

## NOTES & COMMENTS

### TARNISHMENT'S GOODY-TWO-SHOES SHOULDN'T GET ALL THE PROTECTION: BALANCING TRADEMARK DILUTION THROUGH BURNISHMENT

by  
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*Famous marks classically earn twofold confusion and dilution trademark protection. In the past, only famous high-quality, socially acceptable marks—dubbed “wholesome” marks in this Comment—have found protection under dilution theory. Historically, one-sided protection of these wholesome marks isolated an entire classification of trademarks technically qualified for dilution protection, termed “unwholesome marks.” Unwholesome marks are famous marks that either represent salacious goods or services or maintain a constant seamy, gritty, or tawdry appearance. This Comment explores the evolution of dilution theory and its relational effect on unwholesome marks. I hypothesize that courts have construed the dilution doctrine too narrowly and, in doing so, precluded qualified unwholesome marks from bringing viable dilution claims.*

*Part I offers a necessary foundation of trademark protection. Part II explains dilution by tarnishment history and theory before 1995. Part III*

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*explains dilution law after 1995, following the transition from the FTDA to the TDRA. In addition, Part III explores Moseley v. V Secret Catalogue, Inc.'s influential effect on dilution history. Part IV explores burnishment theory and possible methods for implementation and, finally, Part V justifies the need for a burnishment claim.*

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*“Perhaps the most salient factor for the most successful brands is the promise of consistent quality. Whether it’s a business or a consumer making a purchasing decision, they want to be sure in this world of endless choice that their decision is the right one.”*

-Rosi McMurray, Executive Director of Strategy, The Brand Union<sup>1</sup>

In the trademark realm, a name means everything. A trademark embodies the core of a company and acts as the face of a brand. A strong trademark will immediately call to mind companies, products, or services. But a truly successful trademark conjures a feeling—of a desired lifestyle, a wish, memory, hope, or craving for something more, something better.

Trademarks indicate the quality of good, the level of service, or the reputation of a brand. But just as trademarks can denote high-quality goods or desirable service, they can also symbolize mediocrity and represent déclassé brands. Not all trademarks are equal in strength, but it is not the quality of a good that dictates the strength of mark. Instead,

<sup>1</sup> Reprinted in *Why Brands?*, BRAND MANAGEMENT 2016 (Sept. 9, 2016), <http://www.brandevent.cz/en/about-conference/why-brands>. Ms. McMurray, who is now Associate Brand Strategy Partner for Gravity London, confirmed this quote in an e-mail on file with Lewis & Clark Law Review.

trademark strength is measured on a hierarchy that ranges from weak to exceptionally strong marks.<sup>2</sup> The stronger the mark the more swiftly the consumer calls to mind the brand or the origin of the goods. Famous, coined, and arbitrary marks, such as Tiffany & Co., NIKE, and Apple, occupy the top of the hierarchy. Strong marks maintain a distinct association in consumers' minds between the mark and the origin of the goods, partly because consumers quickly recognize these strong marks.

The Lanham Act provides dual protection for qualifying trademarks through dilution and confusion-based claims.<sup>3</sup> More often than not, markowners only qualify for, and therefore must solely rely on, confusion-based protection to prevent unauthorized use of their marks. However, those that qualify as famous markowners are entitled to extended dilution-based protection, which prevents against any use that would blur or tarnish their mark.<sup>4</sup> Dilution by blurring occurs when there is likelihood that the association between a defendant's mark and the famous mark will impair the distinctiveness of the famous mark.<sup>5</sup>

Alternatively, a mark is tarnished when a defendant's unauthorized use "degrad[es] positive associations of the mark and thus . . . harm[s] the reputation of the mark. The Second Circuit observed that: 'The *sine qua non* of tarnishment is a finding that plaintiff's mark will suffer negative associations through defendant's use.'"<sup>6</sup> Typically only wholesome marks assert dilution claims.<sup>7</sup> A wholesome mark is one whose mark, goods, or reputation are commonly considered acceptable by society, whereas society does not commonly accept an unwholesome

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<sup>2</sup> *Abercrombie & Fitch Co. v. Hunting World, Inc.*, 537 F.2d 4, 9 (2d Cir. 1976). The *Abercrombie* hierarchy reflects conceptual strength as opposed to commercial strength, which measures the notoriety of a mark. Conceptual and commercial strength may be correlated, but a conceptually strong mark is not always commercially strong.

<sup>3</sup> 15 U.S.C. § 1125 (2012).

<sup>4</sup> *Id.* § 1125(c).

<sup>5</sup> J. THOMAS MCCARTHY, 4 MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 24:115 (4th ed. 2014).

<sup>6</sup> *Id.* § 24:89 (quoting *Hormel Foods Corp. v. Jim Henson Prods., Inc.*, 73 F.3d 497, 507 (2d Cir. 1996)).

<sup>7</sup> *See, e.g.*, *Starbucks Corp. v. Wolfe's Borough Coffee, Inc.*, 588 F.3d 97 (2d Cir. 2009); *Nabisco, Inc. v. PF Brands, Inc.*, 191 F.3d 208 (2d Cir. 1999), *abrogated by* *Moseley v. V Secret Catalogue, Inc.*, 537 U.S. 418, 432 (2003); *Deere & Co. v. MTD Prods., Inc.*, 41 F.3d 39 (2d Cir. 1994); *L.L. Bean, Inc. v. Drake Publishers, Inc.*, 811 F.2d 26 (1st Cir. 1987); *Pinterest, Inc. v. Pintrips, Inc.*, 140 F. Supp. 3d 997 (N.D. Cal. 2015); *adidas-Am., Inc. v. Payless Shoesource, Inc.*, 546 F. Supp. 2d 1029 (D. Or. 2008); *Hasbro, Inc. v. Clue Computing, Inc.*, 66 F. Supp. 2d 117 (D. Mass. 1999), *aff'd*, 232 F.3d 1 (1st Cir. 2000); *Ringling Bros.-Barnum & Bailey Combined Shows, Inc. v. B.E. Windows Corp.*, 937 F. Supp. 204 (S.D.N.Y. 1996) [hereinafter *Ringling Bros. v. B.E. Windows*].

mark.<sup>8</sup> Unwholesome marks need not represent salacious goods or services but may also be marks that maintain a constant seamy, gritty, or tawdry appearance. Current trademark law does not formally require that dilution by tarnishment only apply to wholesome marks; rather, common practice simply dictates that only wholesome marks may assert a dilution by tarnishment cause of action.<sup>9</sup> This common practice has affected dilution law in two ways. First, it created a void in the statute that prevents unwholesome but otherwise qualified marks from alleging dilution by tarnishment. Second, it prevented full extension of the doctrine to all famous marks because unwholesome famous marks are excluded from asserted dilution by tarnishment.

This Comment proposes an alternative claim, dilution by burnishment, as a solution to the existing truncated dilution protection.<sup>10</sup> Dilution by burnishment would provide an alternative avenue of recourse to otherwise qualifying marks that would normally be unable to assert dilution by tarnishment because of the nature of their goods. Burnishment claims would apply to situations similar to tarnishment, in which a defendant has altered a mark's constant reputation without authorization. However, under a burnishment claim, the association improves the reputation, while in a tarnishment claim the association diminishes the reputation. In both tarnishment and burnishment, the result is the same because the association injures a markholder's reputation. For example, suppose that Mr. A opened a nationwide chain of PINK DIVAS gentlemen's clubs that featured nude dancers, prime steaks, and pornographic videos. Subsequently, a women's rights group adopts PINK DIVAS as the name for their local chapter dedicated to rape counseling, services for victims of human trafficking, and other charitable fundraising activities dedicated to women's rights.<sup>11</sup> In this instance, Mr. A's mark would suffer because of the positive association with the women's rights group. Mr. A could assert a dilution by burnishment claim. Alternatively, consider the example in which a party sells peanut butter medallion candy called "Reefer's Peanut Butter Cups," with packaging that includes images of marijuana leaves.<sup>12</sup> Here,

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<sup>8</sup> Examples of wholesome marks include Apple for computers and electronics, Jansport for backpacks, and Oreo for sandwich cookies. Examples of unwholesome marks include Magnum for condoms, Chippendales for male dancers, and Viagra for performance enhancing drugs.

<sup>9</sup> See *supra* note 7 and accompanying text.

<sup>10</sup> The hypothetical situation in this paragraph is from GRAEME B. DINWOODIE & MARK D. JANIS, TRADEMARKS AND UNFAIR COMPETITION LAW AND POLICY 649 (4th ed. 2014).

<sup>11</sup> *Id.*

<sup>12</sup> See Complaint for Trademark Infringement, Trademark Dilution, False Designation of Origin and Damages at 10, *Hershey Co. v. Conscious Care Coop.*, No. 2:14CV00815 (W.D. Wash. June 3, 2014); see also Keith Coffman, *Hershey's Settles*

the famous Reese's Peanut Butter Cups mark could assert dilution by tarnishment because associating candy with a recreational drug could harm the candy's wholesome reputation.<sup>13</sup> In tarnishment, the wholesome mark declines from its constant reputation, while with burnishment the unwholesome mark rises from its constantly lower reputation.<sup>14</sup> In essence, burnishment is the mirror image of tarnishment, thus balancing dilution law.<sup>15</sup>

This Comment discusses the origins of dilution doctrine and the theory supporting dilution, as well as burnishment theory and methods of implementation for burnishment in current trademark dilution configuration. Part I first provides general trademark background necessary for understanding burnishment. Part II then offers dilution by tarnishment context, discussing history and theory of tarnishment before 1995. Part III explains dilution law after 1995, following the transition from the Federal Trademark Dilution Act of 1995 (FTDA) to the Trademark Dilution Revision Act of 2006 (TDRA), as well as exploring *Moseley v. V Secret Catalogue, Inc.*'s influential effect on dilution history. Throughout the dilution history discussion, I posit that courts too narrowly construed the dilution doctrine. Over time, this subtle misuse of the doctrine excluded qualified unwholesome markowners from bringing dilution claims. Thus, typical application of the doctrine established an informal rule that only wholesome marks were capable of suffering from dilution, effectively preventing unwholesome markowners from asserting any dilution claims. Parts IV and V constitute the bulk of the burnishment discussion, in which I hypothesize that burnishment is the proper cure for the unbalanced dilution doctrine. Part IV explores burnishment theory and how it could be implemented, and Part V frames the need for an additional dilution claim. Ultimately, in comparing the history of dilution theory with the current composition of famous marks, I conclude that recognition of a burnishment claim is necessary for fundamental fairness, to balance the dilution doctrine, and because impending case law suggests there may be an influx of unwholesome famous marks in need of tailored dilution protection like burnishment.

## I. GENERAL TRADEMARK BACKGROUND

A trademark is any symbol, name, or word that identifies the origin and ownership of goods.<sup>16</sup> Trademarks are used to identify goods and

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*Infringement Lawsuits with Two Edible Pot Companies*, REUTERS (Oct. 17, 2014), <http://www.reuters.com/article/usa-hershey-marijuana-idUSL2N0SD03620141018>.

<sup>13</sup> See Complaint for Trademark Infringement, *supra* note 12, at 2–3.

<sup>14</sup> See *infra* Appendix A.

<sup>15</sup> *Id.*

<sup>16</sup> 15 U.S.C. § 1127 (2012).

distinguish those goods from others sold in the marketplace. Further, trademarks function to identify the source of goods.<sup>17</sup> The strength of a trademark is the single-most important designation for a mark. The strength of a mark may be identified on the distinctiveness continuum set out in *Abercrombie & Fitch Co. v. Hunting World, Inc.*: “generic,” “descriptive,” “suggestive,” “arbitrary or fanciful.”<sup>18</sup> The ascending order of the continuum parallels trademark strength, and therefore the degree of protection afforded.<sup>19</sup> However, the categories are rarely clearly distinct.<sup>20</sup> Even more, a mark that fits into one category for a particular good may fit into an entirely separate category when associated with a different good.<sup>21</sup>

A generic mark is “one that refers . . . to the genus of which the particular product is a species,” or a mark by which consumers would use to ask for the specific product.<sup>22</sup> The Lanham Act precludes registration of generic marks in any situation.<sup>23</sup> Descriptive marks are those that describe one or more “ingredient, quality, characteristic, function, feature, purpose, or use of the specified goods or services.”<sup>24</sup> Ordinarily, the Lanham Act prevents registration of descriptive marks, but descriptive marks may register if they acquire secondary meaning.<sup>25</sup> Alternatively, suggestive marks are inherently distinctive and therefore immediately registrable if not prohibited by factors other than strength. The area between descriptive and suggestive marks is the murkiest on the hierarchy making it most difficult to delineate between descriptive and suggestive:

Suggestive marks are those that, when applied to the goods or services at issue, require imagination, thought, or perception to reach a conclusion as to the nature of those goods or services. Thus, a suggestive term differs from a descriptive term, which immediately tells something about the goods or services.<sup>26</sup>

Finally, arbitrary and fanciful marks are those marks that are unknown or completely out of common usage, thus arbitrary and fanciful marks were created solely to function as a trademark.<sup>27</sup> The placement of a mark on

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<sup>17</sup> *Id.*; see also DINWOODIE & JANIS, *supra* note 10, at 45.

