TRADE MARK INFRINGEMENT WITHOUT CONFUSION - DILUTION
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About the Institute

The Institute of Brand and Innovation Law (IBIL), at UCL’s Law Faculty, was established to reflect UCL’s strategy of expanding its activity in the field of intellectual property law. IBIL was founded by Professor Sir Hugh Laddie QC.

IBIL is driven by a strong desire to build bridges between academics, practitioners, industry, the judiciary, policy makers and the student community worldwide. IBIL aims to facilitate opportunities for dialogue through hosting events which combine critical analysis with practical relevance and through producing research of the highest standards of scholarly rigour and real-world significance.

IBIL is proud to be part of a multi-faculty university with a global reputation for excellence. It is keen to establish links with other departments, including those of life sciences and engineering, and institutes across UCL in order to share interests, foster synergies and contribute to common objectives.

STAFF

Veronica Barresi, Co-Director, is Research Fellow in Intellectual Property Law at UCL Laws. Veronica completed an LLM in European Law at UCL and then practiced in Intellectual Property group at White & Case LLP, in Rome and London. Her practice mainly focused on the protection and enforcement of trade marks, designs and copyright. She has dual qualification in both England and Wales and Italy. Veronica’s main research interest lies in the area of trade mark law with a particular focus on the process of European harmonization of trade mark law.

Ilanah Simon Fhima, Co-Director, joined UCL in September 2007 as a lecturer. Ilanah completed her PhD as a Herchel Smith Research Scholar at the Intellectual Property Research Institute of Queen Mary University of London, and held a position at Brunel University before coming to UCL. Ilanah is deputy editor of the European Trade Mark Reports and serves on the editorial board of the European Intellectual Property Review. She is also co-founder and a contributor to the IPKat intellectual property weblog (www.ipkat.com). Her research focuses trade mark law. She is particularly interested in infringement issues and the influence of European law on intellectual property law. She has particular research experience in comparative trade mark law (especially with relation to the United States) and trade mark dilution, the subject of her doctoral thesis and a book which she is working on for OUP. Her edited volume, Trade Mark Law and Sharing Names: Exploring Use of the Same Mark by Multiple Undertakings, is to be published in March 2009 by Edward Elgar.
Ioannis Lianos is the City Solicitors’ Educational Trust Lecturer in European Union Law at UCL Laws, the Associate Executive Director of the Jevons Institute of Competition Law and Economics, and co-Director of the Centre for Law & Governance in Europe. He is a qualified advocate at the Paris and the Athens Bar. He is a visiting professor in competition and intellectual property law at the Centre for International Industrial Property Studies (CEIPI), University of Strasbourg. He is also a member of the Institute of Competition Law, Paris and the chairman of the eCompetition Bulletin editorial board (www.concurrences.com). Ioannis has worked at the European Court of Justice (Chambers of Advocate General G. Cosmas) and the United States Federal Trade Commission (New York office). His research interest lies in international and comparative (EU, UK, French, US) competition law, the competition law and intellectual property intersection, European Union law, comparative administrative and regulatory law, law and economics.

Daniel Alexander QC is a Visiting Professor at UCL and a barrister at 8 New Square Chambers. His practice area covers litigation of intellectual property cases, including IT and media/entertainment cases, competition, EC, commercial and administrative law. He also has experience of international and EC cases include multi-jurisdictional IP issues, private international law, and the international arbitration of IP and media disputes.

Christopher Stothers is a Visiting Lecturer at UCL. He previously taught at both Oxford and Cambridge. He is a practising solicitor with Milbank, Tweed, Hadley & McCloy LLP in London, in the intellectual property litigation group. Christopher has published widely. His research spans intellectual property law (especially patents and trade marks), competition law, EC law and their interface. He has a particular interest in parallel trade and the essential facilities doctrine. His book, Parallel Trade in Europe: Intellectual Property, Competition and Regulatory Law, was published by Hart in 2007.

IBIL’s work is currently being assisted by The Rt. Hon. Lord Justice Jacob

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Director, Max Planck Institute for Intellectual Property and Competition Law in Munich
Patent Judge of the High Court
Reader in IP law at Manchester University
The Rt. Hon. Lord Justice Jacob Court of Appeal
Lord Neuberger House of Lords
Judge Randall Rader Court of Appeals for the Federal Circuit, USA
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Stephen Rubin OBE Chairman, Pentland Group PLC

TEACHING AND COURSES

Members of IBIL teach at both undergraduate and postgraduate levels, and also provide short courses for practitioners. Our courses for the 2008/2009 academic year are:

