trade dress must be non-functional. *Ink Markers* at 26. Functional features of a product are those which are “essential to the use or purpose of the article or . . . affect the cost or quality of the article, that is, if exclusive use of the feature[s] would put competitors at a significant non-reputation related disadvantage.” *TrafFix Devices*, 532 U.S. at 32 (*quoting Qualitex*, 514 U.S. 159, 165 (1995)). The “inquiry is not directed at whether the individual elements are functional

[REDACTED]

but whether the whole collection of elements taken together are functional.” *Int’l Jensen Inc. v. Metrosound U.S.A., Inc.*, 4 F3d 819, 823 (9th Cir. 1993). As explained above, the *Morton-Norwich* criteria inform the functionality determination.

The first *Morton-Norwich* criterion is whether the utilitarian advantages of the design are touted in advertising. Respondents assert that FCA promotes the utilitarian advantages of the Jeep Trade Dress design in its advertising by drawing comparisons of its CJ and Wrangler to the earlier military jeep. Respondents present a history of the design of the military jeep, arguing that each element of FCA’s Jeep Trade Dress element was designed into the military jeep for a specific utilitarian purpose. Therefore, the argument appears to be, because the military had a reason to design its jeeps a specific way, and FCA reminds consumers that its vehicles are, in essence, distant progeny of the military jeep, the functionality of the Trade Dress asserted by FCA is expressly “touted” in its advertising. See generally RIB at 106-12. This argument is incorrect for two reasons. First, the usefulness of each separate element of the design is not at issue. The question is whether the whole collection of elements taken together are functional. *Int’l Jensen*, 4 F.3d at 823. The whole collection of Jeep Trade Dress elements is no more functional than it is generic, as Mr. Hill’s “family tree” demonstrates. See RX-1882C. Second, FCA’s predecessors stopped making vehicles for use in the military and began making the CJ (Civilian Jeep), that was “designed intentionally [it] was a ‘styled’ vehicle.” CX-1001C (Allen), Q/A 40. This “style” is what is advertised, not the military functionality. The connection to the utilitarian aspects of the military jeep in the advertisements is tenuous at best.

The second *Morton-Norwich* criterion is whether the particular design results from a comparatively simple or cheap method of manufacture. It may be that the “flat appearing grille . . . [in the original military vehicle simplifies] manufacturing as compared to the prior iron bar

[REDACTED]

design.” RIB at 105; see also *id.* at 112. But this does not establish that the Jeep Trade Dress overall results in a simple method of manufacture. Again, the whole collection of elements must be taken together; that one element may be easier to manufacture than others does not mean the whole collection of elements is, as well. [REDACTED]

[REDACTED]

[REDACTED] CX-1001C (Allen), Q/A 55, 58, 63.

The third criterion is whether there exists a utility patent that discloses the utilitarian advantage of the design for which protection is sought. Respondents point to a number of utility patents that purportedly illustrate the functionality of the trade dress elements. RIB at 111-12. Specifically, Respondents list U.S. Patent Nos. 2,278,450 (the '450 Patent); 2,378,504 (the '504 Patent); 2,429,732 (the '732 Patent); 2,464,059 (the '059 Patent); 2,367,434 (the '434 Patent); and 2,545,795 (the '795 Patent). RX-1878; RX-1880; RX-2116; RX-2118; RX-2111; and RX-2119; *see also* RX-1010C (Hill), Q/A76-81. But none of these patents explicitly teach the functionality of any of the elements of the claimed trade dress. At most, some elements are shown in the figures and mentioned in the specifications of the various patents (although none of the cited patents explicitly teach exterior door latches). And, again, the question is whether the whole collection of Jeep Trade Dress elements is functional, not whether disparate utility patents disclose each element separately.

The fourth and final criterion is whether commercial alternatives are available. Respondents presented no argument regarding this issue. *See* RIB at 102-14; RRB at 43-46. And with good reason—even their own evidence shows that other automobile companies make and sell alternatives that do not possess the Jeep Trade Dress. *E.g.*, RX-1882C.

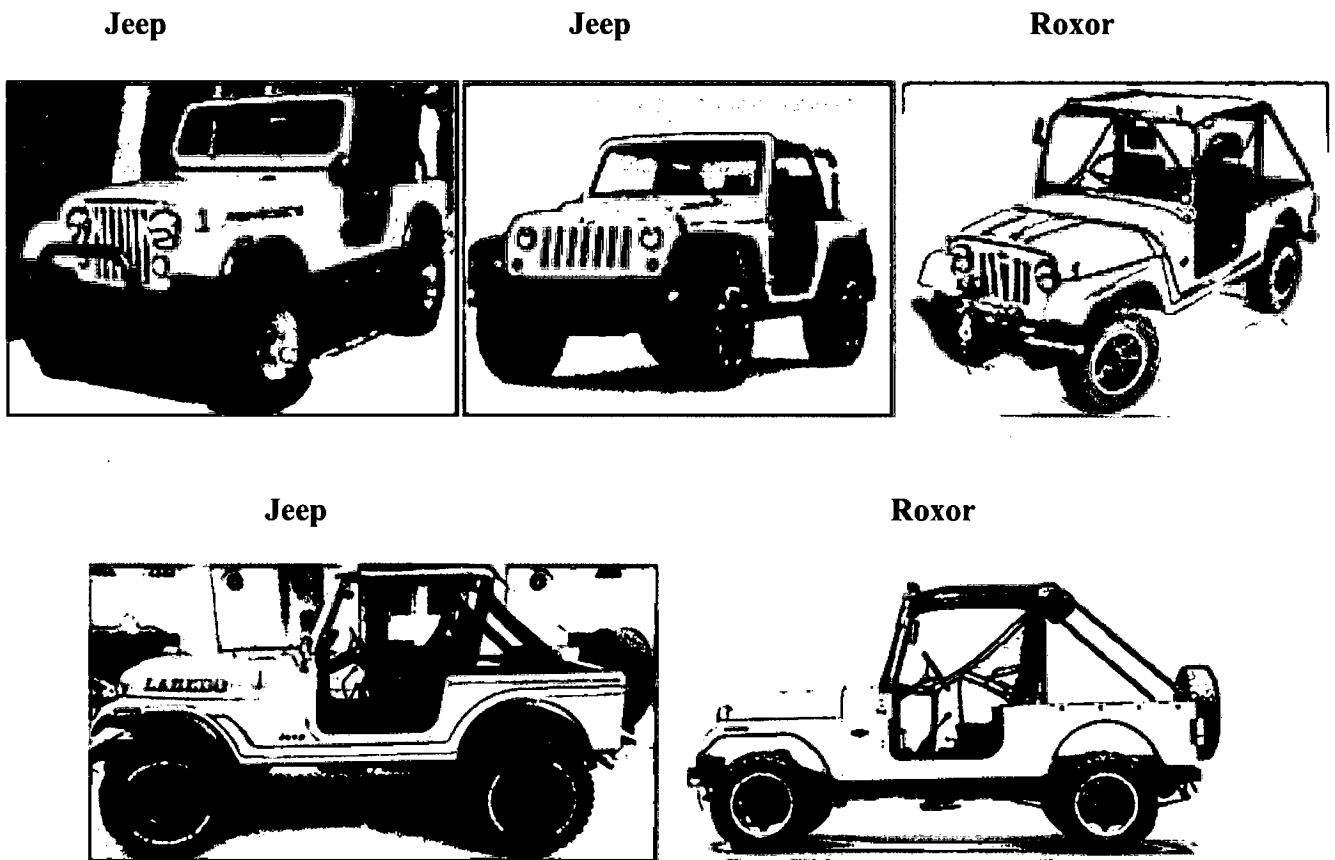
On balance, therefore, FCA has proven that the Jeep Trade Dress is non-functional.

C. Infringement


The primary question in determining whether the Jeep Trade Dress is infringed by Respondents' Roxor is whether it is "confusingly similar" (*Walmart*, 529 U.S. at 210-211), which is determined using the *DuPont* factors. *DuPont*, 476 F.2d at 1361. As explained below, when applying the *DuPont* factors to the record evidence, there is a likelihood that the Roxor vehicle is confusingly similar, and thus, infringes the Jeep Trade Dress.

1. The Similarity of the Marks in Their Entirety

From a simple visual inspection, there is striking similarity between the Roxor vehicle and Jeep brand vehicles displaying the Jeep Trade Dress, as shown in the images below.



Specifically, the Roxor vehicle displays all six Jeep Trade Dress features:

- 
- (i) The Roxor has a boxy body shape with flat appearing vertical side and rear body panels ending at about the same height as the hood;
 - (ii) The Roxor's hood is substantially flat with curved side edges that taper to be narrower at the front;
 - (iii) The Roxor has trapezoidal front wheel wells with front fenders or fender flares that extend beyond the front of the grille;
 - (iv) The Roxor grille is flat with vertical elongated grille slots and a trapezoidal outline that curves around round headlamps positioned on the upper part of the grille;
 - (v) The Roxor has exterior hood latches; and
 - (vi) The Roxor has door cutouts above a bottom portion of the side body panels.

In testimony, many of Respondents' witnesses admitted both the similarity and that the similarity is intentional. For example, Mahindra's CEO and President, Rick Haas testified that:

1. "[W]e are aware that it has the appearance of a CJ." CX-1018C (Haas Dep. Tr.) at 176:9-10.
2. "[O]f course, it does look like a CJ, yeah." *Id.* at 189:7.
3. "So we agree with the statement that it looks like a CJ." *Id.* at 189:11-12. "So they said it looked like a CJ, which, of course, we're fine with because that's what it is." *Id.* at 189:17-19.
4. "Since our vehicle is actually a CJ...." *Id.* at 252:2.
5. "And everyone understands that our vehicle is a CJ, is basically a CJ, and so there are people that want to talk about that, that it's a CJ." *Id.* at 266:22-267:3.
6. "The Mahindra vehicle is a CJ." *Id.* at 300:22-301:1.
7. "The CJ is a Jeep brand vehicle," and "I'm aware" that "in the United States, the only brand to sell a CJ model vehicle has been the Jeep brand." Hr'g Tr. at 710:3-6, 759:7-10.

[REDACTED]

Furthermore, Respondents' designer responsible for the Roxor vehicle, Paul Lewis, expressed [REDACTED]

[REDACTED] CX-1019C (Lowis Dep. Tr.) at 127:8-15. Mahindra's Vice President of Marketing, Richard Ansell, likewise confirmed that [REDACTED]

[REDACTED]

CX-1047C:0002. [REDACTED]

[REDACTED]

CX-1015C (Ansell Dep. Tr.) at 169:7-10. He told his colleagues that [REDACTED]

[REDACTED]

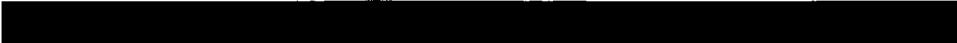
CX-1069C:0001. To Mr. Ansell, [REDACTED]

[REDACTED] CX-1015C (Ansell Dep. Tr.) at 99:5-9. Another Mahindra USA employee, Cleo Franklyn, [REDACTED]

[REDACTED] CX-1069C:0001.

The press has commented on the similarity between the Roxor and Jeep brand vehicles that display the Jeep Trade Dress:

1. CX-1214: A Jalopnik article about the unveiling of the Roxor remarked: "It's a real Jeep. There's no other way to put it. The Roxor is an old-school Jeep. Which may lead you to wonder: how can Mahindra build a Jeep? Can't only Jeep build Jeeps?"
2. CX-1215: A Gordinier Group article discussing Mahindra's Dealer Announcement Show reported that "the vehicle obviously has Wrangler visual cues."
3. CX-1809: A Wall Street Journal article stating "[t]he Roxor is an unusual vehicle, looking much like . . . [the] iconic Jeep Wrangler...."

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4. CX-1810:0003: A Car & Driver article explained how “the sight of an open-top steel body with an upright grille and flattop fenders on a boxed ladder frame with four-by-four capability makes Jeep comparisons inevitable.”
 5. CX-1377: A Car Buzz article entitled “Mahindra Roxor is One Bad-Ass Mini-Jeep, But There is a Catch,” asked, “If it walks like a Jeep and talks like a Jeep, is it a Jeep?”
 6. CX-1575:0002: Another Jalopnik article entitled “The Mahindra Roxor is a Reincarnated WillysJeep” stated that, “if you want classic CJ looks without having to keep an old Jeep alive, the Mahindra Roxor was made for you.”
 7. CX-1576: A Detroit News article opined that the Roxor’s design will herald “inevitable comparisons to Jeeps past and present,” and erroneously suggested that Mahindra must have an agreement with FCA, because few “would need more than a glance to see Jeep in Roxor’s four-and-a-half bar grille, its stubby nose and muscular stance.”

2. The Similarity and Nature of the Products

The second *DuPont* factor weighs somewhat in favor of infringement because the parties’ products are similar; again, a simple visual inspection confirms this. Their sizes and specifications are also similar, at least with respect to one Jeep vehicle embodying the Jeep Trade Dress. *Compare* CX-1200:0002 (Roxor) *with* CX-1699:0010 (CJ-7). Admittedly, the Roxor is only legal as an off-road vehicle in most jurisdictions. *See* CIB at 56. But the Wrangler is designed for off-road use as well, and has been praised as “the leader in the off-road market.” CX-1012C (Carvallo), Q/A 15-18. Conversely, the Roxor can be made street legal with accessories and conversion kits, with one dealer seemingly offering a fully converted Roxor on its website. *See* CX-1836; CX-1854; CX-1856. Respondents’ other points regarding this factor, pertaining to price, financing, test driving, and so forth, are not pertinent (although they are relevant to sales conditions, which is discussed below). *See* RIB at 130-32.

3. The Similarity of Established, Likely-to-Continue Trade Channels

The third *DuPont* factor also weighs somewhat in favor of infringement. FCA admits that the Roxor and Jeep brand vehicles are not sold at the same dealerships. *See* CIB at 60.

[REDACTED]

Nonetheless, the evidence otherwise illustrates parallel marketing efforts. For instance, a Wall Street Journal article covered Mahindra's presence at the 2019 North American International Auto Show, which "features the world's automotive and mobility leaders, showcasing the latest vehicles, products, and technology." CX-1826. The article was entitled, "Indian Auto Maker Shows Jeep Knockoff," and reported that Mahindra "took the brazen step of displaying its Roxor sport-utility vehicle just a few hundred feet away from the Jeep stand." *Id.* at 0003

Witnesses testified that the Wrangler is marketed through many of the same channels (e.g., outdoor magazines, off-road events) as the Roxor. CX-1008C (Carpenter), Q/A 114-115; CX-1012C (Carvallo), Q/A 16 ("I usually see advertisements for both UTVs and vehicles like the Wrangler or Ford Raptor, which are used extensively off-road. These advertisements are usually right next to each other or occupy the same space."). Multiple witnesses testified, in sum, that "[t]here's an overlap in the markets and there's an overlap in culture and what the consumer is looking for: Both want the feeling of freedom and adventure; UTV owners do the same thing that many of our existing owners do, they take their vehicles off-road." CX-1005C (Tallon), Q/A 45; CX-1008C (Carpenter), Q/A 99 ("Buyers in the SUV and UTV market seek overlapping benefits." (quoting JX-1096C:10). Notably, Mahindra's head of marketing agreed. *See, e.g.*, RX 1004C (Ansell), Q/A 56 ("it is not surprising that there is some overlap in the demographic or psychographic profile of the Roxor and Wrangler").

Specific advertisements demonstrate similar trade channels. One example is found in CX-1264C, which discloses that Mahindra and FCA placed national television advertisements for the Roxor and Wrangler, respectively, on ESPN in October 2018. Mahindra advertises the Roxor in 4Wheeler and 4Wheel & Off-Road as well as "general circ[ulation] and mens magazine[s]," such as Car & Driver, Outdoor Life, Men's Journal, and Men's Health; similarly, FCA advertises the

[REDACTED]

Jeep Wrangler in 4Wheeler, 4Wheel & Off-Road, Men's Journal, Men's Health, and Outside. Compare CX-1107C with CX-1707C. Both Mahindra and FCA also advertise their respective vehicles at live sporting events, such as baseball, football, and hockey games. CX-1820; CX-1832; CX-1843; CX-1835; CX-1849; Hr'g Tr. at 1218:7-1219:2.

