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Trademark Dilution

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Guide Information

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Description: This is a library research guide on trademark dilution.

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Associations

[American Intellectual Property Law Association](#)

AIPLA is a national bar association constituted primarily of lawyers involved in the practice of patent, trademark, copyright, trade secret, and unfair competition law, as well as other fields of law affecting intellectual property.

[ABA Section of Intellectual Property Law](#)

The ABA Section of Intellectual Property Law is the largest intellectual property organization in the world and the oldest ABA section.

Introduction

This research guide has been designed to assist law students with research related to trademark dilution. Trademarks, in general, is a vast area of law. Please note, this guide focuses only on trademarks in regards to dilution. This is not a comprehensive guide, however, it provides a listing of the more important, current, and relevant materials available in the area of trademark dilution. It should only be used as a starting point for any trademark dilution research.

United States Patent and Trademark Office

[The United States Patent and Trademark Office \(USPTO\)](#) is the Federal agency for granting U.S. patents and registering trademarks. In doing this, the USPTO fulfills the mandate of Article I, Section 8, Clause 8, of the Constitution that the Executive branch "promote the progress of science and the useful arts by securing for limited times to inventors the exclusive right to their respective discoveries." The USPTO registers trademarks based on the Commerce Clause of the Constitution (Article I, Section 8, Clause 3). Under this system of protection, American industry has flourished. New products have been invented, new uses for old ones discovered, and employment opportunities created for millions of Americans. The strength and vitality of the U.S. economy depends directly on effective mechanisms that protect new ideas and investments in innovation and creativity. The continued demand for patents and trademarks underscores the ingenuity of American inventors and entrepreneurs. The USPTO is at the cutting edge of the Nation's technological progress and achievement.

Trademark Protection Against Dilution

[Office of the Administrator for Policy and External Affairs -Trademarks](#)

The trademark group of Policy and External Affairs specializes in trademark-related domestic and international policy and enforcement matters. This group is tasked with ensuring U.S. implementation and adherence with international treaty obligations relating to trademarks, geographical indications, well-known marks and domain names. Also, the group evaluates domestic trademark policy issues vis-a-vis international obligations, foreign law and practice, as well as the development of U.S. jurisprudence. The group is further responsible for advising on negotiations and monitoring enforcement of treaty provisions relating to these issues, as well as providing technical assistance and training on trademark-related matters for both U.S. and foreign officials.

[Trademark Trial and Appeal Board](#)

All proceedings before the Trademark Trial and Appeal Board ("Board") are governed by the Lanham Trademark Act of 1946, as amended, ("Trademark Act"), 15 U.S.C. § 1051 et seq.; the rules of practice in trademark cases (commonly known as the Trademark Rules of Practice), which may be found in Parts 2 and 7 of Title 37 of the Code of Federal Regulations ("CFR"); the rules pertaining to assignments in trademark cases, which may be found in Parts 3 and 7 of 37 CFR; and the rules relating to the conduct of practitioners and the representation of others before the United States Patent and Trademark Office ("USPTO" or "Office") which may be found in Parts 10 and 11 of 37 CFR. The USPTO rules governing procedure in inter partes proceedings before the Board are adapted, in large part, from the Federal Rules of Civil Procedure, with modifications due primarily to the administrative nature of Board proceedings.

About the Author

Crystal Parker is a 3L at Georgia State University. She completed her undergraduate work in 2000 earning a BA in English with a concentration in Education. After a 10 year break, Parker decided to return to school and study law. It is her hope that upon graduation in December 2012 she will be employed by a firm or corporation as an Intellectual Property attorney specializing in Trademarks.

Disclaimer

This research guide is a starting point for a law student or an attorney to research trademark dilution. This is a very active area of federal law, and it is imperative to Shepardize or KeyCite all cases and statutes before relying on them. This guide should not be considered as legal advice or as a legal opinion on any specific facts or circumstances. If you need further assistance in researching this topic or have specific legal questions, please contact a reference librarian in the Georgia State University College of Law library or consult an attorney.

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Primary Sources

Relevant Federal Statutes

LANHAM ACT

The Lanham Act defines the statutory and common law boundaries to trademarks and service marks. Trademarks (and service marks) are words or designs used in the advertising of goods and services. Rights to use a trademark are defined by the class(es) for which the trademark is used. Therefore, it is possible for different parties to use the same trademark in different classes. The Lanham Act defines the scope of a trademark, the process by which a federal registration can be obtained from the Patent and Trademark Office for a trademark, and penalties for trademark infringement.

[15 U.S.C. §§ 1051-1150](#)

TRADEMARK DILUTION REVISION ACT OF 2006

Trademark dilution is the blurring or tarnishment of famous trademarks by creating a trademark to similar to an existing famous one. Only famous trademarks are protected under dilution laws.

[15 U.S.C. § 1125\(c\) \[Section 43\(c\) Lanham Act\]](#)

Legislative History

Legislative history refers to the progress of a bill through the legislative process and to the documents that are created during that process. Attorneys, judges, and others often turn to these documents to learn why Congress enacted a particular law or to aid in the interpretation of a law.

The components of legislative history for a bill (in order of their importance) are:

committee reports,

bills and their amendments,

sponsor remarks, and

committee hearings.

You can use the links below to access the legislative history of the Trademark Dilution Revision Act of 2006.

