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CHASING MOSELEY'S GHOST: DILUTION SURVEYS UNDER THE TRADEMARK DILUTION REVISION ACT*

By Krista F. Holt** and Scot A. Duvall***

I. INTRODUCTION

The concept of trademark dilution is inherently complex. It embodies many of the challenges intellectual property law has traditionally presented to the lawmakers who define legal standards, and to the judges, attorneys and experts who are called upon to interpret and apply them. The landmark 2003 decision in *Moseley v. V Secret Catalogue*¹ revealed some of the flaws and “missing links” that plagued the statutes and case law precedents that had shaped the legal understanding of dilution law in the United States in the previous decade. The case served as an impetus for a major overhaul of dilution law. The resulting law, the Trademark Dilution Revision Act of 2006 (TDRA), clarified the legal requirements essential to prove dilution and has provided renewed focus on dilution survey evidence. Since the TDRA's passage, several courts have had the opportunity to interpret its mandates and to shape post-TDRA dilution law.

This article will discuss the process by which trademark dilution law has been transformed over the past twelve years. Part II discusses the Federal Trademark Dilution Act of 1996 (FTDA), the difficulties courts had in applying its standards consistently,

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1. *Moseley v. V Secret Catalogue*, 537 U.S. 418 (2003).

and the *Moseley* decision that ultimately proved to be the FTDA's undoing. Part III reviews the major changes to dilution law that were undertaken by the TDRA. The next three sections discuss the dilution survey designs that have been evaluated by the courts under the TDRA. Part IV discusses surveys designed to show dilution by blurring, Part V discusses surveys designed to show dilution by tarnishment, and Part VI examines a recent case in which all the proffered dilution surveys were excluded by the court. Finally, Part VII identifies some of the key dilution law issues to watch in the future.

II. DILUTION AS AN ELUSIVE BUT EVOLVING CONCEPT

Because [dilution] is largely a theoretical and almost ephemeral concept, the legal theory of "dilution" is exceedingly difficult to explain and understand. Misunderstanding is rampant.²

—J. Thomas McCarthy

As one of the most controversial and perhaps most elusive topics in intellectual property law, trademark dilution law has undergone a significant transformation over the past decade. For nearly all of the 20th century, to the extent that trademark dilution was even recognized as a cause of action, it was only recognized as such under state statutory law, and dilution law was seen as protecting the commercial value or "selling power" of a mark by prohibiting uses of a mark that were deemed to dilute the distinctiveness of the mark or to tarnish the associations it evoked.³

A cause of action for dilution was first recognized under U.S. statutory law in the FTDA, which was enacted in 1996.⁴ By the time the FTDA became law, dilution law was commonly considered to focus on two types of harm: "blurring" and "tarnishment." In lay

2. 4 J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition* § 24:67, at 24-166—24-167 (4th ed. 2008) (hereinafter *McCarthy*).

3. Restatement (Third) of Unfair Competition § 25 (1995), cmt. a, at 265.

4. Federal Trademark Dilution Act, P.L. 104-98 (H.R. 1295, S. 1513), 109 Stat. 505 (1995), enacted January 16, 1996. The FTDA legislation was enacted quickly in the House and Senate without controversy. Only the House issued a report on its version of the bill. House Report 104-374 (Nov. 30, 1995). The Senate held no hearings on the dilution legislation, took up the House bill on a suspension of the rules, and passed the House bill on a voice vote without debate. *BNA's Patent, Trademark and Copyright Journal*, Vol. 51, at 336. This was in stark contrast to the first effort to establish a federal cause of action for dilution, which failed in connection with the revisions to the Lanham Act that were enacted in 1988. See Trademark Law Revision Act of 1988, Pub. L. No. 100-667, 102 Stat. 3935 (1988), enacted November 16, 1988.

terms, “blurring” involves⁵ a risk of “clutter” in the minds of consumers on account of the newcomer’s use of a mark that is similar to a famous brand.⁶ Tarnishment, by contrast, involves a newcomer’s use of a mark in a context that risks consumer aversion to the famous brand.⁷ One example of blurring under the FTDA case law involved the use of HERBROZAC as a mark for a natural alternative to the PROZAC brand pharmaceutical.⁸ A classic example of tarnishment under FTDA case law involved the use of CANDYLAND.COM for a sexually explicit website, which understandably evoked negative associations with the famous CANDYLAND brand of children’s board games.⁹

Unfortunately, the statutory language of the FTDA was ambiguous. Under the FTDA, injunctive relief was available to the owner of a “distinctive and famous” trademark against commercial use in interstate commerce of another mark or trade name that “causes dilution” of the famous mark’s “distinctive quality.”¹⁰ In turn, the FTDA had a single definition for “dilution,” which proved to be unwieldy in practice: “the lessening of the capacity of a famous mark to identify and distinguish goods or services.”¹¹

5. The use of “involves” is deliberate here, as the concepts of blurring and tarnishment eluded precise or meaningful definition (even under the FTDA) until the passage of the TDRA.

6. See Scot A. Duvall, *The Trademark Dilution Revision Act of 2006: Balanced Protection for Famous Brands*, 97 TMR 1252, 1254 (“For blurring, the damage is impairment of the famous mark’s distinctiveness in the trademark landscape, caused by the presence of additional similar marks that force consumers to wade their minds through the clutter going forward.”); Deborah R. Gerhardt, *The 2006 Trademark Dilution Revision Act Rolls Out a Luxury Claim and a Parody Exemption*, 8 N.C. J. L. & Tech. 205, 226 (2007) (“To succeed on a dilution by blurring claim, the mark owner must show that the use is likely to create mental “clutter” in the consumer’s mind that detracts from the clear expressive message of the mark.”); Graeme B. Dinwoodie & Mark D. Janis, *Confusion Over Use: Contextualism in Trademark Law*, 92 Iowa L. Rev. 1597, 1625 n.148 (2007) (republished at 98 TMR 1086, 1121 n.148 (2008)) (“The clutter that is generated by information overload, and which interferes with consumer understanding, might be conceptualized under current U.S. law as a facet of dilution by blurring.”).

7. Duvall, *supra* note 6, at 1253.

8. *Eli Lilly & Co. v. Natural Answers, Inc.*, 233 F.3d 456 (7th Cir. 2000).

9. *Hasbro, Inc. v. Internet Entm’t Group Ltd.*, 40 U.S.P.Q.2d 1479 (W.D. Wash. 1996).

10. FTDA, 15 U.S.C. § 1125(c)(1) (repealed by TDRA). As used in the FTDA, “distinctive quality” was a loaded term, considering the varied uses of the term “distinctive” in trademark parlance. It was unclear from the FTDA’s statutory text whether “distinctive” intended to include only marks that were “singular” or “unique” in the marketplace, or whether it intended to include all enforceable trademarks (i.e., one possessing inherent or acquired *distinctiveness* versus a mark capable of distinctiveness but registrable only on the Supplemental Register). The TDRA, discussed *infra*, clarifies this matter in the statutory cause of action. Duvall, *supra* note 6, at 1260.

11. FTDA, 15 U.S.C. § 1127 (definition of “dilution” later repealed by TDRA).

The FTDA extended protection against dilution to the entire United States, roughly half of which had never considered the concepts of dilution under state law. Thus, the first “dilution” experiences for many courts and practitioners were under the FTDA. One immediate difference between the FTDA and traditional trademark infringement principles was that the FTDA did not require proof of likelihood of confusion or competition between the parties’ goods or services.¹² The FTDA expressly reflected Congress’ doctrinally sound consensus that the presence or absence of likelihood of confusion logically has nothing to do with dilution claims.¹³ This principle was sometimes misunderstood, which led to arguments that an absence of likely confusion indicated an absence of the harm necessary to support a dilution claim. Indeed, courts sometimes agreed with the opposite proposition that a finding of dilution *necessarily* followed a finding of likelihood of confusion.¹⁴ Over time, the net effect was increased conflation of traditional trademark law and dilution law principles, resulting in a hodgepodge of conflicting standards for U.S. dilution law.¹⁵

In retrospect, the FTDA was an object lesson in the challenges courts and practitioners face when confronted with a new cause of action cast in unfamiliar language, and it foreshadowed the current challenges that were presented by the passage of the recent Trademark Dilution Revision Act. It is perhaps unsurprising that many courts and practitioners clung to trademark likelihood of confusion-based paradigms in applying dilution law, because those paradigms had long been mainstays of both the common law and state and federal statutory law. Some jurists who were understandably comfortable in the mode of trademark “likelihood of confusion” cases found it difficult to comprehend or justify relief (via dilution principles) in cases where likelihood of confusion was absent. Some courts also expressed concerns about the potentially adverse effects of dilution law on competition in the marketplace when reacting to the aggressive

12. Duvall, *supra* note 6, at 1254.

13. Even the legislative history for the TDRA demonstrates how deeply rooted “confusion” concepts remain in federal trademark law. In the House Committee Report (109-23) supporting the TDRA, the Congressional Budget Office cost estimate states: “H.R. 683 would make changes to trademark law to strengthen a trademark owner’s defense against the use of other similar marks in the market that could harm the reputation of the trademark or confuse consumers.” H. Rep. 109-23, at 7 (2005) (emphasis added).

14. See 4 *McCarthy*, *supra* note 2, § 24:72, at 24-179—24-180, and cases cited therein.

15. See *id.* at 24-178—24-183.

manner in which some trademark owners invoked dilution law, and the sweeping fashion in which other courts had applied it.¹⁶

Yet, the difference between traditional trademark likelihood of confusion and dilution is not beyond comprehension. For example, Professor McCarthy has written about the difference between trademark infringement and dilution by blurring, which is the context in which most dilution cases arise:

Dilution by blurring consists of a single mark identified by consumers with two different sources. One mark: two sources. Traditional trademark infringement involves mistakenly connecting similar marks with the same source or an affiliate source. Similar marks: one [perceived] source. . . . Dilution by blurring is a state of mind of the ordinary consumer separate and distinct from the perception which occurs when the consumer is likely to be confused as to source or affiliation. . . . Dilution is a name for a kind of erosion of the strength of a mark that could occur in the *absence* of consumer confusion.¹⁷

Indeed, much uncertainty still surrounds the true justification for dilution law, which resides in trademark ownership principles.¹⁸ With some exceptions,¹⁹ the basic principle is that it is unfair for a newcomer to hijack the renown of the famous brand for its own immediate benefit, even where it is clear that no likelihood of confusion will result. The true “harm” lies not in any potential confusion, but in the very act of misappropriating another’s famous brand akin to theft or trespass and grounded in property rights. The harm is immediate, grounded in trademark ownership alone, and is in no way contingent on likely marketplace confusion.