4. The Conditions Under Which Sales are Made – Impulse vs. Careful Purchasing

This factor weighs against a likelihood of confusion. “[A]utomobiles are expensive and would only be purchased after careful consideration, thereby reducing the risk of confusion.” *Standard Knitting, Ltd. v. Toyota Jidosha Kabushiki Kaisha*, 77 U.S.P.Q.2d 1917, 1937 (T.T.A.B. 2006); see also *Kiekhoefer Corp. v. Willys-Overland Motors, Inc.*, 236 F.2d 423, 427-28 (C.C.P.A. 1956). Here, the evidence illustrates that UTVs “require a significant investment from purchasers” and “consumers would likely do substantial research as part of the purchase.” RX 1007 (Franklyn), Q/A 57. Additionally, the “average price for the top-selling UTVs range from \$12,900 to \$19,500,” while “the average price for the Jeep Wrangler JL ranges from \$34,400 to \$37,900.” RX-1009C (Gustafson), Q/A 52; RX-1007 (Franklyn), Q/A 58, 59-66 (“consumers average over 14 hours researching their automobile purchase. . . . [W]ith 95% of vehicle buyers now using digital sources as information on the buying process, and 70% of people using YouTube as part of their car buying process, it is clear that there is an abundance of information targeted at having consumers make more informed decisions prior to entering a dealership”); RX-1734; RX-1730.

Other sales particulars also weigh against a likelihood of confusion, including different financing programs for UTVs compared to automobiles, difficulties in test driving UTVs (because they are not street legal), dealership differences (UTVs are typically not sold through automobile dealerships, but instead through “powersports” dealers), and point of sale information such as MSRP stickers, which may not be found on UTVs. See generally RX-1009C (Gustafson), Q/A

[REDACTED]

45-89. In fact, this factor weighs so decisively against infringement that Respondents' argument distinguishing between point of sale confusion and other forms of confusion is beside the point. *See* RIB at 7.

5. The Fame or Strength of the Trade Dress

Fame has both a conceptual and a commercial component, and a trademark is famous for infringement purposes if a significant portion of the relevant consuming public recognizes the mark as a source indicator. *Swagway*, 934 F.3d at 1337; *Palm Bay Imports*, 396 F.3d at 1375. To be sure, trade dress is inherently non-distinctive, as Respondents point out. RIB at 116. But the Jeep Trade Dress has overcome that disadvantage by acquiring distinctiveness, as explained above. Otherwise, Respondents and the Staff address both components of fame as simply a matter of secondary meaning. *See* RIB at 116-17; SIB at 68-69; *but see* CIB at 66-67 (discussing fame for both confusion and dilution purposes). Because the Jeep Trade Dress has acquired substantial secondary meaning, and because it necessarily follows that SUV and UTV purchasers recognize the Jeep Trade Dress as a source indicator, its fame weighs in favor of a likelihood of confusion.

6. The Number and Nature of Similar Marks in Use on Similar Goods

This factor is discussed in more detail in the section related to secondary meaning. Simply put, other SUVs and UTVs do not display the entire Jeep Trade Dress. *See, e.g.*, CX-1006C (Baker) at Q/A19, 28; RX-1907C (Respondents' expert's third-party use chart showing no third-party vehicles having all six Jeep Trade Dress elements); *see also* Hr'g Tr. at 837:14-851:18, 1084:9-12. Therefore, this factor weighs in favor of a likelihood of confusion.

7. Actual Confusion

The evidence of actual confusion strongly suggests that consumers are confused about the origin of the Roxor vehicle. The evidence presented includes e-mail correspondence, articles, and

[REDACTED]

testimony regarding Roxors at Jeep enthusiast events, which show consumers actually associate the Roxor with the Jeep brand.

For example, a number of consumers and dealers wrote online to Mahindra about the Roxor, either thinking that the product was a Jeep vehicle or suggesting that it had some association with the Jeep brand. The following are a few examples of Mahindra's "Contact Us Submission Form" responses:

1. [REDACTED] (CX-1078C).
2. [REDACTED] (CX-1079C).
3. [REDACTED] (CX-1080C).

See also CX-1092C:0001 (MAH0086809) [REDACTED]

[REDACTED] CX-1093C:0001 (MAH0086497) [REDACTED]

[REDACTED]

[REDACTED]

A number of magazine and newspaper articles illustrate actual confusion regarding either the source of the Roxor vehicle or Mahindra's right to manufacture a Jeep. See, e.g., CX-1297C:0001 ("The Mahindra Roxor Is A Tiny Offroad Jeep That You Can Totally Buy In America"); CX-1575; CX-1576; CX-1577; CX-1578; CX-1001C (Allen), Q/A 94-96; CX-1700; CX-1701; CX-1012C (Carvallo), Q/A 53-54. A *Compeau's* article erroneously stated: "The Mahindra Roxor is a lightly updated off-road vehicle based on the old Willys Jeep Mahindra licensed to build in 1947. Mahindra has been renewing that license ever since which allows them

[REDACTED]

to keep stamping out CJ sheet metal....” CX-1212. An *Off-road.com* article also mistakenly reported: “As for the looks, the Roxor looks like an old Jeep because it essentially is one. Mahindra began building the Willys CJ-2A under license in the late 1940’s to sell in India. Those licenses are still in place today, allowing this modern version of those old Jeeps to be sold.” CX-1213. A *Jalopnik* article, entitled “This is Why Mahindra Can Build Tiny Jeeps,” erroneously reported, after the Roxor unveiling at Mahindra’s plant, that the Roxor is a “heavily modified” Mahindra Thar, “which is, yes, a license-built Jeep. And that’s pretty much exactly why Mahindra can build the iconic Jeep without worry—they’ve had a license to do so since 1947.” CX-1214. A *Gordinier Group* article noted that “Mahindra has maintained license from Willy’s since the 1940’s to build this vehicle.” CX-1215. An *onmanorama* (originally from Reuters) article reported: “Mahindra has had a license since the end of [World War II] to make such vehicles in India.” CX-1216.

One of the most telling examples of actual confusion was presented by an FCA witness who saw Roxor vehicles in front of Wranglers for rent to the public, with signage stating “Jeep Rental” in what appears to be the Jeep brand’s font, as shown below. CX-1001C (Allen), Q/A 94-96; CX-1701.



CX-1701.

[REDACTED]

Additionally, potential and actual consumer feedback suggests at least some degree of confusion as to whether the Roxor is associated with the Jeep brand. *See, e.g.*, Hr'g Tr. (Haas), 683:17-685:21 (testimony summarizing CX-1121C:0005); *see also* CX-1080C:0001; Hr'g Tr. (Ansell), 988:13-20, 990:6-11, 993:18-24; CX-1081:0001; CX-1078C:0001. For instance, Mahindra's social media consultant [REDACTED]

[REDACTED] *See* CX-1275C.

FCA also offered evidence of a survey conducted by its expert, Hal Poret, that evidences confusion. *See generally* CX-1010. However, this survey is entitled to little weight, primarily because it did not use an effective control. The control did not share many characteristics with the test vehicle, and in fact, made changes to the control depiction that were unrelated to the trade dress at issue. *See generally* SIB at 64-67.

Overall, however, the evidence shows a significant amount of actual confusion regarding the origin of the Roxor vehicle.

8. The Length of Time When There Has Been Concurrent Use Without Evidence of Actual Confusion

The Roxor was launched in the United States on March 2, 2018. RIB at 12. The FCA filed the present complaint on August 1, 2018. Thus, there has been very little time of concurrent use, with or without confusion. Therefore, this factor is not particularly relevant.

9. The Variety of Goods on Which the Mark is Used

On the one hand, in recent decades FCA generally used the Jeep Trade Dress on only one product at a time—namely, the various versions of the Wrangler. On the other hand, FCA licenses its Jeep Trade Dress to companies to manufacture replacement parts for Jeep CJ and Wrangler vehicles. JX-1116C (Classic Enterprises license); JX-1115C (royalty report for CJ replacement

[REDACTED]

parts); CX-1004C (Spano) at Q/A133-143; CX-1814C (Omix ADA license). FCA also has licenses with manufacturers of toys, including: a Fisher-Price Power Wheels Tough Talking Jeep Wrangler, a toy remote control Bburago Junior Jeep, a die cast Jeep Wrangler Rubicon model, a Jeep Wrangler Matchbox car, a Jeep brand puzzle with multiple Jeep brand vehicles and advertisements including Willys, CJ, and the Wrangler, a 1963 Jeep CJ-5 model, a 1977 Jeep CJ-7 die-cast model, a Jeep Wrangler toddler bed, t-shirts, signs, stickers, and a Tervis water bottle. *See* CX-1717. Additionally, CPX-1001 shows a licensed 2014 JK Wrangler model remote control car made by Jada Toys. CPX-1001; CX-1003C (Adams-House) at Q/A99; CX-1724C; CX-1004C (Spano) at Q/A122-132. [REDACTED]

[REDACTED]

[REDACTED] *See* RRB at 59-60; e.g., CPX-1001.

This factor weighs in favor of infringement. *See In re Wilson*, 57 USPQ 2d 1863, 1867, 2001 WL 58395 at *4 (T.T.A.B. 2001).

10. DuPont Factors 10-12

These factors (market interference between the parties, right of FCA to exclude others, and extent of potential confusion) are embedded in the factors discussed above.

11. Dupont Factor 13 - Other Facts Probative of the Effect of Use

Respondents' intent in adopting the Jeep Trade Dress designation, and thus in confusing consumers as to the origin of its Roxor vehicle, demonstrates a likelihood of confusion. *DuPont*, 476 F.2d at 1361; *see also Converse*, Inv. No. 337-TA-936, 2015 WL 1380550, at *35 (*quoting Ink Markers*, Inv. No. 337-TA-522, 2005 WL 2866049, at *17 (July 25, 2005)). The evidence strongly suggests that Respondents intended to recreate an appearance of the earlier Jeep CJ in its design of the Roxor, as well as create a commercial impression that linked the Roxor to the history

[REDACTED]
of the Jeep CJ's design. *See, e.g.*, CX-1047:0002 (MAH0080479) [REDACTED]

[REDACTED] CX 1011C (Vander Veen), Q/A 105; CX-1045C:0001 (MAH0081045); (JX-1135C) [REDACTED] CX-1060C:0005 (JX-1138C)

[REDACTED] JX-1137C [REDACTED]

[REDACTED] Tr. (Ansell), 983:9-14. [REDACTED]

[REDACTED] RX-1004C (Ansell), Q/A 23-24. The THAR “[l]ooked like an old army jeep.” RX-1003C (Pacella), Q/A 29-30; RX-1012C (Haas), Q/A 147 (“I would agree that the ROXOR looks like a ‘jeep’ in that it’s an open air, military-style vehicle. The ROXOR looks like an old civilian jeep, because that’s what the body basically is: the THAR is descended from the original Mahindra CJs, and we’ve also kept much of the original construction . . .”).

[REDACTED]
[REDACTED] RX-1004C (Ansell), Q/A

26. [REDACTED]

[REDACTED] RX-1004C (Ansell), Q/A 27, 28. [REDACTED]

[REDACTED] 1004C (Ansell), Q/A

30;.; *see also id.*, Q/A 31-32; Hr’g Tr. (Haas), 678:1-11 [REDACTED]
[REDACTED]

[REDACTED]

Respondents' witness Richard Ansell made clear that he wished to create a commercial impression that linked the Roxor to certain historic Jeep or Willys brand vehicles. CX-1059C (MAH0093765). In a July 2015 e-mail, for example, Mr. Ansell stated:

[REDACTED]

CX-1059C (MAH0093765).

After it released the Roxor in the United States, [REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED] RX-1004C (Ansell), Q/A 35 [REDACTED]

[REDACTED] *id.*, Q/A 36 [REDACTED]

[REDACTED] Since

the Roxor's launch in the United States, Mahindra's marketing has attempted to garner recognition through indirect association with the Jeep brand by boasting of "70 years of heritage," a connection to the Willys Jeep, and a suggestion of a U.S. military and World War II connection. CX-1064C:0004; CX-1517C. Furthermore, MANA's Roxor brochure for the 2019 Auto Show stated:

Seven decades, thousands of battles, and an earthload of mud ago, Mahindra began assembling vehicles in India under license from Willys. Yeah, that "Willys." The original 1940's off-road icon. The one that won wars and purple hearts. And now the ROXOR, assembled with the toughness and ruggedness of yesteryear, looks to conquer the world again.

CX-1064C: 0004.

[REDACTED]

Respondents did present evidence to mitigate this powerful evidence of its intent. For example, Mahindra offered evidence that it understood the terms of the 2009 Agreement to mean that FCA would not sue Mahindra over certain designs, and further that Mahindra intended to avoid trading on FCA's brand or reputation by modifying portions of the Roxor's design. *See* RRB at 40-43, 72-73. However, the mitigative effect of such evidence is weak. After the Commission determined not to review the Chief ALJ's ruling that the Roxor Grille was not within the scope of the 2009 Agreement, Respondents continued to import Roxor components. *See generally* Importation Stipulation, Ex. A. And MANA's CEO, Mr. Haas, admitted on cross-examination that Respondents "reconfigured" the grille design negotiated with FCA under the 2009 Agreement. Tr. (Haas), 729:20-25. Indeed, when FCA filed its original complaint in this Investigation, an internal MANA email noted that it was [REDACTED] CX-1127C.

Accordingly, the evidence shows that Respondents: (1) knew consumers would associate the outward appearance of the THAR with "an old Willys or an old CJ"; (2) knew the Roxor would create the same commercial impression as the THAR; and (3) began manufacturing the Roxor without changing its design (except for the grille) to avoid a commercial impression that clearly links its vehicle to the Jeep CJ. In short, Mahindra knew that the public would perceive the Roxor as essentially a reissue of FCA's Jeep CJ vehicles, and intended that the public do so. *See* CX-1037C:0014; CX-1219C:0008; CX-1047C:0002; Tr. (Haas), 970:16-971:9. Thus, the evidence on this factor favors a finding of likelihood of confusion.

D. Defenses and Analysis

Respondents assert that FCA has neither consistently nor continuously used the Jeep Trade Dress, and eventually "abandon[ed]" some elements of it. *See generally* RIB at 46-50.

[REDACTED]

Respondents specifically argue that any rights in the CJ-5 implementation, which allegedly are the features that comprise the Jeep Trade Dress, were abandoned in the 1980s, when FCA's predecessor ceased selling CJs and started selling the Wrangler YJ implementation. *See id.* Respondents contend that the changes from the CJ to the Wrangler YJ were significant, including replacing the round headlights with rectangular headlights, and replacing the flat grille with a grille with an angled break. Respondents further contend that although the Wrangler TJ, the next Wrangler model, sold from 1996-2006, resumed using round headlights, the grille of the Wrangler TJ also had a "kink" to it, meaning that it also was not "flat appearing." Finally, Respondents argue that the more recent Wrangler JK also does not use the combination of the six claimed elements because it does not use a trapezoidal grille, and comparing the most recent implementation of the Jeep Trade Dress with the Roxor shows that there is a lack of similarity. *See id.* at 49-50.