<sup>18</sup> 537 F.2d 4, 9 (2d Cir. 1976).

<sup>19</sup> *Id.*

<sup>20</sup> *Id.*

<sup>21</sup> *Id.*

<sup>22</sup> *Id.*

<sup>23</sup> U.S. PATENT & TRADEMARK OFFICE, TRADEMARK MANUAL OF EXAMINING PROC., § 1209.01(c) (Jan. 2017) [hereinafter TMEP].

<sup>24</sup> *Id.* § 1209.01(b).

<sup>25</sup> *Id.* § 1209.01.

<sup>26</sup> *Id.* § 1209.01(a).

<sup>27</sup> *Id.*

the hierarchy determines the strength of the mark and its corresponding protection.<sup>28</sup> Trademark strength is significant in the scope of tarnishment because only famous marks are allowed dilution protection, and often, famous marks are also strong marks.

Because of the significant role trademarks play in modern business, markholders assert as much protection over their marks as possible. Trademark statutes provide two types of protection for trademarks: confusion-based protection and nonconfusion-based protection. Generally, markowners rely on confusion-based infringement claims to protect against unauthorized use.<sup>29</sup> A markowner may assert a trademark infringement claim when a defendant used that markowner's mark without authorization and the use resulted in a likelihood of consumer confusion.<sup>30</sup> A likelihood of confusion exists when the use of the mark confuses consumers as to the source or sponsorship of the goods, not whether consumers will confuse the two marks with one another.<sup>31</sup> In the alternative, trademark owners assert nonconfusion-based protection through dilution claims. Dilution further extends trademark protection to those marks that qualify as famous.<sup>32</sup> Unlike general infringement, dilution's core is not in consumer confusion; instead, dilution occurs when an association erodes a mark's distinctive qualities in some fashion.<sup>33</sup> Dilution is the lessening of a famous mark's capacity to identify and distinguish goods regardless of the presence of competition between the famous mark and those of other parties, or the likelihood of confusion.<sup>34</sup>

Dilution law provides relief for two types of dilution, dilution by blurring and dilution by tarnishment.<sup>35</sup> Dilution by blurring occurs when the association stemming from similarity between two marks impairs the distinctiveness of the famous mark.<sup>36</sup> For instance, Buick aspirin or

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<sup>28</sup> See *Abercrombie & Fitch Co. v. Hunting World, Inc.*, 537 F.2d 4, 9 (2d Cir. 1976).

<sup>29</sup> The majority of markowners do not meet the minimum qualifications for dilution protection and therefore must rely only on confusion-based protection.

<sup>30</sup> 15 U.S.C. § 1125(a) (2012).

<sup>31</sup> TMEP, *supra* note 23, § 1207.01.

<sup>32</sup> 15 U.S.C. § 1125(c). The question of fame, which acts as a gatekeeping mechanism for the powerful dilution doctrine, is outside the scope of this Comment. Essentially, to qualify for fame, the mark must be a household name. *Id.*

<sup>33</sup> Robert N. Klieger, *Trademark Dilution: The Whittling Away of the Rational Basis for Trademark Protection*, 58 U. PITT. L. REV. 789, 840 (1997).

<sup>34</sup> *Id.*

<sup>35</sup> 15 U.S.C. § 1125(c).

<sup>36</sup> See *id.* § 1125(c)(2)(B)(i)–(vi). Factors to determine whether a mark is likely to cause dilution by blurring include: “The degree of similarity between the mark or trade name and the famous mark”; “[t]he degree of inherent or acquired distinctiveness of the famous mark”; “[t]he extent to which the owner of the famous mark is engaging in substantially exclusive use of the mark”; “[t]he degree of

DuPont shoes would be forms of blurring. However, dilution by blurring is outside the scope of burnishment. Instead, dilution by burnishment originates from dilution by tarnishment. Dilution by tarnishment occurs when the similarities between the marks harm the *reputation* of the famous mark.<sup>37</sup> For example, “Enjoy Cocaine” in the famed Coca-Cola script and white and red coloring would constitute dilution by tarnishment. The association between the soda and the drug would harm Coca-Cola’s positive reputation by suggesting that Coca-Cola in some way endorses or includes cocaine in its product.

A famous markowner can take advantage of both confusion- and nonconfusion-based claims, which would essentially create exclusive rights over their famous mark. Absolute exclusive trademark rights, or property rights in gross, arguably promote trademark protection’s purpose. The purpose of trademark protection is twofold: to protect the public and to protect the trademark owner. Trademark protection safeguards the public by allowing the public to be confident that when one purchases a product bearing a known, favorable trademark the public will receive the product that it expects and wants.<sup>38</sup> Alternatively, trademark law also protects markowners by shielding their investments in the form of time, effort, and money from misappropriation once they present their products to the public.<sup>39</sup> Allowing a famous markowner extra protection, either in the form of tarnishment or burnishment, would also serve the purpose of trademark protection. First, it would encourage markowners to invest in their marks and build famous marks. Upon extension of the dilution doctrine, greater protection would be available, so markowners’ investments would not be in vain. Similarly, dual protection would provide customers with security because they would know, with certainty, that the famous markowners extensively protect their marks, therefore consumers could further rely on the marks.

## II. DILUTION HISTORY AND THEORY BEFORE 1995

Before Congress enacted the first federal dilution statute, the FTDA, dilution theory and protection were solely based on Frank Schechter’s innovative article and state statutes. Before the FTDA, dilution was therefore only actionable under state law.<sup>40</sup> A plaintiff could commonly

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recognition of the famous mark”; “[w]hether the user of the mark or trade name intended to create an association with the famous mark”; “[a]ny actual association between the mark or trade name and the famous mark[.]”

<sup>37</sup> *See id.* § 1125(c)(2)(C).

<sup>38</sup> DINWOODIE & JANIS, *supra* note 10, at 15.

<sup>39</sup> *Id.*

<sup>40</sup> Eric A. Prager, Essay, *The Federal Trademark Dilution Act of 1995: Substantial Likelihood of Confusion*, 7 FORDHAM INTELL. PROP. MEDIA & ENT. L.J. 121, 123 (1996).

carve out a cause of action for dilution under the state statutes by demonstrating that its mark was “distinctive” and that the defendant’s mark was likely to dilute the plaintiff’s mark.<sup>41</sup> Nevertheless, states implemented their respective dilution statutes differently, resulting in a fragmented doctrine that called for federal reform.<sup>42</sup> Subsection A describes Schechter’s introduction to dilution, while Subsection B presents examples of alternative applications of the state dilution statutes.

#### A. *Schechter*

Dilution likely originated as a distinct basis for trademark protection in the German Courts.<sup>43</sup> However, Frank Schechter’s famed law review article *The Rational Basis of Trademark Protection* and congressional testimony introduced dilution theory to American courts in the 1920s and 1930s.<sup>44</sup> Schechter contended that a cause of action based solely on substantial similarity between marks and likelihood of consumer confusion was inadequate to accommodate the modern, twentieth-century markets.<sup>45</sup> Rather, Schechter advocated that “the preservation of the uniqueness of a trademark . . . constitute[d] the only rational basis for its protection.”<sup>46</sup>

Schechter maintained that a mark’s advertising appeal and selling power originated from its uniqueness.<sup>47</sup> Under Schechter’s theory, a defendant’s use of a mark’s unique characteristics equated to appropriating that mark’s advertising appeal and selling power.<sup>48</sup> The markholder embedded the mark’s benefits in the unique characteristics and its association with the goods; nevertheless, the junior user’s unauthorized use created a new, additional association, thus lessening the uniqueness of the mark.<sup>49</sup>

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<sup>41</sup> *Id.*

<sup>42</sup> See William G. Barber, *The Trademark Dilution Revision Act of 2005: Breathing Life Back into the Federal Dilution Statute*, 16 FORDHAM INTELL. PROP. MEDIA & ENT. L.J. 1113, 1113–15 (2006).

<sup>43</sup> MCCARTHY, *supra* note 5, § 24:67 n.1; William Joern, *Goodwill Harboring: The Trademark Dilution Revision Act of 2006 Legitimizes the Goodwill Investment in a Trademark While Safeguarding the First Amendment*, 17 DEPAUL-LCA J. ART & ENT. L. & POL’Y 267, 268 (2007).

<sup>44</sup> Joern, *supra* note 43, at 269; Frank Schechter, *The Rational Basis of Trademark Protection*, 40 HARV. L. REV. 813 (1927).

<sup>45</sup> Joern, *supra* note 43, at 269.

<sup>46</sup> Schechter, *supra* note 44, at 831.

<sup>47</sup> *Id.* at 822.

<sup>48</sup> See *id.* at 827–30.

<sup>49</sup> *Id.* at 825, 831.

In support of his thesis, Schechter looked to the “real injury” that occurs with the simultaneous use of famous marks.<sup>50</sup> The real injury did not come in the form of consumer confusion as in traditional trademark infringement; rather the injury was a “gradual whittling away or dispersion of the identity and hold upon the public mind of the mark or name by its use upon noncompeting goods.”<sup>51</sup> Therefore, dilution as a theory really began as dilution by blurring, only later evolving into the dual protection it is today.<sup>52</sup>

No jurisdiction ever adopted Schechter’s novel dilution proposal outright. The proposal, however, acted as the basis for what is now dilution by expanding trademark protection beyond simple likelihood of confusion. Schechter’s proposed protection, though, was premised on a mark’s uniqueness and the gradual whittling away of that uniqueness rather than on a mark’s fame and the whittling away of that fame and recognizability.<sup>53</sup> While modern dilution protection does not include uniqueness as a requirement for dilution, in a way, current trademark law does espouse Schechter’s unique mark hypothesis because it offers protection to famous marks, which likely found fame because of their uniqueness. Schechter combined confusion-based protection and a version of dilution to essentially create absolute protection against unauthorized trademark copying, also known as trademark property rights in gross in unique marks.<sup>54</sup> The birth of dilution law significantly impacts burnishment because it demonstrates the need for extending trademark protection to famous marks. Burnishment would simply further this need by extending trademark protection to those marks that technically qualify for dilution protection.

#### B. State Statutes

Following Schechter’s introduction of dilution theory, Massachusetts was the first state to adopt an anti-dilution statute, only one year after the Lanham Act went into effect.<sup>55</sup> Other states followed suit, and by 1996 when the FTDA went into effect 28 states had enacted anti-dilution statutes similar to that of Massachusetts.<sup>56</sup> Further, the United States

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<sup>50</sup> *Id.* at 825.

<sup>51</sup> *Id.*

<sup>52</sup> *See supra* Part I (discussing blurring).

<sup>53</sup> Schechter, *supra* note 44, at 825.

<sup>54</sup> *Id.*

<sup>55</sup> MASS. GEN. LAWS ch. 0307 (1947).

<sup>56</sup> Miles J. Alexander & Michael K. Heilbronner, *Dilution Under Section 43(c) of the Lanham Act*, 59 L. & CONTEMP. PROBS. 93, 99 & n.35 (1996) (listing anti-dilution statutes enacted before 1996); Elliot B. Staffin, *The Dilution Doctrine: Towards a Reconciliation with the Lanham Act*, 6 FORDHAM INTELL. PROP., MEDIA & ENT. L.J. 105, 116 n.46 (1995) (same).

Trademark Association included an anti-dilution section to its Model State Trademark Act.<sup>57</sup> Many states modeled their anti-dilution statutes after either Massachusetts' trendsetting statute or the Model State Trademark Act. Now, all of the state anti-dilution acts provide for a cause of action against a junior user notwithstanding consumer confusion; however, courts have been hesitant to apply the plain meaning of the language requiring instead some showing of consumer confusion.<sup>58</sup>

Courts realized that the state anti-dilution statutes allowed a property right in gross for trademark owners. Trademark holders could thus prevent subsequent use of the same or similar marks, essentially amounting to full ownership of a mark. However, this outlook was contrary to the consumer protection model of trademarks in existence before anti-dilution law emerged.<sup>59</sup> Therefore, most courts were reluctant to find a likelihood of dilution in the absence of a likelihood of confusion.<sup>60</sup> Tracking the evolution of state tarnishment law demonstrates how courts initially extended the dilution protection only to wholesome marks, thus initiating the doctrinal void that would exclude unwholesome marks.

