

Trademark Case Shows Infringement Is Often in the Eye of the Beholder — Federal Court Rules in Favor of Beauty Company’s “Dupe” Mascara Product

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Conventional notions of trademark law suggest that emulating a popular product or service carries certain legal risks. However, a recent federal ruling highlights the complexities of trademark infringement cases involving “dupe” products, and shows there may be a greater tolerance for mimicry in some industries.

In December, a California federal judge ruled that e.l.f. Cosmetics’ (ELF) “Lash ‘N Roll” mascara product did not infringe on the trademark or trade dress of Benefit Cosmetics’ (Benefit) “Roller Lash” mascara and “Hook ‘N’ Roll” applicator brush, despite ELF’s admission that it took cues from Benefit’s mascara when developing its product.

“Dupes” — products that mimic the appearance and function of popular items — are particularly prevalent in the cosmetic industry, where high-end products can be expensive and less accessible to some consumers. This case serves as a reminder that dupe products walk a fine line, and the scale can tip either way based on the facts and circumstances of a particular trademark infringement case.

Case Overview

The dispute centers around the Roller Lash mascara product owned by premier beauty brand Benefit. Benefit is known for its catchy and often retro-styled branding. Roller Lash, marketed to curl and lift lashes, includes an applicator known as a “Hook ‘N’ Roll” brush. Roller Lash mascara (including the applicator brush) has achieved more than \$278 million in revenue from U.S. sales since its release in 2015.

Benefit sued ELF for trademark and trade dress infringement following ELF’s release of its own curling mascara known as Lash ‘N Roll in 2022. Among its claims, Benefit asserted that Elf sought to capitalize on Benefit’s success by copying the Benefit products’ “name, packaging, and marketing wholesale.” ELF admitted to releasing the product as a nod to the popular Benefit product, although the Lash ‘N Roll wordmark also aligns with ELF’s music-inspired mascara line, which includes products like “Lash Beats” and “Lash It Loud.”



[1]

Despite ELF's admission that it intended to closely mimic the Benefit mascara product,^[2] the court found that there was no likelihood of confusion to warrant a finding of trademark infringement, concluding "Benefit has not shown that Lash 'N Roll, while it is a 'dupe' of Roller Lash, actually dupes any consumers."

Some of the court's most significant findings with respect to Benefit's trademark and trade dress infringement claims include:

- *The products have distinguishable secondary packaging:* While the court acknowledged that Benefit's trade dress had commercial strength and that the primary packaging was similar, it ultimately focused on ELF's distinguishable secondary packaging, which prominently features its house mark and has design elements to distinguish it from Benefit's product.
- *Benefit failed to take steps to establish actual confusion:* Benefit did not provide sufficient evidence of actual consumer confusion, despite the products co-existing for two years. Benefit also did not conduct any study or survey to support actual consumer confusion, though the court noted that it had the resources to do so. The court explicitly stated that this inaction necessitated a negative finding against Benefit for this factor.
- *Beauty consumers exercise a high degree of care:* Benefit argued that most beauty purchasers are impulse buyers who do not exercise a high degree of care when making a purchase, increasing the likelihood of confusion. The court did not agree, pointing out that Benefit's marketing tactics and efforts reflect the value of brand awareness and that beauty consumers are sophisticated purchasers. The court also cited that the significant price difference between products (\$6 versus \$29) would immediately catch a consumer's attention.
- *The products are sold and marketed through different channels:* The court determined that Benefit is considered a "prestige" beauty company that sells its products in department and specialty beauty stores (e.g., Sephora and Ulta). ELF is what the court described as "a mass company," that sells products in big-box and drug stores. Even where there is marketing overlap — such as Target and Ulta — the products are segregated, with prestige brands like Benefit cordoned off in a different section from mass cosmetic products. The court found that this factor makes it less likely for there to be confusion between the products.
- *ELF did not intend to deceive the consumer.* Despite ELF's acknowledgement that it intended to mimic Benefit's product, the court determined there was no intent to deceive the consumer as to the product's origins. Instead, the court concluded that ELF intended to offer customers a less expensive alternative to Benefit's popular curling mascara product. ELF also demonstrated that it created the product consistent with its own broader musical theme branding, independent of its intent to cue to Roller Lash.

Key Takeaways

Here are some key takeaways from the case to consider going forward:

1. Cue to other products with caution. Businesses should **not** interpret this ruling as open season on popular brands and products and start making dupe products of their own without first conducting a legal evaluation. This case involved a delicate balance of multiple factors and considerations that tipped the scale in ELF's favor.

Each industry, market, brand, and product or service is unique and could result in a different outcome. If your organization wishes to make a nod to another product or service, it's essential to consult with an experienced intellectual property attorney to assess legal risk.

2. Product similarity does not always equal a slam dunk infringement claim. Products with the same purpose can look remarkably similar, but if there is no likelihood of confusion, there are no grounds for trademark or trade dress infringement. In this case, Benefit's lack of any evidence of actual confusion and its lack of any studies or surveys evidencing the likelihood of confusion worked against it. In addition, Benefit focused on the similarities of the products' primary packaging, not considering the packaging as a whole, including the products' distinguishable secondary packaging.

When pursuing trademark or trade dress infringement claims against another party for a dupe product, don't assume perceived similarities will automatically result in a finding of likelihood of confusion. Before proceeding with litigation, potential plaintiffs should evaluate whether there's evidence of actual consumer confusion and, to the extent necessary, conduct consumer surveys for additional evidentiary support. It's also important to take into account the entirety of the trade dress, including both primary and secondary packaging.

3. Does an intent to copy create risk of punitive damages? While this case opinion notes that intent to copy,^[3] but not deceive, can be a neutral or favorable factor in finding a low likelihood of confusion, it may backfire when it comes to damages. For example, if a court finds a likelihood of confusion after balancing all the relevant factors, an organization's "intent to copy" could potentially become an unfavorable factor in determining punitive damages under state law. For example, punitive damages can potentially be triggered in states like California when there is willful or malicious conduct.

^[1] *Benefit Cosmetics LLC v. E.L.F. Cosmetics, Inc.*, No. 3:23-cv-00861, Dkt No. 1, at 6.

^[2] Benefit contended that Lash N' Roll infringed on both its Roller Lash and Hook 'N' Roll word marks individually. However, the court's discussion predominately focused on Roller Lash, noting that Lash 'N' Roll only appears on the side and back of secondary packaging for Roller Lash, with smaller font than Benefit's house mark or Roller Lash word mark.

^[3] The court also noted that ELF's intent to "cue" was not quite an intent to "copy."

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