Abandonment is an affirmative defense requiring proof that the mark's owner has ceased using the mark with an intent to not resume its use. *Cumulus Media, Inc. v. Clear Channel Comms., Inc.*, 304 F.3d 1167, 1173-74 (11th Cir. 2002). In situations concerning alleged abandonment of prior forms of a mark, courts have consistently held that a key question in resolving the dispute is whether the different forms of the mark create the "same, continuing commercial impression." *Ilco Corp. v. Ideal Sec. Hardware Corp.*, 527 F.2d 1221, 1224 (C.C.P.A. 1976)("The law permits a user who changes the form of its mark to retain the benefit of its use of the earlier form, without abandonment, if the new and old forms create the same, continuing commercial impression."); *Jack Wolfskin Ausrüstung Fur Draussen GmbH & Co. KGAA v. New Millennium Sports, S.L.U.*, 797 F.3d 1363, 1368 (Fed. Cir. 2015)("Two marks are legally equivalent if they 'create the same, continuing commercial impression' and where the modified

[REDACTED]

version of the mark does not ‘materially differ from or alter the character’ of the original mark.”)(quoting *Van Dyne-Crotty, Inc. v. Wear-Guard, Corp.*, 926 F.2d 1156, 1159 (Fed. Cir. 1991)); *Rose Art Indus., Inc. v. Swanson*, 235 F.3d 165, 173 (3rd Cir. 2000)(noting that a party “may have trade dress rights even though there are slight variations in its package design so long as the change does not alter the distinctive characteristics and the trade dress conveys a single and continuous commercial expression”) (citations and internal quotations omitted); *see also Hana*, 135 S. Ct. at 910.

The evidence in this case shows that each subsequent model of the Jeep CJ and Wrangler vehicles is a modernized version of the prior model. CX-1001C (Allen), Q/A 35 (designer of the Wrangler JL testifying that to modernize, “[w]e actually looked backward to move forward. Two of the changes that I mentioned . . . are elements that were previously present on the CJ-5 So we brought back those two cues for the new JL.”); Tr. (Allen), 114:19-118:22. While FCA’s witnesses acknowledged that there are differences between models, they also testified that FCA’s designers worked to ensure consistency throughout the Jeep CJ and Wrangler vehicle lines. CX-1001C (Allen), Q/A 28, 38, 46; CX-1688. According to FCA’s witnesses, “[p]art of our customers’ passion for the Wrangler comes from passion for the heritage; its design is a callback to its predecessors, including the CJ models, and Willys brand vehicles even before that.” CX-1001C (Allen), Q/A 28, 38, 46; Hr’g Tr. (Tallon), 36:17-37:12. Even Mahindra’s own experts, Dr. Steckel and Mr. Hill, admit that the Jeep CJ and Wrangler designs over the years include all six elements of the Jeep Trade Dress. *See, e.g.,* RX-1906C; Hr’g Tr. (Hill) at 782:21-23, 784:1-22; Hr’g Tr. (Steckel) at 1052:4-8.

Additionally, statements from the media and the general consuming public, [REDACTED]

[REDACTED] suggest consumers believe the Jeep CJ and the Wrangler create the same,

[REDACTED]

continuing commercial impression. This evidence serves as independent proof that FCA actually achieved its design goal of linking, in the minds of consumers, the Wrangler designs to the Jeep CJ designs and heritage. [REDACTED]

[REDACTED] CX-1454C:0091
(FCA00048517). [REDACTED]

[REDACTED] CX-
1687C:0114 (FCA00010122).

It is also important that this is not a patent case, in which the intellectual property is defined principally by the words in a pre-existing written instrument. Instead, it is a case involving trade dress, where the elements for which protection is sought may be “identified” for the first time in litigation. *General Motors Corp.*, 468 F.3d at 415. The Jeep Trade Dress has been identified by FCA, but FCA’s list of the six elements comprising it is simply that, an identification of the elements, so that “it can be understood exactly what they are looking to protect.” *Id.* So long as there exists a continuous commercial impression, the trade dress remains protectable notwithstanding its evolution; necessarily, therefore, it need not be identified with the exactitude expected of a patent claim. *See Jack Wolfskin*, 797 F.3d at 1368. There is no support in the law for Respondents’ apparent contention that any deviation from the listed trade dress description results in abandonment. *See RIB* at 44-45.

In light of this evidence, Respondents’ abandonment argument is unpersuasive. The Jeep Trade Dress has not changed over time sufficiently to qualify as abandoned. The same commercial impression is created by the various iterations of FCA’s vehicles such that the distinctive Jeep Trade Dress has not changed materially. Granted, there have been noticeable changes in the relevant grille and headlight design over the decades: (1) the Wrangler YJ possessed square

[REDACTED]

headlights beginning in 1986, although round headlights were restored in the Wrangler TJ in 1996 (Hr’g Tr. (Allen) at 89:10-90:10; CX-1004C (Spano), Q/A 46); (2) both the YJ and the TJ had a horizontal “kink” in their grilles, so that the grilles were not entirely flat in a vertical direction (Hr’g Tr. (Allen) at 89:14-23; RPX-1001); (3) the Wrangler JK, which was sold from 2006 to 2018, had a grille shape that was “not as apparent” in previous vehicles, although the trapezoidal appearance was “re-established” with the Wrangler JL in 2018 (RX-1614C (Allen Dep. Tr.) at 195:3-17; CX-1004C (Spano), Q/A 46); and (4) the current Wrangler JL, which was introduced in 2018, also has a “kink” in the grille (RX-2706). But such changes, even if “significant,” as Mr. Allen sometimes admitted at depositions, do not amount to abandonment, or otherwise rise to the threshold needed to nullify the continuous commercial impression from 1986 to the present. *E.g.*, Hr’g Tr. (Allen) at 94:14-21.

In any event, the other trade dress elements—the boxy shape, wheel wells, door cutouts, hood shape, and external hood latches—have changed insubstantially, if at all. *See* RX-1019. Even assuming that the change in headlight shape alone was sufficient to constitute abandonment, Wrangler models have used round headlamps for more than 20 years, four times as long as required for *prima facie* evidence of acquired distinctiveness. *See, e.g.*, 15 U.S.C. § 1052(f). And although the Roxor was designed to, and does, resemble a CJ more than a Wrangler JL, a simple visual comparison shows a definite similarity between the Roxor and the JL, and a continuity of trade dress from the CJ to the JL. *Compare* RX-1637 (Roxor) *with* RX-2701 (CJ-5) *and* RX-2706 (Wrangler JL). Nor does the fact that FCA stopped making original CJs affect the analysis, because of the continuing commercial impression created by the overall trade dress, and because FCA still supports and licenses replacement parts for CJs. *See Ferrari S.P.A. v. Roberts*, 944 F.3d 1235, 1237-38 (6th Cir. 1991)(affirming a finding of infringement of the trade dress of Ferrari’s

[REDACTED]

Daytona Spyder, even though Ferrari initiated the trade dress action 15 years after stopping original production of it); Hr'g Tr. (O'Brien) at 183:1-12.

Considering the totality of the evidence, only one of the *DuPont* factors weighs against a likelihood of confusion, namely, sales conditions (factor 4), and one is neutral, namely, the length of time of concurrent use (factor 8). The remaining factors weigh in favor of a likelihood of confusion, to a greater or lesser degree. The first two factors are especially significant, and both weigh heavily in favor of infringement. I also place particular weight on the evidence of actual confusion—because if there is actual confusion there is necessarily a likelihood of confusion—and on the evidence of intent—because there is little doubt from the record that Respondents intend to market the Roxor based at least in part on the goodwill of the Jeep Trade Dress. And Respondents have not proven abandonment. Accordingly, I find that Respondents' Roxor infringes the Jeep Trade Dress owned and asserted by FCA in this Investigation.

E. Dilution

FCA also asserts a claim for dilution of the Jeep Trade Dress. *See* CIB at 95-105. The Lanham Act provides: “the owner of a famous mark that is distinctive, inherently or through acquired distinctiveness, shall be entitled to an injunction against another person who, at any time after the owner's mark has become famous, commences use of a mark or trade name in commerce that is likely to cause dilution by blurring or dilution by tarnishment of the famous mark, regardless of the presence or absence of actual or likely confusion, of competition, or of actual economic injury.” 15 U.S.C. § 1125(c)(1). For a dilution claim based on unregistered trade dress, the claimant has the burden of proving that: “(A) the claimed trade dress, taken as a whole, is not functional and is famous; and (B) if the claimed trade dress includes any mark or marks registered

[REDACTED]

on the principal register, the unregistered matter, taken as a whole, is famous separate and apart from any fame of such registered marks.” 15 U.S.C. § 1125(c)(4).

As noted, the Jeep Trade Dress is not functional. However, the evidence is insufficient to show that the Jeep Trade Dress is “famous” separate and apart from the fame of FCA’s registered marks.

A mark is famous if it is “widely recognized by the general consuming public of the United States as a designation of source of the goods or services of the mark’s owner.” 15 U.S.C. § 1125(c)(2)(A). In assessing the fame of a mark the following factors may be considered: (i) the duration, extent, and geographic reach of advertising and publicity of the mark, whether advertised or publicized by the owner or third parties; (ii) the amount, volume, and geographic extent of sales of goods or services offered under the mark; (iii) the extent of actual recognition of the mark; (iv) whether the mark was federally registered or on the federal principal register. *Id.*

As to the fourth factor, the Jeep Trade Dress is unregistered, which weighs against a finding of fame. As to the first factor, by contrast, there is significant indirect evidence of fame, including:

- [REDACTED]
- [REDACTED]
- Printed media advertising in, for example, USA Today, Rolling Stone, Outdoor magazine, 4 Wheel Drive & Sport Utility Magazine, 4 wheel & Off-Road, Back Packer, ESPN, Four Wheeler, Men’s Fitness, Men’s Health, and Popular Science;
- Wrangler use and appearances in movies, television, and internet social media (e.g., Super Bowl, “Jurassic Park” movie, “Tomb Raider” movie, “The Dukes of Hazzard” TV show, millions of followers and likes on Twitter and Facebook);

[REDACTED]

- Wrangler promotions and appearances in off-roading enthusiast events (e.g., Moab Easter Jeep Safari); and

- Extensive licensing program for merchandise sales of T-shirts, hats, other clothing, ride-on toys, and Matchbox cars.

See, e.g., CX-1001C (Allen), Q/A 90; CX-1003C (Adams House), Q/A 3, 42-67, 82-97; CX-1004C (Spano), Q/A 88; CX-1005C (Tallon), Q/A 56-60; CX-1008C (Carpenter), Q/A 34-48, 98; CX-1538C; CX-1704C (JX-1117C); CX-1707C; CX-1712C; CX-1713C; CX-1714C; CX-1715C; CX-1717; CX-1718C; CX-1722C; CX-1729 (JX-1118) (RX-1235); CX-1759C; CX-1763C; CX-1769C; CX-1918C; CX-1919C; CX-1933C.

There is also evidence supporting the second factor. [REDACTED]

[REDACTED]

[REDACTED]

[REDACTED] CX-1004C (Spano), Q/A 90 (summarizing CX-1860C, [REDACTED] CX-1005C (Tallon)(summarizing JX-1114C showing sales of Wrangler vehicles since 1986), Q/A 2, 10; CX-1008C (Carpenter)(summarizing CDX-1032 showing sales growth of sales of Wranglers since 1986), Q/A 53; CX-1860C; CX-1678C; CDX-1032 (summarizing CX-1078); JX-1114C.

The third factor is dispositive, however. The Wrangler and Jeep CJ vehicles use the registered Jeep Grille Design Marks asserted in this Investigation. *See, e.g.* JX-1002; JX-1003; JX-1004; JX 1005; RX-1019; CX-1688:003. Accordingly, FCA must show that the Jeep Trade Dress, taken as a whole, is famous separate and apart from any fame of the Jeep Grille Design Marks, as well as any other registered marks. 15 U.S.C. § 1125(c)(4). It is entirely unclear to what extent the evidence supporting the first two factors, pertaining to advertising, publicity, and

[REDACTED]

sales, supports a finding of fame separately as to the Jeep Trade Dress—which seriously undermines the weight of those factors. For instance, the Jada Toys remote control Wrangler, which is otherwise a good example of the type of evidence supporting a fame finding, possesses all six elements of the Jeep Trade Dress. CPX-1001. But it also possesses the seven-slot grille, and the word “Jeep,” in stylized font, appears on the toy and, along with the registered trademark symbol, also on its packaging. *Id.* And the evidence from FCA’s own survey experts indicates that at least some respondents identified a seven-slot grille as a reason for their answers. *See, e.g.*, CX-1498C:0040 (FCA00075119). In particular, Dr. David Neal, FCA’s fame expert, admitted that he did not test for recognition of the Jeep Trade Dress as distinct from the seven-slot grille. Hr’g Tr. at 552:23-553-5. FCA’s attempt to rehabilitate Dr. Neal on redirect examination was unsuccessful because he admitted he did not account for the grille as the thing “other than the claimed trade dress that plausibly could be driving recognition.” *Id.* at 560:9-11.

To be sure, Ms. Butler’s survey results provide some indication that “consumers associate design features separate and apart from the grille with the Jeep Wrangler vehicle.” CX-1008C (Carpenter), Q/A 88. And consumers and journalists have stated that the Wrangler’s shape is “iconic” and “instantly recognizable.” CX-1454C:0091 (FCA00048517); CX-1687C:0114 (FCA00010122). But on the whole, for purposes of proving fame, FCA’s evidence does not adequately distinguish between the fame of the Jeep Trade Dress and the fame of the Jeep Grille Design Marks. Therefore, FCA has not carried its burden of proving that the Jeep Trade Dress is famous, and its dilution claim fails.



VI. THE ASSERTED TRADEMARKS

A. Validity and Ownership

As explained above, Respondents do not dispute that FCA owns the trademarks at issue, nor do they dispute the validity of the marks.

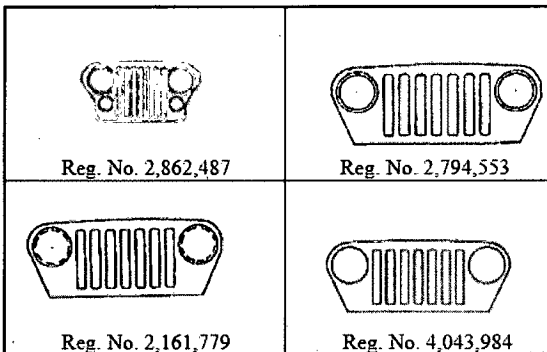
B. Infringement of the Jeep Grille Design Marks

The main question to be answered in determining direct trademark infringement is “whether the alleged infringer’s use of the mark is so similar to complainant’s mark as to create the likelihood of confusion among an appreciable number of members of the public as to the source or sponsorship of the product.” *Chemiluminescent Compositions*, 0091 WL 11732560, at *7. This determination, in turn, is made by applying the *DuPont* factors. *Swagway*, 934 F.3d at 1338-39.

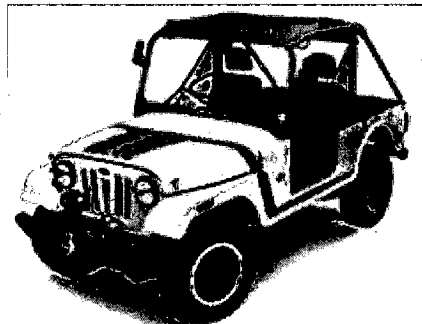
1. The Similarity of the Marks in Their Entirety

Below are the asserted Jeep Grille Design Marks and the Roxor vehicle:

The Jeep Grille Design Marks



The Accused Roxor Grille



Both the Jeep trademarks and the Roxor grill have round headlamps positioned on the upper part of the grille. And the trapezoidal shape of the Jeep marks and the trapezoidal shape of the Roxor grille are very similar. As the Staff points out, when the Jeep Grille Design Marks and

[REDACTED]

Roxor Grille are viewed in the context of the products on which they are used, as shown below, the impressions made by each product's grilles are broadly similar. *See* SIB at 86.



