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Dilution by Tarnishment

Which do you find more persuasive in what follows: the majority opinion or the dissenting opinion?

[The opinion in *V Secret Catalogue, Inc. v. Moseley* is available separately.]

Questions and Comments

1. *Criticisms of the Sixth Circuit majority opinion in* V Secret. Leading voices in trademark law have strongly criticized the majority opinion. *See, e.g.*, MCCARTHY § 24:89 (condemning the *V Secret* presumption as "wildly misguided" and observing that "[t]he majority's presumption certainly sounds like the judiciary is making value judgments about what is unacceptably 'sexy,' a highly subjective and very slippery slope, allowing courts to censor uses they personally find 'sex-related.'"). McCarthy further notes a fundamental problem with the plaintiff's evidence of tarnishment (and perhaps with the theory of dilution by tarnishment more broadly): "I find very troubling that the district court based its finding of a likelihood of tarnishment upon the very same testimony that the Supreme Court in 2003 had characterized as not being evidence of tarnishment." *Id*. McCarthy explains:

> The district court relied on the same Army officer's testimony that the Supreme Court characterized in its opinion. That is, an Army Officer was offended by the junior user's use of its name on what he considered to be tasteless goods. The Supreme Court said that the officer "did not therefore form any different impression of the store that his wife and daughter had patronized ... . The officer was offended by the ad, but it did not change his conception of Victoria's Secret. His offense was directed entirely at [the junior user], not at [the senior user Victoria's Secret]." Moseley v. V Secret Catalogue, Inc., 537 U.S. 418, 434 (2003). Yet, on remand, the district court said this same testimony "suggests the likelihood that the reputation and standing of the VICTORIA'S SECRET mark would be tarnished."

MCCARTHY § 24:89 n. 49.

2. *Is antidilution law constitutional?* In *Matal v. Tam*, 582 U.S. 218 (2017), excerpted in the reading for Class 24 with respect to trademark law and the First Amendment, the Supreme Court ruled that the Lanham Act § 2(a) prohibition on the registration of marks that "may disparage . . . persons" was invalid under the Free Speech Clause of the First Amendment. What are the implications of the Court's reasoning in *Tam* for antidilution law, and particularly for anti-tarnishment law?

3. *Tarnishment or "burnishment"? See* Jake Linford, Justin Sevier & Allyson Willis, *Trademark Tarnishmyths*, 55 ARIZ. ST. L.J. 609 (2023) (reporting the results of a series of

experiments that suggest that purportedly tarnishing conduct associating a targeted mark with sex, narcotics, or sacrilege does not harm the reputation and may even result in the "burnishment" of the mark).