Before the enactment of the FTDA, courts could only rely on state anti-dilution statutes to protect against dilution by tarnishment, and various courts applying state law analyzed the doctrine differently. The primary difference in application between courts was whether to require a showing of likelihood of confusion before allowing dilution protection. Many courts, whether state or federal applying state anti-dilution law, required a finding of likelihood of confusion before considering dilution. In *Polaroid Corp. v. Polaroid, Inc.*, the Seventh Circuit applying Illinois state law found a likelihood of confusion between the marks in dispute before enjoining use of the POLAROID mark.<sup>61</sup> Likewise, in *Tiffany & Co. v. Boston Club, Inc.*, the Defendant used the mark TIFFANY'S for the name of a restaurant and lounge.<sup>62</sup> The plaintiff,

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<sup>57</sup> Model State Trademark Bill 12 (U.S. Trademark Association 1964), reprinted in MCCARTHY, *supra* note 5 § 24:78 ("Likelihood of injury to business reputation or of dilution of the distinctive quality of a mark registered under this Act, or a mark valid at common law, or a trade name valid at common law, shall be a ground for injunctive relief notwithstanding the absence of competition between the parties or the absence of confusion as to the source of goods or services.").

<sup>58</sup> See, e.g., *Holiday Inns, Inc. v. Holiday Out in Am.*, 481 F.2d 445, 447 (5th Cir. 1973); *Polaroid Corp. v. Polaroid, Inc.*, 319 F.2d 830, 837 (7th Cir. 1963); *Haviland & Co. v. Johann Haviland China Corp.*, 269 F. Supp. 928, 956-57 (S.D.N.Y. 1967); *Tiffany & Co. v. Bos. Club, Inc.*, 231 F. Supp. 836, 842 (D.C. Mass. 1964).

<sup>59</sup> James Robert Hughes, *The Federal Trademark Dilution Act of 1995 and the Evolution of the Dilution Doctrine—Is It Truly a Rational Basis for the Protection of Trademarks?*, 1998 DET. C.L. MICH. ST. U. L. REV. 759, 764 (1998).

<sup>60</sup> *Id.*

<sup>61</sup> 319 F.2d at 837.

<sup>62</sup> 231 F. Supp. at 838.

Tiffany & Co., argued that the defendant's use of the famous mark warranted an injunction under the anti-dilution provision of the Massachusetts unfair competition statute.<sup>63</sup> The district court first found a likelihood of confusion between the two marks before considering the injunction.<sup>64</sup> Additionally, the court reasoned that use of the mark in reference to a restaurant and lounge could be distracting, and that risk alone could erode consumers' association between the mark and the plaintiff, "thus diminishing its distinctiveness, uniqueness, effectiveness and prestigious connotations."<sup>65</sup> *Tiffany's* provides an example of a state court refusing to find dilution without confusion.

Following suit, other courts refused to grant relief under state law for trademark dilution without a demonstration of likelihood of confusion. In *Haviland & Co. v. Johann Haviland China Corp.*, the court confirmed that some showing of likelihood of confusion was necessary to grant relief for dilution under the New York anti-dilution statute.<sup>66</sup> Similarly, the Seventh Circuit again refused to grant relief for dilution in the absence of likelihood of confusion, or at least substantial similarity between the marks at issue.<sup>67</sup> Last, in *Holiday Inns, Inc. v. Holiday Out in America*, the Fifth Circuit refused to grant relief under Florida's anti-dilution statute because the marks lacked confusion.<sup>68</sup>

In contrast, some courts attempted to separate the confusion and dilution analyses. In *Esquire, Inc. v. Esquire Slipper Manufacturing Co.*, the First Circuit found that the Massachusetts anti-dilution statute simply extended the consumer protection model to noncompeting goods rather than requiring a separate finding of likelihood of confusion before dilution.<sup>69</sup> Those courts that purported to adhere to the plain language of dilution statutes by eschewing confusion analyses nevertheless allowed the topic to seep into their dilution assessments. For example, in *Mead Data Central, Inc. v. Toyota Motor Sales, U.S.A., Inc.*, under New York's anti-dilution statute the Second Circuit differentiated between a finding of likelihood of confusion and a finding that the marks were substantially similar.<sup>70</sup> The court determined that a likelihood of confusion was not necessary, but the marks needed to be substantially similar in order to maintain a viable claim of dilution.<sup>71</sup> However, the court concluded that the marks were not substantially similar partly because likelihood of consumer confusion between the differing pronunciations of the marks

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<sup>63</sup> *Id.*

<sup>64</sup> *Id.* at 842.

<sup>65</sup> *Id.* at 844.

<sup>66</sup> 269 F. Supp. 928, 956–57 (S.D.N.Y. 1967).

<sup>67</sup> *Alberto-Culver Co. v. Andrea Dumon, Inc.*, 466 F.2d 705, 709 (7th Cir. 1972).

<sup>68</sup> 481 F.2d 445, 450 (5th Cir. 1973).

<sup>69</sup> *See* 243 F.2d 540, 544 (1st Cir. 1957); Hughes, *supra* note 59, at 764.

<sup>70</sup> *See* 875 F.2d 1026, 1029 (2d Cir. 1989).

<sup>71</sup> *Id.*

appeared so low.<sup>72</sup> Thus, even when courts attempted to differentiate between confusion and dilution application, many courts would spiral into circular reasoning that nonetheless muddled the two analyses.

Finally, state anti-dilution interpretation shifted to address the problematic analysis that took place within state anti-dilution law. *Allied Maintenance Corp. v. Allied Mechanical Trades, Inc.* marked these changing times.<sup>73</sup> Previously, either courts incorrectly required a likelihood of confusion before considering dilution, or courts attempted to consider dilution independent of confusion yet ultimately allowed confusion to taint the analysis. *Allied Maintenance* finally called into question the imprecise interpretation, causing courts to attempt to differentiate between consumer confusion and compromising a famous mark's reputation, which is the crux of the tarnishment harm. In *Allied Maintenance*, the New York Court of Appeals acknowledged that in the past state courts had failed "to follow the literal language of the dilution statutes, and have read into these statutes 'a requirement of some showing of confusion, fraud, or deception.'"<sup>74</sup> Although this portion of the court's opinion was merely dicta, the admission inspired other courts to follow the explanation.<sup>75</sup>

In contrast to the cases above that appeared to involve a consideration of consumer confusion before granting relief for dilution, some courts granted extended trademark protection in the form of dilution claims without involving confusion. For example, in *Dawn v. Sterling Drug, Inc.* the plaintiff Dawn had registered the mark TOWER OF BABBLE for educational games, but had only sold approximately 4,000 units in eight years.<sup>76</sup> Dawn brought suit against the maker of Bayer Aspirin for using the phrase "Tower of Babble" in its national advertisement campaign; the suit alleged trademark dilution under the California anti-dilution and trademark infringement statute.<sup>77</sup> The court denied the plaintiff's infringement claim based on lack of confusion, but nevertheless granted an injunction against the defendant for use of the "Tower of Babble" phrase in any subsequent promotional activity.<sup>78</sup> In granting the injunction, the court quoted that the state anti-dilution statute granted this "relief notwithstanding the absence of competition between the parties or the absence of confusion as to the source of goods or services."<sup>79</sup> However, the court's opinion overlooked a requirement of

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<sup>72</sup> *Id.* at 1029–30.

<sup>73</sup> 369 N.E.2d 1162 (N.Y. 1977).

<sup>74</sup> Hughes, *supra* note 59, at 766 (quoting *Allied Maintenance*, 369 N.E.2d at 1165).

<sup>75</sup> *Id.*

<sup>76</sup> 319 F. Supp. 358, 360 (C.D. Cal. 1970).

<sup>77</sup> *Id.* at 360, 363.

<sup>78</sup> *Id.* at 362–63.

<sup>79</sup> *Id.* at 363 (quoting CAL. BUS. & PROF. CODE § 14330 (West 1967)).

likelihood of dilution altogether. Even after the court recognized the plaintiff's failure to present evidence of reduction of business attributable to the defendant, the court granted a property right to Dawn in the TOWER OF BABBLE mark.<sup>80</sup> In this instance, the only necessary element for a property right in gross seemed to be the existence of the mark because in *Dawn* there was neither consumer confusion nor a sufficient showing of dilution attributable to the defendant. Few other courts have granted a property right in gross to trademark owners. Instead, courts may restrict the effects of state anti-dilution statutes by concentrating on alternative elements of the mark and use such as distinctiveness and the specific harms.<sup>81</sup> The spectrum of state court anti-dilution law before 1995 spanned property rights in gross to the requirement of consumer confusion before granting dilution relief.

Alternatively, a New York district court applied, and the Second Circuit upheld, an unconventional approach to dilution by tarnishment under New York's anti-dilution law in *Deere & Co. v. MTD Prods., Inc.*<sup>82</sup> Plaintiff John Deere, a well-known agricultural equipment manufacturer, asserted dilution by tarnishment against Defendant MTD, a lesser-known manufacturer of lawn mowers and tractors.<sup>83</sup> MTD created a commercial with the intention to portray MTD's "Yard-Man" tractor's functionality as comparable to Deere's, but for a lower price.<sup>84</sup> The commercial included an animated version of Deere's "leaping deer" trademark running away from the MTD lawn tractor.<sup>85</sup> Deere sued MTD for, among other things, dilution by tarnishment.<sup>86</sup> The district court found in favor of Deere on the dilution claim and issued an injunction.<sup>87</sup> The Second Circuit affirmed, reasoning that advertisers poking fun at well-known marks to attract attention to their product or advertisements violated the tarnishment statute.<sup>88</sup> The court concluded that the behavior poses a risk because consumers may "come to attribute unfavorable characteristics to a mark and ultimately associate the mark with inferior goods and services."<sup>89</sup> Although the court recognized the importance of allowing the use of competitive marks in advertising, it found the risk of eroding the mark's favorable image too high, concluding that "[w]herever New York will ultimately draw the line, we can be reasonably confident that the

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<sup>80</sup> *Id.*

<sup>81</sup> Hughes, *supra* note 59, at 767.

<sup>82</sup> 41 F.3d 39 (2d Cir. 1994), *aff'd* 860 F. Supp. 113 (S.D.N.Y. 1994).

<sup>83</sup> *Id.* at 41.

<sup>84</sup> *Id.*

<sup>85</sup> *Id.* at 40–41.

<sup>86</sup> *Id.* at 42.

<sup>87</sup> *Id.* at 40, 42.

<sup>88</sup> *Id.* at 44.

<sup>89</sup> *Id.* at 45.

MTD commercial . . . crosses it.”<sup>90</sup> The court’s inarticulate conclusion rendered it difficult for other potential mark-users to rely on the determination and identify the “line” drawn by the court. Instead, it seemed that the Second Circuit confusingly created a novel breed of dilution harm that only existed when a defendant humorously altered a plaintiff’s mark.<sup>91</sup>

Possibly sensing the residual bewilderment, the Second Circuit sought to clarify its *Deere* decision in *Hormel Foods Corp. v. Jim Henson Prods., Inc.*<sup>92</sup> Plaintiff Hormel claimed that a character called Spa’am in the yet-to-be-released film *Muppet Treasure Island* diluted its SPAM mark.<sup>93</sup> Both the district court and court of appeals denied relief to Hormel on its dilution claim.<sup>94</sup> Immediately, the court clarified that it had not unilaterally created a novel category of dilution; instead the court explained that *Deere* exemplified a broad view of tarnishment, in opposition of the conventionally “narrowly confined” doctrine.<sup>95</sup> Thus, the *Hormel* decision limited the overexpansion of the dilution doctrine in *Deere*, while concurrently broadening the dilution by tarnishment doctrine beyond its previously delineated bounds.

Those courts that applied state anti-dilution statutes differently, and correctly, resulted in a fractured legal doctrine that lacked predictability for parties. The central trope in relation to tarnishment throughout these nascent dilution cases is the type of plaintiff bringing suit. Dilution plaintiffs around the origin of the dilution doctrine were largely wholesome, thereby creating a foundation for future mark discrimination against unwholesome marks that qualify for dilution.

### III. FEDERAL DILUTION STATUTES AFTER 1995

Famous markowners continued to rely on state statutes for dilution claims for the majority of the twentieth century. Finally, in 1996 Congress enacted the FTDA.<sup>96</sup> However, lack of clarity in the FTDA led to a circuit split, causing the Court to use the groundbreaking *Moseley v. V Secret Catalogue, Inc.* case to interpret the proper standard of likelihood

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<sup>90</sup> *Id.*

<sup>91</sup> Hughes, *supra* note 59, at 781.

<sup>92</sup> 73 F.3d 497, 507 (2d Cir. 1996).

<sup>93</sup> *Id.* at 500–01.

<sup>94</sup> *Id.* at 500.

<sup>95</sup> *Id.* at 507.