**Undergraduate (LLB)**
- Industrial and Intellectual Property

**Postgraduate (LLM)**
- The Law of Copyright and Designs
- The Law of Trade Marks and Brands
- International and Comparative Law of Trade Marks, Designs & Unfair Competition
- International and Comparative Law of Copyright and Related Rights
- The Commercialisation of Intellectual Property
- Technology and Intellectual Property Law

These postgraduate courses are also available for practitioners, as Continuing Legal Education Students, enabling them to study one course within each academic year: www.ucl.ac.uk/laws/ibil/cle

**SPONSORSHIP OPPORTUNITIES**
IBIL has established a seed fund to support its future events and activities with the generous support of its sponsors. For details of further sponsorship opportunities and associated benefits please check our website: www.ucl.ac.uk/laws/ibil

**ANNUAL LECTURE**
IBIL’s inaugural annual intellectual property lecture will be given by The Rt Hon Lord Hoffmann on 16 June 2009. Please note the date of this event in your diary.

Sign up for notification of future events at our website:
www.ucl.ac.uk/laws/ibil/
Forthcoming Article by Sir Hugh Laddie

Current Legal Problems
Professor Sir Hugh Laddie QC gave his inaugural lecture as Professor of Intellectual Property Law at UCL in December 2007, on the topic of ‘The Insatiable Appetite for intellectual Property Rights’. It was a tour de force, which showcased his formidable intellect, wit and erudition.

The revised text of this lecture has now been published in volume 61 of Current Legal Problems, the prestigious annual volume of papers by leading legal scholars which is published by Oxford University Press in conjunction with the Faculty of Laws, UCL. Sir Hugh’s death is a great loss to everyone within the UCL community, as well as to the wider legal world. As editors of Current Legal Problems, Dr Jane Holder and I are honoured to be able to publish Sir Hugh’s inaugural lecture and have dedicated the volume to his memory.

Colm O’Cinneide,
Co-editor, Current Legal Problems, UCL Laws

Purchase the volume at: http://tinyurl.com/laddie-oup
The Sir Hugh Laddie Chair in Intellectual Property

Professor Sir Hugh Laddie, who died in November 2008, was perhaps the leading English judge and academic in the field of intellectual property law. He had a formidable reputation both within the UK and around the world and did much to shape IP law.

He retired from the bench in 2005 and the following year was appointed Professor of Intellectual Property Law at UCL where he founded the Institute of Brand and Innovation Law.

With the endorsement of his family, UCL is creating an academic Chair funded by charitable contributions in his memory. The Sir Hugh Laddie Chair will be part of the Institute of Brand and Innovation Law, the living, practical IP academic centre founded by Sir Hugh at UCL Laws, and will offer direct value to practitioners and major law firms. Like Sir Hugh, the Chair will be one of the most respected voices in the legal world.

UCL welcomes the participation of friends, alumni and others in the legal profession in establishing this tribute to Sir Hugh. To register your interest, learn about ways to give, or for further details please contact:

Lisa Penfold, UCL Laws  
lisa.penfold@ucl.ac.uk  |  020 7679 1514

See our website for a gift form for the Sir Hugh Laddie Chair  
http://www.ucl.ac.uk/laws/ibil/laddie_chair

Professor Dame Hazel Genn DBE QC  
Dean, UCL Laws
About this seminar

This seminar will explore the issues surrounding the controversial issue of trade mark dilution from the perspective of the United States, the Benelux countries and the UK.

Protecting trade marks against dilution has always been controversial. Traditionally, trade mark protection has been tied to whether consumers are confused. This can be justified because it means that the infringement action serves to protect consumers. However, there is no need for confusion in the dilution action, meaning that the traditional rationale for trade mark protection does not work. This has led to fears that dilution creates ‘property’ in trade marks and only benefits the trade mark owner.

It has also been very difficult to prove dilution. Unlike confusion, dilution is based on subconscious processes, and so both courts and legislators have had difficulty in defining it, and devising a test for it, and some have been sceptical about whether it takes place at all.

Although these issues are no longer new, this is nevertheless a timely seminar: the US has only recently completely replaced its dilution legislation and, at the end of last year, the European Court of Justice issued its first decision considering the meaning of the types of detriment and unfair advantage that European legislation requires (another is in the pipeline).

This seminar brings together leading speakers from the US, the UK and the Benelux (which has always claimed that European dilution law is based on the pre-harmonisation Benelux law) to consider issues including:

- Should we protect trade marks against dilution?
- If so, which marks should benefit from dilution?
- How can dilution be proved?
- Is the present scope of dilution too wide?
- What are the differences between the protection available in the US and Europe? Can we learn from each others’ experiences?