However, the Roxor Grille has slots of varying length, the slots are not perfectly vertical, and there are only five of them. The Jeep Grille Design Marks all have seven slots. JX-0001; JX-0002; JX-0003; JX-0004. Moreover, FCA's CJ and Wrangler vehicles all have grilles with seven slots. *Am. Compl.*, Ex. 6, at 1, 4; RX-1019. In fact, the number of slots in FCA's marks is an important factor. For example, FCA's expert, in the context of asserting a lack of functionality, highlight these differences as being important and distinguishing aspects of the relevant product designs. CX-1006C (Baker), Q/A 33 ("In fact, the figure in the patent shows a 9-slot grille, not a 7-slot grille, with slots of varying lengths."). [REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED] RX-1243C. And

during the negotiations between Chrysler and Mahindra that resulted in the 2009 Agreement, the parties' discussions primarily focused on the number of slots. RX-1013C (Shah), Q/A107, 112-113 (testifying that the key change between a rejected design and an approved design was changing the number of slots from 8 to 5); RX-1012C (Haas), Q/A103; *see also* 100-DayTr.(Shah), 96:22-

[REDACTED]

98:19; 103:1-104:22; RX-1013C (Shah), Q/A101 (“He told me many times that it was the number of slots that mattered).

Accordingly, given these differences, the degree of similarity between the Jeep Grille Design Marks and the Roxor vehicle weighs against infringement.

2. The Similarity and Nature of the Products

The second *DuPont* factor is essentially the same for both the asserted trade dress and the asserted trademarks. As noted, there is a definite similarity between the Roxor and the Wrangler JL, the current version of the Wrangler, and a striking and intentional similarity between the Roxor and the CJ-5. This weighs in favor of infringement.

3. Trade Channels, Sales Conditions, and Market Interference

DuPont factors three, four, and ten will be considered together because they all pertain, at least to some extent, to sales of the Roxor and Jeep vehicles. As discussed above, FCA’s products bearing the marks in question are marketed, at least in part, to the same consumers and for the same uses, as that of the Roxor. *See, e.g.*, CX-1005C (Tallon), Q/A 45, 48-49; CX-1008C (Carpenter), Q/A 99, 114-115; CX-1676C (JX-1096C) (RX-1174C); RX-1004C (Ansell), Q/A 56; CX-1012C (Carvallo), Q/A 15-18, 115; CX-1517C; CX-1012C (Carvallo), Q/A 31-32, 45-54; CX-1771C:0019-21 (FCA00008980-82) (JX-1099C) (RX-1112C); CX-1001C (Allen), Q/A 90-96; CX-1700; CX-1701.

However, when focused solely on the Jeep Grille Design Marks, there are significant differences between the parties’ marketing strategies. FCA’s grille designs are a centerpiece of its product designs [REDACTED] confirms that FCA has successfully highlighted for consumers the Jeep Grille Design Marks. *See* CX-1687C:0114-116 (FCA0010122-24); CX-1405C; CX-1003C (Adams House), Q/A 2, 13; CX-1378:0004

[REDACTED]

(FCA00077567); CX-1006C (Baker), Q/A 28, 30; CX-1498C:0040 (FCA00075119). By contrast, Respondents focus more on the overall design of the vehicle and its heritage; Mahindra's wartime history of making Willys or CJs, and the Roxor's substantially superior capabilities relative to other products in the UTV market. *See* RX 004C (Ansell), Q/A 43; RX-1004C (Ansell), Q/A 42; RX-1009C (Gustafson), Q/A 52-60; CX-1005C (Tallon), Q/A 48-49; CX-1517C; CX-1008C (Carpenter), Q/A 114-115. FCA did not present evidence indicating that Respondents highlight the Roxor grille specifically, and certainly not to the degree that FCA highlights the CJ and Wrangler grille designs. And, again, customers can be expected to conduct considerable research before purchases.

Therefore, this factor weighs against a finding of likelihood of confusion.

4. The Fame or Strength of the Mark

Respondents fail to even address the judicial recognition of the fame of the Jeep Grille Design Marks. *Compare* CIB at 109 (citing *AM Gen.*, 311 F.3d at 821-22) *with* RRB at 71-72. When combined with the other evidence of strength, which Respondents also fail to rebut, this factor weighs in favor of infringement. *See* CIB at 109-11; RRB at 71-72.

5. The Number and Nature of Similar Marks in Use on Similar Goods

In contrast to the Jeep Trade Dress, there is concrete evidence of a mark similar to the Jeep Grille Design Marks on a similar good—specifically, the grille of the Hummer. *See* RX-2050; RX-2051. Although the Hummer grille was not identical to, say, the '984 mark, it did include seven vertical slots bracketed by round headlights. *See* RIB at 85-86. And there is evidence of non-FCA commercial imagery that plays off the Jeep Grille Design Marks. *See* RRB at 72. Nonetheless, the Hummer is no longer manufactured and there is no evidence of currently

[REDACTED]

manufactured non-FCA vehicles with similar grille designs. Therefore, this factor weighs in favor of a likelihood of confusion.

6. Actual Confusion

Neither party's survey evidence on this issue is particularly reliable. FCA's expert, Mr. Poret, did not focus his testing on the Jeep Grille Design Marks. *See* CX-1010C (Poret), Q/A 74-93. And Respondents' expert, Mr. Franklyn, did not use a proper test image. RX-2606; *see* CX-1010C (Poret), Q/A 94-100. Thus, this factor is neutral.

7. The Length of Time When There Has Been Concurrent Use Without Evidence of Actual Confusion

The Roxor was launched in the United States on March 2, 2018. RIB at 12. The FCA filed the present complaint on August 1, 2018. Thus, there has been very little time of concurrent use, with or without confusion. Therefore, as with the Jeep Trade Dress, this factor is not particularly relevant.

8. The Variety of Goods on Which the Mark is Used

This factor weighs in favor of infringement because, as explained above, although the Jeep Grille Design Marks appear on only one vehicle at a time, they also appear on licensed products.

9. *DuPont* Factors 11 and 12

As with the Jeep Trade Dress, these factors (right of FCA to exclude others and extent of potential confusion) are embedded in the factors discussed above.

10. *DuPont* Factor 13 – Other Facts Probative of the Effect of Use

While Respondents presented some evidence that they believed the design of the Roxor grille would not infringe the Jeep Grille Design Marks, the evidence overall indicates that Roxor knew that its similar design, when part of the overall confusingly similar vehicle, would confuse consumers into believing that the Roxor vehicle is a Jeep product. Mr. Haas, in particular, testified

[REDACTED]

that Respondents “reconfigured” the grille design permitted under the 2009 Agreement. Hr’g Tr. (Haas), 729:20-25. That reconfiguration was not wholly directed to reduce the differences between the Roxor grille and the Jeep Grille Design Marks. *Id.* at 725:3-22. (describing the use of “prowed” features on the Roxor). But in important respects it did reduce such differences, because, compared to the Approved Grille Design, it: (1) gave the grille slots a more vertical orientation; (2) narrowed and elongated the grille slots; (3) squared the grid holes inside each slot; and (4) made the center slot taller relative to the flanking slots. *Compare JX-0031 with JPX-0001.* The overall result is a Roxor grille that, compared to the Approved Grille Design Respondents negotiated, more closely resembles the Jeep Grille Design Marks. Although Mr. Haas explained that the reconfiguration was prompted by “engineering requirements,” his testimony that Respondents had “followed the intent of the approved grille” is simply not credible in view of the similarity of the Roxor Grille to the Jeep Grille Design Marks. Hr’g Tr. at 723:19-724:13.

The evidence demonstrates that Respondents intended to implement a Roxor grille design more similar to the Jeep Grille Design Marks than the 2009 Agreement permitted, and that this factor weighs in favor of infringement.

11. Analysis

DuPont factors two, five, six, and nine, and the intent of Respondents, weigh in favor of a likelihood of confusion. The remaining factors are neutral, irrelevant, embedded in other factors, or weigh against a likelihood of confusion, to a greater or lesser degree. Although I have treated it as neutral, the lack of evidence of actual confusion is particularly significant, because if there is actual confusion it should not have been difficult for FCA to demonstrate. Even more significant is the degree of dissimilarity between the registered marks and the Roxor grille; this factor by itself

[REDACTED]

weighs so heavily against infringement that it overwhelms the other factors. Accordingly, I find that Respondents' Roxor grille does not infringe the Jeep Grille Design Marks.

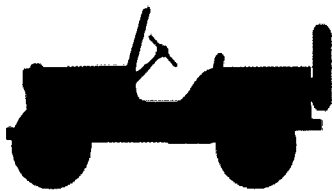
C. Infringement of the '873 Mark

The analysis regarding this mark is similar to the analysis above for the Jeep Grille Design Marks, and I only address the *DuPont* factors that yield different results.

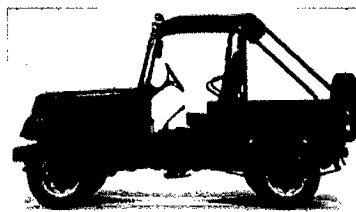
1. Degree of similarity between the '873 Mark and the Roxor

Complainant presented a comparison of the '873 mark and the Roxor vehicle:

The '873 Mark



Mahindra's Roxor



Mahindra Advertising



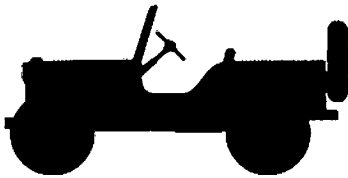
CIB at 109.

These figures illustrate rather significant differences between the mark and the vehicle. The Roxor silhouetted above has a roof of some sort, a gear shift, the interior profile is different, and the back of the Roxor includes a roll cage. And as the Staff notes, comparing a dimly lit, dark colored image of just one of the Roxor's sides should not be given substantial weight because FCA's comparison does not represent the marketplace realities and the commercial impression that the three-dimensional Roxor, as a whole, actually makes on consumers. "The proper test is not a side-by-side comparison of the marks, but instead 'whether the marks are sufficiently similar in terms of their commercial impression' such that persons who encounter the marks would be likely to assume a connection between the parties." *Coach Servs., Inc. v. Triumph Learning LLC*,

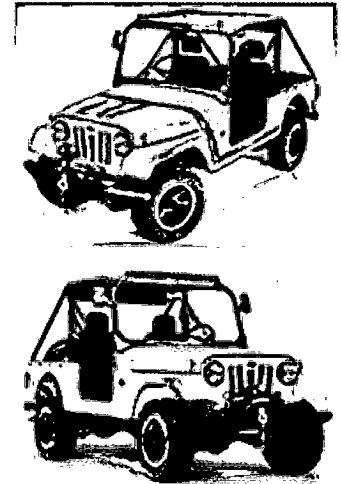
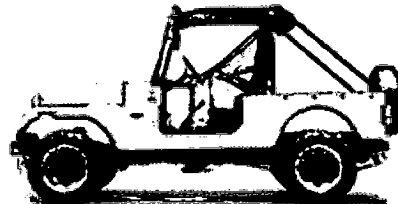
668 F.3d 1356, 1368 (Fed. Cir. 2012) (quoting *Leading Jewelers Guild, Inc. v. LJOW Holdings, LLC*, 82 U.S.P.Q.2d 1901, 1905 (T.T.A.B. 2007)).

The Staff presented their own side-by-side illustration, which is more relevant to the analysis:

The '873 Mark



The Accused Roxor Vehicle



SIB at 80. This silhouette more clearly illustrates a number of differences between the '873 mark and the Roxor. The Roxor has numerous distinctive features that are not part of the '873 mark: a roll cage; netting; gear shifters; bolts; multi-colored body parts; tail lights; head lights; turning lights; roll bar lights; a winch; rearview mirrors; a grille; door cutouts with two vertical sides; a tapering hood; decals; leafsprings; undercarriage parts; and wheel rims. *See id.*

Accordingly, I find the degree of differences between the '873 mark and the Roxor to weigh against a likelihood of confusion.

[REDACTED]

2. The Fame or Strength of the Mark

There is some evidence that the '873 mark has some commercial strength from its extensive use on Jeep vehicles. *See* RX-1613C (Spano Dep. Tr.) at 18:8-16. However, the evidence is equivocal, at best; Ms. Spano was vague and uncertain in her testimony on the subject, and even stated that the '873 mark was used as an “Easter egg[,],” suggesting it is difficult to find on the marked products. *Id.* at 15:19-23. Nor is the '873 mark conceptually strong, because it is simply a silhouette of a vehicle that has not been built in decades. This factor weighs against a likelihood of confusion.

3. The Number and Nature of Similar Marks in Use on Similar Goods

This factor is neutral, because there was no evidence introduced on it.

4. The Variety of Goods on Which the Mark is Used

This factor weighs in favor of infringement, and more so than with the Jeep Grille Design Marks, because the mark appears on multiple vehicles simultaneously, as well as on “licens[ed] products.” RX-1613C (Spano Dep. Tr.) at 15:19-23, 18:17-22.

5. Intent of Respondents in Adopting the Designation

FCA has offered no particularized evidence of Respondents' intent regarding the '873 mark beyond a legal presumption of notice. *See* CIB at 112 (citing 15 U.S.C. § 1072); CRB at 74-75. This factor is at most neutral.

6. Discussion

Except for the ninth *DuPont* factor, which weighs more heavily in favor of infringement, all the *DuPont* factors relative to the '873 mark weigh more against infringement than they do relative to the Jeep Grille Design Marks. The ninth *DuPont* factor, however, is not enough to

[REDACTED]

outweigh or even counterbalance the notable dissimilarity between the '873 mark and the Roxor. Therefore, there is no infringement of the '873 mark by the Roxor.

D. Dilution of the Jeep Marks

A mark is famous if it is “widely recognized by the general consuming public of the United States as a designation of source of the goods or services of the mark’s owner.” 15 U.S.C. § 1125(c)(2)(A). There is no evidence that members of the general consuming public, as opposed to actual or prospective Jeep purchasers, recognize the '873 mark, notwithstanding its extensive commercial use. Nor would they be expected to, because it is placed on the marked vehicles as an “Easter egg[.]” RX-1613C (Spano Dep. Tr.) at 15:19-23. Therefore, the '873 mark is not famous, and has not been diluted by the Roxor.

However, the Jeep Grille Design Marks have been judicially recognized as famous. *AM Gen.*, 311 F.3d at 821-22. When evaluating whether a design is likely to cause dilution by blurring, the following factors must be considered: (1) the degree of similarity between the product’s design and the famous mark; (2) the degree of inherent or acquired distinctiveness of the famous mark; (3) the extent to which the owner of the famous mark is engaging in substantially exclusive use of the mark; (4) the degree of recognition of the famous mark; (5) whether the user of the design intended to create an association with the famous mark; and (6) any actual association between the design and the famous mark. 15 U.S.C. § 1125(c)(2)(B). Factors two through six weigh in favor of blurring, at least to some degree, based on the evidence discussed above. However, there is a low degree of similarity between the Jeep Grille Design Marks and the Roxor, so much so that the other factors pale in insignificance. On this issue, the Staff correctly notes that whatever similarities exist are not substantial (and, as to the sixth factor, that the evidence is unclear as to

[REDACTED]

how the Roxor grille in particular is associated with the Jeep Grille Design Marks). *See* SIB at 93. Therefore, the Jeep Grille Design Marks are famous, but have not been diluted by the Roxor.

E. Affirmative Defenses

1. Equitable Estoppel

Respondents argue that Complainant's claims of unfair competition should be barred because FCA acquiesced to Mahindra's design of the Roxor. *See* RIB at 160-61. In order to prevail, respondents must show that (1) Complainant actively represented that it would not assert a claim; (2) Complainant unreasonably and inexcusably delayed between the active representation and the assertion of the claim; and (3) Respondents were materially prejudiced as a result of the delay. *Certain Agric. Vehicles and Components Thereof*, Inv. No. 337-TA-487, Final Initial and Recommended Determinations, 2004 WL 723330, at *71 (Jan. 13, 2004) (quoting *Sara Lee Corp. v. Kayser-Roth Corp.*, 81 F.3d 455, 461 (4th Cir. 1996)).

