

Fun IP

Prof. Roger Ford
Monday, April 25, 2016
Trademarks: Dilution

15 U.S.C. § 1125 — False designations of origin, false descriptions, and dilution forbidden

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(c) Dilution by blurring; dilution by tarnishment

(1) Injunctive relief

Subject to the principles of equity, the **owner of a famous mark that is distinctive**, inherently or through acquired distinctiveness, shall be entitled to an injunction against another person who, at any time after the owner's mark has become famous, commences use of a mark or trade name in commerce that is **likely to cause dilution by blurring or dilution by tarnishment** of the famous mark, regardless of the presence or absence of actual or likely confusion, of competition, or of actual economic injury.

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(2) Definitions

(A) For purposes of paragraph (1), 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. In determining whether a mark possesses the requisite degree of recognition, the court may consider all relevant factors, including the following:

- (i) The **duration, extent, and geographic reach of advertising** and publicity of the mark, whether advertised or publicized by the owner or third parties.
- (ii) The **amount, volume, and geographic extent of sales of goods or services** offered under the mark.
- (iii) The extent of **actual recognition of the mark**.
- (iv) Whether the mark was **registered** under the Act of March 3, 1881, or the Act of February 20, 1905, or on the principal register.

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(B) For purposes of paragraph (1), "**dilution by blurring**" is association arising from the similarity between a mark or trade name and a famous mark that **impairs the distinctiveness of the famous mark**. In determining whether a mark or trade name is likely to cause dilution by blurring, the court may consider all relevant factors, including the following:

- (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.

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(C) For purposes of paragraph (1), “**dilution by tarnishment**” is association arising from the similarity between a mark or trade name and a famous mark that **harms the reputation of the famous mark**.

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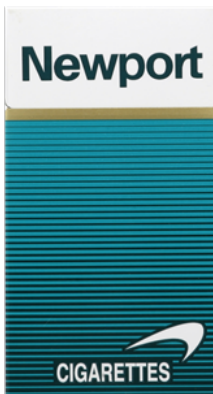


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