Remedying Past and Future Harm: Reconciling Conflicting Circuit Court Decisions Under the Federal Trademark Dilution Act

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I. INTRODUCTION

Pepperidge Farm produces popular cheese-flavored bite-sized crackers in the shape of a goldfish.1 The same goldfish acts as a trademark for Pepperidge Farm.2 Between 1995 and 1998, Pepperidge Farm spent more than one hundred twenty million dollars on promoting its Goldfish trademark nationwide.3 Ringling Bros.-Barnum & Bailey promote their circus around the country through the use of their famous slogan, "The Greatest Show on Earth."4 In 1996 alone, the company spent about nineteen million dollars advertising and marketing this trademark to the public.5

Trademarks have taken on a more prominent role in today’s market economy.6 Consumers have come to rely more and more on trademarks as a means of making an informed decision on what products they purchase.7 In the modern age of the Internet, customers do not even have to go to the grocery store to purchase their goldfish crackers.8 Thus, they have come to

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1. Nabisco, Inc. v. PF Brands, Inc., 191 F.3d 208, 212 (2d Cir. 1999).
2. Id.
3. Id. at 213.
5. Id.
7. See id.

Over the last few years, the commercial side of the Internet has grown rapidly. Web pages are now used by companies to provide information about their products in a much more detailed fashion than can be done through a standard advertisement. Moreover, many consumers and businesses now order goods and services directly from company web pages.
rely on the trademark as a way of informing them about the products they have purchased. In fact, trademarks have become "silent [salesmen] that reach[] over the shoulder of the retailer and across the latter’s counter, straight to the consumer."

Knowing this, companies such as Pepperidge Farm have invested millions of dollars on creating and promoting their trademarks. For these companies, investing anywhere between nineteen and forty million a year to maintain the strength of their trademarks means that their trademarks have become valuable marketing tools, as well as valuable assets. Realizing the incredible marketing power of a widely recognized trademark, smaller companies have attempted to market their products by using trademarks similar to the famous trademark. Through the use of these trademark imitations, smaller companies have accomplished consumer deception. By using confusingly similar trademarks, they have confused the consumer into

Id. at 493.

9. See Sporty’s Farm, 202 F.3d at 493.

For consumers to buy things or gather information on the Internet, they need an easy way to find particular companies or brand names. The most common method of locating an unknown domain name is simply to type in the company name or logo with the suffix .com. . . . As a result, companies strongly prefer that their domain name be comprised of the company or brand trademark and the suffix .com.


10. Julius R. Lunsford, Trademark Basics, 59 Trademark Rep. 873, 880 (1969); see also Patricia Kimball Fletcher, Comment, Joint Registration of Trademarks and the Economic Value of a Trademark System, 36 U. Miami L. Rev. 297, 302-03 (1982) (“The technological advances of the industrial revolution, particularly in communication and transportation, caused the consumer and manufacturer to become distant . . . . Trademarks thus became, and still remain, the symbols bridging the gap between manufacturer and consumer.”)


13. Robert N. Klieger, Trademark Dilution: The Whittling Away of the Rational Basis for Trademark Protection, 58 U. Pitt. L. Rev. 789, 824 (1997). “A producer must be wary of trademark imitators. ‘If an imitator can seize the bridge [stretching from producer to consumer through public deception], he can collect the rich toll.’” Id. at 852 (quoting Ralph S. Brown, Jr., Advertising and the Public Interest: Legal Protection of Trade Symbols, 57 Yale L.J. 1165, 1187 (1948)).

14. Id. “So too does a [trademark imitator] who, while not directly diverting business away from the [trademark owner], deceives the public into believing that the [trademark owner] sponsored or is otherwise associated with the [imitator’s] use.” Id.
buying an inferior product. Traditionally, owners of famous trademarks have been able to stave off potential trademark thieves under the legal theory that their competitors were committing trademark infringement.

However, given the incredible monetary investment and the informational value placed on trademarks, is it enough to protect trademark owners from such unfair competition? For instance, Pepperidge Farm can sue under traditional trademark law against competitors who unlawfully imitate their goldfish trademarks to sell crackers or their snacks. But what legal redress do they have against non-competitors who imitate their trademark? For instance, what if a drug company wanted to market its goldfish-shaped children’s vitamins by using a goldfish trademark? If such imitation was to continue unabated, is it possible that the countless imitations might "dilute" the potency of the original trademark?

The concept that a non-competitor's use of a similar trademark dilutes the strength of the trademark is an irresistible concept for owners of valuable trademarks. However, how far can Pepperidge Farm take the dilution concept in order to fend off non-competitors?

Despite these perplexing questions, during the past fifty years, various states have enacted dilution legislation. In the last fifty years, only about
one-half of the states have enacted dilution laws. However, legislating this doctrine has provided plenty of controversy in the courts. To add fuel to the fire, the courts have received dilution laws with mixed reactions. Some courts have rejected dilution laws due to their extreme pro-big-business disposition, other courts have welcomed dilution laws as a legitimate protector of trademark dilution.

To remedy this mixed bag of jurisprudence, in 1995, Congress stepped in and created a federal cause of action for trademark dilution by enacting the Federal Trademark Dilution Act ("FTDA"). Congress intended for this remodeled federal law to provide certainty and uniformity in the area of trademark dilution. However, in the past few years, the circuit courts have begun to split on a new issue. The issue is whether the FTDA provides a remedy for harm that has already occurred, or harm that is likely to occur in the future. In 1999, the battle lines were drawn between the Fourth and Second Circuits. Since then, other circuit courts have joined the battle and have started to form alliances with either side.

This controversy is relatively new in the field of trademark dilution, and specific to the FTDA. However, the current disagreement has brought to the forefront a controversy that surrounded the birth of the dilution doctrine. This Comment examines the current controversy in light of the old one. Part II of this Comment outlines the development of the dilution doctrine, including early criticism of the dilution doctrine. This Comment examines the current controversy in light of the old one. Part II of this Comment outlines the development of the dilution doctrine, including early criticism of the dilution doctrine. Part III addresses the jurisprudence of dilution legislation in the states and by Congress, and then discusses the controversy surrounding the federal statute. Part IV analyzes the split among the circuit courts, focusing on the seminal decisions from the enactment of the FTDA in 1995.
Fourth and Second Circuits. Part V attempts to reconcile the split by taking a critical look at the positions taken by both sides and suggesting a new method of interpreting the FTDA. Finally, Part VI concludes by arguing that the current controversy should be resolved by interpreting the FTDA to remedy both past and future harm.

II. DEVELOPMENT OF THE DILUTION DOCTRINE

A. Traditional Trademark Law and the Rising Importance of Trademarks

In the early 1900's, the dilution doctrine was a revolutionary concept because it deviated from the traditional notions of trademark law. In 1927, the intellectual property landscape was significantly altered by Professor Schechter's introduction of the concept of dilution. "As Professor Schechter recognized, the idea of trademark dilution as a harm that must be prevented was contrary to the then-prevailing understanding of both the function of trademarks and the predominant justification for their protection." Under traditional notions of trademark law, the primary purpose behind protecting trademarks was for the protection of the consumer.

37. See infra notes 151-198 and accompanying text.
38. See infra notes 199-304 and accompanying text.
39. See infra notes 305-318 and accompanying text.
40. McCabe, supra note 34, at 1833-37; see also Ablin & Koshy, supra note 23, at 66-67 (explaining the new role for trademarks); Schechter, supra note 12, at 824 (arguing that traditional trademark law is "hampered by obsolete conceptions both as to the function of a trademark and as to the need for its protection"). Congress first enacted federal trademark legislation in 1870, creating a federal trademark registration scheme for trademarks used in local, interstate, and foreign trade. The United States Supreme Court declared the statute unconstitutional in the Trade-Mark Cases, holding that Congress overstepped its Commerce Clause authority. Congress adopted a second federal registration statute in 1881 that, unlike its predecessor, limited registration to trademarks used in commerce with foreign nations and Indian tribes. The Trademark Act of 1905, Congress' third attempt at a federal registration scheme, did reach trademarks used in interstate commerce and remained in force until the enactment of the Lanham Act, the modern federal trademark statute, in 1946.
41. Ablin & Koshy, supra note 23, at 66.
42. Id. at 66-67.
43. Id.; see also Lanham Act, 15 U.S.C. § 1114(1)(a) (1997). From the start, the touchstone of United States trademark law and the broader law of unfair competition has been consumer confusion. The relevant inquiry in any trademark infringement or unfair competition action has always been whether the defendant's trademark (or, in the unfair competition context, defendant's "total selling 'image'") is likely to cause public deception. While deception today includes confusion as to source,
According to traditional notions of trademark law, trademarks themselves did not have the marketing value that they have today. Instead, trademarks were merely symbols used by companies to represent their products and services to consumers. Thus, their usefulness existed in their ability to represent to the consumer a particular product or service. Traditional trademark law attempted to preserve this “source-signaling ability” of trademarks. More specifically, traditional trademark law sought to protect trademarks against imitators who were “likely to confuse” consumers into believing that they were purchasing a different product or service from the one that they were actually receiving.

The justification for the law was that this practice of consumer deception, if continued unabated, would lead to distrust of a trademark to signal to the consumer a specific product or service.

Historically, trademarks have served myriad functions. Traditionally, they were symbols used by companies to identify their products and services.
to consumers. However, their functions have changed. "Commercial transactions, however, underwent a dramatic transformation by the early twentieth century. As face-to-face meetings between producers and consumers became increasingly uncommon, trademarks assumed growing importance as indicators of consistent, albeit anonymous, source and quality." Simply put, trademarks no longer identified a product but "actually [sold] the goods." Thus, as customers increasingly relied on trademarks to be "silent salesmen," companies made substantial investments in creating and promoting their trademarks. In fact, trademarks became essential vehicles for creating "brand personas," serving both to identify a product and advertise it at the same time.

B. The Birth of the Dilution Doctrine

The concept of the dilution was first expounded by Professor Schechter in his 1927 article, The Rational Basis of Trademark Protection. Professor Schechter argued that the role of trademarks had changed. The trademark

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had moved beyond acting merely as a symbol of a product—it now served as "an agency for the actual creation and perpetuation of good will." Thus, Professor Schechter argued that it was time to preserve the true value of the trademark in the modern market economy.

To effectuate this new purpose, Professor Schechter proposed that trademarks be given protection from a new danger called trademark dilution. Professor Schechter stated that due to the "vast expenditures in advertising" used to build trademarks, protection against dilution was needed to protect the investment of the trademark owner.