Inasmuch as Respondents assert that FCA agreed not to sue based on the 2009 Agreement, the assertion was fully adjudicated and found it to be without merit. *See generally* Order No. 18, EDIS Doc. ID 664927 (Dec. 21, 2018). Moreover, the bulk of Respondents' dealings with FCA and its predecessors occurred outside of the United States. RX-1013C (Shah), Q/A 47-48. Respondents do not identify any other instance, apart from the historic wartime exceptions, in which Mahindra has tested its ability to import into the United States a vehicle that uses the Roxor's exterior design. *See* RIB at 160-61. Thus, the evidence does not show that Respondents "reasonably" believed FCA or its predecessors would allow Mahindra to sell the Roxor (which, again, looks strikingly similar to FCA's CJ vehicle) in the United States, which is a market territory where FCA's predecessors were the only company to make and sell the CJ for decades.

2. Unclean Hands

Respondents assert, for the first time in its Post-Hearing Brief, that FCA seeks relief with unclean hands because FCA knowingly submitted false evidence during the hearing in the form of CX-1700. This photograph shows a tan Jeep Wrangler side-by-side with a tan Roxor that was being offered for rent. Respondents allege that the photograph was used in a misleading way to indicate that both of the vehicles were offered for rent. Not so. The witness who took the photograph testified that he saw a Roxor being offered for rent, and the Roxor was under a sign that said “Jeep Rentals.” He further testified that he moved a Wrangler beside the Roxor and took the picture to show what he thought were similarities between the two vehicles. Hr’g Tr. at 124:23-126:3. To be sure, he may not have explained all that in his witness statement, but overall this does not rise to misconduct in litigation.

Respondents also assert unclean hands on the basis that FCA seeks market exclusivity with respect to the allegedly “generic World War II jeep design at issue in this matter,” and has engaged in trademark infringement in India. RPB at 169; RIB at 162-63. However, FCA’s claims are plainly directed to trade dress dating back to 1955 and the CJ design, not FCA’s uses of an allegedly generic World War II jeep design in the 1940’s, and Respondents’ allegation of infringement of a foreign trademark are entirely unsupported by evidence. *See* RIB at 162-63.

3. Fair Use

Respondents also argue that the Roxor cannot infringe because it does not use its design as a trademark to denote the source of the product. Respondents urge that they use the design of the Roxor “because that’s the look of a classic military vehicle – it connotes **qualities** like ruggedness, durability, and adventure, not the **source**.” *See* RX-1012C (Haas), Q/A169; RIB at 163 (emphasis in original). Respondents further argue that they rely on “branding, which is featured prominently

[REDACTED]

on the exterior and interior of the vehicle, to designate source. *See* RX-1004C (Ansell), Q/A20-21; RIB at 164.

The doctrine of fair use relates to a defendant's use of a mark in the descriptive sense, and not as a designation of source. *See Abercrombie & Fitch Co. v. Hunting World, Inc.*, 537 F.2d 4, 12-13 (2d Cir. 1976). The central inquiry is whether the defendant is using the allegedly protected word or image descriptively, and not as a mark. *See* 15 U.S.C. § 1115(b)(4). The evidence shows that there are several different vehicle designs that successfully convey their capabilities without using the Jeep IP. *See, e.g.*, CX-1006C (Baker), Q/A 27. Moreover, as discussed above, [REDACTED]

[REDACTED] *See, e.g.*, CX-1047:0002 (MAH0080479) [REDACTED]
[REDACTED] CX 1011C (Vander Veen), Q/A 105; CX-1045C:0001 (MAH0081045) (JX-1135C) (RX-0079C) [REDACTED] CX-1060C:0005 (JX-1138C) (RX 1416C) [REDACTED] (emphasis added)); JX-1137C [REDACTED] Tr. (Ansell), 983:9-14.

Therefore, the fair use doctrine is inapplicable.

4. No Importation

Respondents urge a finding of no violation of Section 337 of the Roxor grille because the grille is not imported. RIB at 164-65. It is undisputed that the Roxor grille is not imported, and this provides an alternative ground for a finding of no violation with respect to the Roxor grille. *See* Joint Stipulation Regarding Importation, EDIS Doc. ID No. 679183 (June 21, 2019). This finding does not preclude the finding that Respondents' Roxor vehicle as a whole is "imported," however.

[REDACTED]

VII. DOMESTIC INDUSTRY

A. The Technical Prong

As previously explained, proof of a domestic industry that satisfies §1337(a)(3)(A)—(B) is divided into (i) a “technical prong” (which requires FCA’s articles to be covered by the asserted trade dress and trademark) and (ii) an “economic prong” (which requires certain levels of activity with respect to the protected articles or trade dress and trademark itself). *Certain Hair Irons and Packaging Thereof*, Inv. No. 337-TA-637, Order No. 14, at 10 (March 10, 2009).

Because the same products are covered by both the federally registered and common law trademark rights in this case, the relevant domestic industry involved is all one industry. *Ink Markers*, Order No. 30 at 55-56. As discussed earlier, Complainant’s products covered by the trademarks and Jeep Trade Dress are the Wrangler, the CJ5-8, and the CJ66 products. Therefore, FCA has established the technical prong of domestic industry.

B. The Economic Prong

FCA relies on investments starting about 13 years prior to the filing of the Complaint, during which FCA built both the Wrangler JK (from 2006 to 2017) and the Wrangler JL (from 2017 to the present) at its dedicated Toledo Assembly Complex. CX-1002C (DiMambro), Q/A 8-17; JX-1109; JX-1112. The Toledo Assembly Complex is comprised of the Toledo South facility, which includes the Toledo Supplier Park. It opened in 2006 to produce the then-new Jeep Wrangler JK. CX-1002C (DiMambro), Q/A 19. [REDACTED]

[REDACTED]

[REDACTED] *Id.* [REDACTED]

[REDACTED] *Id.* at Q/A31; CX-1011C (Vander Veen), Q/A 45 [REDACTED]

[REDACTED]

[REDACTED]

[REDACTED] CX-1002C (DiMambro), Q/A 34.

[REDACTED]

[REDACTED] *Id.* at Q/A 36.

The evidence establishes that since 2015, FCA invested the following sums in the production of the Jeep Wrangler JK in the Toledo South facility:

- a. [REDACTED]
- b. [REDACTED]
- c. [REDACTED]

CX-1011C (Vander Veen), Q/A 49; CX-1002C (DiMambro), Q/A 52.

FCA further presented evidence regarding its Toledo North facility, which launched the Wrangler JL vehicle in Q4 2017. CX-1002C (DiMambro), Q/A 63. [REDACTED]

[REDACTED] *Id.* at Q/A 90.

[REDACTED]

[REDACTED] *Id.* at Q/A 92. FCA's equipment and labor investments in the production of the Jeep Wrangler JL in the Toledo North facility are:

- a. [REDACTED]
- b. [REDACTED]

CX-1011C (Vander Veen), Q/A 49-52; CX-1002C (DiMambro), Q/A 52, 53, 104, 109.

The evidence overwhelmingly establishes that FCA has met all three groups of activities listed in section 337(a)(3) to meet the domestic industry requirement. Moreover, Respondents do not raise objections to this evidence.

[REDACTED]

Respondents do, however, argue that FCA's investments in the CJ66 Concept Vehicle, and the investments made by FCA's licensee, Classic Enterprises, do not support a finding of a domestic Industry. I disagree. The evidence shows that FCA created a concept vehicle, the CJ66,

[REDACTED]

[REDACTED]

[REDACTED] CX-1011, Q/A 58-59; CX 1336C; CX-1001C (Allen), Q/A 79-82, 87, 88; CX-1674C (JX-1102C) (RX-1402C); CX-1368C. Since its production, [REDACTED]

[REDACTED]

[REDACTED] CX-1001C (Allen), Q/A 89. [REDACTED]

[REDACTED] FCA's expenditures on the CJ66 are evidence of domestic activity supported or created by FCA.

Our Family Enterprises LLC (doing business as "Classic Enterprises") possesses certain rights to make Jeep and Willys branded replacement auto body parts and panels for, among other vehicles, the Jeep CJ5, CJ6, CJ7, and CJ8. *See generally* CX-1013C (O'Brien). Again, while the expenditures made with respect to the Wrangler vehicles unequivocally establish the economic prong, the license to Classic Enterprises also should be considered. The evidence at the hearing established that Classic Enterprises, which is located in Rice Lake, Wisconsin, [REDACTED]

[REDACTED]

[REDACTED] CX-1011C (Vander Veen), Q/A 63; CX-1013C (O'Brien), Q/A 6, 7, 25. A Classic Enterprise employee testified [REDACTED]

[REDACTED] CX-1011C (Vander Veen), Q/A 68-69. [REDACTED]

[REDACTED]

[REDACTED] *Id.* [REDACTED]

[REDACTED]

[REDACTED] *Id.*, Q/A 74-75. [REDACTED]

[REDACTED] *Id.*, Q/A 71. [REDACTED]

[REDACTED]

[REDACTED] *Id.*, Q/A 72.

[REDACTED]

[REDACTED]

Nonetheless, while such expenditures alone may not prove a domestic industry exists, they are evidence of domestic activity supported or created by FCA.

Thus, FCA satisfies the economic prong of the domestic industry requirement.

Accordingly, I find that FCA has established a domestic industry under Section 337(a)(2)-(3).

VIII. INJURY TO DOMESTIC INDUSTRY

FCA asserts a violation of Section 337(a)(1)(A) by reason of common law trade dress infringement and dilution. Therefore, FCA must prove that the Respondents' practices have caused substantial injury to the domestic industry or that the presence of the accused imported products demonstrate relevant conditions or "circumstances from which probable future injury can be inferred." *Power Tools* at 246, 248. In addition, FCA must prove a nexus between the Respondents' unfair acts and the injury to the domestic industry. *Id.* at 246. The evidence necessary to prove such a nexus includes a "broad range of indicia," including:

- (1) the respondent's volume of imports and penetration into the market,
- (2) the complainant's lost sales,
- (3) underselling by the respondent, and
- (4) the complainant's declining production, profitability, and sales.

[REDACTED]

Id.

Other evidence to consider in determining if there has been substantial injury is harm to goodwill and reputation. *Multimeter*, Order No. 22 at 17. The injury requirement can also be met “[w]hen an assessment of the market in the presence of the accused imported products demonstrates relevant conditions or circumstances from which probable future injury can be inferred.” *Id.* Such circumstances may include:

- (1) foreign cost advantages and production capacity,
- (2) the ability of the imported product to undersell the domestic product, or
- (3) substantial foreign manufacturing and intent to enter the domestic market.

Id.

Additionally, the threatened injury must be “substantive and clearly foreseen” and the complainant must show a causal connection between the respondent’s unfair act and the alleged future injury. *Id.*

Thus, a threshold issue is whether the Roxor and the Jeep Wrangler actually compete in the relevant domestic marketplace. The evidence shows that FCA and [REDACTED]

[REDACTED]

[REDACTED] *See, e.g.*, CX-1045C:0001 (MAH0081045) (JX-1135C) (RX-0079C); CX-1005C (Tallon), Q/A 45 (“there’s an overlap in the markets and there’s an overlap in culture and what the consumer is looking for: Both want the feeling of freedom and adventure; UTV owners do the same thing that many of our existing owners do, they take their vehicles off-road.”).

The evidence also shows that [REDACTED]

[REDACTED]

[REDACTED] Mahindra’s own witness, Mr. Ansell, [REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

CX 1045C:0001 (MAH0081045) (JX-1135C) (RX-0079C); Hr'g Tr. (Ansell) at 976:15-22.

During the hearing, Mr. Ansell attempted to back away from the above statement, saying that it reflected only his own thoughts in late 2015 and not those of Respondents. Hr'g Tr. (Ansell) at 976:23-977:1. However, the evidence indicates that [REDACTED]

[REDACTED]

[REDACTED]

- [REDACTED] Hr'g Tr. (Ansell) at 977:8-11; CX-1047:0002 (MAH0080479).

- [REDACTED] CX-1067C:0001; Hr'g Tr. (Ansell) at 981:1-25.

- [REDACTED] CX-1271C:0001; Hr'g Tr. (Ansell) at 978:4-979:7.

The evidence also shows that Respondents [REDACTED]

[REDACTED]

- [REDACTED] Hr'g Tr. (Haas) at 685:17-21 (testimony summarizing CX-1121C:0005).

- [REDACTED] CX-1080C:0001; Hr'g Tr. (Ansell) at 990:6-11.

[REDACTED]

- [REDACTED] CX-1081:0001; Tr. (Ansell) at 993:18-24.
- [REDACTED] CX-1078C:0001; Hr'g Tr. (Ansell) at 988:13-20.

On balance, the Roxor clearly competes with the Jeep Wrangler in the domestic marketplace.

Furthermore, Respondents' practices have caused substantial injury to Complainant's domestic industry and/or demonstrate possible future injury. For example, the evidence clearly illustrates that Respondents [REDACTED]

[REDACTED]

[REDACTED] See, e.g., Tr. (Haas) at 715:21-718:13. Respondents launched the Roxor in March 2018, and since then have established [REDACTED] across North America, [REDACTED]

[REDACTED] CX-1011C (Vander Veen), Q/A 100; CX-1142C:0041 (MAH0246183) (JX-1140C). Respondents also have a 400,000 square foot manufacturing facility that imports parts and builds the Roxor. [REDACTED]

[REDACTED] CX-1011C (Vander Veen), Q/A 100; CX-1922C:0002 (MAH0100209-10); see Hr'g Tr. (Haas) at 715:21-718:13. [REDACTED]

[REDACTED]

[REDACTED] CX-1035C. [REDACTED]

[REDACTED] *Id.*; see also CX-1815:0002, (FCA00003189) (Mahindra press release stating: "The \$19 billion company [M&M], in the midst of a plan to invest a \$1 billion in the U.S. is investing heavily in the State of Michigan including the support for this new powersports product [i.e., the Roxor] and launch effort.").

The evidence also shows that "in relatively short order" [REDACTED]

[REDACTED] CX-1011C (Vander Veen), Q/A 101; Hr'g Tr.

[REDACTED]

(Haas) at 739:9-23. [REDACTED]

[REDACTED]

[REDACTED] CX-1011C (Vander Veen), Q/A 94-95; Hr'g Tr. (Haas) at 711:-22-712:5, 712:18-715:20. [REDACTED]

[REDACTED] CX-1011C (Vander Veen), Q/A 93-94. [REDACTED]

[REDACTED]

Id., Q/A 93-94 [REDACTED]

[REDACTED] *see also id.* ("by 2025, India could be one of the top low-cost country exporters for auto components"); CX-1371. [REDACTED]

[REDACTED]

[REDACTED]

The evidence also shows that Respondents [REDACTED]

[REDACTED]

[REDACTED] As Mr. Ansell noted:

[REDACTED]

CX-1047:0002 (MAH0080479); CX-1011C (Vander Veen), Q/A 105; *see also* CX 1045C:0001 (MAH0081045) (JX-1135C) (RX-0079C); CX-1047:0002 (MAH0080479); CX-1067C:0001; CX-1271C:0001; Hr'g Tr. (Ansell) at 976:15-977:1, 977:8-11, 981:1-25, 978:4-979:7.

Similarly, [REDACTED]

[REDACTED]

(RX-1416C); CX-1011C (Vander Veen), Q/A 105. Notably, “Go Anywhere/Do Anything” is a slogan that is associated with Wrangler promotions. CX-1005C (Tallon), Q/A 16.

There is ample evidence of injury and threatened injury to FCA’s goodwill and business reputation. FCA and its predecessors spent decades and [REDACTED] building and maintaining the Jeep brand, which has culminated in an “iconic” Wrangler vehicle (and previously, the Jeep CJ). CX-1011C (Vander Veen), Q/A 108. Respondents’ importation of a product with fewer features or capabilities, that Respondents’ intend to have associated with the Jeep brand, will erode the value of the Wrangler. FCA no longer will be able to control its brand image. *Id.*, Q/A 108-109; CX-1078C. Any such association also will erode the distinctiveness of the Jeep intellectual property in the marketplace. CX-1011C (Vander Veen), Q/A 110, 123.