<sup>96</sup> Federal Trademark Dilution Act of 1995, Pub. L. No. 104-98, 109 Stat. 985.

required by the FTDA.<sup>97</sup> Ultimately, Congress superseded the Court's interpretation in the passage of the FTDA's successor, the TDRA.<sup>98</sup>

#### A. FTDA

The FTDA amended the Lanham Act and was the principal federal statute on point for trademark dilution claims until Congress enacted its successor.<sup>99</sup> Echoing Schechter's dilution approach, which focused on a mark's loss of uniqueness, the FTDA focused on "the lessening of the capacity of a famous mark to identify and distinguish goods" or the famous mark's loss of distinctiveness.<sup>100</sup> Congress initially passed the FTDA in an effort to bring uniformity to dilution theory and as a response to inconsistency among state anti-dilution laws; the result was a federal cause of action against the dilution of famous marks.<sup>101</sup> However, the FTDA did not preempt state law; instead, it articulated a definition of dilution, thus acting as a national exemplar for establishing dilution protection.<sup>102</sup> To succeed on a dilution by tarnishment claim under the FTDA, the claimant was required to show:

- (1) the senior mark must be famous; (2) it must be distinctive; (3) the junior use must be a commercial use in commerce; (4) it must begin after the senior mark has become famous; and (5) it must cause dilution of the distinctive quality of the senior mark.<sup>103</sup>

Closely following the enactment of the FTDA, a Virginia district court applied and the Fourth Circuit upheld a classic FTDA tarnishment analysis. In *Ringling Bros.-Barnum & Bailey Combined Shows, Inc. v. Utah Division of Travel Development*, Ringling Bros. alleged dilution by tarnishment against a state agency defendant, arguing that the defendant's mark, THE GREATEST SNOW ON EARTH, tarnished

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<sup>97</sup> 537 U.S. 418 (2003).

<sup>98</sup> Greg Horn & Matthew Malm, *Sex Changes Everything, but the Trademark Dilution Revision Act Shouldn't*: V Secret Catalogue, Inc. v. Moseley and the Burden of Proof in Trademark Dilution Actions, 79 U. CIN. L. REV. 1583, 1587 (2011).

<sup>99</sup> Trademark Dilution Revision Act of 2006, Pub. L. No. 109-312, 120 Stat. 1730 (codified as amended in scattered sections of 15 U.S.C.).

<sup>100</sup> Federal Trademark Dilution Act of 1995, § 4, 109 Stat. at 986; *see also* Anne E. Kennedy, Note, *From Delusion to Dilution: Proposals to Improve Problematic Aspects of the Federal Trademark Dilution Act*, 9 N.Y.U. J. LEGIS. & PUB. POL'Y 399, 407-10 (2006).

<sup>101</sup> 141 CONG. REC. H36189 (daily ed. Dec. 12, 1995) (statement of Rep. Moorehead) ("A Federal trademark dilution statute is necessary, because famous marks ordinarily are used on a nationwide basis and dilution protection is only available on a patch-quilt system of protection.").

<sup>102</sup> Kennedy, *supra* note 100, at 406.

<sup>103</sup> *Nabisco, Inc. v. PF Brands, Inc.*, 191 F.3d 208, 215 (2d Cir. 1999) (quoting Lanham Act § 43).

plaintiff's mark, THE GREATEST SHOW ON EARTH.<sup>104</sup> However, the court found no dilution by tarnishment because the Plaintiff did not even contend that the Defendant's mark created a risk of negative associations with the Ringling Circus.<sup>105</sup>

The Second Circuit, in *Nabisco, Inc. v. PF Brands, Inc.*, diverged from the Fourth Circuit's analytical tactic in requiring only a mere likelihood of dilution rather than a showing of actual dilution.<sup>106</sup> Pepperidge Farm is the maker of the famed Goldfish cracker.<sup>107</sup> Nabisco, another cracker company, entered a joint promotion with Nickelodeon for its cartoon "CatDog" featuring a conjoined cat and dog.<sup>108</sup> The promotional CatDog cracker closely resembled the goldfish cracker.<sup>109</sup> Nabisco sought declaratory judgment against Pepperidge Farm that the CatDog product did not violate any of Pepperidge Farm's rights in the Goldfish.<sup>110</sup> Pepperidge Farm counterclaimed that Nabisco's product, among other things, diluted its trademark under the Lanham Act and New York dilution law.<sup>111</sup> "The district court found for Pepperidge [Farm] and granted the preliminary injunction on the federal and state dilution claims."<sup>112</sup> The district court also concluded that the "likelihood of dilution 'automatically' establish[es] irreparable harm."<sup>113</sup> Nabisco appealed and in doing so argued that dilution "cannot be found without . . . actual injury."<sup>114</sup> The court rejected this argument.<sup>115</sup> The court reasoned that it would be too difficult and speculative for a senior markholder to show that its loss was due to the dilution of the mark.<sup>116</sup> Further, contextual evidence had been used to establish infringement, thus these circumstantial factors should effectively transfer to establish dilution.<sup>117</sup> Finally, the court determined that reading a requirement of actual dilution would "defeat the intent of the statute."<sup>118</sup> The statute is written in present tense ("causes dilution") so "it seems

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<sup>104</sup> 955 F. Supp. 605, 608–09 (E.D. Va. 1997), *aff'd*, 170 F.3d 449, 451 (4th Cir. 1999).

<sup>105</sup> *Id.* at 614.

<sup>106</sup> *Nabisco*, 191 F.3d at 220.

<sup>107</sup> *Id.* at 212.

<sup>108</sup> *Id.* at 213.

<sup>109</sup> *Id.*

<sup>110</sup> *Id.*

<sup>111</sup> *Id.*

<sup>112</sup> *Id.*

<sup>113</sup> *Id.* at 214 (quoting *Nabisco, Inc. v. PF Brands, Inc.*, 50 F. Supp. 2d 188, 210 (S.D.N.Y. 1999) (internal citation omitted)).

<sup>114</sup> *Id.*

<sup>115</sup> *Id.* at 223.

<sup>116</sup> *Id.* at 224.

<sup>117</sup> *Id.*

<sup>118</sup> *Id.*

plausibly within Congress's meaning to understand the statute as intending to provide for an injunction to prevent the harm before it occurs."<sup>119</sup> Nabisco advanced the circuit split between the Second and Fourth Circuits, calling attention to the faults within the FTDA's wording.

*World Wrestling Federation Entertainment, Inc. v. Big Dog Holdings* illustrates the Second Circuit's tarnishment application under the FTDA.<sup>120</sup> World Wrestling Federation Entertainment ("WWE") promotes wrestling entertainers THE ROCK, STONE COLD STEVE AUSTIN, and the UNDERTAKER; these names also serve as WWE's protected marks. Integral to Steve Austin's character are the phrases "Open up a Can of Whoop Ass!"; "Austin 3:16"; "rattlesnake"; and "Cause Stone Cold Said So."<sup>121</sup> Big Dog Holdings ("Big Dog") "develops, markets, and retails a branded lifestyle collection of unique, consumer products including active wear, casual sportswear, accessories and gifts."<sup>122</sup> Big Dog manufactured products with a graphic depicting a dog caricature of wrestling character "Bone Cold Steve Pawstin" along with the phrase "Open up a Can of Woof Ass!"<sup>123</sup> The dog was dressed in jeans and a t-shirt that said "Pawstin 3:16" with rattlesnakes under it along with the phrase "Because Bone Cold Said So." Big Dog also released merchandise depicting a dog wrestler character called "The Underdogger," and another called "The Rock-weiler," using phrases similarly parodying WWE wrestlers The Undertaker and The Rock.<sup>124</sup> WWE claimed that Big Dog's association and use tarnished the wrestling marks.<sup>125</sup> Big Dog moved for summary judgment; to survive the motion, the court required WWE to show a likelihood of tarnishment.<sup>126</sup> The Pennsylvania District Court determined there was no genuine issue of material fact as to whether Big Dog had tarnished WWE's mark.<sup>127</sup> WWE asserted that Big Dog's use tarnished its marks by using them in ways "wholly inconsistent" with WWE's image.<sup>128</sup> Unconvinced by WWE's argument, the court reasoned that "[a] mark is tarnished, therefore, when it is improperly associated with an *inferior* or *offensive* product or service as a result of the junior user's mark, 'presenting a danger that consumers will form unfavorable associations with the mark.'"<sup>129</sup> According to the court, Big Dog's

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<sup>119</sup> *Id.*

<sup>120</sup> 280 F. Supp. 2d 413 (W.D. Pa. 2003).

<sup>121</sup> *Id.* at 418–19.

<sup>122</sup> *Id.* at 418.

<sup>123</sup> *Id.* at 420.

<sup>124</sup> *Id.* at 421–22.

<sup>125</sup> *Id.* at 417.

<sup>126</sup> *Id.* at 442–43.

<sup>127</sup> *Id.* at 445.

<sup>128</sup> *Id.* at 442.

<sup>129</sup> *Id.* (quoting *Strick Corp. v. Strickland*, 162 F. Supp. 2d 372, 378 n.10 (E.D. Pa. 2001)).

merchandise was neither inferior nor offensive, thus avoiding a likelihood of tarnishment.<sup>130</sup> *World Wrestling Federation Entertainment* offers an example of a district court perpetuating the Second Circuit's likelihood of tarnishment standard, as opposed to the Fourth Circuit's tarnishment standard that requires a showing of actual tarnishment.

Closely following implementation of the FTDA, a New York District Court executed a standard dilution by tarnishment analysis under both the FTDA and New York Dilution Law with little struggle in *Clinique Labs, Inc. v. Dep Corp.*<sup>131</sup> Clinique, a high-end makeup and skincare manufacturer, sought to enjoin Dep from selling a low-end skincare line, "Basique."<sup>132</sup> Clinique argued that its trademark would be tarnished by Dep's "cheap knock-offs of the CLINIQUE line of products."<sup>133</sup> The court determined that Clinique did not prevail on its argument because of the limited scope of tarnishment claims.<sup>134</sup> Dep's products did not associate Clinique with obscenity or sexual or illegal activity, and the Basique line of products was neither shoddy nor unwholesome.<sup>135</sup> Further, Clinique presented no evidence that its mark would suffer negative associations because of Dep's use of the Basique mark.<sup>136</sup> *Clinique Laboratories* presents a classic tarnishment analysis and serves as an illustration of the narrow tarnishment application that caused a rift in the case law and a need for the burnishment claim.

Finally, *Eli Lilly & Co. v. Natural Answers* portrays the common struggle courts experienced post-FTDA.<sup>137</sup> At issue in *Eli Lilly* was whether plaintiff Eli Lilly should be required to show that defendant Natural Answer's use created a mere likelihood of dilution or whether proof of actual dilution was necessary.<sup>138</sup> The pharmaceutical giant Eli Lilly manufactured Prozac, a popular drug used to treat clinical depression.<sup>139</sup> Subsequently, the defendant developed, marketed, and sold a natural drug alternative mood enhancer labeled "HERBROZAC."<sup>140</sup> Plaintiff sued to enjoin Defendant's use of the name based on an FTDA dilution by tarnishment claim.<sup>141</sup> The district court enjoined the Defendant, who then appealed.<sup>142</sup> On appeal, the Seventh Circuit affirmed the district

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<sup>130</sup> *Id.* at 442–43.

<sup>131</sup> 945 F. Supp. 547, 562 (S.D.N.Y. 1996).

<sup>132</sup> *Id.* at 549.

<sup>133</sup> *Id.* at 562.

<sup>134</sup> *Id.*

<sup>135</sup> *Id.*

<sup>136</sup> *Id.*

<sup>137</sup> 233 F.3d 456 (7th Cir. 2000).

<sup>138</sup> *Id.* at 467–68.

<sup>139</sup> *Id.* at 459.

<sup>140</sup> *Id.*

<sup>141</sup> *Id.* at 460.

<sup>142</sup> *Id.* at 461.

court's holding and found that *Eli Lilly* showed a likelihood of success in proving a likelihood of dilution.<sup>143</sup> The Seventh Circuit struggled with applying the FTDA. To solve the central issue, the court first looked to legislative history, which did "not specifically address [the] question"<sup>144</sup> Rather, in light of the circuit split on the issue, the court would "take [its] own stab at decid[ing] what 'causes dilution' means."<sup>145</sup> In taking its own stab, the court compared the Fourth and Second Circuits' analytical approaches to the FTDA and decided whether to propagate the likelihood of dilution or actual dilution standard.<sup>146</sup> Ultimately, the Seventh Circuit sided with the Second Circuit in that the proper standard was showing a likelihood of tarnishment.<sup>147</sup> The determinative point of reasoning for the *Eli Lilly* court in following the Second Circuit was that the Fourth Circuit's requirement of actual dilution held plaintiffs to "an impossible level of proof."<sup>148</sup> Further, the Court observed that "the Fourth Circuit's reading of the statute would subject senior mark holders to uncompensable injury."<sup>149</sup> The primary remedy for tarnishment is an injunction against future harmful use. Therefore, if the standard for the "causes dilution" element was proof of actual dilution, the law would prevent senior markholders from bringing suit before suffering an injury.<sup>150</sup> To avoid this legal Catch-22, the Seventh Circuit reiterated the Second Circuit's holding that the logical "causes dilution" standard was likelihood of dilution.<sup>151</sup> *Eli Lilly* embodies the confusion within courts following implementation of the FTDA. The statute's subtle distinctions were difficult to apply, and legislative history and *stare decisis* were of no direction, thus forcing courts into frustratingly individualized analyses.