This new rationale for protecting trademarks meant that traditional trademark law needed to be expanded. Under the dilution doctrine, it did not matter whether the trademark thief was a competitor or a non-competing entity. Instead, he argued that trademark law should protect trademarks against the dilution of the uniqueness of trademarks. This legal theory was radical for its time because it shifted the focus away from the

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59. See id. at 818.
60. See Schechter, supra note 12, at 831 ("[P]reservation of the uniqueness of a trademark should constitute the only rational basis for its protection."). As one commentator noted, in the "modern era of sealed packages and shrink-wrap," the use of a trademark "removes the need for consumers to inspect the quality of the good or services at each and every purchase." McCabe, supra note 34, at 1832 (stating that "[d]espite statutory advancements during the past century in protecting trademarks, the nature of this protection continues to be embroiled in controversy, particularly in the area of dilution claims.").
61. Id. at 832. Professor Schechter also argued that the purpose of trademark dilution law should be to protect against the "gradual whittling away or dispersion of the identity and hold upon the public mind of the mark or name by its use upon non-competing goods." Id. at 825.
62. Id. at 830 (arguing that the "vast expenditures in advertising" used to build a trademark "should be protected to the same extent as plant and machinery").
63. Ablin & Koshy, supra note 23, at 67. "[Professor Schechter] arg[ue]d that the idea that no harm is done when there is no consumer confusion is 'an archaic notion' that 'ignores the fact that the creation and retention of custom... is the primary purpose of the trademark today.'" Id. at 67 n.43.
64. Id. at 67. "This new role for trademarks meant that protection against only a likelihood of confusion was insufficient." Id.; see also Schechter, supra note 12, at 825 (noting that protection against dilution should be concerned with "the gradual whittling away or dispersion of the identity and hold upon the public mind of the mark or name by its use upon non-competing goods").

65. Testifying before a Congressional committee, Frank Schechter stated: "If you take Rolls Royce—for instance, if you allow Rolls Royce restaurants and Rolls Royce cafeterias, and Rolls Royce pants, and Rolls Royce candy, in 10 years you will not have the Rolls Royce mark any more." Hearing Before the House Comm. on Patents, 72d Cong., 1st Sess. 15 (1932) (statement of Frank I. Schechter), quoted in David S. Welkowitz, Reexamining Trademark Dilution, 44 VAND. L. REV. 531, 539 (1991).
protection of the consumer to the protection of the trademark owner.\textsuperscript{66} In effect, this shift changed the landscape of trademark law.\textsuperscript{57} Now, trademark law was no longer based on unfair competition and protecting the public from deception, but rather on the property rights of trademark holders much like those afforded in copyright and patent law.\textsuperscript{68} However, Professor Schechter maintained that such laws were necessary to preserve the true value of trademarks in our modern economy.\textsuperscript{69}

C. Criticism of the Dilution Doctrine

This radical theory continues to be entangled in controversy.\textsuperscript{70} Opponents of the dilution doctrine, known as "restrictionists," argue that granting legal protection against trademark dilution amounts to a legislative grant of a monopoly for big businesses.\textsuperscript{71} They argue that big businesses do not need any more protection in the marketplace.\textsuperscript{72} They contend that

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\item \textsuperscript{66} Frank I. Schechter, The Historical Foundations of the Law Relating to Trademarks 150, 164-66, 171 (Faculty of Law of Colum. Univ. ed., 1925). "The owner of a trade-mark who expends large sums of money in making his mark known to the public as a symbol and guarantee of the excellence of the quality of his product should receive the same protection from the courts for his investment . . . ." Id. at 171.
\item \textsuperscript{67} Klieger, supra note 13, at 808.
\item In the two decades immediately following Schechter’s dilution proposal, courts, and eventually Congress, eliminated the direct competition requirement that had prevented trademark law from matching trade realities. By the second half of the twentieth century, few could question the degree to which the consumer confusion test protected the source and quality identification functions of trademarks . . . .
\item \textsuperscript{68} See infra notes 77-84 and accompanying text for discussion of trademark law versus copyright and patent law.
\item \textsuperscript{69} Ablin & Koshy, supra note 23, at 68.
\item But Schechter believed that such protection was necessary to protect what was, in his opinion, the true value of trademarks in the modern market economy. Moreover, Professor Schechter envisioned a sliding-scale of protection in which "the degree of protection depend[ed] in turn upon the extent to which, through the efforts or ingenuity of its owner, [the mark was] actually unique and different from other marks." As a result, "arbitrary, coined or fanciful marks or names should be given a much broader degree of protection than symbols, words or phrases in common use."
\item Id.
\item \textsuperscript{70} Klieger, supra note 13, at 802 ("Until recently, Schechter’s dilution proposal, unlike his observations on the quality representation function of trademarks, remained on the periphery of United States trademark law.").
\item \textsuperscript{72} McCabe, supra note 34, at 1834. “Despite the arguments of proponents of trademark protection, the fear of monopoly exists even today, affecting courts’ decisions in determining the relief to be granted in any type of trademark claim.” Id.
\end{itemize}
generally, big businesses own well-known and “dilutable” trademarks.\(^7\) They argue that because these companies already have the resources to fend off competing trademarks, they don’t need the added protection afforded under the dilution doctrine.\(^7\) They contend that this type of unnecessary protection would create large barriers to entry into the marketplace, which would lead to decreased competition.\(^7\) However, they contend that the ultimate harm was to the consumers, as the consumers will face diminished choices in the market and unnaturally high prices.\(^7\)

Restrictionists base their argument on several different concepts. First, they claim that unlike real property, copyright, and patents, trademarks are not property rights in gross.\(^7\) Historically, trademark law has been based on a tort theory of unfair competition.\(^7\) The legal justification originates from

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73. Klieger, supra note 13, at 861-62.
74. See id. at 862. “Dilution protection thus encourages companies to invest more than they otherwise might in the creation of intangible associations that add no real value to the product and that derive economic efficiency.”
75. Id. at 856. “Consumer reliance on trademarks as source and quality identifies can generate strong consumer allegiances to products that prove difficult, and sometimes near impossible, for future market entrants to break.”
77. McCabe, supra note 34, at 1834. “Trademarks are recognized only as quasi-property, with limited rights and protections very different from those associated with full-blown property rights.”
the notion of fairness in commerce where a competitor is prohibited from passing off his product as that of another. Moreover, trademarks have enjoyed legal protection contingent upon their usefulness to the public. The rationale was that illegal imitation of trademarks ultimately deceived the public and caused consumer confusion.

However, dilution “shifts the focus away from consumer protection and towards the protection of an owner’s actual property right in the trademark.” This right is similar to that afforded to copyright, patent, and real property. Copyright and patent laws seek to protect the investment made in the intellectual property.

In addition, restrictionists argue that trademarks are just another form of advertisement, and as such they should not be given special protection over other forms of advertisements. The restrictionists contend that because there are many forms of advertising available to a company, there is no need to protect this one. Using similar logic, restrictionists also contend that dilution protection results in an unnecessary restraint on the free use of language.

Overall, these arguments all lead to one place. Basically, the gravamen of the complaint is that the dilution doctrine upsets the balance of the free law tort origins of trademark beyond recognition.

Ids. at 466-67.

79. Id. at 465. “English courts first used the term unfair competition in 1803, using the words ‘passing off’ or ‘palming off.’ The justification of this tort was that one should not pass off one’s goods as those of another and thereby profit from the deception.” Id.

80. McCabe, supra note 34, at 1835. In contrast, a trademark property right is contingent on commercial use and maintenance of the mark and the good or service it indicates. Specifically, property rights in trademark are defined in light of protecting the public, and are largely limited to the right to prevent customer confusion or dilution of a mark.

Ids.

81. Id.


84. McCabe, supra note 34, at 1836. Accordingly, while the intellectual labor invested in copyrights and patents is directly protected under the Constitution, trademark protection is rooted in the Commerce Clause, which is predicated on guaranteeing a predictable and consistent source of goods in commerce to the public.” Id.

85. Id. at 1833 (citing Ralph S. Brown, Jr., Advertising and the Public Interest: Legal Protection of Trade Symbols, 108 YALE L.J. 1619, 1635 (1999)).

86. Id. (noting that the restrictionist point of view is that “marks [are] merely another form of advertising, designed to entice customers to purchase a product or service they neither want nor need, rather than an essential identification tool”).

87. Id. at 1832 (“[F]ederal trademark protection results in a restraint on the free use of language . . . .”)
market in favor of big businesses. Restrictionists argue that the dilution doctrine prevents small and unrecognized companies from using any similar words or symbols to market their products. They essentially claim that the dilution doctrine is monopolistic in nature. This in turn will lead to a suppression of competition, and will ultimately result in harm to the consumer.

III. FEDERAL TRADEMARK DILUTION ACT

A. Dilution Statutes in the States

Although the dilution doctrine met resistance along the way, it gained popularity in state legislatures—leading some states to enact dilution laws. Despite the initial interest by the states in enacting statutory protection against trademark dilution, Congress was not quick to jump on the bandwagon. Starting in 1947 and up to 1996—the year Congress passed the Federal Trademark Dilution Act—as many as twenty-eight states had enacted their own dilution legislation. Most of these statutes provided protection
for trademarks if there was a "[l]ikelihood of injury to business reputation or of dilution of the distinctive quality" of a trademark."¹⁹⁵ Judicial response to these statutes were mixed, and some courts even received these statutes with much hostility.⁹⁶ At the center of controversy was the issue of the amount of protection that should be afforded to trademarks.⁹⁷ Echoing the restrictionists’ views, some courts claimed that these statutes granted trademark owners a monopoly in the marketplace.⁹⁸ Other courts welcomed the dilution doctrine as being a protector of the true value of trademarks.⁹⁹ The critical phrase, "likelihood of dilution" necessarily provided an expansive reading of the dilution doctrine.¹⁰⁰ Courts criticized this phrase as being over protective of trademarks because this phrase implied that there was some measurable future harm.¹⁰¹ In addition, one commentator has claimed that this language resulted from an unnecessary borrowing of the "likelihood of confusion" standard from a traditional trademark infringement claim, which has no place in a dilution analysis.¹⁰² As a result, the dilution doctrine evolved over the years as a mixed bag of jurisprudence, creating a

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95. E.g., CAL. BUS. & PROF. CODE § 14330 (West Supp. 1997). "Each of the state antidilution statutes contains identical or substantially similar language." Klieger, supra note 13, at 794 n.19.

96. Id. at 811 (stating that "'[a]lthough courts expressed initial fascination with dilution theory, intrigue quickly turned to hostility").

97. See id. at 816 (stating that courts encountered difficulty in defining both the interest to be protected and dilution).

98. Id. at 811 n.153 (quoting Coffee Dan’s, Inc. v. Coffee Don’s Charcoal Broiler, 305 F. Supp. 1210, 1217 n.13 (N.D. Cal. 1969) ("Until [the California antidilution] statute is interpreted more fully by a California court, we feel constrained not to give it overly broad application lest it swallow up all competition in the claim of protection against trade name infringement.").)

99. E.g., Sally Gee, Inc. v. Myra Hogan, Inc., 699 F.2d 621, 624-25 (2d Cir. 1983) (stating that the New York dilution law was enacted to protect "the selling power that a distinctive mark or name with favorable associations has engendered for a product in the mind of the consuming public").

100. Klieger, supra note 13, at 816-17 ("Although the statutes spoke of a ‘likelihood of dilution,’ courts were left without standards for determining when the ‘whittling away’ of a trademark’s selling power was likely to occur or even what types of marks were protected.").

101. Id. at 817.

Less speculative than why courts disapproved of dilution theory is how they stymied its application. Courts accomplished the evisceration of the dilution case of action by reading a series of restrictive requirements into dilution law that did not appear on the face of the antidilution statutes. Most strikingly, many courts found that dilution, despite clear statutory language that it applied "notwithstanding . . . the absence of confusion as to the source of goods or services," required a finding of actual or likely confusion.


102. See Klieger, supra note 13, at 817. "Some dilution proponents blamed judicial difficulties in interpreting the antidilution statutes on misdrafting." Id.
“patch-work system” of case law that existed in only about half of the states.