This question of “immediacy” of dilution harm was at issue five years ago in the only U.S. Supreme Court decision to interpret the FTDA, *Moseley v. V Secret Catalogue*.²⁰ Though the “immediacy” concept is rooted in dilution theory, the statutory language of the FTDA was a poor choice. The key issue was whether the operative language “causes dilution” meant proof of “actual dilution” or merely a “likelihood of dilution.” The lower courts were split in their interpretation of the standard of proof set forth in the statutory text. Proponents of a *likelihood of dilution* standard argued that harm occurred at the very moment of use of the famous mark by a third party. The rationale here was that

16. See 4 McCarthy, *supra* note 2, § 24:67, at 24-169—24-170.

17. *Id.* at 24-171—24-172 (emphasis in original).

18. Duvall, *supra* note 6, at 1254.

19. See *id.* at 1253 (“Because tarnishment can present significant free speech concerns, the courts traditionally have been more cautious in applying that ground.”).

20. *Moseley v. V Secret Catalogue*, 537 U.S. 418 (2003).

multiple uses by third parties, if left unchecked, would cumulatively result in a loss of “distinctiveness” of the famous mark, with the injury being similar to “being stung by a hundred bees” or “death by a thousand small cuts.”²¹ Proponents of an *actual dilution* standard focused on the phrase “causes dilution” in the FTDA. In their view, this language precluded an assumption that third-party usage of a famous mark would inevitably cause it harm.

At the time the petition for writ of certiorari to the Supreme Court was filed in *Moseley*, two U.S. Courts of Appeals (the Fourth and Fifth Circuits) held that objective proof of actual injury to the economic value of a famous mark (resulting from actual, consummated dilution) was a precondition to any and all relief under the FTDA.²² Three Courts of Appeals (the Second, Seventh, and Sixth Circuits) held that future harm to a famous mark (presumably resulting from a mere likelihood of dilution) was sufficient for relief under the FTDA.²³ In following the Second Circuit’s precedent, the Seventh Circuit stated:

[The requirement of proving actual dilution] holds plaintiffs to an impossible level of proof. In the case of an immensely successful product . . . it is possible that the distinctiveness of its mark could be diluted even as its sales are increasing, albeit not increasing as much as they would in the absence of the offending mark. Even if diminished revenue could be shown, moreover, it would be immensely difficult to prove that the loss occurred as a result of the dilution of the senior mark.²⁴

In concluding that proof of actual dilution was an “impossible” burden, the Seventh Circuit specifically considered and rejected the suggestion that surveys could be used to establish such proof:

We doubt that dilution of the distinctiveness of a mark is something that can be measured on an empirical basis by even the most carefully constructed survey. It is hard to believe

21. 4 *McCarthy*, *supra* note 2, § 24:120, at 24-346; *see also* 4 *McCarthy* § 24:69, at 24-173 (“If TIFFANY restaurants are permitted, then perhaps it will be followed by TIFFANY auto parts, TIFFANY cookies and TIFFANY insurance sales.”).

22. *See* Ringling Bros.-Barnum & Bailey Combined Shows, Inc. v. Utah Div. of Travel Dev., 170 F.3d 449 (4th Cir.), *cert. denied*, 528 U.S. 923 (1999); Westchester Media v. PRL USA Holdings, Inc., 214 F.3d 658 (5th Cir. 2000).

23. *See* Nabisco, Inc. v. PF Brands, Inc., 191 F.3d 208 (2d Cir. 1999); Eli Lilly & Co. v. Natural Answers, Inc., 233 F.3d 456 (7th Cir. 2000); V Secret Catalogue, Inc. v. Moseley, 259 F.3d 464 (6th Cir. 2001).

24. *Eli Lilly*, 233 F.3d at 468.

that Congress would create a right of action but at the same time render proof of the plaintiff's case all but impossible.²⁵

Ultimately, the stimulus for statutory change came in the form of the Supreme Court's decision in *Moseley*. In deciding the case appealed from the district court, the Sixth Circuit had followed the Second Circuit in holding that a likelihood of dilution was sufficient grounds for injunctive relief under the FTDA.²⁶ The Supreme Court granted certiorari and reversed the Sixth Circuit's ruling:

The relevant text of the FTDA . . . provides that "the owner of a famous mark" is entitled to injunctive relief against another person's commercial use of a mark or trade name if that use "causes dilution of the distinctive quality" of the famous mark. This text unambiguously requires a showing of actual dilution, rather than a likelihood of dilution.²⁷

The *Moseley* decision upended several dilution law principles that many in the trademark community had advocated, including that dilution harm commences upon the use of a famous mark by a newcomer. The Supreme Court's holding that a completed harm of "actual dilution" must be proved was directly at odds with this incipency concept, even though the Supreme Court confirmed that proof of actual *economic* injury was not required.²⁸ Another watershed passage in the Supreme Court's decision suggested that dilution by tarnishment was "arguably" outside the scope of the FTDA.²⁹

However, the most important insight on the nature of "dilution" was perhaps the Supreme Court's holding that not just any type of mental association between the marks in the minds of consumers can support a dilution claim.³⁰ Being institutionally unfamiliar with the dilution concept, however, the Court was of little practical assistance in determining what "dilution" would mean under the FTDA going forward. In the absence of a clear legal standard for the phenomenon of dilution, there was little chance of establishing either actual or likely "dilution" to the satisfaction of the courts.

25. *Id.*

26. Duvall, *supra* note 6, at 1256.

27. *Moseley*, 537 U.S. at 432-33 (internal citations omitted, emphasis in original).

28. *Id.* at 433.

29. *Id.* at 432.

30. *See id.* at 434 ("Blurring" is not a necessary consequence of mental association. (Nor, for that matter, is 'tarnishing')). The Court noted, as one possible exception, circumstances where "identical marks" were at issue. *Id.*

In the aftermath of the Supreme Court's *Moseley* decision, those looking for dilution relief were confronted with unexpectedly stringent and difficult standards.³¹ Practitioners were thus faced with the onerous prospect of having to prove "actual dilution," even though the Supreme Court held that proof of actual loss of sales or profits was not required.³² Despite the Supreme Court's suggestion of using surveys to prove actual dilution, as of October 2006, no published decisions had accepted consumer survey data as proof of actual dilution under the post-*Moseley* interpretation of the FTDA.³³

In retrospect, one could contend that devising a cogent framework to identify and remedy dilution of a trademark under the FTDA was too much to ask of students, practitioners, judges, and even those academics to whom the trademark community often looked for guidance. This sentiment was aptly summed up by Professor McCarthy, who commented in 2004 on the difficulties inherent in the dilution issue:

No part of trademark law that I have encountered in my forty years of teaching and practicing IP law has created so much doctrinal puzzlement and judicial incomprehension as the concept of "dilution" as a form of intrusion on a trademark. It is a daunting pedagogical challenge to explain even the basic theoretical concept of dilution to students, attorneys, and judges. I have tried mightily. I believe that few can successfully explain it without encountering blank stares of incredulity or worse, nods of understanding which mask and conceal puzzlement and misconceptions. Even the U.S. Supreme Court has failed to grasp the contours of the doctrine.³⁴

Professor McCarthy's comment was but one of many explicit and implicit calls to action that were sounding within the trademark community. In March 2003, the International Trademark Association (INTA) commissioned a group of trademark attorneys to study federal dilution law and to propose modifications to the FTDA, which culminated in recommendations

31. See House Judiciary Committee Report H. Rep. 109-23 on H.R. 683, 109th Cong., 1st Sess. (March 17, 2006), at 5 ("The *Moseley* [sic] standard creates an undue burden for trademark holders who contest diluting uses and should be revised").

32. Todd Anten, *In Defense of Trademark Dilution Surveys: A Post-Moseley Proposal*, 39 Colum. J.L. & Soc. Probs. 1, 11-12.

33. *Id.* at 3.

34. J. Thomas McCarthy, *Proving a Trademark Has Been Diluted: Theories or Facts?*, 41 Houston L. Rev. 713, 726 (2004).

for several substantive changes.³⁵ INTA's recommendations were codified into H.R. 683, which eventually was named the Trademark Dilution Revision Act of 2006 (TDRA), and which was enacted by Congress and signed into law by the President in October 2006.³⁶

III. IMPORTANT CHANGES IN THE TDRA AND THEIR RELEVANCE TO SURVEYS

While the TDRA embodied numerous changes to federal dilution law, perhaps the most significant change was to the standard of proof. The TDRA clearly requires only a *likelihood* of dilution, a standard the Supreme Court had previously rejected based on its scrutiny of the FTDA's statutory text. Both INTA and Congress recognized the impracticality of an actual dilution standard of proof and the difficulty of effectively proving it. By enacting the TDRA, Congress provided increased opportunities to employ surveys to evidence a likelihood of dilution.

The most salient features of the TDRA for purposes of our following discussion are as follows:

A. The "Fame" Requirement Is More Restrictive

The FTDA had done little to set forth an objective standard for determining whether a mark's fame was sufficient to warrant protection from dilution, and some courts had allowed dilution protection for marks having mere "niche" fame.³⁷ With far less room for misinterpretation, the TDRA expressly protects marks "widely recognized by the general consuming public of the United States as a designation of source of the goods or services of the

35. See INTA Press Release, *INTA Forms Select Committee To Review Famous Trademark Law After Victoria's Secret Decision* (Mar. 25, 2003). Kathryn Barrett Park, then-President of INTA, appointed a diverse group of trademark attorneys to serve on the Select Committee on the FTDA, comprised of the following: Jacqueline Leimer (then-Vice President of INTA) as chair, David Bernstein, Guy Blynn, Andrew Bridges, Dale Cendali, Rodrick Enns, Bruce Ewing, Jerome Gilson, Anne Gundelfinger, Steven Pokotilow, Paul Reidl, Albert Robin, David Stimson, Jerre Swann, and co-author Scot Duvall. The group engaged in a nine-month comprehensive study of dilution law and the FTDA, which resulted in INTA's recommendations to Congress to "provide greater clarity regarding protection afforded under the statute, better define the standard of proof for dilution, and strengthen protection for free speech interests." See generally Testimony of Jacqueline A. Leimer, President, International Trademark Association, before House Subcommittee on Courts, the Internet and Intellectual Property, Committee on the Judiciary, *Submission of INTA on Revising the Dilution Act* (April 22, 2004) (available at www.inta.org, under the section Policy Development and Advocacy / Letters and Testimony).