For 50 years before the FTDA's enactment, courts solely relied upon state anti-dilution law. So, courts' struggle with applying the nuances of the new FTDA was only amplified by the subtle yet significant differences between dilution and infringement. Moreover, the confusion in the courts around likelihood of confusion versus dilution claims perpetuated judicial resistance to implement the federal dilution doctrine at all.<sup>152</sup> Congress's aim in creating the FTDA was to provide a uniform, national standard for protection against trademark dilution.<sup>153</sup> But confusion,

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<sup>143</sup> *Id.* at 465.

<sup>144</sup> *Id.* at 467.

<sup>145</sup> *Id.*

<sup>146</sup> *Id.* at 467–68.

<sup>147</sup> *Id.*

<sup>148</sup> *Id.* at 468.

<sup>149</sup> *Id.* at 467.

<sup>150</sup> *Id.*

<sup>151</sup> *Id.* at 468.

<sup>152</sup> See Kennedy, *supra* note 100, at 400–10.

<sup>153</sup> *Id.* at 400–02, 406.

primarily surrounding the proper standard for dilution law, ensued when courts applied the federal law.<sup>154</sup>

B. *Moseley v. V Secret Catalogue, Inc.*

Finally, judicial confusion surrounding implementation of the FTDA reached a pinnacle when the Supreme Court's 2003 decision in *Moseley v. V Secret Catalogue, Inc.* raised the standard for key parts of the statute.<sup>155</sup> In *Moseley*, the Moseleys opened an adult novelty shop called "Victor's Secret."<sup>156</sup> Victoria's Secret, a well-known national lingerie retailer, sent a cease-and-desist letter and in response the Moseleys changed the name to "Victor's Little Secret."<sup>157</sup> Unhappy with the alteration, Victoria's Secret sued the Moseleys alleging multiple claims including trademark dilution.<sup>158</sup> The federal district court found in favor of Victoria's Secret, reasoning that the Moseleys tarnished the reputation of Victoria's Secret's famous mark, thus violating the FTDA.<sup>159</sup> The federal appellate court affirmed the lower court's decision, finding that the Moseleys had tarnished *and* blurred the famous Victoria's Secret mark.<sup>160</sup>

The Supreme Court granted certiorari partially to reconcile an ongoing circuit split over the appropriate standard of proof in trademark dilution cases.<sup>161</sup> The Fourth and Fifth Circuits maintained that the proper standard of proof for dilution cases was actual dilution as articulated in the FTDA.<sup>162</sup> Contrastingly, the Second Circuit asserted that a showing of actual dilution was unnecessary; instead, plaintiffs could demonstrate only a likelihood of dilution to meet the standard for a dilution claim.<sup>163</sup> However, the Court struggled with the fundamental issue of regulating federal protection in the framework of specific evidentiary showing.<sup>164</sup> *Moseley* ultimately raised the bar for a tarnishment action when the Court agreed with the Fourth and Fifth Circuits in finding that the FTDA required a "showing of actual dilution, rather than a likelihood of dilution."<sup>165</sup> The Court opined that actual dilution does

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<sup>154</sup> See *infra* notes 164–165 and accompanying text.

<sup>155</sup> 537 U.S. 418 (2003).

<sup>156</sup> *Id.* at 423.

<sup>157</sup> *Id.*

<sup>158</sup> *Id.* at 423–24.

<sup>159</sup> *Id.* at 425, 432.

<sup>160</sup> *Id.* at 432.

<sup>161</sup> *Id.* at 428.

<sup>162</sup> *Westchester Media v. PRL USA Holdings, Inc.*, 214 F.3d 658, 670–71 (5th Cir. 2000); *Ringling Bros.–Barnum & Bailey Combined Shows Inc. v. Utah Div. of Travel Dev.*, 170 F.3d 449, 458 (4th Cir. 1999).

<sup>163</sup> *Nabisco, Inc. v. PF Brands, Inc.*, 191 F.3d 208, 223–25 (2d Cir. 1999).

<sup>164</sup> *Moseley*, 537 U.S. at 434.

<sup>165</sup> *Id.* at 433; see also Kennedy, *supra* note 100, at 410–12; Manny D. Pokotilow, *Disparagement/Tarnishment After Moseley v. V Secret*, in TRADEMARK DILUTION AFTER

not necessarily require a showing of the effects of dilution, like lost profits or sales, yet it neglected to specify types of evidence necessary to prove actual dilution.<sup>166</sup> The Court found that *Victoria's Secret* failed to show that the Moseleys caused actual dilution to the famous mark.<sup>167</sup> While *Moseley* was not the sole impetus for the change to the burden of proof in the FTDA, it was a major motivation in Congress' passage of the TDRA.

### C. TDRA

The complexity and diversity of questions raised by the Supreme Court in *Moseley* prompted a call for revision of the FTDA.<sup>168</sup> Many trademark professionals advocated for change including the International Trademark Association (INTA), American Intellectual Property Law Association (AIPLA), and the Intellectual Property Owners Association (IPO).<sup>169</sup> In its attempt to reconcile 10 years of judicial confusion caused by the FTDA, which reached a crescendo in the *Moseley* decision, Congress passed the TDRA in 2006.<sup>170</sup> It is important to understand dilution by tarnishment under modern federal law because burnishment derives directly from TDRA law. The development of federal dilution law also illustrates how courts expanded the void in the dilution statute for protection of unwholesome marks.

The TDRA provides:

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 tarnishment of the famous mark, regardless of the presence or absence of actual or likely confusion, of competition, or of actual economic injury.<sup>171</sup>

The TDRA amended the FTDA most notably by reinstating the likelihood of dilution standard of proof for trademark dilution that was prevalent before *Moseley*.<sup>172</sup> Moreover, the TDRA includes an explicit

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*Victoria's Secret*: RECENT DEVELOPMENTS AND CURRENT ISSUES 153, 164 (ALI-ABA Course of Study, Feb. 5–6, 2004).

<sup>166</sup> *Moseley*, 537 U.S. at 433–34.

<sup>167</sup> *Id.*

<sup>168</sup> Kennedy, *supra* note 100, at 412.

<sup>169</sup> *Id.* at 412 n.73; Joern, *supra* note 43, at 280–81.

<sup>170</sup> Trademark Dilution Revision Act of 2006, Pub. L. No. 109-312, 120 Stat. 1730. The TDRA is the tarnishment statute on point and is codified at 15 U.S.C. § 1125(c) (2012). See *supra* note 98 and accompanying text.

<sup>171</sup> *Id.* § 1125(c) (1).

<sup>172</sup> *Id.*

cause of action for dilution by tarnishment defined as an “association arising from the similarity between a mark or a trade name and a famous mark that harms the reputation of the famous mark.”<sup>173</sup> The TDRA also specifies a clear, more concise set of factors for determining whether a mark is famous.<sup>174</sup> Now, “[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.”<sup>175</sup> The final TDRA fame language effectively eliminated niche fame.<sup>176</sup> The TDRA provides injunctive relief as the primary remedy for violation of the dilution statute. Under the principles of equity, a court may issue an injunction against a person who used a mark or trade name in commerce, any time after the mark became famous, in a way that is likely to cause dilution by tarnishment of the famous mark, regardless of the presence of actual confusion.<sup>177</sup>

The current statute on point for tarnishment law, the TDRA, includes certain exclusions from liability for the tarnishment defendant depending on the type of use.<sup>178</sup> These exclusions apply to all forms of dilution because the TDRA incorporates the exclusions in a separate section. The intricacies of current dilution by tarnishment law are, therefore, noteworthy not only because tarnishment acts as the model for burnishment, but also because the TDRA exclusions could apply to burnishment. To state a *prima facie* case of dilution the plaintiff must show the following:

- (1) that the plaintiff owns a famous mark that is distinctive; (2) that the defendant has commenced using a mark in commerce that allegedly is diluting the famous mark; (3) that a similarity between the defendant’s mark and the famous mark gives rise to an association between the marks; and (4) that the association is likely to impair the distinctiveness of the famous mark or likely to harm the reputation of the famous mark.<sup>179</sup>

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<sup>173</sup> *Id.* § 1125(c)(2)(C).

<sup>174</sup> *Id.* § 1125(c)(2)(A) (“In determining whether a mark possesses the requisite degree of recognition, the court may consider all relevant factors, including the following: (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 registered under the Act of March 3, 1881, or the Act of February 20, 1905, or on the principal register.”) The issue of fame is outside the scope of this Comment.

<sup>175</sup> *Id.*

<sup>176</sup> MCCARTHY, *supra* note 6, § 24:105 & n.3.

<sup>177</sup> 15 U.S.C. § 1125(c)(1).

<sup>178</sup> *See infra* Part III.D.

<sup>179</sup> *Louis Vuitton Malletier S.A. v. Haute Diggity Dog, LLC*, 507 F.3d 252, 264–65 (4th Cir. 2007).

In the post-TDRA case *Starbucks v. Wolfe's Borough Coffee*, the Second Circuit yet again took an alternative approach to statutory tarnishment application.<sup>180</sup> At the time of the *Starbucks* case the coffee conglomerate boasted stores in over 8,700 locations worldwide and an internet site that generated over 350,000 hits per week.<sup>181</sup> The defendant, Black Bear, was also a coffee retailer, but was a small family-owned business that manufactured and roasted its own coffee beans and sold related goods over the internet and in a small number of supermarkets.<sup>182</sup> Black Bear began selling a dark roast coffee titled "Charbucks Blend" and "Mister Charbucks."<sup>183</sup> After Starbucks sent a cease-and-desist letter, Black Bear refused to cease selling the dark roast blends—so Starbucks filed a complaint alleging, *inter alia*, trademark dilution.<sup>184</sup> The district court found that there was neither actual dilution nor a likelihood of dilution and ruled in favor of Black Bear.<sup>185</sup> While Starbucks' appeal with the Second Circuit was pending, Congress amended federal trademark dilution law and passed the TDRA.<sup>186</sup> Because of the change in federal trademark statutory law, the Second Circuit vacated the lower court's judgment and remanded for further proceedings.<sup>187</sup> Again, the district court found in favor of Black Bear reasoning that Starbucks failed to establish an entitlement to relief.<sup>188</sup> Once again, Starbucks appealed to the Second Circuit.<sup>189</sup>

On its second appeal, Starbucks argued that the district court erred in concluding that the term "Charbucks" did not damage Starbucks' positive reputation by conjuring both "Starbucks" and negative associations of bitter, burnt, and over-roasted coffee in the minds of consumers.<sup>190</sup> However, the Second Circuit upheld the lower court's decision that Black Bear's use was not tarnishment.<sup>191</sup> In its analysis the court first defined tarnishment under the TDRA: "Dilution by tarnishment is an 'association arising from the similarity between a mark or trade name and a famous mark that harms the reputation of the famous mark.'"<sup>192</sup> The court continued to explain that "[a] trademark

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<sup>180</sup> 588 F.3d 97 (2d Cir. 2009), *aff'g* 559 F. Supp. 2d 472 (S.D.N.Y. 2008).

<sup>181</sup> *Id.* at 102.

<sup>182</sup> *Id.* at 103.

<sup>183</sup> *Id.*

<sup>184</sup> *Id.*

<sup>185</sup> *See id.* at 104.

<sup>186</sup> *Id.*

<sup>187</sup> *Id.* (citing *Starbucks Corp. v. Wolfe's Borough Coffee, Inc.*, 477 F.3d 765, 766 (2d Cir. 2007) (per curiam)).

<sup>188</sup> *Id.* at 105.

<sup>189</sup> *See id.*

<sup>190</sup> *Id.* at 110.

<sup>191</sup> *Id.* at 111.