B. Congressional Mandate Against Trademark Dilution

In 1995, the Federal Trademark Dilution Act ("FTDA") was enacted to combat trademark dilution on a national level. The FTDA was created to effectuate the following purposes: (1) to create a nationwide uniform scheme of dilution protection for trademarks, and (2) to create a federal cause of action to protect trademarks from unauthorized users that attempt to dilute the distinctive quality of famous marks.

In order to prevail under the FTDA, the plaintiff has to prove the following four elements:

1. that plaintiff’s trademark must be famous;
2. that defendant must use plaintiff’s trademark in commerce;
3. that defendant began using plaintiff’s trademark after it became famous; and
4. that defendant’s use of plaintiff’s trademark is likely to cause secondary meaning.

103. See Ablin & Koshy, supra note 23, at 68-70. "[T]he judicial decisions based on state antidilution statutes are suspect as either attempts to evade legislative mandates or as indications of widespread confusion regarding the concept of dilution." Id. at 70.


In determining whether a mark is distinctive and famous, a court may consider factors such as, but not limited to:

(A) the degree of inherent or acquired distinctiveness of the mark;
(B) the duration and extent of use of the mark in connection with the goods or services with which the mark is used;
(C) the duration and extent of advertising and publicity of the mark;
(D) the geographical extent of the trading area in which the mark is used;
(E) the channels of trade for the goods or services with which the mark is used;
(F) the degree of recognition of the mark in the trading areas and channels of trade used by the marks' owner and the person against whom the injunction is sought;
(G) the nature and extent of use of the same or similar marks by third parties; and
(H) whether the mark was registered under the Act of March 3, 1881, or the Act of February 20, 1905, or on the principal register.

Id.

107. Id.

108. Id.

109. Id.
(4) that defendant's use of plaintiff's trademark "causes dilution of the distinctive quality" of plaintiff's trademark.\textsuperscript{110}

If the plaintiff is successful in proving the above elements, then under the FTDA, plaintiff will be entitled to an injunction against the defendant.\textsuperscript{111} However, in cases where the plaintiff can prove that the defendant willfully diluted plaintiff's trademark, then the plaintiff will be entitled to receive damages.\textsuperscript{112} The defendant will have several defenses, as expressly set forth in the FTDA: (1) "fair use" of a famous trademark by another person to identify the good or service of the trademark;\textsuperscript{113} (2) noncommercial use of the trademark;\textsuperscript{114} and (3) "all forms of news reporting and news commentary.\textsuperscript{115}

There are several key differences between the FTDA and state dilution statutes that are worth noting at this point.\textsuperscript{116} First, the FTDA specifically requires that a trademark be famous in order to qualify for protection.\textsuperscript{117} Second, the FTDA omitted the "likelihood of dilution" standard.\textsuperscript{118} Rather, the FTDA states that defendants are enjoined from trademark imitations that "cause[] dilution," suggesting that the plaintiff must prove actual harm rather than the likelihood of harm.\textsuperscript{119} Lastly, the FTDA specifically defines dilution

\textsuperscript{110} Id. In addition, the FTDA defines the term, "dilution" as the "lessening of the capacity of a famous mark to identify and distinguish goods or services, regardless of the presence or absence of—(1) competition between the owner of the famous mark and other parties, or (2) likelihood of confusion, mistake, or deception." Id. § 1127

\textsuperscript{111} Id. § 1125(c)(1). "The owner of a famous mark shall be entitled, subject to the principles of equity and upon such terms as the court deems reasonable, to an injunction against [the defendant] ..." Id.

\textsuperscript{112} Id. § 1125(c)(2). In an action brought under this subsection, the owner of the famous mark shall be entitled only to injunctive relief as set forth in section 34 [15 U.S.C. § 1116] unless the person against whom the injunction is sought willfully intended to trade on the owner's reputation or to cause dilution of the famous mark. If such willful intent is proven, the owner of the famous mark shall also be entitled to the remedies [which are damages] set forth in sections 35(a) and 36 [15 U.S.C. § 1117(a), 1118], subject to the discretion of the court and the principles of equity.

\textsuperscript{113} Id. § 1125(c)(4). "The following shall not be actionable under this section." Id. "Fair use of a famous mark by another person in comparative commercial advertising or promotion to identify the competing goods or services of the owner of the famous mark." § 1125(c)(4)(A).

\textsuperscript{114} Id. § 1125(c)(4)(B) ("Noncommercial use of a mark").

\textsuperscript{115} Id. § 1125(a)(4)(C).


\textsuperscript{117} Id.; see also 15 U.S.C. § 1125(c)(1)(A)-(H).

\textsuperscript{118} Voss, supra note 116, at 270; see also 15 U.S.C. § 1125.

as the loss of the trademark’s ability to “identify and distinguish goods or services.”

Courts have interpreted the FTDA and found that there are three types of dilution: (1) dilution by blurring; (2) dilution by tarnishment; and (3) dilution by cybersquatting. However, courts have found difficulty in applying these types of dilution theories to actual cases. Despite some clarity in the courts as to what types of dilution Congress sought to protect, there has also been confusion as to the temporal requirements of the FTDA. In the past few years, courts have begun to diverge on the issue of whether the FTDA requires plaintiffs to demonstrate some calculable past harm, or merely the possibility of future harm.

C. Confusion in the Courts

Despite Congressional intent to provide uniformity and consistency to the protection of trademarks, case law interpreting the FTDA has resulted in another “patch-quilt system of protection” for trademark owners. As in the

120. Voss, supra note 116, at 270; see also 15 U.S.C. § 1127.

121. Mark R. Becker, Note, Streamlining the Federal Trademark Dilution Act to Apply to Truly Famous Marks, 85 IOWA L. REV. 1387, 1397 (2000). “The first type of dilution, dilution by blurring,” closely resembles the original concept of dilution envisioned by Professor Schechter. Id. Blurring typically occurs when a secondary use of the trademark weakens the uniqueness of the original trademark and its ability to identify the original product. Id.; see also Mead Data Ctr., Inc. v. Toyota Motor Sales, U.S.A., 875 F.2d 1026, 1031 (2d Cir. 1989).

122. Hormel Foods Corp. v. Jim Henson Prods., Inc., 73 F.3d 497, 507 (2d Cir. 1996). “The sine qua non of tarnishment is a finding that plaintiff’s mark will suffer negative associations through defendant’s use.” Id. Courts have found tarnishment where the trademark diluter uses the original trademark to sell products or “services of an obscene, drug-related, or pornographic nature.” Becker, supra note 121, at 1398.

123. Sporty's Farm L.L.C. v. Sportman's Mkt., Inc., 202 F.3d 489, 495 (2d Cir. 2000). Cybersquatting involves the registration as domain names of well-known trademarks by non-trademark holders who then try to sell the names back to the trademark owners” in bad faith. Id. at 493.

124. McCabe, supra note 34, at 1867. Many courts still cannot distinguish between a [dilution] claim and an infringement claim, despite the straightforward Congressional language in the FTDA and the increasing number of suits that include a separate claim for dilution. “Often... courts will view dilution and infringement as descriptions of the same phenomenon... Dilution is not, however, a consequence of infringement.” Id.

125. Voss, supra note 116, at 270. “While the language of the [FTDA] provides substantial guidance for determining the threshold requirements of fame and distinctiveness, it is silent as to how a court should establish dilution.” Id.

126. Ablin & Koshy, supra note 23, at 90-91. “Coming to terms with dilution under the [FTDA] is understandably difficult. The definition of dilution under the [FTDA], in its comparative minimalism, laid itself open to perverse interpretation.” Id. at 90.

127. H.R. REP. NO. 104-374, at 4 (1995), reprinted in 1995 U.S.C.C.A.N. 1029 (stating that “[a] federal dilution statute is necessary because famous marks ordinarily are used on a nationwide basis and dilution protection is currently only available on a patch-quilt system of protection, in that only approximately 25 states have laws that prohibit trademark dilution.”); see also infra notes 151-210 and accompanying text for a discussion of relevant case law.
past, courts have been cautious in granting dilution protection to trademark owners for fear that they are essentially granting a monopoly.\textsuperscript{128} As one commentator has pointed out, courts “will often employ legal gymnastics to reject a dilution claim, imposing artificial limitations on the dilution remedy.”\textsuperscript{129} “As a result, the dilution doctrine has been distorted by the courts in ways that defy or misconstrue its original purpose and parameters.”\textsuperscript{130}

Of the four elements, the first element of “fame,” and the fourth element of “causes dilution” have been critical in the analysis of a dilution claim.\textsuperscript{131} Unlike state legislatures, Congress went to great lengths to limit dilution protection for only “famous” trademarks.\textsuperscript{132} Specifically, Congress listed eight non-exhaustive factors to help courts in determining whether a trademark is famous.\textsuperscript{133} However, due to the lack of clear guidance by Congress, there is much confusion in the courts as to what constitutes a famous trademark.\textsuperscript{134}

Some courts and commentators have even asserted that this prong is the critical component of the FTDA because it restricts the expansive scope of the dilution doctrine.\textsuperscript{135} Commentators have argued that Congress’ “scrupulous attention” to the fame requirement ensures that only a tiny fraction of all trademarks will qualify for dilution protection.\textsuperscript{136} The success

\textsuperscript{128} See Avery Dennison Corp. v. Sumpton, 189 F.3d 868, 875 (9th Cir. 1999) (stating that the “[d]ilution causes of action, much more so than infringement and unfair competition laws, tread very close to granting ‘rights in gross’ in a trademark.”); see also Playboy Enters., Inc. v. Netscape Communications Corp., 55 F. Supp. 2d 1070, 1080-81 (C.D. Cal. 1999), aff’d, 202 F.3d 278 (9th Cir. 1999). “A trademark is not an omnibus property right or a monopoly on the use of the words in the trademark.” Id. “A trademark is a limited property right in a particular word, phrase or symbol. Trade-marks are not monopolistic grants like patents and copyrights.” Id. (citations omitted).

\textsuperscript{129} McCabe, supra note 34, at 1834.

\textsuperscript{130} Id.

\textsuperscript{131} This Comment will focus on the “causes dilution” prong rather than the “fame” prong for the reasons stated in the text. For a full discussion of the “fame” prong, see generally Becker, supra note 121.


\textsuperscript{133} Id.; see infra note 107 for a list of the eight factor test.

\textsuperscript{134} See Becker, supra note 121, at 1408. As Becker points out, circuit courts have taken inconsistent approaches to analyzing the “fame” element. Id.

\textsuperscript{135} See id. at 1395-96; see also Avery Dennison Corp. v. Sumpton, 189 F.3d 868, 875 (9th Cir. 1999) (stating that “[w]e view the famousness prong . . . as reinstating the balance—by carefully limiting the class of trademarks eligible for dilution protection . . . .”); see also I.P. Lund Trading Aps v. Kohler Co., 163 F.3d 27, 46 (1st Cir. 1998) (stating that the FTDA extends only to “truly prominent and renowned” trademarks) (citation omitted).