Mr. Carpenter testified at the hearing that the “Jeep Wrangler design features uniquely evoke the Jeep Wrangler and Jeep brands with their full value meaning to consumers,” but the Roxor also “evokes the Jeep Wrangler brand, which will erode the uniqueness of the Jeep Wrangler brand, reducing its value to FCA.” CX-1008C, Q/A 118. According to Mr. Carpenter, the loss of uniqueness will translate to lost sales even if consumers know that the Roxor is not made by FCA and even if they ultimately decide not to purchase a Roxor instead of a Wrangler. *Id.* at Q/A 119.

Moreover, the goodwill and reputation that is at risk here is substantial. The evidence shows that the Jeep brand—which depends in significant part on the continued success of the Wrangler—is valued at 120 percent of FCA’s \$23.6-billion market capitalization. CX-1008C, Q/A 101, 124. And Mr. Carpenter testified that “[b]y reducing the value of the Jeep brand, Mahindra will reduce the value of FCA from its current \$23.6 billion.” CX-1008C, Q/A 124.

[REDACTED]

Therefore, the evidence of record clearly shows that Respondents' importation and sale after importation into the United States of infringing motorized vehicles and components thereof has caused and/or threatens to cause injury to FCA's domestic industry. Furthermore, because FCA has demonstrated that its common law trade dress is valid and infringed, it has shown that its domestic industry has been substantially injured.

IX. CONCLUSIONS OF LAW

1. The Commission has subject matter and personal jurisdiction.
2. The importation or sale requirement of Section 337 is satisfied.
3. The domestic industry requirement is satisfied.
4. Complainant has legal rights to the Jeep Trade Dress.
5. Complainant's Jeep Trade Dress has acquired secondary meaning.
6. Complainant's Jeep Trade Dress is not generic.
7. Complainant's Jeep Trade Dress is not functional.
8. Respondents' Roxor vehicle infringes Complainant's Jeep Trade Dress
9. Respondents' Roxor vehicle does not cause dilution of the Complainant's Jeep Trade Dress.
10. Respondents' Roxor vehicle does not infringe Trade Mark Reg. No. 2,862,487.
11. Respondents' Roxor vehicle does not infringe Trade Mark Reg. No. 2,794,553.
12. Respondents' Roxor vehicle does not infringe Trade Mark Reg. No. 2,161,779.
13. Respondents' Roxor vehicle does not infringe Trade Mark Reg. No. 4,043,984.
14. Respondents' Roxor vehicle does not infringe Trade Mark Reg. No. 4,272,873.
15. There is a violation of Section 337 with respect to the Complainant's Jeep Trade Dress.

[REDACTED]

X. RECOMMENDED DETERMINATION ON REMEDY AND BOND

The Commission's Rules provide that subsequent to an initial determination on the question of violation of section 337 of the Tariff Act of 1930, as amended, 19 U.S.C. § 1337, the administrative law judge shall issue a recommended determination concerning the appropriate remedy in the event that the Commission finds a violation of section 337, and the amount of bond to be posted by respondent during Presidential review of the Commission action under section 337(j). *See* 19 C.F.R. § 210.42(a)(1)(ii).

The Commission has broad discretion in selecting the form, scope, and extent of the remedy in a section 337 proceeding. *Viscofan, S.A. v. Int'l Trade Comm'n*, 787 F.2d 544, 548 (Fed. Cir. 1986). Under Section 337(d)(1), if the Commission determines as a result of an investigation that there is a violation of section 337, the Commission is authorized to enter either a limited or a general exclusion order. 19 U.S.C. § 1337(d)(1). A limited exclusion order instructs the U.S. Customs and Border Protection ("CBP") to exclude from entry all articles that are covered by the patent at issue and that originate from a named respondent in the investigation. A general exclusion order instructs the CBP to exclude from entry all articles that are covered by the patent at issue, without regard to source. *Certain Purple Protective Gloves*, Inv. No. 337-TA-500, Comm'n Op. at 5 (Dec. 22, 2004). Under section 337(f)(1), the Commission may issue a cease and desist order in addition to, or instead of, an exclusion order. 19 U.S.C. § 1337(f)(1). The Commission generally issues a cease and desist order directed to a domestic respondent when there is a "commercially significant" amount of infringing, imported product in the United States that could be sold, thereby undercutting the remedy provided by an exclusion order. *See Certain Crystalline Cefadroxil Monohydrate*, Inv. No. 337-TA-293, USITC Pub. 2391, Comm'n Op. on Remedy, the Public Interest and Bonding at 37-42 (June 1991); *Certain Condensers, Parts Thereof*

[REDACTED]

and Prods. Containing Same, Including Air Conditioners for Automobiles, Inv. No. 337-TA-334 (Remand), Comm'n Op. at 26-28, 1997 WL 817767, at *11-12 (U.S.I.T.C. Sept. 10, 1997).

Additionally, during the 60-day period of Presidential review under 19 U.S.C. § 1337(j), “articles directed to be excluded from entry under subsection (d) . . . shall . . . be entitled to entry under bond prescribed by the Secretary in an amount determined by the Commission to be sufficient to protect the complainant from any injury.” *See* 19 U.S.C. § 1337(j)(3). “The Commission typically sets the bond based on the price differential between the imported infringing product and the domestic industry article or based on a reasonable royalty. However, where the available pricing or royalty information is inadequate, the bond may be set at one hundred (100) percent of the entered value of the infringing product.” *Certain Industrial Automation Systems and Components Thereof Including Control Systems, Controllers, Visualization Hardware, Motion and Motor Control Systems, Networking Equipment, Safety Devices, and Power Supplies*, Inv. No. 337-TA-1074, Comm'n Op. at 13 (Apr. 23, 2019) (“Automation Systems”) (public version) (citation omitted).

Section 337 also mandates consideration of the effect of exclusion on (1) public health and welfare; (2) competitive conditions in the U.S. economy; (3) U.S. production of articles that are like or directly competitive with the articles subject to the investigation; and (4) U.S. consumers. 19 U.S.C. § 1337(d)(1). By publication in the Federal Register, the Commission has instructed me “to take evidence or other information and hear arguments from the parties and other interested persons with respect to the public interest in this investigation, as appropriate, and provide the Commission with findings of fact and a recommended determination on this issue, which shall be limited to the statutory public interest factors set forth in 19 U.S.C. 1337(d)(1), (f)(1), (g)(1).” 83 Fed. Reg. 28,865 (June 21, 2018).

[REDACTED]

A. Limited Exclusion Order

Since a violation has been found, FCA seeks a limited exclusion order to “cover [Respondents’] infringing ROXOR motor vehicles and components of those vehicles.” CIB at 153. The Staff agrees with FCA, and further points out that the Notice of Investigation states that the scope of this Investigation is defined by “motorized vehicles, kits and assemblies for motorized vehicles, and replacement and aftermarket components for motorized vehicles thereof.” 83 Fed. Reg. 46,518 (Sept. 13, 2018). SIB at 124. Respondents do not address the requested limited exclusion order. See RIB at 182-86.

As determined above, a violation of Section 337 has taken place, and I therefore recommend to the Commission that a limited exclusion should issue according to statute. 19 U.S.C. § 1337(d)(1).

B. Cease and Desist Order

FCA also seeks a cease and desist order to prevent the sale of infringing ROXOR vehicles and components thereof held in domestic inventory. [REDACTED]

[REDACTED]

[REDACTED] CX-1035C [REDACTED]

[REDACTED] CIB

at 154 (citing CX-1011C (Vander Veen), Q/A 131; CX-1035C).

Respondents’ witness, Mr. Green, testified that Dr. Vander Veen overstates Mahindra’s domestic inventory because his calculation fails to deduct “raw materials” and “materials in transit,” [REDACTED] RX-1007C

(Green), Q/A 253-260 (citing CX-1014C; RX-1423C). Respondents argue that the Roxor is not a “kit vehicle,” and thus, “categories such as ‘raw materials’ and ‘material in transit’ should not be

[REDACTED]

included in any inventory analysis.” RIB at 184 (citing RX-1008 (Green), Q/A259-60)(emphasis in original). Mr. Green explained that [REDACTED]

[REDACTED]

[REDACTED] RX-1007C (Green), Q/A 261. Mr. Green testified that [REDACTED]

[REDACTED]

[REDACTED]

Id., Q/A 262-66 (citing RX-1706C; RX-1814C (CX-1033C) (JX-1139C); RX-1815C; RX-1816C; RX-1423C; CX-1014C). Mr. Green estimated that [REDACTED]

[REDACTED] RX-1007C (Green), Q/A 267.

The Staff points out that the inventory calculated by Respondents’ expert “includes only ‘finished goods,’ or presumably only finished ‘Stock’ Roxor vehicles.” SIB at 127. However, as noted above, the scope of this Investigation includes “motorized vehicles, kits and assemblies for motorized vehicles, and replacement and aftermarket components for motorized vehicles thereof.” 83 Fed. Reg. 46,518 (Sept. 13, 2018). Thus, the scope of the Investigation is broader than argued by Respondents, and includes components and parts that are in the United States and destined to be used in a complete Roxor assembly. Accordingly, I find that Dr. Vander Veen’s analyses are reliable, and that Respondents maintain a commercially significant inventory of infringing articles in the U.S.

A cease and desist order will prevent Respondents from selling a significant volume of infringing Roxor vehicles and components thereof held in domestic inventory. Accordingly, a cease and desist order is recommended in this case.

[REDACTED]

C. Bond

If an exclusion order or cease and desist order is entered in this case, Respondents may continue to import and sell their products during the pendency of the 60-day Presidential review period under a bond in an amount determined by the Commission to be “sufficient to protect the complainant from any injury.” 19 U.S.C. § 1337(j)(3); 19 C.F.R. § 210.50. FCA argues that a bond rate of 100% of the entered value of the imported articles is appropriate because “Respondents import *components* that are later assembled into Roxor vehicles, and thus it is impractical if not impossible to undertake a price comparison to determine underselling of the components as compared to FCA’s Wrangler brand vehicles.” CIB at 155 (emphasis in original). But this is merely an assertion that it is difficult to calculate price differences between the imported components and FCA’s vehicle components. The Commission requires complainants to present affirmative evidence showing either a direct price comparison, or difficulty in ascertaining price that justifies setting a 100% bond. *Certain Rubber Antidegradants, Components Thereof, and Products Containing Same*, Inv. No. 337-TA-533, Comm’n Op. at 134 (Apr. 2008). FCA failed to present such evidence.

By contrast, Respondents and the Staff presented plausible methodologies for determining a bond that will effectively protect FCA from injury. See RIB at 185; SIB at 128-29. [REDACTED]

[REDACTED]

[REDACTED] RX-1008C (Green), Q/A 281 (citing JX-1115C). [REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED] RX-1008C (Green), Q/A 281 (citing JX-1107C, RX-1811C, RX-1224C, RX-1768, and

[REDACTED]

RX-1769). Although Respondents principally contend that no bond is appropriate, they contend in the alternative, predicated on this evidence, that any bond should be based on the imported Roxor components at a rate of 10%, or on a fully assembled Roxor at a rate of 1-2%; the Staff agrees with Respondents' recommendation. See RIB at 185; SIB at 128-29.

Respondents' proposal is reasonable and supported by the evidence, and will be adopted. Accordingly, I recommend a bond of 10% based on unassembled Roxor components imported into the U.S., or a bond of 1% based on the finished Roxor vehicle, be imposed during the Presidential Review Period.

D. Public Interest

None of the parties address the statutory public interest factors, and there is no evidence that the requested relief would meaningfully impact public health and welfare, competitive conditions, domestic production of articles, or U.S. consumers. Accordingly, it is my recommended determination that issuance of a remedial order in this investigation would not be contrary to the public interest.

XI. INITIAL DETERMINATION AND ORDER

Based on the foregoing, it is my Initial Determination that there is a violation of Section 337 of the Tariff Act of 1930, as amended, 19 U.S.C. § 1337, in the importation into the United States, the sale for importation, or the sale within the United States after importation of certain motorized vehicles, kits and assemblies for motorized vehicles, and replacement and aftermarket components for motorized vehicles thereof, in connection with the Jeep Trade Dress. Furthermore, it is my determination that a domestic industry in the United States exists that practices or exploits the Jeep Trade Dress.


[REDACTED]

I certify to the Commission this Initial Determination, together with the Record of the hearing in this Investigation consisting of the following: the transcript of the evidentiary hearing, with appropriate corrections as may hereafter be ordered; and the exhibits accepted into evidence in this Investigation, as listed by the parties, attached herein as Appendix A with appropriate corrections as may hereafter be ordered. The pleadings of the parties filed with the Secretary need not be certified as they are already in the Commission's possession in accordance with Commission rules.

Pursuant to 19 C.F.R. § 210.42(h), this Initial Determination shall become the determination of the Commission unless a party files a petition for review pursuant to 19 C.F.R. § 210.43(a) or the Commission, pursuant to 19 C.F.R. § 210.44, orders on its own motion a review of the Initial Determination or certain issues therein.

This Initial Determination is being issued as confidential, and a public version will be issued pursuant to Commission Rule 210.5(f). Within seven (7) days of the date of this Initial Determination, the parties shall jointly submit: (1) a proposed public version of this opinion with any proposed redactions bracketed in red; and (2) a written justification for any proposed redactions specifically explaining why the piece of information sought to be redacted is confidential and why disclosure of the information would be likely to cause substantial harm or likely to have the effect of impairing the Commission's ability to obtain such information as is necessary to perform its statutory functions.

SO ORDERED.

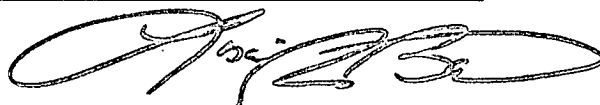

Cameron Elliot
Administrative Law Judge

**CERTAIN MOTORIZED VEHICLES AND COMPONENTS
THEREOF**

INV. NO. 337-TA-1132

PUBLIC CERTIFICATE OF SERVICE

I, Lisa R. Barton, hereby certify that the attached **INITIAL DETERMINATION** has been served by hand upon the Commission Investigative Attorney, **Jose Recio, Esq.** and the following parties as indicated, on NOV 21 2019.



Lisa R. Barton, Secretary
U.S. International Trade Commission
500 E Street SW, Room 112A
Washington, DC 20436

FOR COMPLAINANT FCA US LLC	
Frank C. Cimino, Jr., Esq. VENABLE LLP 600 Massachusetts Avenue NW Washington, DC 20001	<input type="checkbox"/> Via Hand Delivery <input checked="" type="checkbox"/> Express Delivery <input type="checkbox"/> Via First Class Mail <input type="checkbox"/> Other: _____
FOR RESPONDENTS MAHINDRA & MAHINDRA LTD. and MAHINDRA AUTOMOTIVE NORTH AMERICA, INC.	
R. David Hosp, Esq. ORRICK, HERRINGTON & SUTCLIFFE LLP 500 Boylston Street Suite 1850 Boston, MA 02116	<input checked="" type="checkbox"/> Via Hand Delivery <input checked="" type="checkbox"/> Express Delivery <input type="checkbox"/> Via First Class Mail <input type="checkbox"/> Other: _____

UNITED STATES INTERNATIONAL TRADE COMMISSION
Washington, D.C.

In the Matter of

**CERTAIN MOTORIZED VEHICLES
AND COMPONENTS THEREOF**

Investigation No. 337-TA-1132

**NOTICE OF A COMMISSION DETERMINATION NOT TO REVIEW AN INITIAL
DETERMINATION FINDING THAT COMPLAINANT IS NOT CONTRACTUALLY
BARRED FROM ENFORCING ITS INTELLECTUAL PROPERTY AGAINST THE
NAMED RESPONDENTS**

AGENCY: U.S. International Trade Commission.

ACTION: Notice.

SUMMARY: Notice is hereby given that the U.S. International Trade Commission has determined not to review an initial determination (“ID”) (Order No. 18) of the presiding administrative law judge (“ALJ”) finding that complainant is not contractually barred from enforcing its intellectual property against the named respondents.