<sup>192</sup> *Id.* at 110 (citing 15 U.S.C. § 1125(c)(2)(C) (2012)).

may be tarnished when it is linked to products of shoddy quality, or is portrayed in an unwholesome or unsavory context, with the result that the public will associate the lack of quality or lack of prestige in the defendant's goods with the plaintiff's unrelated goods."<sup>193</sup>

Unfortunately for Starbucks, when the court applied the TDRA rules to the facts of the case it found that tarnishment was unlikely. The court's finding was due in large part to Starbucks's unpersuasive evidence that 30.5% of the people surveyed associated "Charbucks" with "Starbucks" and of those people 62% found "Charbucks" to denote a negative characteristic.<sup>194</sup> The Second Circuit explained that these findings were insufficient to establish a likelihood of dilution by tarnishment.<sup>195</sup> The court further clarified that the relevant question was not whether consumers associated "Charbucks" with "Starbucks," but whether the association was likely to actually harm the plaintiff's reputation in the minds of consumers—a question Starbucks failed to ask in its survey.<sup>196</sup> Interestingly, the Second Circuit found that the Charbucks line of coffees could have strengthened the Starbucks brand because they could draw consumers' attention to the missing "Char" in Starbucks, thus rendering Starbucks the tastier of the two coffees.<sup>197</sup> Finally, the Second Circuit justified its decision by comparing the qualities of the goods. Black Bear marketed its Charbucks products as high quality, just as Starbucks claims to, which "is inconsistent with the concept of 'tarnishment.'"<sup>198</sup> The Second Circuit's analysis focused heavily on the likelihood and type of harm by defendant's use. As the prime example of post-TDRA tarnishment cases, *Starbucks* demonstrates that the crux of a TDRA tarnishment analysis should be the harm to the plaintiff. If broadly applying this theory, burnishment adheres to the Second Circuit's analysis guidance because burnishment's central focus is the harm to the unwholesome mark's constant reputation.

#### D. TDRA Exceptions

The TDRA also details certain conduct that does not constitute dilution, and therefore allows certain types of speech and use of marks that courts would otherwise consider violations.<sup>199</sup> The TDRA now reads:

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<sup>193</sup> *Id.* (internal quotation marks omitted) (quoting *Hormel Foods Corp. v. Jim Henson Prods., Inc.*, 73 F.3d 497, 507 (2d Cir. 1996)).

<sup>194</sup> *Id.*

<sup>195</sup> *Id.*

<sup>196</sup> *Id.* at 110–11.

<sup>197</sup> *Id.* at 110–11.

<sup>198</sup> *Id.* at 111 (citing *Hormel*, 73 F.3d at 507).

<sup>199</sup> 15 U.S.C. § 1125(c)(3) (2012).

## (3) Exclusions

The following shall not be actionable as dilution by blurring or dilution by tarnishment under this subsection:

(A) Any fair use, including a nominative or descriptive fair use, or facilitation of such fair use, of a famous mark by another person other than as a designation of source for the person's own goods or services, including use in connection with—

(i) advertising or promotion that permits consumers to compare goods or services; or

(ii) identifying and parodying, criticizing, or commenting upon the famous mark owner or the goods or services of the famous mark owner.

(B) All forms of news reporting and news commentary.

(C) Any noncommercial use of a mark.<sup>200</sup>

If burnishment were included in the TDRA these defenses would also be available to burnishment defendants. The simplest of the TDRA exceptions applies to any type of news reporting. The unauthorized uses of a trademark for news-reporting or commentary purposes are exempt from liability under the TDRA.<sup>201</sup> This exception prevents famous markholders from using injunctions to control important information that the defendant should disseminate to the public. Additionally, the TDRA provides the noncommercial use exception to exclude from liability use of another's famous trademark for noncommercial purposes.<sup>202</sup> Congress preserved this exception from the FTDA, under which courts extensively interpreted, but rarely agreed upon, the meaning of "noncommercial."<sup>203</sup> Courts remained at two analytical extremes: either the unauthorized use of the famous mark should have been entirely noncommercial to receive constitutional protection or the use could be only partially noncommercial and therefore considered fully constitutionally protected speech.<sup>204</sup>

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<sup>200</sup> *Id.*

<sup>201</sup> *Id.* § 1125(c)(3)(B).

<sup>202</sup> *Id.* § 1125(c)(3)(C).

<sup>203</sup> *See, e.g.,* *Mattel, Inc. v. MCA Records, Inc.*, 296 F.3d 894, 904–05 (9th Cir. 2002) (describing noncommercial use as "a use that consists entirely of noncommercial, or fully constitutionally protected, speech"); *Lucasfilm Ltd. v. Media Mkt. Group, Ltd.*, 182 F. Supp. 2d 897, 900–01 (N.D. Cal. 2002) (describing noncommercial use as comprising "parody, satire, editorial and other forms of expression that are not [a] part of a commercial transaction") (quoting 141 CONG. REC. H36189 (daily ed. Dec. 12, 1995) (statement of Rep. Moorehead)).

<sup>204</sup> Byron Crowe II, *[Insert Company Name] Sucks: A Response to Speech, Citizenry and the Market*, 99 MINN. L. REV. HEADNOTES 38, 44–46 (2014).

Finally, and most significant to burnishment, the TDRA provides an exception from liability for fair use.<sup>205</sup> This fair use exclusion might pose the greatest hindrance to burnishment causes of action. The fair use exception of the TDRA simultaneously aims to protect the constitutional right to free speech while extending broad protection to trademark holders through the tarnishment portion of the statute. Famous marks are often targets of parody, an act that occurs when individuals use marks in humorous or entertaining ways. Parody may damage the reputation of the famous markowner all for the objective of mocking the mark or its goods, or for communicating a message to the public. By definition, a successful parody must incorporate elements of the senior mark.<sup>206</sup> Parody requires familiar elements of the famous mark, simply so the ordinary viewer recognizes the association embedded in the parody.<sup>207</sup> The “[p]arody needs to mimic an original to make its point,” but must do so without claiming association with the original mark.<sup>208</sup>

The TDRA fair use exception provides a complete defense from liability for any fair use of a famous mark so long as the purpose of the use was other than source identifying for the user’s goods or services.<sup>209</sup> The TDRA’s expanded fair use exception allows the public to comment on, criticize, and parody famous marks as long as the behavior does not denigrate the mark by taking advantage of the famous markholder’s investment. Causes of action under dilution by tarnishment implicate the fair use exception because often the purpose of a defendant’s use of the famous mark may be to criticize or ridicule the famous mark. This type of practice suggests fair use because it is not for commercial gain and it does not disparage the mark.

Rights between fair use and trademark protection are somewhat mutually exclusive, causing tension between the two. Either a trademark owner may protect his mark and allow his trademark rights to bleed into the realm of language, or the markholder is denied his right to dictate

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<sup>205</sup> 15 U.S.C. § 1125(c)(3)(A).

<sup>206</sup> See *Louis Vuitton Malletier S.A. v. Haute Diggity Dog, LLC*, 507 F.3d 252, 260 (4th Cir. 2007).

<sup>207</sup> *Id.*

<sup>208</sup> *Campbell v. Acuff-Rose Music*, 510 U.S. 569, 580–81 (1994).

<sup>209</sup> “[N]ominative fair use occurs when the alleged infringer uses ‘the [trademark holder’s] mark to describe the [trademark holder’s] product, *even if the [alleged infringer’s] ultimate goal is to describe his own product.*’ Nominative fair use also occurs if the only practical way to refer to something is to use the trademarked term.” *KP Permanent Make-Up, Inc. v. Lasting Impression I, Inc.*, 328 F.3d 1061, 1071–72 (9th Cir. 2003) (quoting *Cairns v. Franklin Mint Co.*, 292 F.3d 1139, 1151 (9th Cir. 2002)), *rev’d. on other grounds*, 543 U.S. 11 (2004). By contrast, “classic” fair use occurs “where the defendant has used the plaintiff’s mark to describe the defendant’s *own* product.” *New Kids on the Block v. News Am. Publ’g, Inc.*, 971 F.2d 302, 308 (9th Cir.1992). Nominative and descriptive fair use are outside the scope of this Comment, which will instead focus on parody.

the use of his mark while others' First Amendment free speech rights protect their unauthorized use of famous marks. "It is important that trademarks not be 'transformed from rights against unfair competition to rights to control language' . . . [because] [s]uch a transformation would diminish our ability to discuss the products or criticize the conduct of companies that may be of widespread public concern and importance."<sup>210</sup> However, evolution of the protection has blurred the boundary between legitimate and unprotected parody as evidenced by the evolution of fair use trademark protection.<sup>211</sup> Overall, the TDRA fair use exception aims to balance the markholder's ability to control parodic use of its mark and protect its goodwill investment with First Amendment free speech protection. Because burnishment would either be integrated via amendment into the TDRA or recognized within the current statutory framework, the TDRA's fair use section, including parody and comparative advertising, would also apply to burnishment defendants.

The noteworthy *Louis Vuitton Malletier S.A. v. Haute Diggity Dog, Inc.* case elucidated the TDRA's fair use parody exception.<sup>212</sup> Plaintiff Louis Vuitton (LVM), a manufacturer of luxury handbags, luggage, and accessories including limited pet products ranging in price from \$250–\$1,600, alleged dilution by tarnishment against the defendant, Haute Diggity Dog, LLC (HDD), a producer of stuffed dog toys based on luxury brand items for around \$10, including the "Chewy Vuiton" dog toy.<sup>213</sup> LVM alleged dilution by tarnishment, among other claims, against HDD and both parties filed for summary judgment.<sup>214</sup> The court found that

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<sup>210</sup> *CPC Int'l, Inc. v. Skippy Inc.*, 214 F.3d 456, 462 (4th Cir. 2000) (quoting Mark A. Lemley, *The Modern Lanham Act and the Death of Common Sense*, 108 YALE L.J. 1687, 1710–11 (1999)).

<sup>211</sup> *Compare* 15 U.S.C. § 1125(c)(4)(A) (1994) (Fair use excludes use "of a famous mark by another person in comparative commercial advertising or promotion to identify the competing goods."), *and* *Moseley v. V Secret Catalogue, Inc.*, 537 U.S. 418, 431 (2003) (The 1995 Act included the exception of "a provision allowing 'fair use' of a registered mark in comparative advertising."), *with* 15 U.S.C. § 1125(c)(3) (2012) (Fair use exclusions include: "(A) Any fair use, including a nominative or descriptive fair use, or facilitation of such fair use, of a famous mark by another person other than as a designation of source for the person's own goods or services, including use in connection with—(i) advertising or promotion that permits consumers to compare goods or services; or (ii) identifying and parodying, criticizing, or commenting upon the famous mark owner or the goods or services of the famous mark owner.").

<sup>212</sup> 507 F.3d 252, 266 (4th Cir. 2007).

<sup>213</sup> *Id.* at 258. Haute Diggity Dog also sells clever plush dog toys such as Arfsolute Vodka, Barkin Bag, Furcedes Car, Grrona Beer Bottle, Jimmy Chew Shoe, and Starbarks Pupkin Spice Latte. *See* HAUTE DIGGITY DOG, <http://www.hautediggitydog.com/collections/view-all-designer-parody-toys> (last visited Feb. 27, 2017).

<sup>214</sup> *Louis Vuitton*, 507 F.3d at 256–58.

LVM failed to demonstrate a claim for tarnishment, so the court granted HDD's summary judgment motion.<sup>215</sup>

The court reasoned that dilution by tarnishment occurs either with association of a high quality mark to a lower quality product or a negative portrayal of a high quality mark.<sup>216</sup> Tarnishment is improbable, however, when the defendant establishes association through harmless puns or parodies.<sup>217</sup> In *Louis Vuitton*, LVM failed to provide sufficient evidence that HDD's inferior and comical products could tarnish LVM's reputation.<sup>218</sup> It was unlikely that HDD's caricature portrayal of LVM's goods surpassed harmless parody. The quality and type of goods were the antithesis of LVM's and consumers would likely never associate HDD's use with LVM's mark, so HDD essentially lacked the necessary association to tarnish LVM's mark. LVM, therefore, could not restrain the parodic use of its mark to preserve its goodwill investment in the mark.<sup>219</sup>

The significance of the TDRA exclusions, some of which Congress preserved from the FTDA, is to prevent a property right in gross to a famous mark owner even in the face of First Amendment protected speech or additional statutorily implemented situations. While some posit that dilution by tarnishment is already too far an extension of trademark protection rights,<sup>220</sup> the TDRA exclusions maintain some limited rights that do not infringe on the commercial success or investment in goodwill of the famous markholder. Thus, the TDRA exclusions effectively even the struggle between trademark and First Amendment rights. The fair use exception would be the chief obstacle for the possibility of burnishment, making it important to understand the underlying policies and former application of the exceptions.

#### IV. BURNISHMENT

Although courts often construe the typically fact-specific doctrine differently, the common theme throughout the above representative FTDA and TDRA cases is the type of plaintiff and mark. Tiffany & Co., John Deere, Hormel, and Starbucks are all famous, wholesome brands: an upscale jeweler, agricultural icon, American foodmaker, and ingenious coffee-brewing conglomerate built upon baristas. The common tarnishment plaintiff coupled with courts' zealous protection of famous marks has tailored dilution into an imbalanced doctrine in need of a claim like burnishment. Subsection A defines burnishment theory

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<sup>215</sup> *Id.* at 268–69.

<sup>216</sup> *Id.* at 264.

<sup>217</sup> *Id.* at 268–69.