36. Trademark Dilution Revision Act of 2006, Pub. L. No. 109-312, 120 Stat. 1730 (2006), enacted October 6, 2006.

37. See 4 *McCarthy*, *supra* note 2, § 24:105, at 24-282.

mark's owner."³⁸ The TDRA enumerates four factors for courts to consider in determining whether a mark is famous enough to qualify for protection under the statute.³⁹ One of these factors, "[t]he extent of actual recognition of the mark," may be quantified through the use of a survey.⁴⁰

B. Famous Marks that Have "Acquired Distinctiveness" Qualify for Protection

The TDRA makes dilution protection available to a famous mark that is inherently distinctive or has acquired distinctiveness.⁴¹ This aspect of the TDRA overruled the Second Circuit's decision in *TCPIP Holding Co. v. Haar Communications, Inc.*,⁴² which held that only inherently distinctive marks were entitled to protection under the FTDA. If a famous mark is not considered to be inherently distinctive, survey evidence may be employed to establish the degree of distinctiveness necessary to qualify for protection against dilution. A secondary meaning survey could demonstrate that a significant portion of consumers nationwide associate the famous mark with a single source, being the owner of the famous mark.

C. "Blurring" and "Tarnishment" Are Recognized as Two Separate Causes of Action

Drafters of the TDRA responded to the Supreme Court's suggestion in *Moseley* that the FTDA governed dilution only in the form of blurring by defining each type of dilution in the TDRA. The law now expressly governs both dilution by blurring and dilution by tarnishment. Under the TDRA, these are now separate causes

38. TDRA, 15 U.S.C. § 1125(c)(2).

39. These factors are: (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; and (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. TDRA, 15 U.S.C. § 1125(c)(2)(A).

40. Duvall, *supra* note 6, at 1262. See also Testimony of Anne Gundelfinger, President, International Trademark Association, before House Subcommittee on Courts, the Internet and Intellectual Property, Committee on the Judiciary, 109th Cong., 1st Sess. (Feb. 17, 2005), at 11 ("The third factor, 'the extent of actual recognition of the mark,' is meant to incorporate survey evidence, market research such as brand awareness studies, and unsolicited media coverage, and other evidence of actual recognition.").

41. Duvall, *supra* note 6, at 1259-60.

42. *TCPIP Holding Co. v. Haar Comms., Inc.*, 244 F.3d 88, 90 (2d Cir 2001) ("Because plaintiff's mark, 'The Children's Place,' for a store selling children's clothes, is descriptive and lacks inherent distinctiveness, it does not qualify for the protection of the Act.").

of action that have different legal standards. Both causes of action require a newcomer's use of a similar or identical mark. However, each cause of action is grounded in a different effect that is likely to arise from consumer perceptions of similarity.

The TDRA defines dilution by blurring as "association arising from the similarity between a mark or trade name and a famous mark that *impairs the distinctiveness* of the famous mark," and it sets forth the following relevant objective factors:⁴³

- (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.

Survey evidence is potentially relevant to prove the first, second, fourth, and sixth factors. Courts have used surveys to evaluate the degree of similarity between two marks (first factor). Although not covered in this article, secondary meaning surveys may be used to measure a mark's acquired distinctiveness (second factor). Fame surveys, which are also beyond the scope of this article, may be utilized to determine a mark's degree of recognition (fourth factor). Finally, as discussed later in this article, dilution surveys may be used to establish the existence of actual association between the marks at issue (sixth factor).⁴⁴

In contrast to the TDRA's standard for blurring, the TDRA defines dilution by tarnishment as "[a]ssociation arising from the similarity between a mark or trade name and a famous mark that *harms the reputation* of the famous mark."⁴⁵ The main distinction between blurring and tarnishment is that while blurring creates an association that damages a famous mark by impairing its *distinctiveness*, tarnishment creates an association with a famous mark that harms its *reputation*. Tarnishment surveys therefore may measure not only the association between two marks, but also

43. TDRA, 15 U.S.C. § 1125(c)(2)(B) (emphasis added).

44. Testimony of Anne Gundelfinger, *supra* note 40, at 11. See also 4 *McCarthy*, *supra* note 2, § 24:97, at 24-243; § 24:100, at 24-256—24-257.

45. TDRA, 15 U.S.C. § 1125(c)(2)(C) (emphasis added).

the likelihood of that association harming the reputation of the famous mark.

D. Conflict Between Governing Standards (FTDA Versus TDRA) May Exist for Some Time

The potential for retroactive application of the TDRA is a significant issue in currently pending dilution cases. The *Starbucks* case, discussed later in this article,⁴⁶ is an example of what can happen when surveys are constructed with one legal standard in mind (the FTDA as interpreted post-*Moseley*) and then is offered into evidence to a court under another (the TDRA). While the court's comments on the survey in *Starbucks* are instructive going forward, there is a risk that lower courts will apply the decision of that case in a manner that hinders the development of coherent and consistent dilution survey designs. Moreover, as we will see, the efforts to replicate what may have been considered "successful" surveys under the FTDA may not survive scrutiny under the new TDRA standards.

**IV. SURVEYS EVALUATED FOR DILUTION
BY BLURRING UNDER THE TDRA**

Surveys have been evaluated by the courts for evidence of two significant TDRA factors relevant to dilution by blurring. Because the definition of "blurring" is "association *arising from the similarity*" of the marks at issue, the first factor, "[t]he *degree of similarity* between the mark or trade name and the famous mark" is an integral consideration in assessing blurring.⁴⁷ Former INTA President, Anne Gundelfinger, offered this observation during her Congressional testimony in support of passage of the TDRA:

Under [the "degree of similarity"] test, not just any mental association will suffice—it must be an association that arises from the similarity or identity of the two marks, as opposed to an association that arises because of product similarities or competition between the owners of the two marks, or for some other reason.⁴⁸

Another relevant consideration, set forth in the sixth factor, is "[a]ny actual association between the mark or trade name and the

46. *Starbucks Corp. v. Wolfe's Borough Coffee, Inc.*, 559 F. Supp. 2d 472 (S.D.N.Y. 2008).

47. TDRA, 15 U.S.C. § 1125(c)(2)(B) (emphasis added).

48. Testimony of Anne Gundelfinger, *supra* note 40, at 12.

famous mark.”⁴⁹ Survey evidence is one method of establishing “actual association.” In her Congressional testimony, Ms. Gundelfinger also commented that actual association “refers to survey evidence and other evidence that association is actually occurring (e.g., direct consumer association or confusion).”⁵⁰

Professor McCarthy has observed that “association” and the “degree of similarity” are intimately intertwined,⁵¹ and has emphasized the link between the “actual association” factor and consumer perception:

“[A]ssociation” in the realm of [dilution] law means that the ordinary person on encountering the junior user’s mark will think of the senior user’s famous mark. Or in other words, the accused mark calls to mind or conjures up the senior user’s famous mark. For example, assume that the ordinary person, on encountering an advertisement for ROLEX branded sports shoes, thinks of (“associates”) the famous ROLEX mark for watches, but also thinks (correctly) that the two products do *not* come from the same or an affiliated source. . . . [I]n that person’s mind there *is* the kind of “association” that is required before dilution can occur.⁵²

As discussed below, some surveys have been accepted as evidence of “actual association.” While some may disagree with the courts’ reasoning (McCarthy, for one, rejects the notion of possible overlap between confusion and dilution in a single consumer’s mind),⁵³ courts are just beginning to develop standards under the TDRA. Now is an opportune time to take account of such cases.

49. TDRA, 15 U.S.C. § 1125(c)(2)(B).

50. Testimony of Anne Gundelfinger, *supra* note 40, at 14.

51. 4 *McCarthy*, *supra* note 2, § 24:116, at 24-321 (“The required ‘association’ must be created solely by the similarity of the conflicting marks, not from some other source. This means that the required ‘association’ cannot be created just because the two products possess some similar characteristics.”).

52. *Id.* at 24-321—24-322 (emphasis in original). *See also id.* at 24-322 (“‘Association’ is a real world state of mind that occurs in people’s brains.’ . . . The statutory element of ‘association’ requires some proof that it is likely that some persons will be exposed to both of the conflicting marks and that it is likely that those persons will make the required ‘association’ of the marks.”); *see also id.* at 24-320 (“[D]ilution by blurring will not be likely unless it is likely that the ordinary ‘consuming public of the United States’ will make an ‘association’ arising from the similarity of the marks that ‘impairs the distinctiveness of the famous mark.’”) (internal citations omitted).

53. 4 *McCarthy*, *supra* note 2, § 24:72, at 24-178.

***A. Dilution by Blurring:
The Use of New Survey Designs***

The first published decision accepting a dilution survey for blurring under the TDRA was *Nike, Inc. v. Nikepal International, Inc.*, which issued from a district court within the Ninth Circuit.⁵⁴ Shortly thereafter in *Perfumebay.com, Inc. v. eBay, Inc.*,⁵⁵ the Ninth Circuit accepted a similar survey design, although the court was applying a state-law equivalent of the FTDA. These cases are instructive because both involved surveys that shared a similar design by asking consumers, “What, if anything, came to mind” when they first heard the allegedly diluting mark?⁵⁶ This approach is consistent with Professor McCarthy’s view of the TDRA’s required “association” between the marks, which exists if when encountering the junior user’s mark, a person thinks of the senior user’s famous mark.⁵⁷ These cases provide insight into potentially successful survey designs for TDRA blurring.