[HeinOnline](#)

[ProQuest Legislative Insight](#)

Relevant Georgia Statute

ANTI-DILUTION STATUTE

Georgia's Statute reads in pertinent:

(a) A person engages in a deceptive trade practice, when, in the course of his business, vocation or occupation, he:

(1) Passes off goods and services as those of another;

(2) Causes likelihood of confusion or of misunderstanding as to the source, sponsorship, approval, or certification of goods and services;

[O.C.G.A. § 10-1-451](#)

Case Law

You can search for cases containing trademark dilution issues using [Westlaw](#) or [LexisNexis](#). A brief list of relevant opinions is listed below. You can access the opinions in this list by clicking the link. There is no need to access Westlaw or LexisNexis.

[Moseley v. V. Secret Catalogue, Inc.](#)

V Secret Catalogue, Inc., the affiliated corporations that own the Victoria's Secret trademarks, filed suit, alleging that the name Victor's Little Secret contributed to "the dilution of famous marks" under the Federal Trademark Dilution Act (FTDA). The law defines "dilution" as "the lessening of the capacity of a famous mark to identify and distinguish goods or services." The District Court granted V Secret summary judgment on the FTDA claim. The Court of Appeals affirmed, finding that V Secret's mark was distinctive and that the evidence established dilution even though no actual harm had been proved.

[Louis Vuitton Malletier S.A. v. LY USA, Inc.](#)

This case involved the importation and sale of counterfeit luxury goods bearing trademarks owned by Louis Vuitton (plaintiff) and others. Defendants appealed from the district court's judgment granting summary judgment to plaintiff on its claims of trademark counterfeiting and infringement, and awarding plaintiff statutory damages in the amount of \$3 million, and more than \$500,000 in attorney's fees and costs. The court concluded that the district court did not abuse its discretion in declining to stay the proceedings; that, as the district court concluded, an award of attorney's fees under 15 U.S.C. 1117(a) could accompany an award of statutory damages pursuant to 15 U.S.C. 1117(c); and that the district court did not abuse its discretion in awarding such fees or in setting their amount. Accordingly, the judgment was affirmed.

[Coach Services, Inc. v. Triumph Learning LLC](#)

The Court of Appeals for the Federal Circuit affirmed-in-part the decision of the Trademark Trial and Appeal Board ("Board"), which had dismissed the notice of opposition filed by Coach Services, Inc. ("CSI") opposing the registration of the COACH mark by Triumph Learning L.L.C. ("Triumph"). The Federal Circuit upheld the Board's holding that CSI failed to prove that Triumph's educational materials were likely to dilute CSI's luxury travel brand. In so holding, the court provided an example of a level of fame that is insufficient to qualify for protection from brand dilution under the Lanham Act.

[Super Duper, Inc. v. Mattel, Inc., 382 Fed. Appx. 308 \(4th Cir. S.C. 2010\)](#)

Super Duper, Inc., a South Carolina corporation, manufactures education and therapy materials for children. Mattel, Inc., an international toy manufacturer, challenged Super Duper's registration of four trademarks and filed formal notices of opposition and petitions for cancellation with the United States Patent and Trademark Office. Super Duper brought a declaratory judgment action in the federal district court to determine if its trademark infringed on Mattel's trademarks. Mattel counterclaimed asserting trademark infringement along with other claims.

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Secondary Sources

Trademark Law and Dilution Books

- Defending the Brand by Brian H. Murray
Call Number: HD69.B7 M79 2004
ISBN: 0814407544
Publication Date: 2003-10-31
- Trademark Dilution by David S. Welkowitz
ISBN: 1570183139
Publication Date: 2002-06-01

Law Reviews and Journals

Below is a list of law reviews and journals that focus on Trademark Law with many articles on trademark dilution:

- [Michigan Law Review](#) - The Trademark Dilution Revision Act of 2006: A Welcome—and Needed—Change
- [Chicago-Kent Law Review](#) - Victor's Not So Little Secret: Trademark Dilution is Difficult But Not Impossible to Prove Following *Moseley v. V. Secret Catalogue, Inc.*
- [Santa Clara Computer and High Technology Law Journal](#) - The Trademark Use Requirement in Dilution Cases
- [Harvard Law Review](#) - Intellectual Property Law and the Sumptuary Code

Legal Encyclopedias

American Jurisprudence and Corpus Juris Secundum are great legal encyclopedias for any area of law.

[74 Am Jur 2d Trademarks and Tradenames § 108](#)

[74 Am Jur 2d Trademarks and Tradenames § 109](#)

[87 C.J.S. Trademarks, Etc. § 99](#)

Treatises

Please see below for a list of relevant trademark law treatises. These treatises can be found in the Georgia State University College of Law. The call number is listed below the title and author information.

McCarthy on Trademarks and Unfair Competition

by [McCarthy, J. Thomas, 1937-](#)

Call Number: KF3180 .M33 1996 PubDate:1996

Gilson on Trademarks

by [Lalonde, Anne Gilson.](#)

Call Number: KF3180 .G54 PubDate:2007

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Online Sources and Recommended Readings

Trademark Law Overview Pages

The following pages provide an overview of trademark law with short definitions and explanations of relevant law.

[HARVARD LAW PAGE](#)

[CORNELL UNIVERSITY PAGE](#)

[BITLAW](#)

Recommended Readings

In addition to your substantive research, you may want to read other articles to further familiarize yourself with trademark dilution. Below is a list of recommended readings.

- [TRADEMARK DILUTION: OF FAME, BLURRING, AND SEALING WAX, WITH A TOUCH OF JUDICIAL WISDOM](#)
- [THE STILL BLURRY STANDARDS FOR PROVING TRADEMARK DILUTION](#)
- [THE WAGES OF UBIQUITY IN TRADEMARK LAW](#)
- [A CLOSER LOOK AT THE TRADEMARK DILUTION ACT OF 2006](#)

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