\textsuperscript{136} Ablin & Koshy, supra note 23, at 75 (“Congress’ scrupulous attention to the fame requirement and the rigor with which it intends that the requirement be enforced ensures that only a tiny fraction of all trademarks will qualify for protection from dilution.”); see also Becker, supra note 121, at 1395-96 (asserting that the fame element “has become one of the courts’ most effective means of controlling the potential rights-in-gross problem of dilution theory”).
of the famous prong in limiting the power of the FTDA is beyond the scope
of this Comment.\footnote{137} Instead, for the reasons stated below, this Comment will
focus on the second hurdle of the FTDA—the "causes dilution" prong.\footnote{138}

Several commentators have suggested that this is actually the critical
component of the FTDA.\footnote{139} This is because depending on how the phrase
"causes dilution" is interpreted, the owner of a famous trademark might be
forced to prove that they have suffered past dilution.\footnote{140} This issue is critical
to a proper dilution analysis because it determines just how much protection
the owner of famous trademark will receive under the FTDA.\footnote{141} A broad
interpretation of the "causes dilution" test gives will make it easier for
plaintiffs to prove their case.\footnote{142} However, this "would effectively give
trademark owners property rights in gross, and thereby upset the careful
balance achieved in the existing system."\footnote{143} On the other hand, a restrictive
reading might leave the plaintiffs with no remedy at all.\footnote{144} This would
effectively defeat the purpose of the FTDA to protect owners of famous
trademarks from dilution.\footnote{145}

\footnote{137. For a full discussion of success of the "fame" prong in limiting the power of the FTDA, see
generally Becker, supra note 121.}

\footnote{138. See infra notes 139-50 and accompanying text.}

\footnote{139. 15 U.S.C. § 1125(c)(1) (stating that the owner of a famous trademark is entitled to relief if
another person’s use of the famous trademark “causes dilution of the distinctive quality of the
mark”); see also 4 MCCARTHY, supra note 90, at 24:114 “The pros and cons of the dilution doctrine
have been extensively argued by many legal writers.” Id. Suffice it to say that the issue of whether
the dilution idea is a good one is still controversial and remains to be definitely resolved. Id. One’s
attitude depends in large upon how much protection one thinks a trademark deserves, given the goal
of free competition. Id. “Unless these state statutes and the [FTDA] are repealed or read into
obscurity by the courts, trademark law’s historic balance between free and fair competition will
falter, undermining market efficiency and consumer welfare.” Klieger, supra note 13, at 865-66.}

\footnote{140. See Voss, supra note 116, at 266 (“However, the language of the [FTDA], while providing
guidance for determining whether a mark is sufficiently famous to qualify for protection, is silent on
the issue of how to prove dilution.”). Compare Ringling Bros.-Barnum & Bailey Combined Shows,
Inc. v. Utah Div. of Travel Dev., 170 F.3d 449, 464 (4th Cir. 1999) (overruling the lower court on
the issue of the “causes dilution” test), with Nabisco, Inc. v. PF Brands, Inc., 191 F.3d 208, 224 (2d
Cir. 1999) (explicitly rejecting the Fourth Circuit’s analysis of the “causes dilution” test).}

\footnote{141. Voss, supra note 116, at 266. “Because dilution offers such a potentially expansive
exclusory right, determining precisely what a plaintiff must prove to establish dilution is vital to
maintaining the proper balance between fair competition and free competition.” Id.}

\footnote{142. Ringling Bros., 170 F.3d at 456 (stating that an expansive reading of the FTDA would grant
the owner of famous mark a property right in gross, a right which is comparable to copyright and
patent law).}

\footnote{143. Voss, supra note 116, at 267; see also 4 MCCARTHY, supra note 90, at 24:114.

[N]o anti-dilution law should be so interpreted and applied as to result in granting the
owner of a famous mark the right to exclude any and all uses of similar marks . . . . Such
a radical expansion of trademark exclusory rights would upset the delicate balance
between free competition and fair competition. Id.}

\footnote{144. Voss, supra note 116, at 267; see also Nabisco Inc. v. PF Brands, Inc., 191 F.3d 208, 224
(2d Cir. 1999) (rejecting the Fourth Circuit’s “actual consummated” harm interpretation and holding
that the “causes dilution” test encompasses a remedy for future harm).}

\footnote{145. Id. “To read the statute [narrowly] would subject the [owner of a famous trademark] to
uncompensable injury. The statute could not be invoked until the injury had occurred. And because

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The battlelines have been drawn, and the battle is between big businesses and small businesses. The big businesses, who usually own famous trademarks favor the future harm standard because they want to enjoin potential diluters before they incur any harm. Conversely, the small businesses want courts to stick to the more stringent past harm standard because it makes it more difficult more owners of famous trademarks to enjoin them. Within the past two years, the circuits courts have split as to which standard to apply. The growing divergence in interpretation of the FTDA began two years ago between the Fourth and Second Circuit.

IV. SPLIT IN THE CIRCUIT COURTS

A. Ringling Bros.-Barnum & Bailey Combined Shows, Inc. v. Utah Division of Travel Development

1. Facts

In Ringling Bros. v. Utah Division of Travel Development, plaintiff, Ringling Bros.-Barnum & Bailey Combined Shows, Inc. (hereinafter "Ringling Bros.") sued defendant, Utah Division of Travel (hereinafter...
“UTD”) alleging that defendant’s use of the slogan “Greatest Snow on Earth” diluted its trademark, “Greatest Show on Earth.”

Since 1872, Ringling Bros. has offered and promoted their circus to the public by using the slogan, “Greatest Show on Earth.” In 1996, Ringling Bros. spent approximately nineteen million dollars in using its slogan to advertise its trademark through various media such as magazines, radio, television, videos, and billboards. It is estimated that about seventy million people each year are exposed to the “Greatest Show on Earth” trademark. In 1961, Ringling Bros. received federal trademark registration for its trademark.

As early as 1962, UTD, an agency of the state of Utah, began using its slogan, “Greatest Snow on Earth,” to promote winter tourism. Since then, UTD has spent about 300,000 to 450,000 dollars per year advertising its slogan, mainly on automobile license plates. Despite the protest by Ringling Bros., UTD received federal registration of its trademark in 1997.

2. Fourth Circuit Decision

In analyzing Ringling Bros.’s dilution claim, the court set forth the following elements as Ringling Bros.’s burden of proof: (1) that its trademark was “famous”; (2) that UTD adopted its trademark after Ringling Bros. had become famous; and (3) that UTD’s trademark diluted Ringling Bros.’s trademark by “blurring.” In analyzing the first element, the court made a cursory ruling on the first and second elements. The court specifically addressed the issue of whether UTD’s trademark diluted Ringling Bros.’s trademark by “blurring.” The court gave deference to the district court’s opinion that dilution by blurring occurs not merely because consumers mistakenly confuse the two trademark, but because consumers confuse the two trademarks and the goods that the trademarks are associated with. Moving on, the court stated that this left the critical issue of whether
UTD’s trademark had diluted Ringling Bros.’s famous trademark.\(^{164}\)

The bulk of the court’s analysis involved defining what it meant to “dilute” a trademark.\(^{165}\) In interpreting the statutory language of the FTDA, the court delved into the history and evolution of the dilution doctrine due to the “sheer difficulty that courts have had in getting a firm handle on the basic concept of ‘dilution.’”\(^{166}\) But eventually, the court broke down the plaintiff’s burden of proof into three elements:

1. A sufficient similarity between the junior and senior [trade]marks to evoke an ‘instinctive mental association’ of the two by a relevant universe of consumers which

2. Is the effective cause of

3. An actual [harm to] the senior [trade]mark’s selling power. . . .\(^{167}\)

The court conceded that this was a “stringent application” of dilution under the FTDA because it forced Ringling Bros. to prove that it suffered actual economic harm, instead of proving that it was likely to suffer economic harm in the future.\(^{168}\) The court arrived at this conclusion by analyzing the definition of “dilution” given in the text of the FTDA.\(^{169}\) The court reasoned that a broad interpretation of the meaning of dilution grants a property-right-in-gross to the owner of the senior trademark, and that the text of the FTDA required proof of actual harm already caused by use of a junior trademark.\(^{170}\)

\(^{164}\) Id. The court specifically addressed the issue of whether UTD’s trademark diluted Ringling Bros.’s trademark by “blurring” it. Id. The court gave deference to the district court’s opinion that dilution by blurring occurs not merely because consumers mistakenly confuse the two trademarks, but because consumers confuse the two trademarks and the goods that the trademarks are associated with. Id. at 453 (quoting Ringling Bros. Bros.-Barnum & Bailey Combined Shows, Inc. v. Utah Div. of Travel Dev., 55 F. Supp. 605, 615-16 (E.D. Va. 1997)).

\(^{165}\) Id. at 453-61.

\(^{166}\) Id. at 453-56. In embarking on the difficult task of defining dilution, the court admitted that “more than thirty years after courts first began grappling with the interpretive problem . . . ‘dilution remains a somewhat nebulous concept.’” Id. at 455 (quoting Sally Gee, Inc. v. Myra Hogan, Inc. 699 F.2d 621, 625 (2d Cir. 1983)).

\(^{167}\) Id. at 458.

\(^{168}\) Id. at 458-59.

\(^{169}\) Id. at 458. The court quoted the FTDA, which defined dilution as “the lessening of the capacity of a famous mark to identify and distinguish goods or services.” Id.

\(^{170}\) Id. at 459-60. The court opined that the textual definition of dilution can be interpreted as follows: (1) that the FTDA intended to protect the “distinctiveness” of the word symbol, or (2) that the FTDA allows the court to presume that the owner of the famous trademark has suffered
To bolster its position, the court primarily relied on the plain meaning rule. The court stated that the phrase “causes dilution” did not mean “mere threatened” dilution of the famous trademark. In addition, the court reasoned that taken in context of the entire statute, the word “capacity” referred to the lessening of the “former capacity” of the famous trademark to distinguish itself. Thus, the court reasoned that the FTDA was intended to protect past economic harm rather than future economic harm. Lastly, the court reasoned that the FTDA was not intended to protect possible future dilution because Congress deliberately omitted the phrase “likelihood of dilution” from the text of the FTDA.

B. Nabisco, Inc. v. PF Brands, Inc.

1. Facts

In Nabisco, Inc. v. PF Brands, Inc., plaintiff, Pepperidge Farm, sued defendant, Nabisco alleging that Nabisco’s fish shaped crackers diluted its goldfish-shaped cheese crackers, commonly known as Goldfish. Since 1962, Pepperidge Farm has produced small cheese crackers in the shape of a Goldfish. Between 1995 and 1998, Pepperidge Farm spent more than one hundred twenty million dollars marketing its goldfish crackers. To date, Pepperidge Farm’s Goldfish is the second largest selling cheese cracker in America, and ranks number one when measured in dollar sales. Since 1962, Pepperidge Farm has obtained many trademark economic harm due to the similarity of the senior and junior trademarks. However, the court rejected both of these interpretations.

171. Id. at 459. However, the court rejected both of these interpretations. Id.

172. Id. at 461. The court also argued that the text of the FTDA did not state “will” or “may” cause, but instead merely stated “causes” dilution. Id.

173. Id. at 460. The court stated that the word, “capacity” was temporally neutral, but in context of the FTDA, “it is plain that the ‘capacity’ spoken of is ‘former capacity’” and not future capacity. Id.