1. Nike, Inc. v. Nikepal International, Inc.

In this case, Nike opposed Nikepal’s attempt to register the mark NIKEPAL in connection with glass syringes and other laboratory products and services.⁵⁸ The Trademark Trial and Appeal Board (TTAB) denied Nike’s opposition to registration of the NIKEPAL mark on the ground that the parties’ marks were not sufficiently similar.⁵⁹ Nike appealed the TTAB’s decision to the U.S. District Court for the Eastern District of California, where Nike asserted additional claims of trademark infringement, unfair competition, and U.S. and state trademark dilution.⁶⁰ After conducting a bench trial, the district court found in favor of Nike on its U.S. and state dilution claims; and as a result, the court did not rule on Nike’s infringement and unfair competition claims.⁶¹

54. *Nike, Inc. v. Nikepal International, Inc.*, 84 U.S.P.Q.2d 1820 (E.D. Cal. 2007).

55. *Perfumebay.com, Inc. v. eBay, Inc.*, 506 F.3d 1165 (9th Cir. 2007).

56. See discussion at Part IV.A, *infra*.

57. 4 *McCarthy, supra* note 2, § 24:116, at 24-321—24-322 (“[A]ssociation’ in the realm of [dilution] law means that the ordinary person on encountering the junior user’s mark will think of the senior user’s famous mark.”).

58. In its U.S. trademark application, Serial No. 76/123346, Nikepal sought registration for “import and export agencies and wholesale distributorships featuring scientific, chemical, pharmaceutical, biotechnology testing instruments and glassware for laboratory uses, electrical instruments, paper products and household products and cooking appliances.”

59. *Nikepal*, 84 U.S.P.Q.2d at 1822.

60. *Id.*

61. *Id.*

In evaluating Nike's TDRA blurring claim, the district court relied upon survey evidence that was submitted by Nike. Nike tendered a survey that strove to "measure, *inter alia*, the likelihood of dilution of the NIKE brand as a result of Nikepal's use of the NIKEPAL mark."⁶² The telephone survey⁶³ consisted of contacting Nikepal's list of current and potential customers (the survey's "universe"⁶⁴) and asking respondents about their perception of the website www.nikepal.com. Respondents in the telephone survey were asked the following three questions:⁶⁵

(1) Assume for a moment that you were searching the Internet and you encountered a web site called NIKEPAL.COM. Let me spell it for you: N-I-K-E-P-A-L. Would you OR would you not have a belief as to who or what company or companies puts out or sponsors a site called NIKEPAL? Who or what company is that? Any others? What makes you say that? What else?⁶⁶

This first question was designed to identify potential source confusion; a customer may be "confused" in the event the owner of the famous mark is named as the source of the junior user's branded product.⁶⁷

The second question followed:

(2) And, do you OR don't you know of any products or brands that you believe come from or are associated with NIKEPAL? What products or brands are those? Any others? What makes you say that? What else?⁶⁸

The survey continued with the third question:

62. *Id.* at 1824.

63. Telephone surveys are generally less expensive and time-consuming than in-person surveys. They are also useful when the target universe consists of people who are generally difficult to find (i.e., doctors, lawyers, business professionals). Unless aided, telephone surveys do not allow for a visual stimulus. In this case, only "the persons most responsible for ordering laboratory equipment at their business" were asked to participate. *Id.* at 1825.

64. The "universe" for a survey is the defined group from which the sample of respondents to be surveyed is selected. The universe should mirror the "segment of the population whose perceptions and state of mind are relevant to the issues in the case." 5 *McCarthy, supra* note 2, § 32:159, at 32-307.

65. Survey questionnaires sometimes have bolded, italicized or underlined words.

66. Declaration of [Nike's Expert] at 5.

67. 4 *McCarthy, supra* note 2, § 24:69, at 24-171—24-172 ("Traditional trademark infringement [likelihood of confusion] involves mistakenly connecting similar marks with the same source or an affiliate source. Similar marks: one source.").

68. Declaration of [Nike's Expert] at 5-6.

(3) What, if anything, came to your mind when I first said the word NIKEPAL? Anything else? What makes you say that? What else?⁶⁹

The second and third questions were aimed specifically at dilution. These questions measured the respondent's association between the NIKEPAL mark and the NIKE mark.

The district court considered Nike's survey results in evaluating the "similarity of the marks" factor for blurring. In holding that the parties' marks were "nearly identical,"⁷⁰ the court found that the survey demonstrated that "the vast majority of the survey respondents, representing a significant segment of Nikepal's target customer group, associate[d] Nike and/or its products and services when they encounter[ed] the mark NIKEPAL, thus perceiving the two marks as essentially the same."⁷¹ The court did not specify which survey questions created the requisite "association."⁷² Nonetheless, the court's reliance on the survey evidence merely buttressed its conclusion that the marks were "nearly identical."

In addition to finding that the actions of domain registrars constituted evidence of actual association between the marks under the TDRA, the district court also considered the survey as evidence of "actual association."⁷³ The court noted that "over 87% of the people in Nikepal's own customer pool associated the stimulus⁷⁴ [NIKEPAL] with NIKE."⁷⁵ The court noted that many survey respondents were not actually confused about the source of the website, but they nevertheless associated NIKEPAL with Nike and/or its offerings. For these reasons, the court reversed the TTAB's finding that there was no likelihood of dilution.⁷⁶

69. Declaration of [Nike's Expert] at 6.

70. *Nikepal*, 84 U.S.P.Q.2d at 1827.

71. *Id.*

72. *See id.* It is conceivable that the court relied, at least in part, on survey evidence eliciting potential confusion between NIKE and NIKEPAL.

73. *Id.*

74. A survey stimulus is an object or word introduced to the respondent to test what response it initiates. In a typical confusion survey, the stimulus may be either (1) the product or brand name at issue, or (2) a representation of the product or brand name at issue whose differences do not affect the viewer's potential to be confused. Surveys typically contain control stimuli as well—these are similar to test stimuli but differ in a way that is sufficient to eliminate "noise" or respondent guessing.

75. *Id.* at 1828.

76. *Id.* at 1829.

The Nikepal survey was recently mentioned by a U.S. district court in *V Secret Catalogue, Inc. v. Moseley*,⁷⁷ on remand, as an example of a survey offering evidence of likelihood of dilution. Notably, the court suggested that since Nikepal sold unrelated goods, “a survey of [Nikepal’s] particular customer base was, no doubt, necessary . . . to establish actual association.”⁷⁸ The court appeared to distinguish the facts of *Nikepal* to support its reliance on what it termed to be “compelling” evidence of “actual association” under the TDRA through means other than a survey (“an individual consumer who saw the accused mark . . . [who] was so offended by the association to ‘Victoria’s Secret’ that he contacted the company to report the offending use”).⁷⁹ The district court’s reasoning in *Moseley* is noteworthy, as it suggests that a survey may actually be deemed necessary in some cases to elicit evidence of actual association, even though the TDRA does not expressly require a showing of actual association, which is one of six relevant factors for blurring.

2. A Comparable Dilution Survey: *Perfumebay.com, Inc. v. eBay, Inc.*

Subsequent to the *Nikepal* case, a similar survey was referenced by the Ninth Circuit in *Perfumebay.com, Inc. v. eBay, Inc.*⁸⁰ This case is instructive, even though the case involved a state-law dilution claim, which was considered by the Ninth Circuit to have the same standards as an FTDA claim.⁸¹ Perfumebay brought an action seeking a declaratory judgment that its use of the mark PERFUMEBAY did not infringe the eBay mark.⁸² eBay asserted a claim for likelihood of dilution under California law. The U.S. district court had held that conjoined forms of “perfumebay” created a likelihood of confusion, but that non-conjoined forms of “Perfume Bay” did not.⁸³ The district court also held that the Perfumebay marks did not engender a likelihood

77. *V Secret Catalogue, Inc. v. Moseley*, 558 F. Supp. 2d 734, 748 (W.D. Ky. 2008). After the 2003 U.S. Supreme Court decision in *Moseley* and remand to the Court of Appeals for the Sixth Circuit, the case was held in limbo in the Sixth Circuit until the court remanded the case to the U.S. district court in 2007. 4 *McCarthy, supra* note 2, § 24:112, at 24-304.2. During this over four-year hiatus, the TDRA was enacted, presenting the district court with issues of retroactivity of the TDRA. At the time of this writing, the case is again on appeal to the Sixth Circuit.

78. *Moseley*, 558 F. Supp. 2d at 748.

79. *Id.*

80. 506 F.3d 1165 (9th Cir. 2007).

81. *Id.* at 1180.

82. *Id.* at 1169.

83. *Id.* at 1172.

of dilution.⁸⁴ The parties appealed to the Ninth Circuit, which reversed the district court's finding of no likelihood of dilution.⁸⁵

The Ninth Circuit referenced two consumer surveys that had been conducted by eBay's expert. The first claimed to establish that third-party usage of the term "bay" in connection with a website, or as part of a website name, could result in initial interest confusion and actual confusion. The second survey, which was conducted by telephone, asked the following questions:

(1) Assume for a moment that you were shopping or browsing online for such products⁸⁶ and you encountered a website that used the word BAY (SPELL "BAY" FOR RESPONDENT SLOWLY, LETTER BY LETTER: B-A-Y) as part of its name or in its Internet address. What, if anything, comes to your mind? Anything else?

(2) Specifically, thinking about encountering the name BAY (SPELL "BAY" FOR RESPONDENT SLOWLY, LETTER BY LETTER: B-A-Y) on the Internet, what website or company, if any, comes to mind? What makes you say that? Anything else?

(3) Are there any other websites or companies that come to mind? Which is that? What makes you say that? Anything else?⁸⁷

In addition to conceding that the surveys were not designed to measure actual confusion or actual dilution, the expert also acknowledged that the survey only tested the term "bay," and not "PerfumeBay."⁸⁸ The opposing expert criticized the survey for not using a control group, among other issues.⁸⁹ The survey reflected that 52% of a California sample and 64% of a nationwide sample responded that eBay would come to mind when they saw the term "bay" utilized by a website.⁹⁰

In reversing the district court's finding of no likelihood of dilution, the Ninth Circuit did not specifically reference the

84. *Id.*

85. *Id.* at 1182.

86. The previous screening question asked respondents, "How interested are you in shopping or visiting websites that sell women's clothing, women's fragrances, or women's shoes during the coming six months?" Expert Report of [eBay's expert] at 4.