The seminar is allied to two of IBIL’s key research themes: (i) IP and European integration and (ii) comparative trade mark law.

This course is accredited with 2 CPD hours by the Solicitors Regulation Authority (SRA - our course provider reference is IU/UCL) and the Bar Standard Board. It is also accredited by ITMA and constitutes relevant CPD for CIPA Fellows.
Programme

16.00  Registration

16.30  Welcome
Dr Ilanah Simon Fhima  
Co-Director, Institute of Innovation and Brand Law, UCL

Chair
The Rt. Hon. Lord Justice Jacob

16.45  U.S. Anti-Dilution Law: Illegality Without Injury to the Trademark?
Professor J. Thomas McCarthy  
McCarthy Institute for IP and Technology Law, University of San Francisco;  
Of Counsel: Morrison & Foerster LLP, San Francisco, California

17.15  The Benelux Perspective
Professor Charles Gielen  
NautaDutilh, Amsterdam, The Netherlands

17.45  The UK Perspective
Professor David Llewellyn  
White & Case, and King’s College London, UK

18.15  Questions

18.45  Drinks Reception  
in the South Cloisters, UCL main building  
(to the right hand side of the portico)
Speakers Biographies

The Rt. Hon. Lord Justice Jacob is in charge of the Court of Appeal intellectual property list and sits on most appeals in IP cases and nearly all patent cases. He is a Judicial Visitor at UCL Laws. After reading Natural Sciences at Cambridge, Sir Robin then read for the Bar and an LLB from the LSE. He practiced at the Intellectual Property Bar from 1967. From 1976 to 1981 he was the Junior Counsel for the Comptroller of Patents and for Government departments in intellectual property. He was made a Queen’s Counsel in 1981 and his practice took him abroad often (Hong Kong, Singapore, Europe, USA, Australia). His practice at the Bar involved working with experts in many fields – scientists or engineers concerned with the technology of a particular patent case, accountants concerned with valuation of patents and so on. He was appointed to the Bench in 1993. From 1997 to 2001 he was Supervising Chancery Judge for Birmingham, Bristol and Cardiff. He was appointed a Lord Justice of Appeal in October 2003. He was Treasurer of Gray’s Inn in 2007. He has written extensively on all forms of intellectual property. He is President of the Intellectual Property Institute, Hon President of the UK branch of the Licensing Executive Society, and Hon President of the Association of Law Teachers.

Professor J. Thomas McCarthy is a Senior Professor at the University of San Francisco School of Law, where he has been on the faculty for over forty years. He is the Founding Director of the McCarthy Institute of Intellectual Property and Technology Law.

Professor McCarthy is the author of the seven-volume treatise “Trademarks and Unfair Competition,” published by Thomson-West. This book is in its Fourth Edition and has been in print for over thirty five years. This treatise has been cited as authority in over 3000 judicial decisions. He is also the author of the two volume treatise, “The Rights of Publicity and Privacy,” and the reference book, “McCarthy’s Desk Encyclopedia of Intellectual Property.”

His most recent articles on trademark dilution are: Dilution of a trademark: European and United States law compared, 94 Trademark Reporter 1163 (November-December 2004) and Proving a Trademark Has Been Diluted: Theories or Facts? 41 Houston Law Review 713 (2004).

He received the 2003 President’s Award from the International Trademark Association; the 2000 Pattishall Medal for excellence in teaching trademark law from the Brand Names Education Foundation and the Centennial Award in Trademark Law from the American Intellectual Property Law Association in 1997.

He is a consultant “of counsel” with Morrison & Foerster in San Francisco. He is an avid watercolor painter, winning prizes at the Contra Costa County fair for several years.
Professor Charles Gielen PhD, holds a law degree from the Catholic University of Brabant in Tilburg and a doctorate degree from the University of Utrecht, the Netherlands. He is a partner of the Dutch law firm NautaDutilh and works in their Amsterdam office. He is professor of IP law at the University of Groningen. He specialises in intellectual property law. He mainly handles patent and trademark litigation. In trademark matters he acts for Diageo Plc., L’Oreal, the LVMH Group, Intel, Coca-Cola and Lego. In patent matters he handled litigation for Pharmacia, Aventis Pharma, Medtronic and Nikon.