174. Id. at 460-61.

175. Id. at 461. “Finally and most telling, there is the fact that in the face of the obvious centrality of ‘likelihood of dilution’ provisions in the interpretation and application of state antidilution statutes for the fifty years of their existence, the federal Act does not so provide.” Id.

176. 191 F.3d 208 (2d Cir. 1999).

177. Id. at 212. Pepperidge Farm also sued under New York’s antidilution statute. Id.

178. Id.

179. Id. at 213. During this period, net sales of Goldfish crackers more than doubled, to $200 million per year. Id.

180. Id.
registrations for the use of its Goldfish trademark.\textsuperscript{181}

In 1998, Nabisco planned to produce small fish-shaped crackers, similar to Pepperidge Farm’s Goldfish line.\textsuperscript{182} Soon thereafter, upon learning of Nabisco’s plans, Pepperidge Farm sent a cease and desist letter to Nabisco, demanding that Nabisco halt the production of its crackers.\textsuperscript{183} In 1999, both parties sought legal action, with Pepperidge Farm seeking a preliminary injunction against Nabisco under federal dilution law.\textsuperscript{184}

2. Second Circuit Decision

Just five months after the decision by the Fourth Circuit, on August 31, 1999, the Second Circuit explicitly rejected the Fourth Circuit’s interpretation of the FTDA.\textsuperscript{185} Unlike the Fourth Circuit,\textsuperscript{186} the Second Circuit ruled that the plaintiff must prove five elements to succeed on a dilution claim: (1) that the senior trademark must be famous; (2) that the senior trademark must be distinctive; (3) that “the junior use must be a commercial use in commerce”; (4) that the junior use must begin after the senior trademark has become famous; and (5) that the junior trademark must cause dilution of the distinctive quality of the senior trademark.\textsuperscript{187} Of these five elements, the court engaged in a cursory analysis of the first, third, and fourth elements, and ruled that Pepperidge Farm met them all.\textsuperscript{188} Like the Fourth Circuit, the court undertook an extensive analysis of the fifth element, by interpreting the statutory phrase, “causes dilution of the distinctive quality of the [famous] mark.”\textsuperscript{189}

\textsuperscript{181} Id. at 212.
\textsuperscript{182} Id. at 213.
\textsuperscript{183} Id.
\textsuperscript{184} Id. Nabisco initiated legal proceedings by filing a complaint seeking declaratory judgment that it did not violate Pepperidge Farm’s rights in the Goldfish line. Id. “Pepperidge Farm counterclaimed that Nabisco’s crackers constituted trademark infringement... and dilution under” both federal and New York state law. Id.
\textsuperscript{185} Id. at 223 (“We reject [defendant’s] argument because we disagree with the Fourth Circuit’s interpretation of the statute.”).
\textsuperscript{186} Ringling Bros.-Barnum & Bailey Combined Shows, Inc. v. Utah Div. of Travel Dev., 170 F.3d 449, 453 (4th Cir. 1999) (interpreting the FTDA to require a plaintiff to prove three elements).
\textsuperscript{187} Nabisco, Inc. v. PF Brands, Inc., 191 F.3d 208, 215 (2d Cir. 1999).
\textsuperscript{188} Id. The court stated that it is undisputed that Pepperidge Farm’s Goldfish is a famous trademark. Id. In addition, the court stated that it was clear that Nabisco engaged in commercial use of its trademark, and that it began after Pepperidge Farm’s trademark became famous. Id.
\textsuperscript{189} Id. at 214. However, unlike the Fourth Circuit, the Second Circuit initially analyzed the meaning of the term, “distinctiveness” because the court ruled that the plaintiff must prove an independent element of “distinctiveness,” separate from the element of “fame.” Id. at 215.
More specifically, the Second Circuit turned to the interpretation of the phrase, "causes dilution." The court explicitly rejected the Fourth Circuit’s reading of this phrase and stated that the Fourth Circuit’s reading relied on "excessive literalism." Thus, the Second Circuit ruled that plaintiffs need not show actual economic harm in order to receive protection under the FTDA.

The court adopted a non-exhaustive ten-factor test to allow the owner of a famous trademark to prove possible future harm. The court admitted that a simple reading of the statute lends support for holding that the plaintiff must prove actual consummated economic harm. However, the court warned that this "defeat[s] the intent of the statute." The court reasoned that Congress provided an injunction as a remedy, and as such Congress intended to prevent the harm before it occurred. The court argued that forcing both parties to wait until the harm had occurred would cause "uncompensable injury" to the plaintiff and uncertainty for the defendant. Thus, the court concluded that injunctive relief should be granted to owners of famous trademarks even before the dilution actually occurred.

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190. Id. at 223-24.
191. Id. at 224.
192. Id. at 224-25.
193. Id. at 217-22. The factors are:
   (A) Distinctiveness;
   (B) Similarity of the marks;
   (C) Proximity of the products and likelihood of bridging the gap;
   (D) Interrelationship among the distinctiveness of the senior mark, similarity of the junior mark, and the proximity of the products;
   (E) Shared consumers and geographic limitations;
   (F) Sophistication of consumers;
   (G) Actual confusion;
   (H) Adjectival or referential quality of junior use;
   (I) Harm to the junior user and delay by the senior user; and
   (J) Effect of senior’s prior laxity in protecting the mark.

Id.
194. Id. at 224. “We recognize that the language of the statute gives some support to this reading, in that it uses the formulation, ‘causes dilution,’ rather than referring to ‘likelihood of dilution.’” Id. (citing Ringling Bros.-Barnum & Bailey Combined Shows, Inc. v. Utah Div. of Travel Dev., 170 F.3d 449, 464 (4th Cir. 1999)).
195. Id. The court stated that the Ringling Bros. decision relied on “excessive literalism” to defeat the intent of the FTDA. Id.
196. Id.
197. Id. The court stated that under the actual harm standard, the owner of the famous trademark had to wait until the harm had occurred. Id. However, since the statute only provides injunctive relief, except in cases of willfulness, the owner of the famous trademark might not be able to recover damages. Id. In addition, the court stated that limiting remedy to only those who have suffered past harm is also "disastrously disadvantageous for the junior user." Id. This is because the senior user "will be obligated to spend huge sums involved in a product launch without the ability to seek prior judicial assurance that their mark will not be enjoined." Id.
198. Id. at 225.

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V. RECONCILING THE SPLIT IN THE CIRCUIT COURTS

The split between the Second and Fourth Circuits illustrates the importance placed on the proper interpretation of the "causes dilution" test. Moreover, the sharp difference in interpretive methodology demonstrates the fierce battle between those who favor the idea that famous trademarks should be given protection from dilution and those who believe that the FTDA grants excessive power to successful companies that own famous trademarks. This "David versus Goliath" battle has been fought in the trenches of the text of the FTDA. The central issue is whether the FTDA requires the owner of a famous trademarks to prove past economic harm or merely prove likelihood of future harm.

The Fourth Circuit concluded that trademark owners must adhere to the stricter standard of establishing past economic harm. This may be an impossibility for situations where a famous trademark has recently started to become diluted. Nevertheless, other courts have begun to side with the approach taken by the Fourth Circuit. Recently, the Fifth, Seventh and...
Ninth Circuits have adopted the Fourth Circuit’s actual harm standard.\textsuperscript{206} These courts have mainly relied on the plain meaning of the statute, and thus have taken a “textualist approach.”\textsuperscript{207}

The Second Circuit explicitly rejected this approach as “excessively literal,” and justified its holding by relying on the legislative history of the FTDA.\textsuperscript{208} The Third Circuit has adopted the Second Circuit’s flexible future harm standard.\textsuperscript{209} These courts have taken a “realist approach” to allowing businesses to recover against potential trademark diluters.\textsuperscript{210}

\textbf{A. Textualist Approach}

The “plain meaning rule” states that “[i]f the words convey a definite meaning, which involves no absurdity, nor any contradiction of other parts of the instrument, then that meaning, apparent on the face of the instrument, must be accepted . . . .”\textsuperscript{221} As the Fourth Circuit contended, the courts must first look to the plain meaning of the FTDA, because a purely textual interpretation of the FTDA carries the greatest interpretative weight.\textsuperscript{212}

\begin{itemize}
  \item Eleventh Circuit: Carnival Corp. v. Seascapes Casino Cruises, Inc., 74 F. Supp. 2d 1261, 1269 n.4 (S.D. Fla. 1999) (“There is a split between the Fourth and Second Circuits regarding whether proof of actual economic harm is necessary to prove dilution . . . . but the Court need not address it as it finds that the [trademark] is not famous.”).
\end{itemize}

\begin{itemize}
  \item 206. \textit{Westchester Media}, 214 F.3d at 670 (“As an issue of first impression in this Circuit, we endorse the Fourth Circuit’s holding that the FTDA requires proof of actual harm . . . . ‘\textit{Syndicate Sales}, 192 F.3d at 633; \textit{Playboy}, 55 F. Supp. 2d at 1075. Plaintiff must show that the defendant has caused actual economic harm to establish dilution. \textit{Id.} (citing \textit{Ringling Bros.}, 170 F.3d at 459).”
  \item 207. \textit{Ringling Bros.}, 170 F.3d at 460 (“We cannot accept [the future harm standard] as a matter of the [FTDA’s] plain meaning.”); \textit{Westchester Media}, 214 F.3d at 670 (“[W]e endorse the Fourth Circuit’s holding that the FTDA requires proof of actual harm since this standard best accords with the plain meaning of the statute.”).
  \item 208. Nabisco, Inc. v. PF Brands, Inc., 191 F.3d 208, 224 (2d Cir. 1999). “In our view, however, [the Fourth Circuit’s actual harm standard] depends on excessive literalism to defeat the intent of the statute.” \textit{Id.}
  \item 209. \textit{Times Mirror Magazines, Inc. v. Las Vegas Sports News, L.L.C.}, 212 F.3d 157, 168 (3d Cir. 2000), cert. denied, 531 U.S. 1071 (2001). “In \textit{Nabisco}, the Court of Appeals for the Second Circuit articulated a more complete set of factors for dilution . . . . ‘\textit{Id.} Because we consider the dilution analysis in \textit{Nabisco} helpful, we apply it to facts found by the district court.” \textit{Id.}
  \item 210. \textit{Nabisco}, 191 F.3d at 224. “Notwithstanding the use of the present tense in ‘causes dilution,’ it seems plausibly within Congress’ meaning to understand the statute as intending to provide for an injunction to prevent the harm before it occurs.” \textit{Id.} (emphasis added).
  \item 211. \textit{Ringling Bros.}, 170 F.3d at 461 n.6 (quoting Lake County v. Rollins, 130 U.S. 662, 670 (1889)). “[W]e are not free to depart from that plain meaning . . . .” \textit{Id.}
  \item 212. \textit{Voss, supra note 116, at 278}. However, the Fourth Circuit did not delve into the legislative history of the FTDA. See \textit{id.} “While purely textual arguments undoubtedly carry the greatest interpretive weight, legislative history plays a useful role in the interpretive process. The court in \textit{Ringling Bros.} however, makes no attempt to reconcile its interpretation requiring actual harm and proof of economic loss with the Dilution Act’s legislative history.” \textit{Id.}
\end{itemize}
Although the Second Circuit accused the Fourth Circuit of engaging in “excessive literalism,” as a commentator has noted, the Fourth Circuit did not engage in an elaborate analysis of the plain meaning of the FTDA.\(^{213}\)

Under the plain meaning rule, a court must accept the plain meaning of the FTDA, so long as there is “no absurdity, nor any contradiction of other parts” of the FTDA.\(^{214}\) However, as the realists have pointed out, interpreting the statute to require proof of past economic harm rather than possible future harm would lead to an absurd reading of the statute.\(^{215}\) If the plaintiff had to prove past economic harm, then essentially the plaintiff could not invoke the FTDA until there has been some measure of economic harm.\(^{216}\) This could lead to disastrous results for companies such as Nabisco and Ringling Bros. who spend millions of dollars every year protecting the value of their trademarks.\(^{217}\)

In addition, under the textualist approach, companies may never be unable to recover their economic loss.\(^{218}\) This is because under the FTDA, the primary remedy for the plaintiff’s injury is an injunction.\(^{219}\) Textualist argue that the plaintiff may be economically compensated because the FTDA does provide for damages.\(^{220}\) However, it provides damages only in rare cases where a trademark was diluted through willful action.\(^{221}\) Thus, in

\(^{213}\) See id. at 276-77 (applying other interpretive corollaries of the plain meaning rule to the text of the FTDA).