<sup>218</sup> *Id.*

<sup>219</sup> *Id.*

<sup>220</sup> *See, e.g.,* Klieger, *supra* note 33, at 865–66.

and outlines a proposal for burnishment statutory language. Subsection B identifies two procedures for effectuating burnishment, concluding that simple recognition by courts of the burnishment claim is the optimal procedure for burnishment implementation.

A. *Burnishment Theory*

Since before the enactment of the FTDA, predominately wholesome markowners have asserted dilution by tarnishment.<sup>221</sup> Because only wholesome markowners like Tiffany & Co., Starbucks, NIKE, etc., assert dilution by tarnishment, the resulting precedent only represents wholesome plaintiffs and establishes a claim that only serves a purpose for wholesome plaintiffs. Classic tarnishment has been further shaped over the years by expanding tarnishment protection beyond simple association with sex, drugs, or nudity. Instead, tarnishment could occur with other negative associations causing a likelihood of harm to the famous markholder's reputation in the minds of consumers. However, the protection does not include a full scope of harm because if it did, dilution by burnishment would also have a presence in the courts. The archetypal plaintiff, compounded with the standard application of tarnishment by courts, resulted in an imbalanced statute lacking a claim for unwholesome famous marks similarly harmed. If adopted, burnishment would bring balance to the TDRA by offering a claim for marks harmed by an improved reputation. Burnishment would protect against unauthorized use of unwholesome marks, like those predicated on sex, violence, nudity, and the like, that results in a likelihood of harm to the constant, unwholesome reputation. Unlike dilution by tarnishment, the harm to the unwholesome reputation would be an improvement because by making the unwholesome brand *more* wholesome the underlying concept of the brand suffers.

For example, consider the famous restaurant chain HOOTERS that boasts scantily clad "Hooters Girls" as waitresses.<sup>222</sup> If a group dedicated to raising awareness about the endangered Blakiston's fish-owl appropriates the HOOTERS name, the association with the positive group could belie the arguably nasty and salacious famous HOOTERS brand. Although the current use and history of tarnishment appears to accommodate only wholesome marks, in theory unwholesome but equally famous marks should have protection equivalent to wholesome marks. This Comment proposes dilution by burnishment as an alternative claim to dilution by tarnishment for unwholesome marks. Essentially, dilution by burnishment is the mirror image of dilution by tarnishment. Thus, dilution by burnishment balances dilution as tarnishment's opposite. All

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<sup>221</sup> See *supra* note 7 (listing cases).

<sup>222</sup> See HOOTERS, <https://www.hooters.com/hooters-girls/> (last visited Feb. 27, 2017).

famous marks have maintained a constant reputation regardless of what the crux of their mark is based upon, and because of this constant reputation consumers can rely on the mark to denote certain features of the product such as level of quality. Tarnishment offers an avenue of relief for markholders to use against defendants who decrease the marks from their constant level.

Burnishment, however, would offer a claim for markowners to use against defendants who increased famous unwholesome marks from their constant levels, a result which could also be detrimental to the brand. Together tarnishment and burnishment create two claims to assert against a defendant whose unauthorized use resulted in altering the constant reputation of a famous mark.<sup>223</sup> Therefore, burnishment would complete the property-right-in-gross theory initially set out by Schechter, but perpetuated throughout dilution history.

The prima facie case of dilution by burnishment would read as follows:

To state a [prima facie] dilution claim . . . [a] plaintiff must show: (1) that the plaintiff owns a famous mark that is distinctive; (2) that the defendant has commenced using a mark in commerce that allegedly is diluting the famous mark; (3) that a similarity between the defendant's mark and the famous mark gives rise to an association between the marks; and (4) that the association is likely to impair the distinctiveness of the famous mark or likely to harm the reputation of the famous mark.<sup>224</sup>

Notice that the prima facie case of burnishment would not differ from the prima facie case of tarnishment. Under burnishment, the famous mark's reputation built upon negative influences like drugs, sex, violence, and nudity would risk harm. Historically, tarnishment has been easily satisfied when the famous mark is associated with sex, drugs, or nudity.<sup>225</sup> However, in burnishment the mark has found fame *because of*

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<sup>223</sup> See *supra* text accompanying note 14 and Appendix A (comparing tarnishment and burnishment).

<sup>224</sup> *Louis Vuitton*, 507 F.3d at 264–65.

<sup>225</sup> This is because tarnishment is satisfied when the unauthorized use of the mark creates a negative association. See, e.g., *Deere & Co. v. MTD Prods., Inc.*, 41 F.3d 39, 43 (2d Cir. 1994) (“‘Tarnishment’ generally arises when the plaintiff’s trademark is linked to products of shoddy quality, or is portrayed in an unwholesome or unsavory context” (internal quotation marks omitted)); *L.L. Bean, Inc. v. Drake Publishers, Inc.*, 811 F.2d 26, 31 (1st Cir. 1987) (“The threat of tarnishment arises when the goodwill and reputation of a plaintiff’s trademark is linked to products which are of shoddy quality or which conjure associations that clash with the associations generated by the owner’s lawful use of the mark[.]”); *Pinterest, Inc. v. Pintrips, Inc.*, 140 F. Supp. 3d 997, 1030–31 (N.D. Cal. 2015) (“These uses dilute the selling power of these trademarks . . . by tarnishing them with negative associations.”) (quoting *Mattel, Inc. v. MCA Records, Inc.*, 296 F.3d 894, 903 (9th Cir. 2002)); *adidas-Am., Inc. v. Payless Shoesource, Inc.*, 546 F. Supp. 2d 1029, 1065 (D. Or. 2008)

sex, drugs, or nudity, so association with something more wholesome could dilute the mark's reputation. Take, for example, the Playboy bunny mark. Perhaps a junior user manufactured a stuffed rabbit children's toy under the name "Playgirl Rabbit." Although a famous markholder with a consistent reputation, Playboy would have little chance for remedy under the dilution by tarnishment claim because, generally, courts have construed the claim narrowly to include only associations with sex, drugs, or nudity.<sup>226</sup> A rabbit stuffed animal has neither sexual connotations nor a basis in drugs, nudity, or violence. Therefore, under the narrow application by past courts Playboy would likely find little protection or recourse under dilution by tarnishment. However, under dilution by burnishment Playboy would have a cause of action because Playboy could argue likelihood that the association adversely affected the famous mark's reputation. The association could rehabilitate Playboy's reputation, which may alarm the brand's established consumer base. The association would improve Playboy from its constant state, thus diluting the nasty brand. The current interpretation of the dilution by tarnishment statute would preclude Playboy from asserting an effective dilution claim because courts typically only recognize dilution of wholesome brands. Therefore, courts should expand dilution by tarnishment to recognize situations like Playboy's as dilution by burnishment.

#### *B. Methods for Burnishment Implementation*

Courts could implement burnishment by acknowledging its existence and subsequently waiting to hear a suitable case. Alternatively, Congress could create a separate amendment to the TDRA to include burnishment. The plain meaning and legislative history of dilution statutes reveal burnishment's pre-existence in the TDRA, while the legislative history does not directly contest amending the TDRA to include burnishment.

When read for plain meaning, the final element of the dilution by tarnishment statute calls for proof of an association that is "likely to harm

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("Actual dilution occurs 'by either a blurring of the mark's identification or a tarnishment of the positive associations the mark has come to convey.')" (quoting *Moseley v. V Secret Catalogue, Inc.*, 537 U.S. at 433 (2003)); *Hasbro, Inc. v. Clue Computing, Inc.*, 66 F. Supp. 2d 117, 119 (D. Mass. 1999) ("A tarnishment claim would require Hasbro to show that Clue Computing is using the mark in an unwholesome manner or for a low quality product which could create a negative association with Hasbro's product."); *Ringling Bros. v. B.E. Windows*, 937 F. Supp. 204, 209 (S.D.N.Y. 1996) ("Tarnishment occurs when the Plaintiff's mark is used by the Defendant in association with inferior or unwholesome goods or services.").

<sup>226</sup> *See id.* (illustrating that dilution claims require a negative association brought upon a wholesome mark rather than an unwanted positive association brought upon an unwholesome mark).

the reputation of the famous mark.”<sup>227</sup> But the final prong does not specify in detail what type of reputation the mark must hold or what type of harm the mark must incur to meet the elements of the prima facie case. Therefore, *any* harm to *any* famous mark’s reputation should presumably meet the statutory requirement. Dilution by burnishment harms unwholesome marks by improving their unsavory reputations. Congress already drafted the federal dilution statute to include dilution by burnishment because burnishment is a concrete form of harm to a famous mark’s reputation.

Yet, courts generally only apply the statute to wholesome plaintiffs, thus encouraging only wholesome plaintiffs to assert dilution by tarnishment claims. Courts’ general application of dilution by tarnishment ultimately created the assumption that unwholesome famous markowners could not meet the burden of proof for dilution by tarnishment. However, because the prima facie definition of tarnishment already has a dilution by burnishment claim included within it, the practical option for implementing dilution by burnishment is for the courts to recognize the claim’s existence, wait for an applicable case to arise, and properly interpret the statute to include dilution by burnishment.

Alternatively, to establish burnishment as a separate trademark claim Congress could completely amend the TDRA to include dilution by burnishment. Legislative history indicates that a burnishment amendment to the current trademark statute would further the purpose of the TDRA; it explains to what situation dilution applies, and burnishment falls into that description.<sup>228</sup> Additionally, the purpose of federal dilution legislation was to bring uniformity to the doctrine.<sup>229</sup> If burnishment were not added to the TDRA, courts could interpret the claim differently, which might result in a fractured doctrine similar to state anti-dilution law before federal dilution came into play. A distinct dilution by burnishment claim would ensure that unwholesome famous plaintiffs would have equal trademark protection and would not be at the mercy of courts’ interpretations to determine whether a dilution by burnishment should survive. However, facilitating another amendment to the trademark statute would be an involved process that could prevent some potential plaintiffs from taking advantage of the claim while waiting for amendments to be implemented. Therefore, court recognition of the burnishment claim is the best form of implementation.

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<sup>227</sup> *Louis Vuitton*, 507 F.3d at 265.

<sup>228</sup> H.R. REP. NO. 109-23, at 4 (2005) (indicating that “[dilution] applies when unauthorized users attempt to trade upon the goodwill and established renown of such marks, and thereby dilute their distinctive quality”); *id.* (discussing Congress promoting uniformity and certainty for trademark owners by enacting a federal dilution statute in 1995).

<sup>229</sup> *Id.*

## V. WHY FAMOUS TRADEMARKS NEED BURNISHMENT

Famous marks need burnishment because the current statute is imbalanced, biased, and fundamentally unfair. If disregarded, the accepted approach to dilution that only wholesome marks can suffer from tarnishment could develop into a technical rule. Moreover, recent case law indicates an increase in registered unwholesome marks,<sup>230</sup> which logically will increase the number of famous unwholesome marks that require dilution protection. Without burnishment, the pool of famous unwholesome marks will continue to expand while traditional tarnishment plaintiffs will not only be the norm, but the formal rule.

### A. *Balancing the Dilution Doctrine*

For decades wholesome marks have been fully protected by both confusion and dilution-natured claims. In actuality, full trademark protection did not exist because not all qualified marks could assert dilution. Without burnishment, an imbalance in the statute and precedent would continue to allow only a certain level of mark to avail itself of the statute, resulting in a classist system of trademarks. The TDRA created a growing chasm between wholesome, upscale brands and unwholesome brands. Fewer unwholesome brands invoke dilution by tarnishment while more wholesome brands continue to use tarnishment to their advantage, resulting in the presumption that courts and Congress reserve the claim for upscale or wholesome brands because those are the only marks that *can* be tarnished. Nevertheless, as explored previously, any famous brand with a constant reputation can be harmed if a defendant's unauthorized use changes that reputation through association with the opposite type of brand, product, or message. If plaintiffs continue to assert tarnishment as they have, the disparity between upscale, wholesome and lower-end, unwholesome marks would grow immeasurably. Only some brands could access dilution by tarnishment, while others meeting the minimum dilution by tarnishment requirements would nevertheless be unable to assert the cause of action. Including burnishment in the TDRA or recognizing it as a claim separate from tarnishment would avoid distinguishing between qualities of brands, thus reducing the risk of building a classist trademark system.

### B. *Fundamental Fairness Calls for Burnishment*

As previously stated, dilution by burnishment provides an avenue of relief for marks that would otherwise qualify for dilution by tarnishment but for their unwholesomeness. Restricting protection from certain types of marks based on wholesomeness is fundamentally unfair, particularly

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<sup>230</sup> See *infra* Part V.C.

when taking into account famous markowners' investments. "[T]rademarks encourage investment in good will, quality, and advertising."<sup>231</sup> The time and money famous markowners invest in creating a famous trademark is equivalent regardless of the wholesomeness of the mark. Markowners invest time and money in trademark attorneys, clearance, marketing, strategy, advertising, and expansion and development of the mark in hopes of creating goodwill. Currently, owners of famous wholesome marks receive complete protection for their exhaustive investments in the form of confusion and dilution-based protection. However, owners of famous unwholesome marks who invested the same amounts of time and effort do not receive comprehensive protection for their investments; instead, they may only rely on confusion-based protection.<sup>232</sup> Whether wholesome or unwholesome, marks should be afforded equivalent protections.