He has published several books and articles on subjects involving intellectual property law (in particular patent and trademark law) and is a member of editorial boards responsible for publishing law reviews on intellectual property and competition law such as the European Intellectual Property Review, the European Trademark Reports and “Intelectuele Eigendom & Reclamerecht”. He is also member of the standing advisory committee to the Dutch government on trademark and design law. He is past-President of the “Vereniging voor Intellectuele Eigendom”, the Dutch group of the International Association for the Protection of Industrial Property and forms part of the Executive Committee of this Association. He is co-chairman of the Working Committee of Q 114 (Biotechnology including plant breeders rights) and member of the Program Committee of that Association. He is past member of the Board of Directors and its Executive Committee of the International Trademark Association. He is also past President of the International League of Competition Law (LIDC). He is member of the Board of the anticounterfeiting organisation SNB-REACT in Amsterdam.

On November 8, 2006 he received INTA’ s President Award for outstanding service to the International Trademark Association. On October 6, 2007 the Council of Presidents of AIPPI appointed him Member of Honour of AIPPI for outstanding contributions to and an extraordinary engagement for the fulfilment ot the aims of the Association.

Professor David Llewelyn is a partner at White & Case and Professor of IP at King's College London. He represents clients in all aspects of intellectual property protection and exploitation, as well as the resolution of disputes concerning intellectual property by negotiation, mediation, litigation and arbitration. After a period as a NATO Fellow in 1979, he spent nearly two years as a Research Fellow at the Max Planck Institute for Intellectual Property and Competition Law in Munich. In July 1994 David founded Llewelyn Zietman, which grew to a 25-lawyer firm before he left in September 1999 to join White & Case. David has published and lectured extensively: he is Professor of Intellectual Property Law at King’s College London and External Director of the IP Academy, Singapore. He is co-author of Kerly’s Law of Trade Marks and Trade Names (14th ed. 2005), the leading practitioners’ textbook on the subject in the UK and EU, and joint author of Cornish & Llewelyn on Intellectual Property: Patents, Copyright, Trade Marks and Allied Rights (6th ed. 2007).
THE AMERICAN EXPERIENCE WITH TRADEMARK ANTI-DILUTION LAW

IBIL Brands Seminar - Univ. College London
London, England 11 February 2009

J. Thomas McCarthy

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CONFUSION OVER DILUTION

FREE RIDING?

- EU DIRECTIVE: Use is prohibited if the unpermitted use “is detrimental to the distinctive character or the repute of the trade mark” or “takes unfair advantage of” the mark

- U.S. LAW: No mention of free riding
SOURCES OF U.S LAW

• 36 of 50 States: State Anti-Dilution Law
• 1996 (FTDA) Federal Trademark Dilution Act - replaced by the
• 2006 (TDRA) Trademark Dilution Revision Act (Lanham Act §43(c), 15 U.S.C. §1125(c))

THE TWO FLAVORS OF DILUTION

• BLURRING

• TARNISHMENT
VICTORIA’S SECRET CASE


U.S. Supreme Court: “Actual dilution must be established.”


“There is a complete absence of evidence of any lessening of the capacity of the Victoria's Secret mark to identify and distinguish goods or services sold in Victoria's Secret stores or advertised in its catalogs.”
FEDERAL ANTI-DILUTION ACT OF 1996 (FTDA) JUDICIAL VIEWS

- Injury - Actual Dilution Required – Victoria’s Secret Case - Supreme Court
- Fame – Niche Fame is OK – Third Circuit
- Distinctiveness- Inherent Distinctiveness Required – Second Circuit
- Tarnishment – Probably Not in FTDA - Victoria’s Secret Case - Supreme Court

TRADEMARK DILUTION REVISION ACT OF 2006 (TDRA) KEY CHANGES

- Injury - Actual Dilution Not Required – Likelihood is Sufficient
- Fame – Niche Fame is Not Sufficient
- Distinctiveness- Inherent Distinctiveness is Not Required
- Tarnishment – Explicit in Statute
PRIMA FACIE CASE OF BLURRING UNDER THE TDRA OF 2006

- Plaintiff is the owner of a mark which qualifies as a “famous” mark as measured by the totality of the four factors in §43(c)(2),
- the defendant is making use of the challenged designation as a mark or trade name,
- in interstate commerce,
- and defendant’s use began after the plaintiff’s mark became famous,
- and, considering the six factors in §43(c)(2)(B), defendant’s use is likely to cause dilution by blurring by creating
  - a likelihood of association with plaintiff’s famous mark arising from its similarity to the plaintiff’s famous mark,
  - that is likely to impair the distinctiveness of the plaintiff's famous mark.

WHAT’S A “FAMOUS” MARK?

A mark is famous if it is widely recognized by the general consuming public of the United States as a designation of source of the goods or services of the mark's owner.