\(^{214}\) Ringling Bros., 170 F.3d at 461 n.6 (quoting Lake County, 130 U.S. at 670).

\(^{215}\) Nabisco, 191 F.3d at 224. “To read the statute as suggested by the Ringling [Bros.] opinion would subject the senior user to uncompensable injury.” Id. This reading means that the “statute could not be invoked until the injury had occurred.” Id.

\(^{216}\) Id.

\(^{217}\) Id. supra note 13, at 852.

By the early 1990’s, the cost to a company of introducing a new consumer product had grown to as much as $100 million, with the odds of success no greater than one in ten. Trademarks serve as “a narrow bridge over which all the traffic powered by [product] advertising must pass.”

\(^{218}\) Nabisco, 191 F.3d at 224. “[B]ecause the statute provides only for an injunction and no damages (absent willfulness) . . . such injury would never be compensated.” Id.

\(^{219}\) Federal Trademark Dilution Act (FTDA), 15 U.S.C. § 1125(c)(1) (Supp. IV 1998) (“The owner of a famous mark shall be entitled, subject to the principles of equity and upon such terms as the court deems reasonable, to an injunction . . . .”).

\(^{220}\) Ringling Bros.-Barnum & Bailey Combined Shows, Inc. v. Utah Div. of Travel Dev., 170 F.3d 449, 461 (4th Cir. 1999). “Unlike the statute antidilution statutes which provide only injunctive relief, reflecting their sole focus on prevention of future harm, the federal Act provides that where willful conduct is shown, both compensatory and restitutionary relief may be awarded—for necessarily consummated economic harm.” Id.

\(^{221}\) 15 U.S.C. §1125(c)(2) (stating that “the owner of the famous mark shall be entitled only to injunctive relief unless the person against whom the injunction is sought willfully intended to trade on the owner’s reputation or to cause dilution of the famous mark”); see also Nabisco, 191 F.3d at 224 (“The Ringling [Bros.] reading is . . . disastrously disadvantageous . . . .”).
most cases of dilution, where there is an absence of willfulness, companies such as Nabisco and Ringling Bros. will only be able to enjoin the defendant and ultimately be left with an uncompensated economic injury.222

Another shortcoming of the textualist approach is that it requires plaintiffs to take on the uncertain task of providing the court with proof of economic harm.223 The court in Ringling Bros. admitted that “[p]roof will be difficult, because actual, consummated dilutive harm and its cause are difficult concepts,”224 but the court suggested three general means of available proof: (1) loss of revenue; (2) survey evidence; and (3) indirect evidence through the use of contextual factors.225 However, as the realists pointed out, these methods of proof are “inappropriate” because they are inaccurate, expensive, and prone to manipulation.226 Furthermore, in the absence of significant legal resources, it would be nearly impossible for companies to resort to these methods to show economic harm.227

There is another absurdity with the textualist approach. The position taken by the textualists in Ringling Bros. worked because in Ringling Bros.,

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222. Nabisco, 191 F.3d at 224. “And, because the statute provides only for an injunction and no damages (absent willfulness), such injury would never be compensated.” Id. (citation omitted).

223. Ringling Bros., 170 F.3d at 460. However, the court cited specific reasons for the actual harm standard. Id.

Nor can it be said (as perhaps it can with respect to proving mere “likelihood of dilution”) that even if it is the fact that actual economic harm caused by replicating junior use has occurred, there is no way to prove those facts independently. Though proof of those elements of the elusive dilution concept may tax the skills of advocacy, that results more from their substantive uncertainty than from lack of available means of proof. . . . [T]here are means of proving them by normal evidentiary processes. Impossibility or near-impossibility of proving them does not support their judicial presumption.

224. Id. at 464.

225. Id. at 465.

226. Nabisco, 191 F.3d at 223-24. The Second Circuit pointed to some of the practical problems associated with the textualist approach. See id.

To require proof of actual loss of revenue seems inappropriate. If the famous senior mark were being exploited with continually growing success, the senior user might never be able to show diminished revenues, no matter how obvious it was that the junior use diluted the distinctiveness of the senior. Even if diminished revenue could be shown, it would be extraordinarily speculative and difficult to prove that the loss was due to the dilution of the mark. . . . If a junior user began to market Buick aspirin or Schlitz shellac, we see no reason why the senior users could not rely on persuasive circumstantial evidence of dilution of the distinctiveness of their marks without being obligated to show lost revenue or engage in an expensive battle of surveys. . . . We see no reason why [circumstantial evidence] should not be used to prove dilution.


227. Nabisco, 191 F.3d at 224 (arguing that proof of actual loss is expensive and time-consuming).
the defendant had been allegedly diluting plaintiff’s trademark for about thirty years.228 However, this was not the case in Nabisco where the plaintiff sought to enjoin the defendant even before the defendant began diluting plaintiff’s trademark.229 In Nabisco, the plaintiff claimed that the use of defendant’s trademark might cause dilution.230 This meant that there was not yet any economic harm to plaintiff’s trademark.231 However, if the plaintiff in Nabisco had to follow the textualist approach, then the plaintiff would have been required to do the impossible—to establish past economic harm where there was none.232 Thus, the textualist approach leads to an absurd result when it is taken away from the fact pattern of Ringling Bros. and tested in cases such as Nabisco.233

Finally, the textualist approach undermines the essence of the dilution doctrine.234 The textualist approach implies that the FTDA requires the passage of time before there can be a remedy against dilution.235 As courts and commentators have pointed out, requiring plaintiffs to stand by while their trademarks are being diluted hurts the businesses which have made

228. Ringling Bros.-Barnum & Bailey Combined Shows, Inc. v. Utah Div. of Travel Development, 170 F.3d 449, 451 (4th Cir. 1999). In Ringling Bros., defendant’s junior trademark had allegedly been diluting plaintiff’s senior trademark for about thirty-four years. Id. This period started from when defendant began using its trademark, which was about 1962, to when plaintiff brought its suit, which was 1996. Id. at 451-52.

229. Nabisco, 191 F.3d at 213. In Nabisco, the plaintiff brought its lawsuit before the defendant marketed its similar goldfish trademark. Id. “In mid-December 1998, executives at Pepperidge Farm for the first time saw a sample of [defendant’s trademark]. On December 21, Pepperidge Farm wrote to Nabisco protesting the goldfish-shaped cracker and requesting that Nabisco cease and desist use of that cracker in its product and marketing.” Id.

230. Id.

231. Id. “Nabisco responded by filing a complaint against Pepperidge Farm seeking a declaratory judgment that [its trademark] did not violate any of Pepperidge Farm’s rights in the Goldfish.” Id. (citation omitted).

232. Id. at 223. The court in Nabisco stated that the Fourth Circuit’s approach was an “arbitrary and unwarranted limitation on the methods of proof.” Id.

233. See id. at 224. In addition, the court in Nabisco pointed out the practical problems that the junior user might face if the junior user had to adhere to the Fourth Circuit’s ruling. Id.

If the statute is interpreted to mean that no adjudication can be made until the junior mark has been launched and has caused actual dilution, businesses in Nabisco’s position will be unable to seek declaratory relief before going to market. They will be obligated to spend the huge sums involved in a product launch . . .

Id.

234. Welkowitz, supra note 65, at 584. “The real justification for the use of dilution is more the protection of marks against misappropriation than against ‘whittling away.’ Courts and commentators, explicitly or implicitly, believe it to be unfair for a second user to gain any advantage in the marketplace by using the first user’s mark.” Id.

235. Id. at 588. “Dilution is a theory that requires the passage of time and possible additional users for the process to be complete.” Id.
significant investments in creating and promoting their trademarks. By allowing diluters to more easily dilute a famous trademark, the trademark owner will have less incentive to invest significantly in a trademark. The incentive then would be to produce the lowest possible quality of trademarks. Ultimately, this would create a marketplace devoid of trademarks that consumers can rely on. The effect of the textualist approach is detrimental to consumers because they will no longer be able to trust the trademark to signal a certain quality of product or service.

B. Realist Approach

In explicitly rejecting the textualist approach to the dilution problem, the realists have relied on evidence other than the text of the FTDA to determine the temporal requirement. The realists argue that the textualist approach can lead to absurd results, especially when applied in cases such as

236. Klieger, supra note 13, at 855. “Without trademarks or legal protection of trademarks against public deception, consumer search costs would be dramatically higher, the incentive for quality production would disappear, and competitive markets would cease to function.” Id; see also Nabisco, 191 F.3d at 224 (arguing that without dilution protection, companies will be obligated to spend huge sums of money without the ability to seek judicial assurance).

237. McCabe, supra note 34, at 1834. “[A]dvocates argue that trademarks in fact encourage competition and . . . incentivize companies to develop marks that are unique or arbitrary.” Id.

238. Klieger, supra note 13, at 855. Klieger explained a world without incentives for businesses to invest in trademarks. Id. “[T]rademarks do more than indicate consistent product quality to consumers; as compared to a world without trademarks, they also heighten the level of quality that consumers can expect.” Id.

A world without trademarks would be very difficult to imagine. If everything came in a plain brown wrapper, the incentive to try to make a better product than the competition would be thrown into complete reverse. The incentive then would be to produce the lowest possible quality, because the consumer would not be able to tell the difference and thus would not be in a position to retaliate against any particular supplier by refusing to buy his product in the future.

Id. (citing Sidney A. Diamond, The Public Interest and the Trademark System, 62 J. PAT. OFF. SOC’T 528, 544 (1980)).

239. See id.

In other words, if a consumer is unable to quickly and easily identify unsatisfactory products, producers have no incentive in the form of lost sales to improve product quality. Consumers might still be able to rely on a consistent level of quality; unfortunately, that level will, for all products, be the lowest level of quality imaginable.

Id.

240. See id. Through the use of a hypothetical, Klieger explained the detrimental effect of the textualist approach on consumers. See id.

If, for example, a consumer bought a box of ‘Lucky Charms’ believing it was manufactured by General Mills, but it was actually manufactured by the Barely Edible Cereal Company, consumer dissatisfaction with the product would be visited upon General Mills. General Mills would have no incentive to maintain a higher level of quality than Barely Edible were such gross public deception not actionable.