FOR FURTHER INFORMATION CONTACT: Clint Gerdine, Esq., Office of the General Counsel, U.S. International Trade Commission, 500 E Street SW, Washington, D.C. 20436, telephone (202) 708-2310. Copies of non-confidential documents filed in connection with this investigation are or will be available for inspection during official business hours (8:45 a.m. to 5:15 p.m.) in the Office of the Secretary, U.S. International Trade Commission, 500 E Street, SW, Washington, D.C. 20436, telephone (202) 205-2000. General information concerning the Commission may also be obtained by accessing its Internet server at <https://www.usitc.gov>. The public record for this investigation may be viewed on the Commission’s electronic docket (EDIS) at <https://edis.usitc.gov>. Hearing-impaired persons are advised that information on this matter can be obtained by contacting the Commission’s TDD terminal on (202) 205-1810.

SUPPLEMENTARY INFORMATION: The Commission instituted this investigation on September 13, 2018, based on a complaint filed on behalf of FCA US LLC (“FCA”) of Auburn Hills, Michigan. 83 FR 46517-18. The complaint alleges violations of section 337 of the Tariff Act of 1930, as amended, 19 U.S.C. 1337, by reason of infringement of U.S. Trademark Registration Nos. 2,161,779; 2,794,553; 2,862,487; 4,043,984; and 4,272,873. The complaint further alleges violations of section 337 based upon trade dress infringement, trademark dilution, and infringement of common law trademarks, the threat or effect of which is to destroy or substantially injure an industry in the United States. The Commission’s notice of investigation named two respondents: Mahindra & Mahindra Ltd. of Mumbai, India and Mahindra Automotive North America, Inc. of Auburn Hills, Michigan (collectively, “Mahindra”). The

Office of Unfair Import Investigations (“OUII”) is also a party to the investigation. The notice of investigation ordered the ALJ to issue an ID, within 100 days of institution, determining whether FCA is contractually barred from enforcing its intellectual property against Mahindra. *Id.* at 46518.

Following an evidentiary hearing and pre- and post-hearing briefing from the parties, the ALJ issued the subject ID on December 21, 2018. The ALJ found that FCA’s allegations in this investigation are not contractually barred.

On February 4, 2019, Mahindra petitioned for review of the ID’s finding that FCA’s allegations are not contractually barred. On February 11, 2019, OUII and FCA each filed a response in opposition to the petition for review.

Having reviewed the record in this investigation, including Mahindra’s petition for review and the responses thereto, the Commission has determined not to review the subject ID.

The authority for the Commission’s determination is contained in section 337 of the Tariff Act of 1930, as amended, 19 U.S.C. 1337, and in Part 210 of the Commission’s Rules of Practice and Procedure, 19 CFR part 210.

By order of the Commission.



Lisa R. Barton
Secretary to the Commission

Issued: February 28, 2019

PUBLIC CERTIFICATE OF SERVICE

I, Lisa R. Barton, hereby certify that the attached **NOTICE** has been served by hand upon the Commission Investigative Attorney, **Jose Recio, Esq.** and the following parties as indicated, on **February 28, 2019**.



Lisa R. Barton, Secretary
U.S. International Trade Commission
500 E Street, SW, Room 112
Washington, DC 20436

On Behalf of Complainants FCA US LLC:

Frank C. Cimino, Esq.
VENABLE LLP
600 Massachusetts Avenue NW
Washington, DC 20001

- Via Hand Delivery
- Via Express Delivery
- Via First Class Mail
- Other: _____

**On Behalf of Respondents Mahindra & Mahindra Ltd. and
Mahindra Automotive North America, Inc.:**

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FISH & RICHARDSON P.C.
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Suite 1850
Boston, MA 02116

- Via Hand Delivery
- Via Express Delivery
- Via First Class Mail
- Other: _____

PUBLIC VERSION

UNITED STATES INTERNATIONAL TRADE COMMISSION

Washington, D.C.

**In the Matter of
CERTAIN MOTORIZED VEHICLES
AND COMPONENTS THEREOF**

Inv. No. 337-TA-1132

**ORDER NO. 18: INITIAL DETERMINATION FINDING COMPLAINANT FCA IS
NOT CONTRACTUALLY BARRED FROM ENFORCING ITS
INTELLECTUAL PROPERTY AGAINST THE NAMED
RESPONDENTS**

(December 21, 2018)

PUBLIC VERSION

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I. Introduction

A. Procedural History

By publication of a Notice of Investigation (“NOI”) in the *Federal Register* on September 13, 2018, pursuant to subsection (b) of section 337 of the Tariff Act of 1930, as amended, the Commission instituted this investigation to determine:

(a) Whether there is a violation of subsection (a)(1)(A) of Section 337 in the importation into the United States, the sale for importation, or the sale within the United States after importation of certain products identified in paragraph (2) by reason of trade dress infringement, trademark dilution, or infringement of common law trademarks, the threat or effect of which is to destroy or substantially injure an industry in the United States;

(b) whether there is a violation of subsection (a)(1)(C) of section 337 in the importation into the United States, the sale for importation, or the sale within the United States after importation of certain products identified in paragraph (2) by reason of infringement of one or more of the '873 mark; the '487 mark; the '779 mark; the '553 mark; and the '984 mark, and whether an industry in the United States exists as required by subsection (a)(2) of section 337;

83 Fed. Reg. 46518 (Sept. 13, 2018).

Paragraph (2) of the NOI provides:

Pursuant to section 210.10(b)(1) of the Commission’s Rules of Practice and Procedure, 19 CFR 210.10(b)(1), the plain language description of the accused products or category of accused products, which defines the scope of the investigation, is “motorized vehicles, kits and assemblies for motorized vehicles, and replacement and aftermarket components for motorized vehicles.”

Id.

Additionally, the Commission ordered:

Pursuant to section 210.10(b)(3) of the Commission’s Rules of Practice and Procedure, 19 CFR 210.10(b)(3), the presiding Administrative Law Judge shall hold an early evidentiary hearing, find facts, and issue an early decision, within 100 days of institution except for good cause shown, as to whether the complainant is contractually barred from enforcing its intellectual property against the named respondents. In the alternative, the

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presiding Administrative Law Judge may decide this issue through summary determination proceedings if he or she determines that no material facts are in dispute. Notwithstanding any Commission Rules to the contrary, which are hereby waived, any such decision should be issued in the form of an initial determination (ID) under Rule 210.42(a)(3), 19 CFR 210.42(a)(3). The ID will become the Commission's final determination 30 days after the date of service of the ID unless the Commission determines to review the ID. Any such review will be conducted in accordance with Commission Rules 210.43, 210.44, and 210.45, 19 CFR 210.43, 210.44, and 210.45.

Id.

The complainant is FCA US LLC ("FCA") of Auburn Hills, Michigan. *Id.*

The named respondents are Mahindra & Mahindra Ltd. ("M&M") of Mumbai, India and Mahindra Automotive North America ("MANA") of Auburn Hills, Michigan (together, "Mahindra"). *Id.*

The Commission Investigative Staff ("Staff") is also a party to the investigation. *Id.*

Pursuant to the procedural schedule set forth in Order No. 5 (Sept. 27, 2018), the parties submitted prehearing briefs ("PreHB"). An evidentiary hearing was held starting November 7, 2018 and ending November 8, 2018. *See* Tr. 1-485. The parties subsequently submitted initial ("PHB") and reply ("RHB") post-hearing briefs.

B. The Private Parties

FCA is a vehicle manufacturer in the United States, selling vehicles under several brands, including the Jeep® brand. FCA has corporate roots that relate back to the Chrysler Corporation, first organized in 1925, and is the owner of the Jeep® brand. CX-0002 at Q/A 7-8.

Respondent Mahindra & Mahindra Ltd. is an Indian multinational federation of diversified companies headquartered in Mumbai, Maharashtra, India. Respondent Mahindra Automotive North America, Inc. is a Delaware corporation and M&M subsidiary, with its

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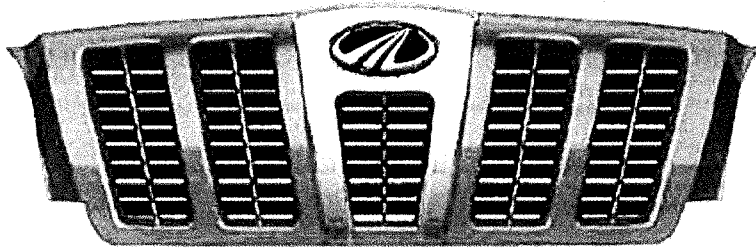
corporate headquarters in Michigan. MANA sells the Roxor vehicle accused in this investigation. Response to Complaint at ¶ 11, 13.

C. The 2009 Agreement

The evidence shows that FCA's predecessor, Chrysler Group LLC ("Chrysler"), in 2008 learned that M&M intended to introduce into the United States a vehicle called the Scorpio. CX-0002 at Q/A 12. The Scorpio incorporated a grille design that, in Chrysler's view, was confusingly similar to a Jeep® brand vehicle grille. *See* JX-0008 at MAH0001645; JX-0031. In response to Chrysler's request to change the grille design, M&M proposed a Non-Disclosure Agreement to share a "revised design for the front grill" so that Chrysler could evaluate it against its own "grille designs." JX-0013 at FCA00003312-14. Over several months, M&M proposed two alternative grille designs. JX-0015 at FCA0003300; JX-0018 at FCA0000046. Chrysler rejected both. JX-0016 at MAH0001696-97; JX-0019 at MAH0001715-16. M&M then proposed a third alternative, which Chrysler approved. JX-0022 at FCA00003293; JX-0023 at MAH0001720. The parties memorialized their agreement in a short document entitled "Agreement and Acknowledgement" (the "2009 Agreement"). JX-0031 at FCA00004245-47.

In the 2009 Agreement, the parties defined the approved grille as follows: "Chrysler consents to the use and incorporation of the grille design shown in Exhibit A (hereinafter the 'Approved Grille Design')." JX-0031 at FCA00004245, ¶ 1. Exhibit A consists of the following picture:

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JX-0031 Exhibit A: "Approved Grille Design"

The disputed portion of the 2009 Agreement reads:

Chrysler consents to the use and incorporation of the grille design shown in Exhibit A (hereinafter the "Approved Grille Design") in vehicles sold and advertised in the United States by Mahindra and/or its affiliates and authorized dealers. Chrysler agrees and warrants that it will not assert against Mahindra, its affiliates, authorized dealers, or customers, or anyone else, any claim for infringement of Chrysler's trade dress, trademark, or other intellectual property rights in the United States based on: (1) a grille having the Approved Grille Design; or (2) a vehicle containing or using the Approved Grille Design.

JX-0031 at FCA0004245-46, ¶ 1.

After the 2009 Agreement was signed, M&M never introduced the Scorpio into the United States. RX-113C at Q/A 24.

D. The Intellectual Property and Products at Issue

This investigation involves allegations of trade dress infringement with respect to the overall exterior appearance and styling of the Jeep® Wrangler® and its predecessor, the Jeep® CJ vehicles. *See* NOI; Compl. PHB at 5-6. The investigation also involves allegations of infringement of certain trademarks on individual grille designs and U.S. Trademark No. 4,272,873 ("the '873 trademark") to a vehicle profile, as well as dilution and unfair competition claims. *See* NOI; Compl. PHB at 6.

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In early March 2018, Respondents revealed the product accused in this investigation, a new motor vehicle called the Roxor that is assembled and sold in the United States by MANA using components imported from other countries, including India. Response to Complaint at ¶¶ 30-31.

E. The Scope of the 100-Day Proceeding

As set forth in the NOI, the scope of this 100-day proceeding is limited to whether the Roxor uses the Approved Grille Design shown in Exhibit A of the 2009 Agreement and, if so, whether all of FCA's claims are barred. Mahindra bears "the burden to prove . . . by a preponderance of the evidence" that all of FCA's claims are "contractually barred" by the 2009 Agreement. *See* Order No. 8: Regarding Burden of Proof for Early Determination Proceeding, at 2 (Sept. 28, 2018).

II. Relevant Law

The parties agree that Michigan state law applies to the construction of the 2009 Agreement. *See* Compl. PHB at 6, n.27; Resp. PHB at 8; Staff PHB at 9; *see also* *Aronson v. Quick Point Pencil Co.*, 440 U.S. 257, 262 (1979) ("State law is not displaced merely because the contract relates to intellectual property."). "[I]f the language of the contract is clear and unambiguous, it is to be construed according to its plain sense and meaning; but if it is ambiguous, testimony may be taken to explain the ambiguity." *City of Grosse Pointe Park v. Michigan Mun. Liab. and Prop. Pool*, 702 N.W.2d 106, 113 (Mich. 2005) (citation omitted). Courts "will not create ambiguity where the terms of the contract are clear." *Id.*

"According to Michigan law, the burden is on the party alleging the ambiguity to present an interpretation of the contract that is equally as plausible as the common sense interpretation." *Sault Ste. Marie Tribe of Chippewa Indians v. Granholm*, 475 F.3d 805, 812 (6th Cir. 2007)

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“The party alleging the ambiguity must carry this burden because a court cannot create an ambiguity where none exists.” *Id.* “A written instrument that is clear on its face may, upon consideration of extrinsic evidence or some collateral matter, be rendered latently ambiguous when applied in the real world.” *Stryker Corp. v. Nat’l Union Fire Ins. Co. of Pittsburgh, PA*, 842 F.3d 422, 427 (6th Cir. 2016) (citing *City of Grosse Pointe Park*, 702 N.W.2d at 113). The exception is limited in scope, with a singular purpose “not to pervert the written instrument, but to prevent the written instrument being perverted from the true intent of the contracting parties,” and thereby to “effectuate the intent of the parties.” *Shay v. Aldrich*, 790 N.W.2d 629, 642-43 (Mich. 2010) (quoting *Meyer v. Shapton*, 178 Mich. 417, 425 (Mich. 1914)). If the extrinsic evidence does not specifically demonstrate that the parties intended a meaning contrary to the contractual text, no latent ambiguity exists. *See, e.g., Grosse Pointe Park*, 702 N.W.2d at 115 (denying latent ambiguity based upon course of conduct “because when we consider how the clause applies or has been applied, it cannot be said that the clause was intended to have a different meaning than that reflected in the text of the policy”). As the Sixth Circuit noted in *Stryker*, the classic example of a latent ambiguity is *Raffles v. Wichelhaus*, 2 H. & C. 906, 159 Eng. Rep. 375 (Ex. 1864), where a contract related to a shipment of cotton on the ship “Peerless,” arriving from Bombay, was facially unambiguous, but the real-world facts showed that there were two cotton-bearing ships named “Peerless” that had arrived from India. *Stryker*, 842 F.3d at 427. In such a case, “parol evidence may be given” in order to ascertain the true intent of the parties. *Id.*

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III. Analysis and Discussion

A. Meaning of “Approved Grille Design”

1. Plain and Ordinary Meaning

The 2009 Agreement defines the Approved Grille Design with an image shown in its attached Exhibit A. JX-0031 at FCA0004245-46, ¶ 1. Defining the Approved Grille Design with an image, and not in words, removes any ambiguity about the specific grille design that Chrysler permitted Mahindra to use.¹ The 2009 Agreement does not contain any language allowing for variations on the grille design. For example, the 2009 Agreement does not have language permitting “substantially” or “materially” the same grille as the Approved Grille Design, and it does not have language that permits a grille to be “adapted” or “inspired” from the Approved Grille Design. *See* CX-0008C at 47:14-20 (MANA’s CEO testifying that the 2009 Agreement “didn’t give us the right to adapt an Approved Grille Design”). Instead, the 2009 Agreement provided Chrysler’s consent to only the specific Approved Grille Design shown in Exhibit A.