87. Expert Report of [eBay's expert] at 4-5.

88. *Perfumebay.com*, 506 F.3d at 1172.

89. The use of control groups and/or control questions can be used to filter results by removing extraneous factors called "noise" that may bias the results.

90. *See Perfumebay.com*, 506 F.3d at 1172. According to the plaintiff's survey report, "a substantial majority of consumers . . . believe that eBay is the company that comes to mind when they hear the word 'bay' used in connection with a web site or is part of the name of a web site, when they are on the internet engaged in shopping behavior."

dilution surveys. Relying on existing Ninth Circuit precedent, the court held that the district court erred in not fully considering the strength of eBay's mark, and the "nearly identical" nature of the marks, in its evaluation of dilution under state law.⁹¹ Notably, the court explained that Perfumebay's use of the marks may result in consumers no longer associating the usage of the "Bay" suffix with eBay's unique services, and specifically, the sale of products on an Internet-based marketplace.⁹² The Ninth Circuit concluded, "The uniqueness of eBay's mark is diluted in direct proportion to the extent consumers, particularly Internet users, disassociate the eBay mark with eBay's services."⁹³

Though the Ninth Circuit did not expressly rely upon the eBay survey in finding a likelihood of dilution, it remarked generally on the evidence of consumers' association with the "Bay" suffix.⁹⁴ The dilution survey proffered by eBay deviated from the survey accepted by the *Nike* court by not presenting respondents with the actual accused trademark. Had the survey referenced "PERFUMEBAY," the court might have relied upon the survey as additional support for eBay's dilution claim. Another notable difference lies in the fact that the survey accepted by the *Nike* court measured both confusion and dilution in the same survey, while the two eBay surveys measured confusion and dilution separately. However, the courts have yet to comment on the effect of this difference, leaving for future judicial consideration any doctrinally significant differences in these approaches.

B. Dilution by Blurring: Use of Confusion Surveys

As discussed above, Professor McCarthy has observed a conceptual distinction between confusion and dilution. In his view, "confusion" occurs when a customer incorrectly believes that two products come from the same source, whereas "dilution" occurs

91. The court concluded that the evidence reflected the strength of the eBay mark given its distinctiveness and fame (indeed, the parties stipulated that the eBay mark was famous). The court concluded as a matter of law that the eBay mark was so highly distinctive that consumers were likely to view the marks as essentially the same.

92. *Perfumebay.com*, 506 F.3d at 1181.

93. *Id.* In the view of co-author Duvall, the Ninth Circuit's reasoning would have been questionable had the case been decided under the TDRA, which requires for blurring that the use of the junior mark is likely to cause association arising from similarity of the marks that "impairs the distinctiveness" of the famous mark. The use of the term "impairs" in the definition of blurring suggests that evidence of mere "disassociation" of the famous mark from its services may not be sufficient to constitute a likelihood of dilution. Moreover, the TDRA sets forth a six-factor framework that considers not only the "degree of similarity" and "actual association" between the marks, but other factors as well.

94. *Id.*

when a customer correctly believes that one mark identifies two different sources.⁹⁵ McCarthy further states:

For dilution to occur, the relevant public must make some connection or association between the mark and both parties. But that connection or association is not the kind of mental link between the parties that triggers the classic likelihood of confusion test. Rather, the assumption is that the relevant public sees the junior user's use, and intuitively knows, because of the context of the junior user's use, that there is no connection between the owners of the respective marks.⁹⁶

A similar view has been expressed by the U.S. Supreme Court in *Moseley*⁹⁷ and by INTA in Congressional testimony in support of the TDRA's passage.⁹⁸

The dilution surveys relied upon in *Nikepal* and *Perfumbay.com* were designed in whole, or in part, to ask respondents what "came to mind" when confronted with the allegedly diluting mark. However, confusion surveys have been considered by the Ninth Circuit as evidence of "actual association"⁹⁹ for the purpose of evaluating likelihood of dilution under the TDRA.¹⁰⁰ For this reason, it is helpful to understand how a confusion survey is typically designed.

95. 4 *McCarthy*, *supra* note 2, § 24:69, at 24-171—24-172; *see also id.* at 24-322, n.6 ("Only in the sense that they both involve a state of mind of the public, do the doctrines of dilution 'association' and 'likelihood of confusion' in traditional trademark infringement law have an evidentiary similarity.").

96. 4 *McCarthy*, *supra* note 2, § 24:72, at 24-176. In the view of co-author Duvall, Professor McCarthy thus highlights a potentially important consideration in evaluating the feedback of respondents in surveys that test both for confusion and dilution in a single survey. In light of his suggestion of a dichotomy between mental associations identifying confusion versus those identifying dilution, it is conceivable that a court could decline to rely on *confusion* surveys as support for a finding of *dilution*. However, the Ninth Circuit has recognized confusion survey results in evaluating dilution claims. *See* discussion of *Jada Toys, Inc. v. Mattel, Inc.*, 518 F.3d 628 (9th Cir. 2008), at note 104, *infra*.

97. *See Moseley*, 537 U.S. at 419 ("the mere fact that consumers mentally associate the junior user's mark with a famous mark is not sufficient to establish actionable dilution.").

98. *See* Testimony of Anne Gundelfinger, *supra* note 40, at 12 ("Under [the likelihood of dilution] test, not just any mental association will suffice—it must be an association that arises from the similarity or identity of the two marks, as opposed to an association that arises because of product similarities or competition between the owners of the two marks, or for some other reason.").

99. *See* discussion of *Jada Toys, Inc. v. Mattel, Inc.*, 518 F.3d.628 (9th Cir. 2008), at note 104, *infra*.

100. In the view of co-author Duvall, utilizing confusion-based survey findings as evidence of similarity of the marks for purposes of dilution is a thorny proposition when considering the doctrinal differences between confusion and dilution. Some pre-TRDA case law requires as a prerequisite for a finding of dilution that marks have a higher degree of similarity than would be required for infringement, yet no such requirement appears in the TDRA. Intuitively, it seems reasonable to assume that marks which are similar enough to

A typical confusion survey may ask three questions to measure confusion as to source, sponsorship or approval, and affiliation or connection.¹⁰¹ The theoretical construct of a confusion survey allows the respondent to view the allegedly infringing mark in a simulated purchase context (similar to the manner in which they would be likely to encounter the mark in the marketplace). After viewing the mark, usually in connection with a product, the respondent is asked some variation of the following questions:

- (1) If you have an opinion, what company or companies puts out or made this product?
- (2) If you have an opinion, do you or don't you think the company or companies that put out or made this product received—or needed to receive—the permission or approval from another company or companies?
- (3) If you have an opinion, do you or don't you think the company or companies that put out or made this product is affiliated with, is connected to, or is part of another company or companies?¹⁰²

The following case is an example in which a court considered confusion survey results in assessing consumer *association between the marks* under the TDRA.¹⁰³

engender a likelihood of confusion logically *could* also be similar enough to engender dilution, even though confusion is not logically implicated in dilution. Under the TDRA, however, consumers must associate the marks based on their similarity, rather than some other basis such as the relatedness of the goods or otherwise. In view of these doctrinal differences, careful consideration of the design of the survey questions, and the analysis and presentation of the survey results, should assist courts in determining whether the answers to a particular confusion-based query logically indicate sufficient similarity of the marks for purposes of dilution.

101. For a more detailed description of the variations of confusion survey designs, see Jerre B. Swann, *Likelihood of Confusion Studies and the Straitened Scope of Squirr*, 98 TMR 739 (2008).

102. As with every survey, a confusion survey must be tailored to the research objective and adhere to certain practice standards.

103. See co-author Duvall's discussion of doctrinal concerns inherent in considering confusion survey results as evidence of similarity of the marks for purposes of dilution, at note 100, *supra*.

1. *Jada Toys, Inc. v. Mattel, Inc.*

In *Jada Toys, Inc. v. Mattel, Inc.*,¹⁰⁴ both companies manufactured and sold toy automobiles, including trucks and cars—Jada Toys under the HOT RIGZ brand, and Mattel under the HOT WHEELS brand.¹⁰⁵ On cross-motions for summary judgment, the U.S. district court found that Jada Toys' HOT RIGZ mark did not infringe or dilute Mattel's HOT WHEELS mark.¹⁰⁶ Mattel appealed to the Ninth Circuit, which reversed the district court's grant of summary judgment and remanded the case for further proceedings.¹⁰⁷ In the course of its decision, the Ninth Circuit considered two surveys proffered by Mattel.

Mattel's expert conducted and proffered both surveys as evidence in support of Mattel's dilution claim against Jada Toys.¹⁰⁸ The two Mattel surveys employed a so-called "*Eveready*" confusion survey design.¹⁰⁹ In the first survey, respondents were "exposed to the HOT RIGZ name" and asked whom they believed "puts out or makes" a toy vehicle with that name.¹¹⁰ Twenty-eight percent (28%) of the respondents indicated that the HOT RIGZ toy was "either made by Mattel or by the same company that produced HOT WHEELS, or that whatever company did produce it required permission from Mattel to sell the product."¹¹¹

In the second survey, respondents were shown a HOT RIGZ package and asked typical confusion questions.¹¹² According to the court, seven percent (7%) of the respondents believed the product was "either made by Mattel or by the same company that produced HOT WHEELS, or that whatever company did produce it required

104. 518 F.3d 628 (9th Cir. 2008). Jada Toys brought suit against Mattel on grounds of trademark infringement, false designation of origin, and unfair competition alleging that Mattel's OLD SCHOOL and NEW SCHOOL brands infringed Jada Toys' registered OLD SKOOL mark. Mattel asserted counterclaims of trademark infringement, dilution, and copyright infringement grounded in Jada Toys' use of its own HOT RIGZ registered mark, in light of Mattel's famous HOT WHEELS mark.

105. *Jada Toys*, 518 F.3d at 631.

106. *Id.*

107. *Id.* at 637.

108. The surveys were not mentioned in the Ninth Circuit's assessment of Mattel's trademark infringement claim against Jada Toys.

109. A confusion survey modeled after the *Eveready* design is one where respondents are asked what company they believe is responsible for putting out or making the junior user's product or brand without being exposed to the senior user's product or brand. 5 *McCarthy*, *supra* note 2, § 32:174, at 32-354—32-356. *See also id.* § 32:175 at 32-356—32-357.

