

# Trademarks

Law 115 | Week 5 | Lecture 11  
Rachael Vaughn

# Agenda

1. Dilution
2. Trade Dress
3. Defenses
4. Examples

# Dilution

Even if there is no likelihood of confusion, owners of famous marks may have a claim for dilution. There are two flavors of dilution...

1. Blurring
2. Tarnishment

**Federal Dilution Revision Act (2006):**  
Dilution occurs when...defendant begins use...that is likely to cause dilution by blurring or tarnishment, regardless of actual or likely confusion, competition, or actual economic injury

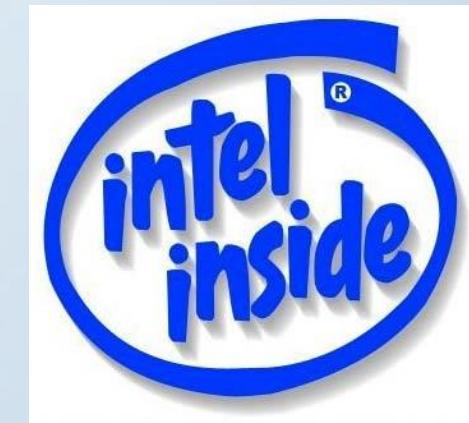


# Dilution: Famous Marks

**Famous Trademark** = widely recognized by general consuming public (defined in FDRA)

1. Duration, extent, geographic reach of advertising
2. Amount, volume, and geographic extent of sales
3. Actual recognition of plaintiff's mark
4. Whether plaintiff's mark is registered

Marks that have “niche fame” are **not** considered famous under FDRA.



# Dilution: Blurring



**Dilution by Blurring** = the association arising from the similarity defendant's trademark and plaintiff's famous trademark harms the distinctiveness of the plaintiff's mark

- Examples: Buick for aspirin, Kodak for pianos
- Blurring lessens the capacity of a famous mark to identify and distinguish goods

# Dilution: Tarnishment

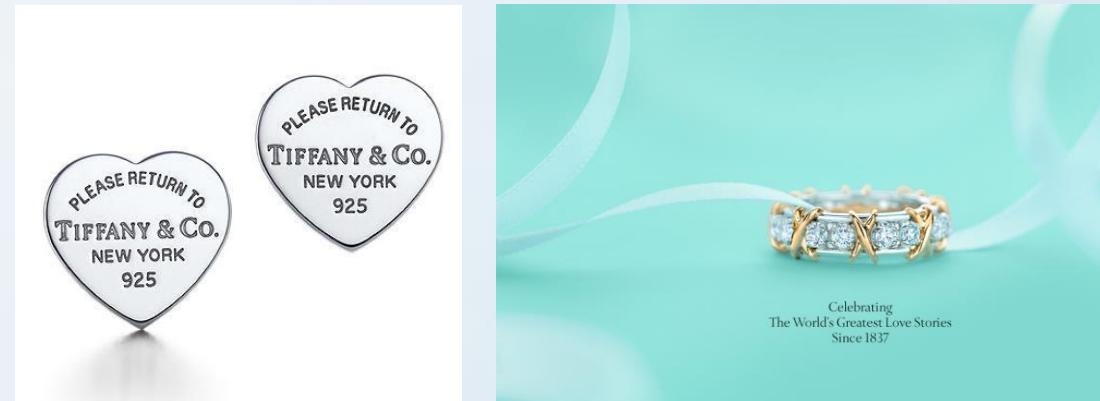
**Dilution by Tarnishment** = the association arising from the similarity b/t defendant's trademark and plaintiff's famous TM that harms the reputation of plaintiff's trademark

- Harms the image of the trademark holder
- Use of the mark in an unsavory way arguably adds a negative association to that reputation, and threatens to change the very meaning of the mark itself, by adding disreputable meaning to the mark's associations



# Dilution vs. Infringement

Famous Mark: Tiffany



Use	Type of Claim
Tiffany for a jewelry store	Infringement
Tiffany for an upscale restaurant	Blurring
Tiffany for an adult book store	Tarnishment

# Dilution



# Trade Dress

**Trade Dress** = total image of product

- Includes features such as size, shape, color or color combinations, texture, graphics, even sales techniques and design of product
- Elements combine to create the whole visual image presented to customers
- Three types →
  1. Product design
  2. Product packaging
  3. Tertium Quid

