

**THE AMERICAN
EXPERIENCE WITH
TRADEMARK ANTI-
DILUTION LAW**

IBIL Brands Seminar - Univ. College London
London, England 11 February 2009

J. Thomas McCarthy

FREE RIDING?

- EU DIRECTIVE: Use is prohibited if the unpermitted use *“is detrimental to the*

VICTORIA'S SECRET CASE

V Secret Catalogue
v.
Mosley, 537 U.S. 418
(2003)



U.S. Supreme Court:
“Actual dilution must be established.”

V Secret Catalogue v. Mosley (2003)

“There is a complete **absence of evidence** of any lessening of the capacity of the Victoria's Secret mark to identify and distinguish goods or services sold in Victoria's Secret stores or advertised in its catalogs.”

FEDERAL ANTI-DILUTION ACT OF 1996 (FTDA) JUDICIAL VIEWS

- **Injury** -Actual Dilution Required –Victoria's Secret Case - Supreme Court
- **Fame** – Niche Fame is OK – Third Circuit
- **Distinctiveness**- Inherent Distinctiveness Required – Second Circuit
- **Tarnishment** –

**TRADEMARK DILUTION REVISION
ACT OF 2006
(TDRA) KEY CHANGES**

- Injury - Actual Dilution Not Required

—

DILUTION BY BLURRING

Dilution by blurring is association arising from the similarity between an accused mark or trade name and a famous mark that “**impairs the distinctiveness** of the famous mark.”
Lanham Act sec.43(c)(2)(B)

DILUTION BY TARNISHMENT

Dilution by tarnishment is association arising from the similarity between an accused mark or trade name and a famous mark that “**harms the reputation** of the famous mark.”

Lanham Act sec.43(c)(2)(C)

DIFFERENT BASIS FOR DILUTION AND INFRINGEMENT

- TRADITIONAL TRADEMARK LAW RESTS PRIMARILY ON A TORT-LIKE POLICY OF PROTECTION OF CUSTOMERS FROM MISTAKE AND DECEPTION.
- ANTI-DILUTION LAW DOES NOT RESEMBLE THE LAW OF CONSUMER PROTECTION, AND HAS MORE SIMILARITY TO THE LAW OF TRESPASS ON PROPERTY.

STOPS ON A LINE? CONFUSION AND DILUTION



LIST OF HYPOS USED BY STATE LEGISLATURES & CONGRESS

LIST OF OFFENDING EXAMPLES AGAINST WHICH ANTI-DILUTION LAWS ARE DIRECTED IS:

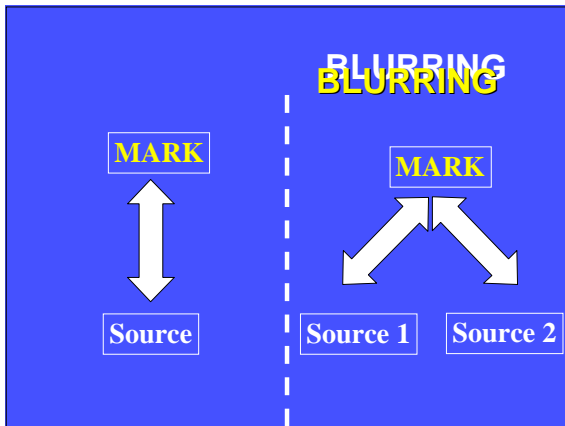
- DUPONT SHOES
- SCHLITZ VARNISH
- KODAK PIANOS
- BUICK ASPIRIN
- BULOVA GOWNS.

ROLEX WATCHES

SLIPPERY SLOPE

ROLEX SHOES

ROLEX



TDRA: SIX FACTORS FOR BLURRING

- (i) The degree of similarity between the mark or trade name and the famous mark.
- (ii) The degree of inherent or acquired distinctiveness of the famous mark.
- (iii) The extent to which the owner of the famous mark is engaging in substantially exclusive use of the mark.
- (iv) The degree of recognition of the famous mark.
- (v) Whether the user of the mark or trade name intended to create an association with the famous mark.
- (vi) Any actual association between the mark or trade name and the famous mark.

LIKELIHOOD OF ASSOCIATION IS NOT THE SAME AS LIKELIHOOD OF BLURRING

Blurring is a kind of injury or damage to a mark, defined by the statute as an impairment of the distinctiveness of a mark that is caused by "association." The two elements of "association" and "blurring" are separate and

Hershey v Art Van Furniture, 2008
WL 4724756 (E.D. Mich. 2008)



versus



HERSHEY
chocolate bar

ART VAN furniture retailer

**NON-TRADEMARK USE DOES
NOT DILUTE**



IN CONTENT OF
EXPRESSIVE

Louis Vuitton v. Haute Diggity Dog
507 F.3d 252 (4th cir. 2007)

LESSON: A commercial parody may

THE END

Dilution 2009

J. Thomas McCarthy

Copyright 2009 J.T. McCarthy