Id.

241. Nabisco, Inc. v. PF Brands, Inc. 191 F.3d 208, 224 (2d Cir. 1999). The Second Circuit stated that “it seems plausibly within Congress’s meaning to understand the [FTDA] as intending to provide for an injunction to prevent the harm before it occurs.” Id.
Thus, they argue that it is necessary to look beyond the statute and into the intent of Congress in aiding their understanding of the FTDA. Relying on the legislative history of the FTDA, the realists argue that Congress did not intend for the plaintiff to provide proof of past economic harm. They reason that if Congress intended to provide such an obstacle for the plaintiff, then Congress would have provided for such a provision in the text of the FTDA. Thus, they contend that the absence of such a provision implies that Congress did not intend for plaintiff to meet such a high burden. In addition, they argue that Congress contemplated that the harm caused by dilution would occur in the future. In the House Report, Congress stated “dilution is an infection, which if allowed to spread, will inevitably destroy the advertising value of the mark.” This language suggests that Congress intended to protect the trademark holder before the injury actually occurred.

242. Voss, supra note 116, at 276-77. [Interpreting the [FTDA] to require actual harm created not only an uncompensable injury, it makes it unlikely the holder of a famous mark could enjoin any diluting use until substantial injury had already occurred. By inevitably leading to an substantial uncompensated injury, the [textualists'] actual harm interpretation arguably creates an absurdity.]


As for the propriety of using legislative history at all, common sense suggests that inquiry benefits from reviewing additional information rather than ignoring it. . . . Our precedents demonstrate that the Court’s practice of utilizing legislative history reaches well into its past. . . . We suspect that the practice will likewise reach well into the future.]

Id. 244. Id. at 278.

The legislative history is replete with discussion of the fame and distinctiveness barrier, but nowhere in the legislative history of either the 1988 dilution bill, the Dilution Act, or the Report of the Trade Mark Commission is it suggested that a plaintiff must demonstrate . . . the far more difficult showing of actual [past] harm.

Id. at 278-79. “[T]o ensure that the bill does not supplant the current protection of trademarks . . . the committee amended the legislation to place greater emphasis . . . a sufficient level of fame . . . to qualify for federal protection [from dilution]. . . .” S. REP. No. 100-515, at 41-42 (1988), reprinted in 1988 U.S.C.C.A.N. 5577.

245. Voss, supra note 116, at 279 “It seems strange that Congress would omit any mention of an actual harm requirement in [the House Report for the FTDA]—a substantial additional hurdle—if one was intended.” Id. 246. See id.

247. Id. (“The ‘loss’ Congress sought to remedy was a loss in a mark’s distinctiveness, not solely its economic value.”); see also H.R. REP. No. 104-374, at 3 (1995), reprinted in 1995 U.S.C.C.A.N. 1029.

248. Id. (emphasis added).

However, as a commentator has indicated, the text of the FTDA contradicts the realist approach. First, unlike the state dilution statutes, the FTDA expressly requires that a trademark be famous in order to qualify for protection. Furthermore, Congress went to great lengths to specify what constitutes a famous trademark, listing eight non-exhaustive factors for courts to consider in making this determination. However, as the commentator pointed out, Congress did not do the same with the "causes dilution" element. In fact, Congress specifically omitted the "likelihood of dilution" language that is commonly found in state dilution statutes. This specific omission by Congress directly undermines the position taken by the realists.

The realists claim that the textualist approach is simply unrealistic and impractical. As the Fourth Circuit admitted, requiring the owner of the senior trademark to prove actual harm is an uncertain and near-impossible task. The realists argue that there are practical problems with providing the court with evidence of past economic harm. Relying on practical concerns, the realists reason that their flexible ten-factor test is more realistic and practical for plaintiffs to use in establishing dilution.

However, there are also problems applying the realists' flexible ten-factor test. Commentators have criticized the court's ten-factor future

the unauthorized use of a famous mark reduces the public's perception that the mark signifies something unique... and [when] 'the distinctive quality of a mark could be materially reduced during a period of rising sales.' Voss, supra note 116, at 279 (quoting S. REP. NO. 100-515, 41-45 (1988), reprinted in 1988 U.S.C.C.A.N. 5577)).

250. Voss, supra note 116, at 270.
252. See id.
253. Id.; see also Voss, supra note 116, at 270 (stating the FTDA "simply proscribes the use which 'causes dilution' suggesting that... the plaintiff must prove actual rather than likely harm.").
255. Ringling Bros.-Barnum & Bailey Combined Shows, Inc. v. Utah Div. of Travel Dev., 170 F.3d 449, 461 (4th Cir. 1999). "Finally and most telling, there is the fact that in the face of the obvious centrality of 'likelihood of dilution' provisions in the interpretation and application of state antidilution statutes for the fifty years of their existence, the federal Act does not so provide." Id.
256. See supra notes 212-36 and accompanying text for a discussion of the impracticality of the textualist approach. See generally Nabisco, Inc. v. PF Brands, Inc., 191 F.3d 208 (2d Cir. 1999).
257. Ringling Bros., 170 F.3d at 460 (stating that requiring plaintiffs to prove actual economic harm may "tax the skills of advocacy"); see also Klieger, supra note 13, at 840 (stating that to require proof of actual harm would erect "an impenetrable barrier to any federal dilution action").
258. See generally supra notes 214-40 and accompanying text for a discussion of the impracticality of the textualist approach.
259. Times Mirror Magazines, Inc. v. Las Vegas Sports News, L.L.C, 212 F.3d 157, 168 (3d Cir. 2000). "In Nabisco... the Second Circuit articulated a more complete set of factors for dilution.... [We] consider the dilution analysis in Nabisco helpful." Id.; see also supra note 193 and accompanying text for a complete list of the ten-factor text.
260. Voss, supra note 116, at 280. "If Ringling relies too heavily on textualism, Nabisco goes too far the other way—completely ignoring the significant differences between state anti-dilution statutes and the [FTDA]." Id.
harm test because it mistakenly includes a trademark infringement factor for "consumer confusion."\textsuperscript{261} In addition, courts have also noted that consumer confusion has no place in a dilution analysis.\textsuperscript{262} In fact, the original purpose of the dilution doctrine was to do away with a consumer confusion analysis.\textsuperscript{263} As Professor Schechter proposed, the focus was on the dilution of the uniqueness of the trademark regardless of whether the dilution caused consumer confusion.\textsuperscript{264} Commentators contend that the realists' ten-factor test reduces the potency of the dilution claim and frustrates the original purpose of the dilution doctrine.\textsuperscript{265} "[B]y inserting confusion factors into the state of mind required for confusion and dilution are distinct and dissimilar. The essence of dilution by blurring is a loss of distinctiveness as a unique identifier that occurs when consumers realize the same mark is used for more than one product, and are not confused as to source. If consumers are confused, blurring of the mark cannot occur simply because in their minds the mark remains the sole identifier for the senior user's product. This is in contrast to traditional trademark infringement, which requires precisely the opposite: consumer confusion as to the source of the mark. Thus, it is impossible for unauthorized use of a trademark to cause both confusion and dilution by blurring in the mind of any one person.

\textsuperscript{261} Id. at 281. Voss explained why the factor for consumer confusion should not be included in a dilution analysis. \textit{Id.}

The state of mind required for confusion and dilution are distinct and dissimilar. The essence of dilution by blurring is a loss of distinctiveness as a unique identifier that occurs when consumers realize the same mark is used for more than one product, and are not confused as to source. If consumers are confused, blurring of the mark cannot occur simply because in their minds the mark remains the sole identifier for the senior user's product. This is in contrast to traditional trademark infringement, which requires precisely the opposite: consumer confusion as to the source of the mark. Thus, it is impossible for unauthorized use of a trademark to cause both confusion and dilution by blurring in the mind of any one person.

\textsuperscript{262} Avery Dennison Corp. v. Sumpton, 189 F.3d 868, 875 (9th Cir. 1999). "In the infringement and unfair competition scenario, where the less famous a trademark, the less chance that consumers will be confused as to origin, a carefully-crafted balance exists between protecting a trademark and permitting non-infringing uses." \textit{Id.} (citing AMF, Inc. v. Sleekcraft Boats, 599 F.2d 341, 349 (9th Cir. 1979)). "In the dilution context, likelihood of confusion is irrelevant." \textit{Id.} (citations omitted).

"If dilution protection were accorded to trademarks based only on a showing of inherent or acquired distinctiveness, we would upset the balance in favor of over-protecting trademarks...." \textit{Id.; see also} I.P. Lund Trading ApS v. Kohler Co., 163 F.3d 27, 49 (1998) ("[T]he classical likelihood of confusion analysis... are not particularly relevant or helpful in resolving the issue of dilution....").

\textsuperscript{263} See Schechter, supra note 12, at 821-23. Professor Schechter believed that trademarks should be afforded protection even when there is no possibility of consumer confusion. \textit{See id.}

\textsuperscript{264} Id. at 831. "[T]he preservation of the uniqueness of a trademark... constitute[s] the only rational basis for its protection." \textit{Id.}

\textsuperscript{265} Voss, supra note 116, at 282. "[T]he court's multi-factor test represents an improvement over previous tests, but by inserting confusion factors into dilution it ultimately converts dilution into a fallback provision for weak infringement claims, and unnecessarily lengthens what is already an exhaustive multi-factor analysis." \textit{Id.; see also} McCabe, supra note 34, at 1858-65.

One reason for [the use of the confusion factor] may be that the volumes of case law examining consumer confusion make it easier for courts to analyze a dilution violation under those standards. Courts find it difficult to ignore that precedent, even though the standard is inapplicable in a dilution claim.

\textit{Id.} at 1858.

More dangerously, to reinsert a confusion standard into a dilution claim causes dilution to fall prey once again to doctrinal murkiness.... Despite Congressional intent, demonstrated by the clear language of the FTDA stating that dilution can be found absent likelihood-of-confusion, the Second Circuit reintroduced a confusion element into the dilution doctrine.

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dilution it ultimately converts dilution into a fallback provision for weak infringement claims. In so doing, the court reduces the emphasis on the key dilution inquires.

Finally, the main criticism of the realist approach stems from its willingness to grant a monopolistic right to the owner of a famous trademark. By allowing owners of famous trademarks protection against future harm, the realist approach will tip the balance in favor of granting owners of famous trademarks a monopolistic right in trademarks. Over-protecting famous trademarks will stifle competition by creating a barrier to entry for other trademarks. The realist approach allows the owner of a famous trademark to exclude other similar trademarks fairly easily. Thus, smaller companies with unrecognized trademarks which may or may not dilute the famous trademark will nevertheless be excluded from the marketplace.

Furthermore, the Fourth Circuit has criticized the realist approach as creating an unnecessary presumption. The presumption is that the owners of famous trademarks need protection in the marketplace from predatory diluters. The presumption is predicated on the notion that the entry of the

Id. at 1864.

266. Voss, supra note 116, at 282. Moreover, because plaintiffs are not required to prove confusion under the FTDA’s definition of dilution, the dilution standard necessarily has a lower burden of proof than an infringement claim. Unfortunately, because of the on-going mischaracterization of the dilution standard, as exemplified by Nabisco, such plaintiffs often are not afforded the protections they deserve.

McCabe, supra note 34, at 1865-66.