110. *Jada Toys*, 518 F.3d at 636.

111. *Id.*

112. *Id.*

permission from Mattel to sell the product.”¹¹³ Typically, these results would suggest that seven percent (7%) of respondents were confused as to the product’s origin, sponsorship, or approval.

In applying the first factor of the six-factor framework for blurring under the TDRA, the Ninth Circuit found that a reasonable trier of fact could conclude that the marks HOT RIGZ and HOT WHEELS were “quite similar,” or indeed, “nearly identical” due to the common use of the term HOT, a flame design, and similar colors.¹¹⁴ The Ninth Circuit also found that a reasonable trier of fact could conclude that the surveys demonstrated “significant evidence of actual association between the alleged diluting mark and the famous mark,” which is evidence of the sixth blurring factor.¹¹⁵ Overall, the court held that a reasonable trier of fact could find the evidence sufficient to establish the existence of a likelihood of dilution.¹¹⁶ The Ninth Circuit therefore reversed the district court’s entry of summary judgment against Mattel.¹¹⁷

The Ninth Circuit further concluded that despite the fact that the design of the Mattel surveys was to test for confusion, the results suggested that HOT WHEELS “does not adequately identify its product” because consumers believed that HOT RIGZ was a product produced or approved by Mattel.¹¹⁸ In reaching this conclusion, the court relied upon *Moseley*¹¹⁹ by stating that *Moseley*

113. *Id.*

114. *Id.* The district court had granted summary judgment on Mattel’s dilution claim because the marks at issue were not “identical or nearly identical.” *Id.* at 634.

115. *Id.*

116. *Id.* In the view of co-author Duvall, the Ninth Circuit’s analysis suffered from conflation of the rationales for trademark confusion law and trademark dilution law. The survey respondents relied upon by the court evidently considered both HOT WHEELS and HOT RIGZ to emanate from a single source (Mattel), not two separate sources. Accordingly, the consumer “association” between the marks revealed in the surveys demonstrated source confusion, not dilution.

117. *Id.*

118. In the view of co-author Duvall, the Ninth Circuit’s conclusion that the HOT WHEELS brand “no longer adequately identified” Mattel’s product suggests a view that the distinctiveness of the HOT WHEELS mark was somehow impaired by the HOT RIGZ mark (if one were to apply the TDRA definition of dilution by blurring). However, insofar as the survey respondents considered *both* products to emanate from Mattel, the opposite conclusion seems to have been warranted, namely, that the HOT WHEELS mark was so distinctive in the marketplace that a latecomer’s product was considered as an extension of the famous HOT WHEELS brand that was emanating from the same source.

119. Co-author Duvall views the Ninth Circuit’s reliance on *Moseley* as questionable at best. The U.S. Supreme Court in *Moseley* denied the plaintiff’s motion for summary judgment, did not find actual dilution in that case, and said more about what actionable dilution was *not* than what would actually suffice as proof of actual dilution. Though the Supreme Court in *Moseley* suggested that cases that involve identical marks might increase the prospect of actual dilution, this situation was not presented in *Jada Toys*. Moreover, the

“[held] that such evidence is sufficient to meet the heightened standard of actual dilution.”¹²⁰ The court concluded that a reasonable trier of fact could conclude that the survey evidence was sufficient to establish the existence of a likelihood of dilution.¹²¹

Notably, the case originally arose under the FTDA, and the Ninth Circuit then determined that the TDRA applied retroactively to the case. In its 2005 decision, the U.S. district court held that *actual* dilution must be shown pursuant to the U.S. Supreme Court’s decision in *Moseley*.¹²² In 2008, however, the Ninth Circuit held that the TDRA standard was applicable to Mattel’s “blurring” claim.¹²³ The Ninth Circuit reasoned that its precedent in *Nissan Motor Co. v. Nissan Computer Corp.*¹²⁴ (a case applying the FTDA to a use that predated its enactment)

TDRA provides a new definition for dilution by blurring, so the Ninth Circuit’s reliance on *Moseley* was misplaced. However, future cases arising within the Ninth Circuit may be plagued by the *Jada Toys* decision, as courts within that circuit that encounter surveys in TDRA cases may be likely to consider themselves bound by the *Jada Toys* court’s reasoning. Likewise, litigants within that circuit may feel compelled to use the same survey methodology that was successful for Mattel in that case. However, it is always possible that courts (even within the Ninth Circuit) may find ways to distinguish or limit the *Jada Toys* case, or that the Ninth Circuit could resolve these issues by way of *en banc* review.

120. *Jada Toys*, 518 F.3d at 636. In the view of co-author Duvall, the Ninth Circuit’s decision implies that evidence of actual dilution under the FTDA will suffice to establish likelihood of dilution under the TDRA. However, that assumption is doctrinally flawed in that the TDRA established a specific definition for “dilution by blurring” that was not contained in the FTDA. Because the TDRA superseded the FTDA, cases evaluating dilution under the FTDA standards are of questionable utility going forward. A court undertaking to evaluate a case under the TDRA must apply the TDRA standards, particularly in blurring cases, for which Congress specifically enumerated six relevant factors.

121. In the view of co-author Duvall, the Ninth Circuit’s reasoning in *Jada Toys* is precisely the sort which Professor McCarthy has cautioned against, as the survey results supported, if anything, a finding of trademark infringement but not dilution: “Traditional trademark infringement involves mistakenly connecting similar marks with the same source or an affiliate source. Similar marks: one [perceived] source.” In *Jada Toys*, the survey relied upon by the Court suggested that HOT WHEELS and HOT RIGZ were similar marks having one perceived source.

122. *Jada Toys*, 518 F.3d at 634 & n.2.

123. *Id.* Co-author Duvall notes that the Ninth Circuit also relied on an FTDA-era case, *Panavision Int’l L.P. v. Toeppen*, 141 F.3d 1316, 1324 (9th Cir. 1998), in holding, inexplicably, that the analysis of Mattel’s California state-law dilution claim and federal dilution claims were the same. *Jada Toys*, 518 F.3d at 634. This holding seems particularly egregious in that the court’s decision purported to apply the TDRA blurring factors to Mattel’s claims. In short, the court suggested inappropriately that there was no substantive difference between the FTDA and TDRA. To the extent that the California dilution statute tracked the FTDA provisions, it seems inescapable that analysis of the state and federal dilution claims would be different once the court applied the TDRA provisions.

124. *See Nissan Motor Co. v. Nissan Computer Corp.*, 378 F.3d 1002, 1009-10 (9th Cir. 2004).

necessitated the retroactive application of the TDRA.¹²⁵ The court thus applied a dilution standard different from the one in effect when the surveys were conducted. Nevertheless, the case provides some insight as to how a court may consider surveys identifying confusion in evaluating dilution by blurring under the TDRA. As of this article's writing, the only published decisions suggesting that a confusion survey may provide evidence of dilution by blurring have issued from within the Ninth Circuit (comprising the federal courts within the states of Alaska, Arizona, California, Hawaii, Idaho, Montana, Nevada, Oregon, and Washington). Only time will tell whether and how closely other Circuits will follow these precedents,¹²⁶ or whether the Ninth Circuit will eventually modify or overrule its own precedents in this regard.

V. SURVEYS EVALUATED FOR DILUTION BY TARNISHMENT UNDER THE TDRA

The concept of a challenged junior use that is likely to *harm the reputation* of a famous mark is a new legal concept introduced by the 2006 revision.

—J. Thomas McCarthy¹²⁷

As stated earlier, the TDRA defines dilution by tarnishment as “[a]ssociation arising from the similarity between a mark or trade name and a famous mark that harms the reputation of the famous mark.”¹²⁸ Tarnishment surveys therefore should measure not only the *association* between two marks, but also the *harm* that the association causes to the senior mark. While the TDRA does not set forth any factors for evaluating a claim of dilution by tarnishment, we can expect that courts will look to pre-TDRA tarnishment cases for guidance.¹²⁹ Yet, in light of the specific definition of tarnishment in the TDRA, courts also need to determine what consumer states of mind would suffice to show a likelihood of dilution on that basis. One can expect that courts will

125. The court distinguished the case from *Horphag Research Ltd. v. Garcia*, 475 F.3d 1029 (9th Cir. 2007), in which it had retroactively applied the FTDA (including *Moseley's* actual dilution standard). The court explained that the parties in *Horphag* did not seek to apply the TDRA standard.

126. The Court of Appeals for the Second Circuit has ruled in a recent case, *Louis Vuitton v. Dooney & Bourke, Inc.*, 561 F. Supp. 2d 368 (S.D.N.Y. 2008) (discussed below in Part VI), that consumers that are determined to be confused cannot be counted as also being diluted.

127. 4 *McCarthy*, *supra* note 2, § 24:89, at 24-230 (emphasis in original).

128. TDRA, 15 U.S.C. § 1125(c)(2)(C).

129. Duvall, *supra* note 6, at 1267; Testimony of Anne Gundelfinger, *supra* note 40, at 12.

consider survey evidence probative on the statutory element of harm to reputation of the famous mark.

The courts have considered very few tarnishment surveys in cases decided under the TDRA, and even those surveys were actually conducted *prior* to the TDRA.¹³⁰ Although the survey discussed below could have been evaluated in light of the stringent “actual dilution” standard established under *Moseley*,¹³¹ it was considered under the TDRA’s “likelihood of dilution” standard instead. The court’s observations and ruling on the survey evidence are instructive.

Starbucks Corp. v. Wolfe’s Borough Coffee, Inc.