By contrast, Mahindra and the Staff take the position that “‘grille design’ refers to the primary design elements of the grille, and to ‘incorporate’ a grille design into a vehicle means to apply those design elements in the space available on a specific vehicle according to engineering

¹ Mahindra argues there is a possibility of latent ambiguity within the language of the 2009 Agreement such that “extrinsic evidence developed during the hearing shows that Mahindra’s interpretation . . . is consistent with the parties’ understanding and the industry usage.” Resp. PHB at 15; *see also id.* at 15-23. Mahindra has not met its burden to establish a latent ambiguity. The Sixth Circuit has recognized “the fundamental principle that ‘[p]arol evidence under the guise of a claimed latent ambiguity is not permissible to vary, add to, or contradict’ any other ‘plainly expressed terms of [the] writing.’” *Stryker*, 842 F.3d at 428 (quoting *Mich. Chandelier Co. v. Morse*, 297 N.W. 64, 66 (Mich. 1941)). Here, the 2009 Agreement identifies the “grille design **shown in** Exhibit A,” language that refers only to the grille shown in Exhibit A and not a different thematically-related grille. In other words, there is no gap to fill with an industry understanding. JX-0031 at FCA0004245-46, ¶ 1 (emphasis added).

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and aesthetic requirements.” Resp. PHB at 10; *see also id.* at 11-15; Staff PHB at 12-13.

According to Mahindra, its interpretation of “grille design” “is made clear by dictionary definitions of the words, the context of those words in the agreement, the common industry understanding of ‘grille design,’ and the evidence of what the parties understood at the time the 2009 Agreement was negotiated and signed.” *Id.* at 10.

Mahindra and the Staff’s argument is not persuasive because there is no textual indication in the 2009 Agreement that might have permitted adaptations of the pictured grille design. The 2009 Agreement contains only a single image of an approved grille design. Where, as here, a contract defines a term, “the contractual definition of the defined term controls.” *Collins v. Nat’l Gen. Ins. Co.*, 834 F. Supp. 2d 632, 638-39 (E.D. Mich. 2011). “Ambiguity will not be found by a court solely because a party to the contract interprets terms differently than the express definition provided in the contract.” *MLW Assocs., Inc. v. Certified Tool & Mfg. Corp.*, 106 F. App’x 307, 313 (6th Cir. 2004).

Here, the term “grille design” as used in the 2009 Agreement is clear and unambiguous. The plain meaning of the term “grille design” is the design of a grille, where “design” according to the dictionary is a “plan or drawing produced to show the appearance . . . of something before it is made,” and a “grille” is the decorative or ornamental component at the front end of a vehicle. *See* CX-0054 (2009 Oxford Dictionary and Thesaurus, “*Design*: NOUN, A plan or drawing produced to show the appearance and workings of something before it is made.”); RX-0408 at MAH0006876; CX-0003C at Q/A 14, 31. The “grille design” shown in Exhibit A of the 2009 Agreement comprises an image (a computer aided drawing) that shows the look of the grille before it is made.

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The other dictionary definitions of “design” entered into the record also lead to the same conclusion. Those definitions of “design” speak to an “arrangement of elements or details in a product” or an “outline showing the main features of something to be executed.” RX-0408 at MAH0006875. Read in the context of the 2009 Agreement, the entirety of the elements “shown in Exhibit A” are the “elements or details” and “main features . . . to be executed” of the “design.” *See* CX-0003C at Q/A 50, 56; Tr. (Baker) 403:10-15, 412:2-8. Otherwise, nothing in the 2009 Agreement provides any guidance as to which subset of the illustrated elements or features were the subject of the parties’ agreement (*i.e.*, the “primary design elements” argued by Mahindra).

The 2009 Agreement specifically defines the “Approved Grille Design” not with reference to a list of certain attributes or “primary design elements,” but with reference to a picture. As FCA’s design expert Mr. Baker testified during the hearing, that picture is “worth 1,000 words.” Tr. (Baker) 400:8-14. That specific pictorial definition eliminates any potential ambiguity. Accordingly, the interpretation of this term under the law ends here. *See, e.g., Stryker Corp*, 842 F.3d at 426 (“When a written instrument is patently unambiguous, courts must give effect to that objective expression of contractual intent. Extrinsic evidence cannot be summoned to aid interpretation.”) (internal citations omitted).

2. Mahindra’s Proposed “Plain Meaning” Interpretation of “Grille Design”

Mahindra agrees that the term “grille design” is not inherently ambiguous, but takes the position that “‘grille design’ refers to the primary design elements of the grille, and to ‘incorporate’ a grille design into a vehicle means to apply those design elements in the space available on a specific vehicle according to engineering and aesthetic requirements.” Resp. PHB

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at 10, 11. Mahindra refers to dictionary definitions in support of its proposed interpretation, but (as also discussed above) these definitions fail to persuade. *See id.* at 12.

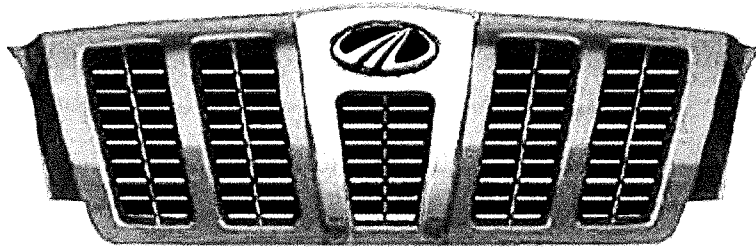
For example, the first cited definition (“a preliminary sketch or outline showing the main features of something to be executed”) is not applicable to the 2009 Agreement because Exhibit A on its face is not a “preliminary sketch or outline showing main features,” but rather a fully rendered final design. CX-0003C at Q/A 62. The other cited definition (“the arrangement of elements or details in a product or work of art”) is somewhat more applicable to the circumstances here, but Exhibit A does more than just arrange elements in a product. Exhibit A actually shows the appearance of the grille before it is made.

Ultimately, the “plain meaning” Mahindra proposes for “grille design” combines phrases from four different dictionary definitions for these two words, removing some words (“details”) and adding others not found in any definition (“covering the area where”) to suit its argument. *See* RX-0408 (“design”); RX-0408 (“grille”); RX-0219 (“grille”). This type of manipulation belies the purpose of a “plain meaning” approach to contract interpretation.

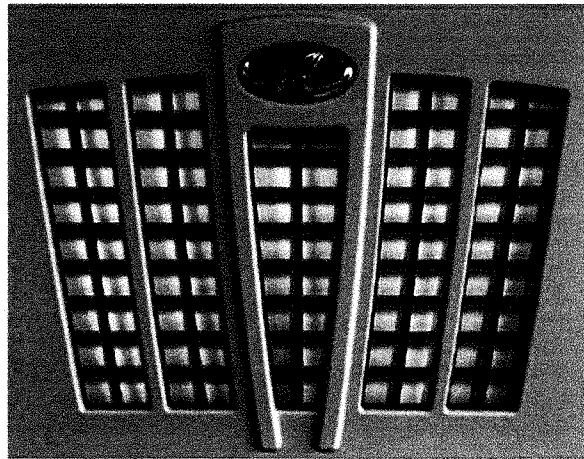
3. Application of the 2009 Agreement

The record evidence establishes that the accused Roxor grille does not embody the Approved Grille Design shown in Exhibit A of the 2009 Agreement. Specifically, the Approved Grille Design and accused Roxor grille have significant differences in (1) overall shape, (2) proportions, and (3) design details. *See, e.g.*, CX-0003C at Q/A 19-23; Tr. (Lowis) 163:9-164:8, 166:13-167:12.

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JX-0031 Exhibit A: “Approved Grille Design”



JPX-0001: Photo of Accused Roxor Grille

Indeed, the evidence shows that Mahindra’s designers understood Mahindra “deviated” from the Approved Grille Design for the Roxor grille. CX-0021C at MAH0002705. For example, when evaluating whether to remove the chrome center cap on the Approved Grille Design, John Pacella (MANA’s Studio Engineering Manager) raised internally the following concern: “If this was the image shared with FCA; we understand that we are deviating and are good with it.” *Id.* Richard Haas, President and CEO of MANA, replied: “Yeah, John. I understand.” *Id.*; *see also* CX-0008C at 143:11-144:3. Moreover, the designer of the accused Roxor grille, Mr. Lewis, testified that the perimeter, aspect ratio, slot aspect ratio, logo

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proportion, and finish are all different between the Approved Grille Design and the Roxor grille. CX-0006 at 109:5-113:13; *see also* CX-0008C at 60:21-61:1.

Accordingly, it is the determination of the undersigned that the accused Roxor grille (JPX-0001) does not embody the Approved Grille Design shown in Exhibit A of the 2009 Agreement.

B. Meaning of “any claim for infringement of . . . trade dress, trademark, or other intellectual property . . . based on: (1) a grille having the Approved Grille Design; or (2) a vehicle containing or using the Approved Grille Design”

1. Plain and Ordinary Meaning

The 2009 Agreement states that Chrysler will not bring “any claim for infringement . . . *based on:* (1) a grille having the Approved Grille Design; or (2) a vehicle *containing or using* the Approved Grille Design.” JX-0031 at FCA00004245, ¶ 1 (emphasis added). Mahindra and the Staff take the position that Chrysler, in essence, agreed not to bring any claim *against* a vehicle using the Approved Grille Design. *See* Resp. PHB at 28-30; Staff PHB at 28-30. Mahindra and the Staff’s argument, however, is not supported by the unambiguous terms of the 2009 Agreement. In particular, to fall within the scope of the 2009 Agreement, the basis of a claim must be analyzed. In order to be subject to the 2009 Agreement’s non-assertion clause, the claim must be *based on* a vehicle *containing or using* the Approved Grille Design. If the claim is not *based on* a vehicle *containing or using* the Approved Grille Design, then the claim is not subject to the 2009 Agreement’s non-assertion clause.

The record evidence demonstrates that the 2009 Agreement’s use of the term “based on” (and not “against”) was intentional, inasmuch as the agreement sought to resolve a dispute “about *the appearance of the grille design* of one of Mahindra’s vehicles currently known as the

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SCORPIO.” *See* JX-0031 at FCA00004245 (emphasis added). Specifically, the 2009 Agreement identifies no dispute broader than that concerning the grille design, and does not provide Chrysler’s consent to any aspects of a vehicle other than its grille. Moreover, Mahindra’s own fact witness on contract negotiation testified that “Mahindra did not understand that Chrysler was giving [Mahindra] the rights to use the word ‘Jeep’ in connection with any vehicle [Mahindra] sold,” or the right “to any of [Chrysler’s] engine technology.” *See* Tr. (Shah) 90:12-20; *see also* Tr. (Shah) 89:23-90:23.

Mahindra and the Staff’s reading of the 2009 Agreement is overbroad, in that it would give Mahindra a royalty-free license to *all* of FCA’s intellectual property as long as a particular vehicle incorporates the Approved Grille Design. If Mahindra’s interpretation were adopted, the 2009 Agreement would prohibit Chrysler (or now FCA) from asserting *any* claim “against” any vehicle using the Approved Grille Design, which might include, for example, a claim for alleged infringement of a utility patent covering engine technology even though that claim is unrelated to the grille. No language in the 2009 Agreement supports this position, and a finding that Chrysler intended to grant Mahindra such broad rights in connection with the resolution of a concern related to a specific grille design is not persuasive. *See, e.g., GKN Driveline Newton LLC v. Stahl Specialty Co.*, No. 13-cv-14427, 2016 WL 1746012, at *5 (E.D. Mich. May 3, 2016) (“Under Michigan law, contracts must be construed consistent with common sense and in a manner that avoids absurd results.”).

2. Parol Evidence

The record evidence confirms the correctness of the plain language interpretation of the 2009 Agreement discussed above, *i.e.*, that Chrysler agreed to forego only claims “based on” the

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use of the Approved Grille Design, and not all claims “against” a vehicle that uses the Approved Grille Design.

Specifically, the evidence demonstrates that the 2009 Agreement was formed after Chrysler raised its concern with M&M about “the grille design of the Scorpio.” JX-0008 at MAH0001643; *see also* CX-0031; RX-0148. In a telephone conversation, M&M confirmed that “the issue under discussion was only the ‘Grille.’” JX-0011 at MAH00001662. M&M agreed to propose new grille designs, including the “New Front Grille” image that became Exhibit A to the 2009 Agreement. *See* JX-0022 at FCA00003293. The evidence also shows that the 2009 Agreement was directed towards the specific grille pictured in Exhibit A, and not to other aspects of a vehicle. *See* JX-0006 at MAH0001733 (Mahindra describing 2009 Agreement as “grille agreement”); JX-0013 at FCA00003312 (explaining that “Chrysler desires to examine” Mahindra’s “revised design front grill of an automobile” in order to “evaluat[e] its similarity to other grille designs as part of Chrysler’s ongoing discussions with Mahindra regarding Mahindra’s Scorpio grille.”).

3. Application of the 2009 Agreement

In view of the discussion above, FCA’s trade dress claim and its ’873 trademark claim are not “based on” the Approved Grille Design or a vehicle having the Approved Grille Design. Instead, these claims are “based on” the overall appearance of the accused vehicle and the vehicle profile, respectively. *See* Complaint at ¶¶ 71-75; CX-0002 at A69-75. Specifically, FCA’s trade dress claim is based on the overall look of the accused vehicle, and not on a vehicle “containing or using” the grille at issue.

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Accordingly, it is the determination of the undersigned that FCA's claims in this investigation are not implicated by the 2009 Agreement, and are not contractually barred thereby.

IV. Initial Determination

For the reasons set forth above, it is the initial determination of the undersigned that (1) the accused Roxor grille (JPX-0001) does not embody the Approved Grille Design shown in Exhibit A of the 2009 Agreement and (2) FCA's claims in this investigation are not implicated by the 2009 Agreement and are not contractually barred thereby.

Pursuant to 19 C.F.R. § 210.42(h), this initial determination shall become the determination of the Commission unless a party files a petition for review of the initial determination pursuant to 19 C.F.R. § 210.43(a), or the Commission, pursuant to 19 C.F.R. § 210.44, orders on its own motion a review of the initial determination or certain issues herein.


V. Order

To expedite service of the public version, each party is hereby ordered to submit to the office of the undersigned, no later than January 4, 2019, a copy of this initial determination with red brackets to show any portion considered by the party (or its suppliers of information) to be confidential, accompanied by a list indicating each page on which such a bracket is to be found and providing a written justification for any proposed redaction specifically explaining why the piece of information sought to be redacted is confidential and why disclosure of the information would be likely to cause substantial harm or likely to have the effect of impairing the Commission's ability to obtain such information as is necessary to perform its statutory functions pursuant to Commission Rules 210.5 and 201.6(a). If a party (and its suppliers of information) considers nothing in the initial determination to be confidential, and thus makes no request that

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any portion be redacted from the public version, then a statement to that effect shall be submitted.

SO ORDERED.


Charles E. Bullock
Chief Administrative Law Judge

**CERTAIN MOTORIZED VEHICLES AND COMPONENTS
THEREOF**

INV. NO. 337-TA-1132

PUBLIC CERTIFICATE OF SERVICE

I, Lisa R. Barton, hereby certify that the attached **Order No. 18 INITIAL DETERMINATION** has been served by hand upon the Commission Investigative Attorney, **Jose Recio, Esq.** and the following parties as indicated, on **JAN 29 2019**



Lisa R. Barton, Secretary
U.S. International Trade Commission
500 E Street SW, Room 112A
Washington, D.C. 20436

FOR COMPLAINANT FCA US LLC	
Frank C. Cimino, Jr., Esq. VENABLE LLP 600 Massachusetts Avenue NW Washington, DC 20001	<input type="checkbox"/> Via Hand Delivery <input checked="" type="checkbox"/> Express Delivery <input type="checkbox"/> Via First Class Mail <input type="checkbox"/> Other: _____
FOR RESPONDENTS MAHINDRA & MAHINDRA LTD. and MAHINDRA AUTOMOTIVE NORTH AMERICA, INC.	
R. David Hosp, Esq. FISH & RICHARDSON P.C. One Marina Park Drive Boston, MA 02210	<input type="checkbox"/> Via Hand Delivery <input checked="" type="checkbox"/> Express Delivery <input type="checkbox"/> Via First Class Mail <input type="checkbox"/> Other: _____