

# Trademark Law

Prof. Madison

**Today: Dilution basics**

**Key concepts from Class 20:**

Dilution by blurring.

Loss of distinctiveness of the mark.

Theories of harm.

### **Trademark dilution: intended for (but not limited to) non-competitive goods and services**

#### **(1) Injunctive relief**

Subject to the principles of equity, 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.

Lanham Act § 43(c) (15 U.S.C. § 1125(c)(1))

Beyond the standard Likelihood of Confusion case

### **Trademark dilution: intended for (but not limited to) non-competitive goods and services**

(C) For purposes of paragraph (1), "dilution by tarnishment" is association arising from the similarity between a mark or trade name and a famous mark that harms the reputation of the famous mark.

Lanham Act § 43(c) (15 U.S.C. § 1125(c)(2))

Beyond the standard likelihood of confusion case

**Tarnishment means “harms the reputation of the famous mark”**



**The Ford Edsel**



**Toblerone in  
2016 changed  
the shape of its  
chocolate bars**



**Tarnishment as self-dilution?**

Famous self-owns by mark owners.

Can you do it to yourself but prevent others from doing it to you?

# Dilution by tarnishment. What is the theory of harm?

## VICTORIA'S SECRET

VICTOR'S  SECRET

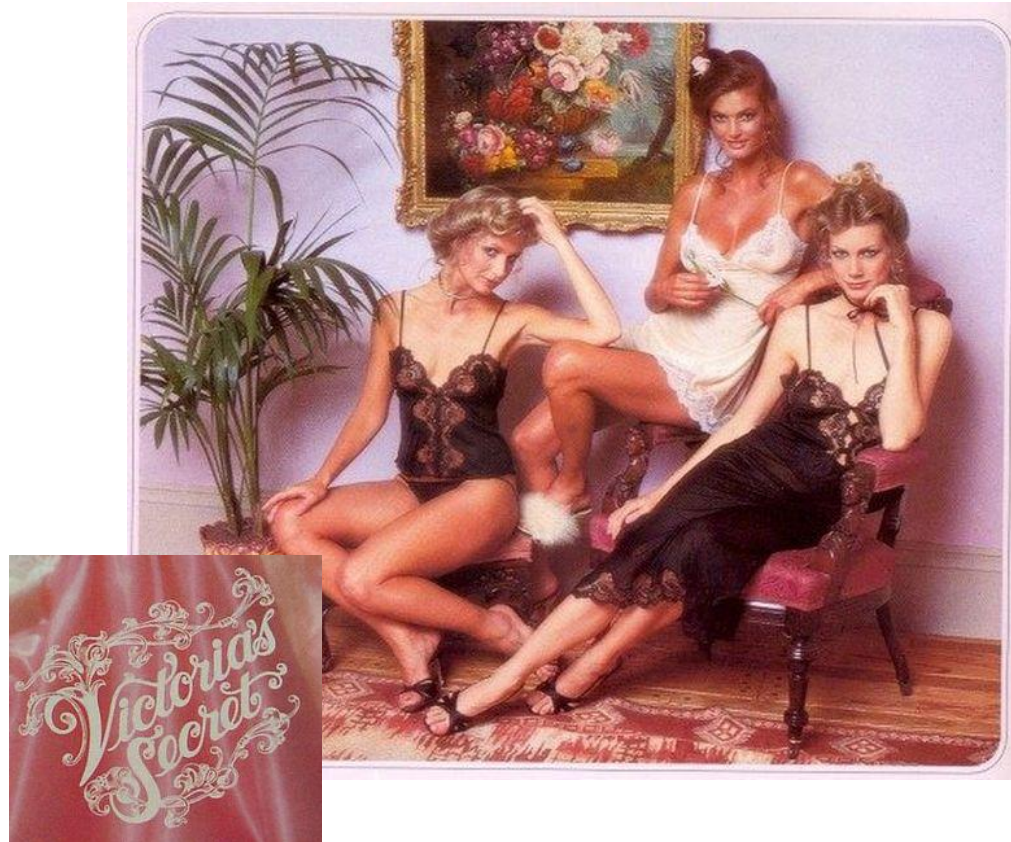


V Secret Catalogue, Inc. v. Moseley  
(6th Cir. 2010)



## Dilution by tarnishment. What is the theory of harm?

- Did the **association** between “Victor’s Little Secret” and “Victoria’s Secret” cause **harm to the VS mark**?
- Maybe: a wholesome mark is tainted by associations with sex.
- Or: a mark that originally signified “the faux bordello environment is comfortable for male shoppers” is being pulled back to its original meaning.
- Who should bear the burden of proof?



*1979 Victoria's Secret catalog image*

To what extent are mark owners entitled to use trademark law to control what their marks signify beyond source? Cf. *Matal v Tam* on how FA interacts with TM law.



Enjoy

*Cocaïne*

Trade-mark ®

Is the reputation of the Coca-Cola mark harmed by this poster? How? Who should bear the burden of proof?



“I’m a Mac; I’m a PC” campaign: comparative advertising – even funny comparative advertising that tries to diminish the competitor – seems to be OK.



## Dilution by tarnishment. What is the theory of harm?



JOHN DEERE



### Tarnishment? Or comparative advertising?

43(c)(3)(C): “dilution by tarnishment” is association arising from the similarity between a mark or trade name and a famous mark that **harms the reputation of the famous mark.**

Deere & Co. v. MTD Products, Inc. (2d Cir. 2004)