In *Starbucks Corp. v. Wolfe’s Borough Coffee, Inc.*,¹³² Starbucks alleged that Wolfe’s Borough’s sale of coffee under the trade name “Mister Charbucks” or “Mr. Charbucks” infringed and diluted, by both blurring and by tarnishment, the STARBUCKS trademark for coffee. The U.S. district court conducted a bench trial, applying the FTDA and the New York state dilution law.¹³³ Starbucks’ survey,¹³⁴ which was entered into evidence during trial, indicated that “39.5% of people associate the term ‘Charbucks’ with ‘Starbucks’ or coffee,” but the district court deemed it insufficient to demonstrate actual or potential dilution by blurring.¹³⁵ Starbucks also alleged that 43.3% of the respondents, when queried as to whether they would have a positive or negative impression of a coffee called “Charbucks,” would have a negative impression.¹³⁶ The district court characterized the survey responses as a “paucity of evidence” that negative impressions of “Charbucks” would have a negative impact on Starbucks’ brand name recognition.¹³⁷ The district court ruled in favor of Wolfe’s Borough, citing Starbucks’ failure to meet its burden of demonstrating its entitlement to relief under federal and state dilution law.¹³⁸ On appeal, the Second Circuit remanded the case

130. See discussion of *Starbucks Corp. v. Wolfe’s Borough Coffee, Inc.*, 79 U.S.P.Q.2d 1138 (S.D.N.Y. 2005).

131. *Moseley*, 537 U.S. at 419.

132. 79 U.S.P.Q.2d 1138 (S.D.N.Y. 2005).

133. *Id.* at 1138-41.

134. The questions referenced in the survey conducted in *Starbucks* were obtained from the Court’s decision and, therefore, may not be as informative as to the survey’s design as the original questionnaire.

135. *Id.* at 1145.

136. *Id.* at 1145-46.

137. *Id.* at 1146.

138. *Id.*

to the district court for reconsideration under the newly-enacted TDRA.¹³⁹

On remand,¹⁴⁰ the district court assessed the actual association factor for TDRA blurring and noted “some consumer association between the spoken, standalone term ‘Charbucks’ and Plaintiff’s Starbucks mark.”¹⁴¹ Despite this acknowledgement, the court referenced its prior finding on the issue of trademark *infringement* as support for maintaining its finding of no dilution by blurring, stating, “[The evidence] is insufficient to make the *actual confusion* factor weigh in [Starbucks’] favor to any significant degree.”¹⁴²

In reevaluating the tarnishment claim under the TDRA, the district court also considered a “newly-calculated statistic” from the survey, submitted by Starbucks on remand, that of the 30.5% of respondents who had an immediate association between CHARBUCKS and STARBUCKS, 62% (or 18.9% of the total respondents) said they would have a negative impression of a coffee called “Charbucks.”¹⁴³ The court concluded, “This statistic says nothing, however, about the likelihood that those respondents’ negative impression of a coffee called ‘Charbucks’ would affect detrimentally their perception of ‘Starbucks.’”¹⁴⁴ The district court further concluded, “[Wolfe’s Borough’s] actual ‘Mr. Charbucks’ coffee product is of such a quality that its association with Starbucks is unlikely to be damaging.”¹⁴⁵

In summary, the district court found that the survey entered into evidence did not sufficiently establish any consumer association between the STARBUCKS mark and any negative impressions of CHARBUCKS. In its decision however, the court implied that the survey might have more accurately measured tarnishment had it determined the effect of the respondents’ opinions of CHARBUCKS on their positive associations with the STARBUCKS mark itself. For this and other reasons, the court held that the plaintiff had not demonstrated the likelihood of

139. Starbucks Corp. v. Wolfe’s Borough Coffee, Inc., 477 F.3d 765 (2d Cir. 2007).

140. Starbucks Corp. v. Wolfe’s Borough Coffee, Inc., 559 F. Supp. 2d 472 (S.D.N.Y. 2008), *on remand from Starbucks Corp. v. Wolfe’s Borough Coffee, Inc.*, 477 F.3d 765 (2d Cir. 2007), *appeal docketed*, No. 08-3331-cv (2d Cir. 2008). INTA has filed an amicus brief in the appeal from the district court’s decision on remand. See Amicus Brief of the International Trademark Association in *Starbucks Corporation v. Wolfe’s Burrough Coffee, Inc.*, 98 TMR 1425 (2008).

141. *Starbucks*, 559 F. Supp. 2d at 478.

142. *Id.* (emphasis added).

143. *Starbucks*, 559 F. Supp. 2d at 480.

144. *Id.*

145. *Id.*

dilution by tarnishment required to support injunctive relief under the TDRA.¹⁴⁶ In this respect, the *Starbucks* survey might have been viewed differently had it included an element present in the *Nikepal* survey, which contained an open-ended question about the respondent's association with the junior mark (i.e., "What, if anything, *came* to your mind when I first said the word NIKEPAL?").¹⁴⁷

Ultimately, Starbucks' tarnishment case was impacted by the particular questions asked in the survey, and the district court's interpretation of the results. Notably, the parties agreed that no further evidence, including a new survey, was required.¹⁴⁸ In applying the TDRA tarnishment standard, the court gave credence to the issue of harm to reputation of the famous mark. The court was unwilling to assume a negative consumer view of STARBUCKS based solely on negative consumer expectations expressed in the survey regarding the MR. CHARBUCKS brand. As a result, the district court concluded that the survey did not demonstrate any likely impact on the reputation of the STARBUCKS brand.

The *Starbucks* decision illustrates the critical need to take the TDRA standards into account when developing surveys that seek to identify whether the challenged mark is likely to cause dilution by tarnishment. Notably, the harm to the reputation of the famous mark is an essential aspect of the TDRA's standard for tarnishment. While the district court's decision was not grounded only in the survey's methodology, it is conceivable that the court's conclusion on tarnishment could have been different had a survey been designed to take account of this essential aspect.¹⁴⁹

146. The district court also found that because the MR. CHARBUCKS mark was not "very" or "substantially" similar to the famous STARBUCKS mark, the "dissimilarity [of the marks] alone is sufficient to defeat [Starbucks'] blurring claim." *Starbucks*, 559 F. Supp. 2d at 477. In the view of co-author Duvall, this reasoning is flawed in that it overlooks the six-factor framework for evaluation of dilution by blurring in the TDRA. The TDRA does not require that marks be "very" or "substantially" similar as a prerequisite to a likelihood of dilution. The statute instructs that "[t]he degree of similarity between the mark or trade name and the famous mark" is but one relevant factor to be considered. The district court's requirement that the marks must be "very" or "substantially" similar was grounded in two cases decided under New York state law rather than U.S. dilution law. *See Hormel Foods Corp. v. Jim Henson Prods.*, 73 F.3d 497, 503 (2d Cir. 1996), and *Mead Data Cent., Inc. v. Toyota Motor Sales, U.S.A., Inc.*, 875 F.2d 1026, 1029 (2d Cir. 1989).

147. Declaration of [Nike's Expert] at 5.

148. *Starbucks*, 559 F. Supp. 2d at 474.

149. In the view of co-author Duvall, the district court's analysis was flawed in a manner that contributed to the court's finding of no likelihood of tarnishment. A significant aspect of the opinion was the court's focus on the "quality" of the defendant's product, i.e., lack of evidence of inferior quality. At least one other district court within the Second Circuit had previously held that there is no substantive difference between the TDRA and FTDA tarnishment standards (at least, one would presume, until FTDA tarnishment had been

VI. SURVEYS EXCLUDED IN RECENT CASES

The surveys evaluated and rejected in *Louis Vuitton Malletier v. Dooney & Bourke, Inc.*¹⁵⁰ offer meaningful insight into how the Second Circuit may evaluate surveys in dilution cases. Although these surveys were conducted in a case filed prior to the enactment of the TDRA, the decision includes important observations as to why the surveys were adjudged to have failed in their applications to dilution law.

In *Dooney & Bourke*, the parties were competing manufacturers of designer handbags. At issue were the Louis Vuitton handbag featuring the “Monogram Multicolore” mark (comprising multicolored monograms of the interlocked initials “L” and “V” and other design features on a black or white bag) and the black and white versions of the Dooney & Bourke “It-Bag” (a designer handbag with multicolored monograms of the interlocked initials “D” and “B” on different colored bags).¹⁵¹ Louis Vuitton filed a complaint against Dooney & Bourke in April 2004, alleging claims under the U.S. Trademark (Lanham) Act (including the FTDA which was codified in Section 1125(c) until superseded by the TDRA) and state law, and moved for a preliminary injunction against Dooney & Bourke.¹⁵² The district court denied injunctive relief, and discovery proceeded pending appeal.¹⁵³ The Second Circuit affirmed the district court’s denial of the preliminary injunction on the FTDA claim on the ground that Louis Vuitton

called into question by *Moseley*, now legislatively overruled). See *Dan-Foam A/S v. Brand Named Beds, LLC*, 500 F. Supp. 2d 296, 307-08 & n.96 (S.D.N.Y. 2007). Further, the Second Circuit has taken the view that the scope of tarnishment is broader than use strictly in connection with shoddy or unwholesome or illegal goods. See *id.* at 307-08 (“Although case law suggests that a mark is tarnished where ‘its likeness is placed in the context of sexual activity, obscenity, or illegal activity,’ this list of categories is not exhaustive. The Second Circuit has expressly held that ‘tarnishment is not limited to seamy conduct.’ Thus, the law in this Circuit takes a ‘broad view of tarnishment’ which does not appear to have been narrowed by the TDRA.”) (*citing* *Hormel Foods Corp. v. Jim Henson Prods., Inc.*, 73 F.3d 497, 507 (2d Cir. 1996)). For example, it could be just as problematic if a “quality” MR. CHARBUCKS product led consumers to ascribe an undesirable “charred” or “burnt” flavor to the STARBUCKS brand, thereby creating a likelihood of harm to the reputation of that famous brand. The district court’s analysis leaves no room for that scenario. Overall, the court’s focus on the purported “quality” of the MR. CHARBUCKS product seems unwarranted in light of the tarnishment law in effect in the Second Circuit, and such a focus is entirely unsupported by the TDRA text, which requires only that the reputation of the famous mark is likely to be harmed.

150. 561 F. Supp. 2d 368 (S.D.N.Y. 2008).

151. See *Dooney & Bourke*, 561 F. Supp. 2d at 373-75 (discussing history of case in connection with Dooney & Bourke’s motion for summary judgment).