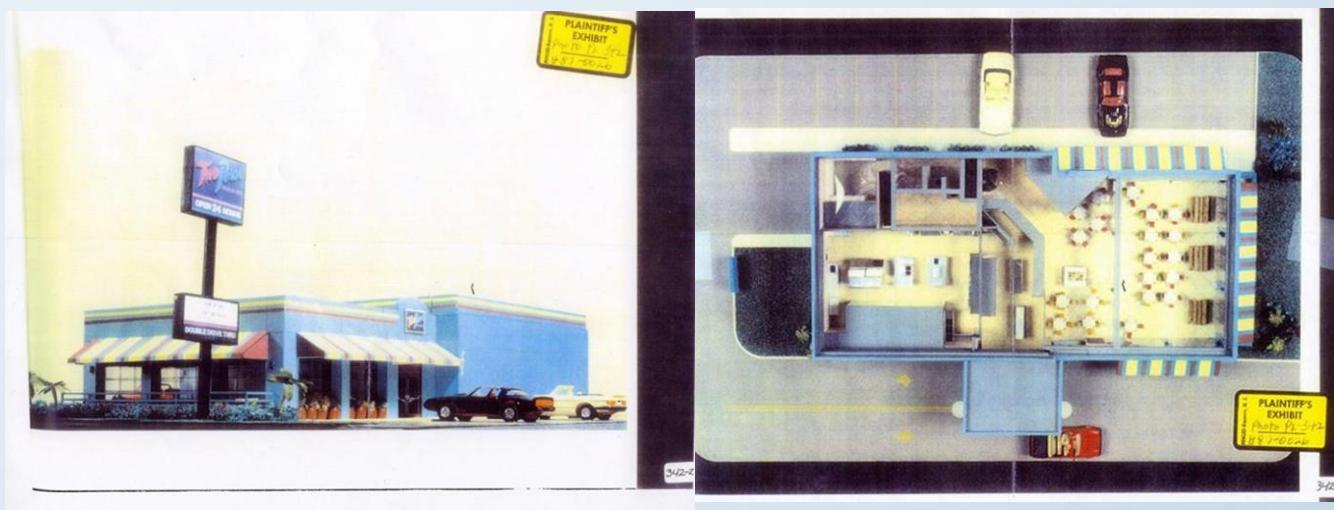


# Trade Dress

Taco Cabana



Two Pesos



# Trade Dress

The screenshot shows the Qualitex website. At the top, there's a green navigation bar with the Qualitex logo and a crown icon. Below the logo are links for "Qualitex Difference", "Contact Us", "Helpful Hints", and "Request to Distribute". The main content area features a section titled "SUN GLOW® PRESS PADS" with a sub-section for "Pads". A text blurb states: "Leading the industry in fit, performance and durability, **Sun Glow® Press Pads** are consistently used by more award-winning dry cleaning plants, by a margin of 8 to 1, than any other press pad on the market." To the right of the text is a photograph of a single, elongated, green-gold colored press pad. Below this, a bold heading reads "Qualitex - Preferred Products For All Your Finishing Needs!" followed by "Call Your Qualitex Distributor!". A small note at the bottom left says: "The Unique Green Gold Color is a Registered Trademark of the Qualitex Company. (The color on your screen may NOT be an accurate display of the Qualitex Green Gold!)" At the very bottom, the company address is listed: "Qualitex Company 4248 N. Elston Avenue Chicago Illinois 60618 • 773.463.6777 • fax 773.463.5731".



# Trade Dress

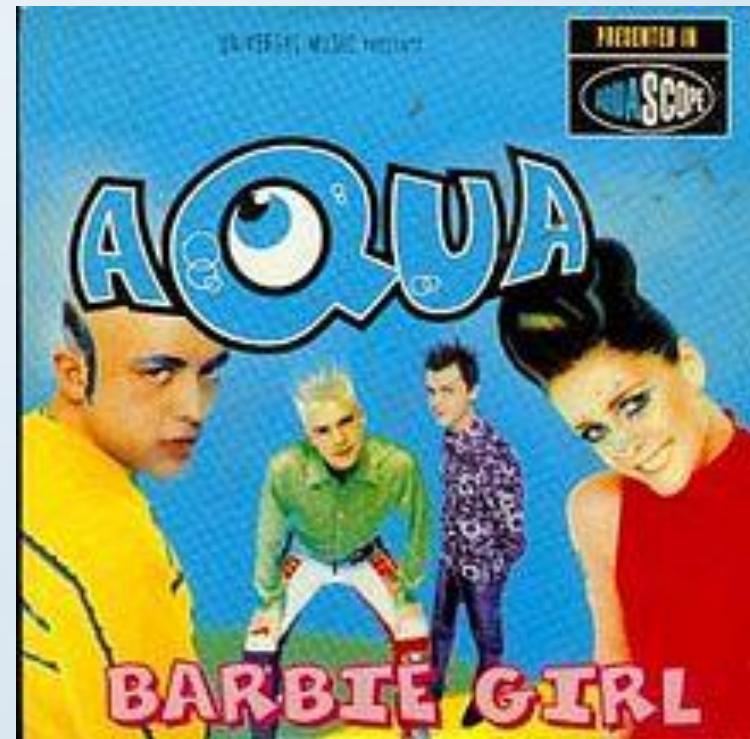


# Defenses

1. **Naked licensing:** unsupervised licensing can result in loss of rights
2. **Abandonment:** discontinued use with no intent to resume the use of the mark
3. **Nominative fair use:** allows descriptive marks to be used in a way necessary to describe the product
4. **Traditional fair use:** more traditional type of fair use based on First Amendment principles

# Example

Barbie Girl video: [http://youtu.be/-\\_pTeDz4Zpk](http://youtu.be/-_pTeDz4Zpk)



# Example