267. Port, supra note 78, at 486-87. “Under dilution theory, the trademark holder not only controls each expression of the mark, but also attempts to control the manner in which consumers or other manufacturers perceive of the mark. In this matter, dilution theory attempts a monopolization of the [trademark],” Id.

268. 4 McCarthy, supra note 90, at § 24:114. “The balance between fair competition and free competition must always be maintained and kept fine tuned for the economy to work at a reasonable rate of efficiency and competitiveness.” Id.

269. Klieger, supra note 13, at 856. The same characteristics that make trademarks so vital to free competition also imbue trademarks with the opposite power to stifle competition. Consumer reliance on trademarks as source and quality identifiers can generate strong consumer allegiances to products that prove difficult, and sometimes near impossible, for future market entrants to break.

Id.; see also Avery Dennison Corp. v. Sumpton, 189 F.3d 868 (9th Cir. 1999).

270. See generally Klieger, supra note 13, at 856-57.

271. Id. at 650. “A study showed that in nineteen of the twenty-two product categories, the leading brand in 1925 was still the leading brand in 1985. The link between persuasive advertising, consumer allegiance, and trademarks can serve as a barrier to entry more powerful even than a patent or copyright.” Id.

272. Ringling Bros.-Barnum & Bailey Combined Shows, Inc. v. Utah Div. of Travel Dev., 170 F.3d 449, 460 (4th Cir. 1999) (“In any event, there are enough reasons why replicating junior use of a mark might not cause any actual economic harm to a senior mark that it is not a proper subject for judicial presumption.”).

273. Id. (stating that “economic harm inevitably will result from any replicating junior use is by
lesser-known and similar trademark into the marketplace will eventually dilute the strength of the trademark to the point where the trademark will no longer be unique. However, owners of famous trademarks already have the upperhand in the marketplace. Thus, these companies already have the resources to fend off competition and do not need the protection afforded to them by the realist approach. Ultimately, this hurts not only the smaller companies but also the consumer. Stifling competition in trademarks means that consumers will not benefit from the innovation and progress that accompany free competition.

C. Toward a New Interpretation of the FTDA

In defense of its position, the Fourth Circuit stated: “Finally and most telling, there is the fact that in the face of the obvious centrality of ‘likelihood of dilution’ provisions in the interpretation and application of state antidilution statutes for the fifty years of their existence, the [FTDA] does not so provide.” As the Fourth Circuit pointed out, in interpreting the FTDA, it is critical to note that Congress did not include the “likelihood of dilution” standard found in the state dilution statutes. However, this omission can be understood in light of the “acquired legal meaning” of dilution, and the function of the dilution doctrine.

First, it is possible to interpret the term “dilution” and give it its “acquired legal meaning.” The tension between the textualists and realists

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274. Id.
275. See Planet Hollywood, Inc. v. Hollywood Casino Corp., 80 F. Supp. 2d 815, 826 (N.D. Ill. 1999). “As a nation, we long have extolled the virtues of free and vigorous competition.... [However,] we hold no less dear the right of individuals and corporations to control and use their own property, including intellectual property such as trademarks.” Id.
276. Voss, supra note 116, at 266. “[The realist approach] would effectively give trademark owners property rights in gross, and thereby upset the careful balance achieved in the existing system where similar marks can coexist on noncompeting products.” Id. at 267
277. Klieger, supra note 13, at 861. “[The realist approach] expressly reorients trademark law around the protection of the persuasive function of trademarks [to the consumer] and, in so doing, upsets trademark law’s historic balance between free and fair competition.” Id.
278. Id. at 862.
281. See Voss, supra note 116, at 277 n.87 (quoting NLRB v. Amax Coal Co., 453 U.S. 322, 329 (1981) (“Where Congress uses terms that have accumulated settled meaning under either equity or the common law, a court must infer, unless the statute otherwise dictates, that Congress means to incorporate the established meaning of these terms.”)).
282. Id. at 277 (“[W]ords which have acquired specific legal meaning should be given that
stem from their extreme approaches to interpreting the FTDA. The textualist approach requires a strict showing of past harm, while the realist approach allows a more flexible showing of future harm. However, the reality is that prior to the enactment of the FTDA, state courts have permitted the use of both approaches. In cases such as Ringling Bros., where the dilution had been occurring for some time, courts have permitted the use of evidence of past harm. Conversely, in cases such as Nabisco, where dilution was imminent, courts have permitted a showing of future harm. Thus, since the inception of the dilution doctrine, "dilution" has acquired a legal meaning consistent with the two approaches taken by the textualists and realists.

In addition, the policy goals behind the dilution doctrine support granting dilution protection in cases where dilution is likely to occur in the future. As originally theorized by Professor Schechter, the dilution doctrine was aimed directly at protecting the investment that the trademark owner made in the trademark. This is a "slow, gradual type of harm" that should be granted protection under dilution law. Congress used this rationale in the House Report to justify enacting the FTDA. The House Report stated that "[t]he concept of dilution recognizes the substantial investment the owner has made in the mark and the commercial value and aura of the mark itself, protecting both from those who would appropriate meaning unless the statute otherwise dictates."
the mark for their own gain." 293 It seems that Congress advocated protection for famous trademarks from those who would, in the future, hurt the significant investment that the owner of the trademark had made.294

This justifies the position that realists have taken.295 Congress sought to protect the value of the trademark from the danger of future dilution.296 However, this does not mean that Congress sought to protect trademarks from future dilution alone.297 In fact, Congress sought to grant relief for trademarks that have already been diluted.298 In light of the original understanding of the dilution doctrine, the goal of dilution law was to protect the investment in trademarks.299 This policy goal was adopted by Congress and expressed in its House Report.300 However, the intent of Congress in enacting the FTDA shows that dilution law sought to protect the investment that the owner of the trademark "has made" in the trademark.301 Thus, it follows that Congress sought to protect the trademark owner from both past and future harm.302

Despite the seemingly opposing views taken by textualists and realists, it seems that both approaches can be reconciled and used together to show the true meaning of dilution.303 The two approaches can be reconciled and ultimately point to a new interpretation of the FTDA favoring the co-existence of a remedy for both past and future harm.304

293. Id.
294. Id. ("Dilution is an injury that differs materially from that arising out of the orthodox confusion. Even in the absence of confusion, the potency of a mark may be debilitated by another's use. This is the essence of dilution.").
295. Voss, supra note 116, at 270; see also Klieger, supra note 13, at 860-62.
297. Id.; see also Schechter, supra note 12, at 831 (arguing for the protection of the uniqueness of trademarks from past and future dilution).
298. H.R. REP. No. 104-374, at 3 (stating that the FTDA will "protect famous marks from unauthorized users that attempt to trade upon the goodwill and established renown of such marks and, thereby, dilute their distinctive quality").
299. Id. (stating that the FTDA "is intended to protect famous marks where the subsequent, unauthorized commercial use of such marks by others dilutes the distinctiveness of the mark").
300. Id.
301. Id. (stating that the aim of dilution law is to protect the commercial investment that the owner of the trademark has made).
302. Voss, supra note 116, at 288 (noting that "[a] fair reading of the Dilution Act provides a remedy for both actual and potential future harm").
303. See id.
304. Id.; see also Ablin & Koshy, supra note 23, at 90. "Coming to terms with dilution under the Dilution Act is understandably difficult. The definition of dilution under the Act, in its comparative minimalism, laid itself open to perverse interpretation. Exercise of this potential misinterpretation was, perhaps, a foregone conclusion." Id.
VI. CONCLUSION

Ironically, the FTDA has caused more confusion than resolution.\textsuperscript{305} When Congress enacted the FTDA, it sought to provide more predictable results for the trademark owner.\textsuperscript{306} However, just five years after Congress enacted the FTDA, trademark owners still face uncertainty in the area of trademark dilution.\textsuperscript{307} As demonstrated by the recent split in the circuit courts, the cases give little guidance to trademark owners.\textsuperscript{308} Congress enacted the FTDA to combat forum-shopping and decrease the amount of litigation in overcrowded courts.\textsuperscript{309} However, the recent split in the circuits means that forum-shopping will continue.\textsuperscript{310} Potential diluters threatened by liability will likely seek declaratory judgment against owners of famous trademarks in the Fourth, Fifth, Seventh, and Ninth Circuits.\textsuperscript{311} There, potential diluters will likely prevail against owners of famous trademarks unless the owners of famous trademarks can meet the rigorous actual harm standard.\textsuperscript{312} Conversely, owners of famous trademarks will proceed on a dilution claim in the Second and Third Circuits, where they will benefit from the flexible ten-factor test.\textsuperscript{313} Furthermore, another potential impact of the inconsistent decisions in the circuit courts is that, overall, owners of famous trademarks will file fewer claims under the FTDA.\textsuperscript{314} Instead, these owners will file more claims in state courts using state dilution statutes.\textsuperscript{315} There, owners of famous trademarks will seek to benefit from the less stringent “likelihood of dilution” standard to prove cases of future dilution.\textsuperscript{316}

\begin{itemize}
\item \textsuperscript{305} H.R. REP. NO. 104-374, at 3 (stating that the purpose of the FTDA was to “bring uniformity and consistency to the protection of famous marks”).
\item \textsuperscript{306} Id. (stating that “[p]resently, the nature and extent of the remedies against trademark dilution varies from state to state and, therefore can provide unpredictable and inadequate results for the trademark owner”).
\item \textsuperscript{307} See Ablin & Koshy, supra note 23, at 61. “Today . . . judicial construction of the [FTDA] is strangling the hope for a single, national standard of dilution. As cases applying the Dilution Act wind their way through the federal judicial system, courts have interpreted the Act in dramatically disparate ways.” Id.
\item \textsuperscript{308} 4 MCCARTHY, supra note 90, at § 24:114 (stating that “[t]he cases give little guidance, and plaintiffs are continually pressing for more and more protection”).
\item \textsuperscript{309} H.R. REP. NO. 104-374, at 4.
\item \textsuperscript{311} Id. “This uncertainty will no doubt produce the adverse effect of forum shopping . . . .” Id.
\item \textsuperscript{312} Id.
\item \textsuperscript{313} Id. (stating that “[t]rademark owners and their counsel must therefore give careful thought to the application of creative, flexible circumstantial evidence factors under Nabisco . . . .”).
\item \textsuperscript{315} Id.
\item \textsuperscript{316} See infra notes 92-103 and accompanying text for a discussion of dilution standards in the states.
\end{itemize}
Today, trademark owners face uncertainty when faced with a claim under the FTDA.\textsuperscript{317} Thus, ultimately, either the Supreme Court will have to resolve this split or Congress will have to amend the FTDA.\textsuperscript{318} In doing so, either the Court or Congress must be mindful of both the text and the history of the FTDA. This Comment advocates the position that in order to give full deference to the accepted jurisprudence of the dilution doctrine, the Court or Congress must extend full protection to owners of famous trademarks for both past and future harm from trademark dilution.

Daniel H. Lee\textsuperscript{319}

\textsuperscript{317} See Deutsch, supra note 314.
\textsuperscript{318} Id. (stating that “[r]ather than wait for the Supreme Court to decide between the two standards for dilution injunctions, trademark owners are likely to ask Congress to amend the FTDA”).
\textsuperscript{319} J.D. Pepperdine University School of Law, 2001.