What is more, unequal protection of such brands could result in a chilling effect. After investing extensive time and money into cultivating brand recognition based on marks, the risk that markowners would lack proper federal protection to safeguard their investments could lead to a decrease in unwholesome mark adoption. A decrease in adoption of unwholesome marks would result in an uneven representation of trademarks, ultimately decreasing the overall pool from which markowners select marks.

### C. Pool of Markholders Affected by Burnishment

Presently, we know the composition of the markholders who take advantage of dilution in the absence of burnishment, yet the amount of markholders that will take advantage of the burnishment claim is still unknown. Theoretically, because the requirements to qualify for burnishment are so narrow only a small number of markholders could take advantage of the claim. However, those few that qualify for burnishment nevertheless deserve equivalent protection for their marks.

Current case law indicates a possible future rise in the pool of markholders affected by burnishment. The Federal Circuit, in *In re Tam*, recently held refusal of disparaging marks unconstitutional under the First Amendment.<sup>233</sup> The same section that requires refusal of disparaging marks also requires refusal of marks with scandalous matter.<sup>234</sup> Therefore, all those unwholesome marks that were initially refused registration because of scandalous matter might now have the

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<sup>231</sup> Simone A. Rose, *Will Atlas Shrug? Dilution Protection for "Famous" Trademarks: Anti-Competitive "Monopoly" or Earned "Property" Right?*, 47 FLA. L. REV. 653, 671 (1995).

<sup>232</sup> See discussion *supra* Part IV.A.

<sup>233</sup> 808 F.3d 1321, 1328 (Fed. Cir. 2015), *cert. granted sub nom. Lee v. Tam*, 137 S. Ct. 30 (2016).

<sup>234</sup> 15 U.S.C. § 1052(a) (2012).

option to reapply for registration, thus increasing the pool of registered unwholesome marks. Those unwholesome marks that qualify as famous will deserve comprehensive protection in the form of burnishment.

Under the Lanham Act, the United States Patent and Trademark Office (USPTO) must register applied-for marks unless they are precluded from registration based on several categories.<sup>235</sup> Section 1052(a) includes an assortment of these restrictions, one of which is the bar on registration of a mark that “[c]onsists of or comprises immoral, deceptive, or scandalous matter.”<sup>236</sup> To refuse a mark based on scandalous nature, the USPTO must show that a mark is “shocking to the sense of truth, decency, or propriety; disgraceful; offensive; disreputable; . . . [g]iving offense to the conscience or moral feelings; . . . [or] calling out [for] condemnation.”<sup>237</sup> More succinctly, the USPTO may prove scandalous matter by demonstrating that a mark is “vulgar.”<sup>238</sup> This demonstration must be made “in the context of contemporary attitudes,” and within the framework of the associated goods.<sup>239</sup> The analysis need not take place from the standpoint of a majority, but “a substantial composite of the referenced group.”<sup>240</sup>

The Court of Appeals for the Federal Circuit long assumed that the prohibition on scandalous marks “[wa]s not an ‘attempt to legislate morality, but, rather, a judgment by the Congress that [scandalous] marks not occupy the time, services, and use of funds of the federal government.’”<sup>241</sup> However, after ordering sua sponte a review of the statute in light of the applied-for mark, THE SLANTS for an Asian-American dance-rock band, the en banc court in *In re Tam* found the refusal of registration based on disparagement unconstitutional.<sup>242</sup> The court identified that disparagement is neither viewpoint nor content

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<sup>235</sup> *Id.* § 1052 (stating: “No trademark . . . shall be refused registration on the principal register on account of its nature unless it[ ] (a) [c]onsists of or comprises immoral, deceptive, or scandalous matter”).

<sup>236</sup> *Id.* § 1052(a).

<sup>237</sup> *In re Mavety Media Grp. Ltd.*, 33 F.3d 1367, 1371 (Fed. Cir. 1994) (alteration in original) (internal quotation marks omitted) (quoting *In re Riverbank Canning Co.*, 95 F.2d 327, 328 (C.C.P.A. 1939)).

<sup>238</sup> *In re Boulevard Entm’t, Inc.*, 334 F.3d 1336, 1340 (Fed. Cir. 2003), *abrogated by In re Tam*, 808 F.3d at 1321.

<sup>239</sup> *In re Tam*, 808 F.3d at 1331 (internal quotation marks omitted) (quoting TMEP, *supra* note 23, § 1203.03(b)(i)).

<sup>240</sup> *Id.* at 1359 (internal quotation marks omitted) (quoting TMEP *supra* note 23, § 1203.03(b)(i)); *see also In re Boulevard*, 334 F.3d at 1340 (analyzing the mark from the standpoint of “a substantial composite of the general public”).

<sup>241</sup> *In re Mavety Media Grp. Ltd.*, 33 F.3d 1367, 1374 (Fed. Cir. 1994) (quoting *In re McGinley*, 660 F.2d 481, 486 (C.C.P.A. 1981), *abrogated by In re Tam*, 808 F.3d at 1321).

<sup>242</sup> *In re Tam*, 808 F.3d at 1328, 1334.

neutral, nor does the section regulate the commercial speech of marks.<sup>243</sup> Therefore, the court applied strict scrutiny to analyze the constitutionality of disparagement under the First Amendment.<sup>244</sup> Disparagement is viewpoint discriminatory on its face because it rejects marks that refer to certain groups negatively, while permitting registration of marks that refer to the same group positively.<sup>245</sup> For example, in this case the USPTO refused to register THE SLANTS for an Asian-American music group, but previously registered marks with positive references to those of Asian descent such as CELEBRASIANS and ASIAN EFFICIENCY.<sup>246</sup> Furthermore, disparagement qualifies as content-based regulation of speech because “it ‘applies to particular speech because of the topic discussed.’”<sup>247</sup> Disparagement does not simply discriminate based on subject, but also “on the basis of the message conveyed,” or “the idea or message expressed” in the trademark.<sup>248</sup> Finally, the court also concluded that disparagement did not constitute commercial speech and, therefore, could not undergo intermediate scrutiny.<sup>249</sup> Again, the court looked to how disparagement regulates a mark’s expressive character rather than its source identifying function.<sup>250</sup> Thus, “[t]he disparagement provision must be assessed under First Amendment standards applicable to what it targets, which is not the commercial-speech function of the mark.”<sup>251</sup>

Even if trademarks were considered commercial speech, however, disparagement would still fail to survive under the *Central Hudson* test for commercial speech.<sup>252</sup> The *Central Hudson* test requires that commercial speech first “must concern lawful activity and not be misleading.”<sup>253</sup> “If this is the case, [the court] ask[s] whether ‘the asserted governmental interest is substantial,’”<sup>254</sup> and “whether the regulation ‘directly and materially advanc[es]’ the government’s asserted interest and is narrowly tailored to achieve that objective.”<sup>255</sup> The court concluded that the government failed to provide a substantial interest in justifying the

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<sup>243</sup> *Id.* at 1334–35.

<sup>244</sup> *Id.* at 1337.

<sup>245</sup> *Id.*

<sup>246</sup> *See id.* at 1336.

<sup>247</sup> *Id.* at 1335 (quoting *Reed v. Town of Gilbert*, 135 S. Ct. 2218, 2227 (2015)).

<sup>248</sup> *Id.*

<sup>249</sup> *Id.* at 1337–38.

<sup>250</sup> *Id.* at 1338.

<sup>251</sup> *Id.*

<sup>252</sup> *Id.* at 1355.

<sup>253</sup> *Id.* (internal quotation marks omitted) (quoting *Cent. Hudson Gas & Elec. Corp. v. Pub. Serv. Comm’n*, 447 U.S. 557, 566 (1980)).

<sup>254</sup> *Id.*

<sup>255</sup> *Id.* (quoting *Lorillard Tobacco Co. v. Reilly*, 533 U.S. 525, 555–56 (2001)).

section 2(a) bar on disparaging marks.<sup>256</sup> “All of the government’s proffered interests boil[ed] down to permitting the government to burden speech it finds offensive,” which is not a legitimate interest.<sup>257</sup> Therefore, the disparagement bar in section 2(a) is unconstitutional under the First Amendment.<sup>258</sup>

The court in *In re Tam* held only the disparagement portion of section 2(a) unconstitutional in the face of the First Amendment.<sup>259</sup> However, the decision could equally affect the remaining section 2(a) bases for refusal of registration, such as scandalous marks. If the USPTO were unable to refuse registration of scandalous marks, the amount of registered scandalous marks would increase. Many unwholesome marks are also scandalous. To allow registration of scandalous marks may also allow registration of unwholesome marks. Removing the preventative mechanism for registration of scandalous marks would likely increase the amount of unwholesome marks registered. As defined earlier, an unwholesome mark is one whose goods, mark, or message is not commonly accepted by society because of its underlying salaciousness. While the Lanham Act does not define a scandalous mark, examples of scandalous marks for which the USPTO has refused registration include COCK SUCKER for chocolate rooster-shaped lollipops and CROCK OF S.H.I.T. for plant food.<sup>260</sup> The vulgar content in marks often refused for scandalous matter is similar to the lascivious and seamy content in unwholesome marks. As refusal for scandalous matter begins to strip away under *In re Tam* and the First Amendment, the number of scandalous marks, and therefore unwholesome marks, may increase. With a new, larger pool of unwholesome registered marks, the demand for burnishment would increase. While qualifying burnishment requirements would remain narrow, the increase in unwholesome marks would likely increase the amount of marks in need of burnishment. The *In re Tam* decision could have a lasting and considerable effect on unwholesome trademark protection by providing extensive opportunity for burnishment.

## VI. CONCLUSION

Throughout the evolution of the dilution doctrine, courts have systematically ignored a major section of famous marks. Courts’ acknowledgement of burnishment as a distinct claim and their commitment to analyzing appropriate cases thereafter would be the ideal

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<sup>256</sup> *Id.* at 1357.

<sup>257</sup> *Id.*

<sup>258</sup> *Id.*

<sup>259</sup> *Id.*

<sup>260</sup> *See In re Fox*, 702 F.3d 633, 635, 636 (Fed. Cir. 2012); CROCK OF S.H.I.T., US Trademark Application Serial No. 73/390,985 (filed Sept. 28, 1982).

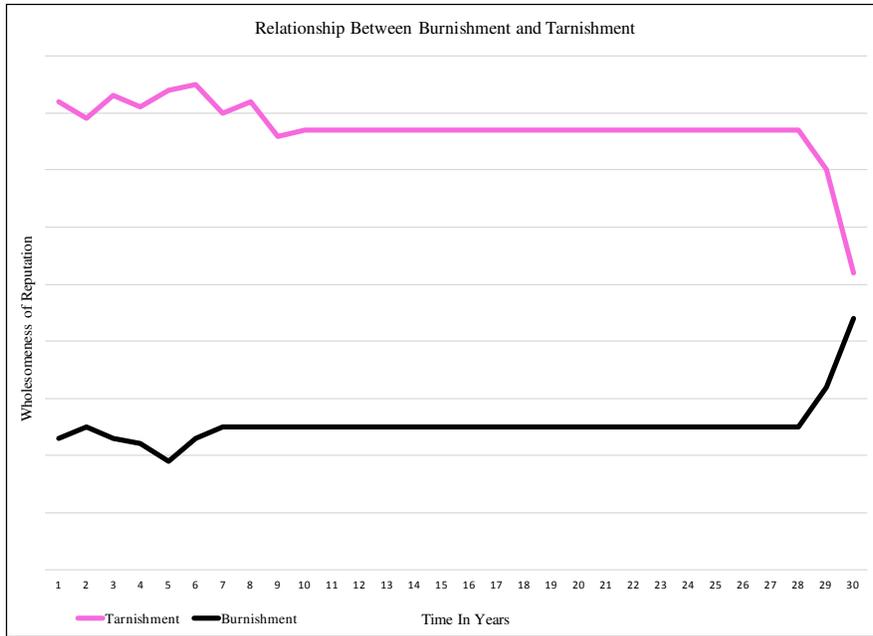
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approach to naturally weave burnishment claims into the trademark tapestry and remedy this error. Fundamental fairness as well as the prospect of an influx of unwholesome marks calls for a dilution claim directed specifically towards unwholesome marks. With a separate claim like burnishment, unwholesome plaintiffs may begin to mend the past 20 years of biased federal dilution.

APPENDIX A



Where year 28 marks the association with the opposite type of mark.