Lanham Act sec. 43(c)(2)
DILUTION BY BLURRING

Dilution by blurring is association arising from the similarity between an accused mark or trade name and a famous mark that “impairs the distinctiveness of the famous mark.” Lanham Act sec.43(c)(2)(B)

DILUTION BY TARNISHMENT

Dilution by tarnishment is association arising from the similarity between an accused mark or trade name and a famous mark that “harms the reputation of the famous mark.”

Lanham Act sec.43(c)(2)(C)
DIFFERENT BASIS FOR DILUTION AND INFRINGEMENT

- TRADITIONAL TRADEMARK LAW RESTS PRIMARILY ON A TORT-LIKE POLICY OF PROTECTION OF CUSTOMERS FROM MISTAKE AND DECEPTION.

- ANTI-DILUTION LAW DOES NOT RESEMBLE THE LAW OF CONSUMER PROTECTION, AND HAS MORE SIMILARITY TO THE LAW OF TRESPASS ON PROPERTY.

STOPS ON A LINE? CONFUSION AND DILUTION
LIST OF HYPOS USED BY STATE LEGISLATURES & CONGRESS

LIST OF OFFENDING EXAMPLES AGAINST WHICH ANTI-DILUTION LAWS ARE DIRECTED IS:

• DUPONT SHOES
• SCHLITZ VARNISH
• KODAK PIANOS
• BUICK ASPIRIN
• BULOVA GOWNS.

BLURRING SLIPPERY SLOPE

ROLEX WATCHES

ROLEX SHOES

ROLEX BREAD

ROLEX CANDY
TDRA: SIX FACTORS FOR BLURRING

- (i) The degree of similarity between the mark or trade name and the famous mark.
- (ii) The degree of inherent or acquired distinctiveness of the famous mark.
- (iii) The extent to which the owner of the famous mark is engaging in substantially exclusive use of the mark.
- (iv) The degree of recognition of the famous mark.
- (v) Whether the user of the mark or trade name intended to create an association with the famous mark.
- (vi) Any actual association between the mark or trade name and the famous mark.
LIKENESS OF ASSOCIATION IS NOT THE SAME AS LIKENESS OF BLURING

Blurring is a kind of injury or damage to a mark, defined by the statute as an impairment of the distinctiveness of a mark that is caused by “association.” The two elements of “association” and “blurring” are separate and distinct.

“[T]he mere fact that consumers mentally associate the junior user's mark with a famous mark is not sufficient to establish actionable dilution. . . . [S]uch mental association will not necessarily reduce the capacity of the famous mark to identify the goods of its owner, the statutory requirement for dilution under the FTDA.”


ASSOCIATION?

AMAZON Internet Seller

AMAZON WOMENS’ FITNESS

AMAZON GARDENING SERVICE

AMAZON HIKING AND SURVIVAL TRAINING
WHICH CAUSATION STANDARD?

**Direct Causation Standard**
Defendant’s use alone must be likely to cause some impairment or diminution of the distinctiveness of the famous mark.

**“no right in gross”**
Any use of a famous mark is likely to cause dilution because others will probably follow, leading eventually to diminution of distinctiveness.

TDRA of 2006 text leaves the causation standard open.

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INJURY CAUSED BY THE CUMULATIVE EFFECT?

- **METAPHOR:** LIKE BEING STUNG BY A HUNDRED BEES, SIGNIFICANT INJURY IS CAUSED BY THE CUMULATIVE EFFECT, NOT BY JUST ONE BEE STING.
Hershey v Art Van Furniture, 2008

versus

Hershey chocolate bar

ART VAN furniture retailer

NON-TRADEMARK USE DOES NOT DILUTE

IN CONTENT OF EXPRESSIVE WORKS, e.g. NOVELS

ART

Andy Warhol

IN CONTENT OF TV & MOVIES

PRESTIGE CLAIMS: “MOOSE RIVER wine, the ROLLS-ROYCE of Idaho wines.”
Louis Vuitton v. Haute Diggity Dog  
507 F.3d 252 (4th cir. 2007)

LESSON: A commercial parody may reinforce rather than blur the plaintiff's mark:

“Indeed, by making the famous mark an object of the parody, a successful parody might actually enhance the famous mark's distinctiveness by making it an icon. The brunt of the joke becomes yet more famous.”
Louis Vuitton v. Haute Diggity Dog
507 F.3d 252 (4th cir. 2007)

LESSON: Silly tarnishment claims won’t work

The argument that a dog might choke on one of defendant’s doggie chew toys and that would harm the plaintiff’s reputation - rejected by the court as pure speculation.

OVER-PROTECTION?

SPORTING GOODS

Nike v. Nikepal,
2007 WL 2782030 (E.D. Cal. 2007)
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