152. See *generally id.* at 375 (discussing history of case).

153. See *id.* at 375-76 (discussing history of case).

had failed to offer evidence of actual dilution, and remanded the case for further proceedings.¹⁵⁴

On remand, dilution evidence was submitted to the district court on behalf of Louis Vuitton by two survey experts. Dooney & Bourke countered with dilution survey evidence of its own. The parties moved to exclude certain expert testimony and reports, including the parties' three dilution surveys, each of which warrants discussion in some detail. In response to the motions, the district court appointed Special Masters, with the consent of the parties, to evaluate their surveys.¹⁵⁵

The **Louis Vuitton First Dilution Survey**¹⁵⁶ was a mall intercept survey¹⁵⁷ that was discussed in the survey expert's April 2004 report.¹⁵⁸ The dilution survey design had all of the respondents view two versions of the accused Dooney & Bourke bag, two Louis Vuitton Bags (which were not the allegedly infringed or diluted bags), and a control bag.¹⁵⁹ After being shown a stimulus bag, each participant was asked whether, as an owner of one of the bags, the existence in the market of the stimulus bag would make them feel the bag they owned was less, the same, or more distinctive; less, the same, or more valuable; less, the same, or more exclusive; and less, the same, or more desirable.¹⁶⁰

The survey also asked respondents if they could tell who put out each of the bags without handling them.¹⁶¹ The Special Masters summarized the survey as finding that "twenty-three percent of the respondents 'reported' 'feeling one or more' . . . 'aspects of dilution' for reasons relating specifically to the It-Bags' use of the Dooney & Bourke Multicolor Monogram Mark."¹⁶² The Special Masters, however, found the dilution survey suffered from a "lack of fit between the survey questions and the law of dilution."¹⁶³ The Special Masters' report noted, "[A] respondent's statement that she is more likely to want to buy the It-Bags in light of the availability in the marketplace of the [Louis Vuitton

154. *See id.* at 376 (discussing history of case).

155. *See id.* at 376 (discussing history of case). *See generally* The Report and Recommendations of the Special Masters, in *Louis Vuitton Malletier v. Dooney & Bourke, Inc.*, 525 F. Supp. 2d 558, 576 (S.D.N.Y. 2007).

156. The survey expert also conducted a separate confusion survey.

157. In-person surveys, such as mall-intercept surveys, are sometimes necessary when a visual stimulus is required.

158. *Dooney & Bourke*, 525 F. Supp. 2d at 600.

159. *Id.*

160. *Id.* at 607.

161. *Id.*

162. *Id.* at 600-01.

163. *Id.* at 612.

bags] does not indicate dilution by either blurring or tarnishment of the Louis Vuitton Multicolore Monogram Mark. . . . A consumer's increased willingness to buy an It-Bag on its own says nothing at all about the status of Louis Vuitton's mark."¹⁶⁴ The court ultimately accepted the Special Masters' recommendation that the survey be excluded in its entirety.¹⁶⁵

A second survey expert was also engaged to conduct the **Louis Vuitton Second Dilution Survey**, which was conducted in December 2006. The survey was designed "to test for initial interest and post-sale confusion and for dilution by blurring."¹⁶⁶ Using a mall intercept survey, the survey expert showed respondents one of three videos. Two of the videos showed a woman carrying a Dooney and Bourke "It-Bag," while the third (the control)¹⁶⁷ showed a woman carrying a bag from Coach, which is another manufacturer unrelated to the parties in suit. Respondents were then asked who made the bag in the video, whether it called to mind any other brands, and whether its maker would have needed to get permission from another company to use the multicolor design.¹⁶⁸ Louis Vuitton's expert concluded that "29.7 and 27.1 percent, respectively, of the qualified handbag consumers considered the white and black multicolored monogram patterns of the Dooney & Bourke handbags to be similar to the . . . Louis Vuitton multicolored monogram trademarks."¹⁶⁹

Counsel for Dooney & Bourke argued that the dilution analysis "is not probative because it did not properly measure dilution."¹⁷⁰ The Special Masters agreed, commenting that the dilution survey, while containing other shortcomings,¹⁷¹ displayed a "fundamental misunderstanding of the theory of dilution by blurring."¹⁷² The Special Masters declared that Louis Vuitton's expert "made a further critical error by counting confused

164. *Id.* at 610.

165. *Id.* at 569-70.

166. *Id.* at 583.

167. The expert "did not explicitly question the control respondents about their level of previous exposure to the control bag." *Id.* at 586-87.

168. *Id.* at 582.

169. *Id.*

170. *Id.* at 591.

171. The Special Masters recommended that the survey be excluded due to the use of an improper stimulus, *id.* at 595, explaining: "Videos #1 and #2 tested . . . the degree to which the 'overall look' of the Dooney & Bourke It-Bags was perceived as similar to the overall look of the Louis Vuitton Murakami bags," despite the fact that Louis Vuitton could not claim trademark rights in a "look." *Id.* at 593.

172. *Id.*

respondents as also demonstrating blurring.”¹⁷³ Citing to Professor McCarthy, the district court explained:

It is axiomatic in trademark doctrine that a consumer—or, as here, a survey respondent—who is confused as to source cannot also demonstrate blurring. Consumer confusion occurs when consumers perceive two similar marks as referring to the same source. Trademark dilution by blurring occurs when consumers perceive two identical (or very similar) marks as referring to *different* sources.¹⁷⁴

In recommending that the survey be excluded, the Special Masters adopted Professor McCarthy’s reasoning that “a given unauthorized use . . . can cause confusion in some people’s minds and in other people’s minds cause dilution by blurring, but in no one person’s mind can both perceptions occur at the same time.”¹⁷⁵

The **Dooney & Bourke Survey** was constructed as a mall-intercept dilution survey¹⁷⁶ in which respondents were exposed to several photographs of handbags. Respondents were instructed “to look at the five handbags as if you were seeing them in stores, or being carried by women walking near you.”¹⁷⁷ After removing the pictures from sight, the interviewer asked each respondent questions relating to confusion, employing an *Eveready* design.¹⁷⁸ The survey expert concluded that there was “[n]o statistically significant difference between the percentage of respondents who named Louis Vuitton after having been shown the photograph including the Louis Vuitton Multicolore Monogram Mark and the percentage of respondents who named Louis Vuitton after having been shown the photograph including the Louis Vuitton Classic Pattern,”¹⁷⁹ the latter being a Louis Vuitton design not at issue in the suit. The survey expert further concluded that “because respondents perceived the Louis Vuitton Multicolore Monogram Mark as a source-indicator of Louis Vuitton as strongly as they perceived the Louis Vuitton Classic Pattern as a source-indicator for Louis Vuitton, the Louis Vuitton Multicolore Monogram Mark ‘has not suffered any distinctive dilution particular to its multi-color character.’”¹⁸⁰

173. *Id.*

174. *Id.* (citing 4 *McCarthy*, *supra* note 2, § 24:69, emphasis in original).

175. *Id.* at 599 (quoting 4 *McCarthy*, *supra* note 2, § 24:69).

176. The survey was conducted in November and December 2006. *Id.* at 625 & n.200.

177. *Id.* at 614.

178. *See supra* note 109 for a brief description of an *Eveready* confusion design.

179. *Dooney & Bourke*, 525 F. Supp. 2d at 614.

180. *Id.*

The Special Masters determined that this survey showed only that the Louis Vuitton Multicolore mark was highly recognizable and did not address whether “the recognition level of the Louis Vuitton Multicolore Mark might have been higher but for the existence in the marketplace of Dooney & Bourke It-Bags.”¹⁸¹ The Special Masters found “that as designed, [the survey] could not provide any reliable indication of whether the Multicolore Monogram mark was diluted.”¹⁸² Their reasoning was based on the survey’s fundamental lack of any comparative analysis. In other words, the survey gave no indication of any relationship between its putative independent variable (the presence of the accused Dooney & Bourke It-Bags) and the dependent variable (the distinctiveness of the Louis Vuitton Multicolore Monogram). The court adopted the recommendation of the Special Masters and excluded the survey, considering the reasoning behind the survey to have been “fundamentally flawed” and the testimony thus inadmissible.¹⁸³

This case highlights specific aspects of dilution surveys that courts may consider. As noted, the Special Masters held fast to Professor McCarthy’s contention that “a given unauthorized use by defendant can cause confusion in some people’s minds and in other people’s minds cause dilution by blurring, but in no one person’s mind can both perceptions occur at the same time.”¹⁸⁴ They also criticized the plaintiff’s first survey for focusing on the overall “look” of the bags and not on the design at issue.

The plaintiff’s second dilution survey led the Special Masters to comment on the nature of consumer association relevant to demonstrate dilution by tarnishment: “A consumer’s increased willingness to buy an It-Bag on its own says nothing all about the status of Louis Vuitton’s mark.”¹⁸⁵ This observation is similar to the Second Circuit’s opinion in *Starbucks*, where the court evaluated the survey that was in evidence and focused on whether the evidence demonstrated consumer associations bearing on the reputation of the famous mark.

The defendant’s survey prompted the Special Masters to once again comment on the relevant associations needed for dilution, criticizing the survey for only comparing the Louis Vuitton bag to another Louis Vuitton bag. As with the plaintiff’s own rejected

181. *Id.* at 637.

182. *Id.* at 615.

183. *Id.* at 575.

184. 4 *McCarthy*, *supra* note 2, § 24:72, at 24-177. Not all courts appear to agree with this proposition. *See* discussion of *Jada Toys, Inc. v. Mattel, Inc.*, 518 F.3d 628 (9th Cir. 2008), at *supra* note 104.

185. *Dooney & Bourke*, 525 F. Supp. 2d at 610.

surveys, the defendant's survey did not show how the Dooney & Bourke It-Bag affected a customer's opinion of the Louis Vuitton multicolor bag.

Following the close of discovery, Dooney & Bourke filed a motion for summary judgment, which the district court granted.¹⁸⁶ Notably, the court held that the FTDA governed Louis Vuitton's federal dilution claim insofar as it sought money damages, and that the TDRA applied to the claim for injunctive relief.¹⁸⁷ Applying the Second Circuit's standard for federal dilution claims that the marks at issue must be "very" or "substantially similar," the court found that the marks were not sufficiently similar to sustain a dilution claim.¹⁸⁸

VII. CONCLUSION

If there is one lesson to be learned from analyzing the recent history of trademark dilution law, it is that dilution is an ever-evolving concept whose definition—even when painstakingly crafted by lawmakers—still leaves much room for courts' own interpretations. Given the trademark community's collective experience with the FTDA from 1996 through the passage of the TDRA in 2006, we should not be surprised that the early decisions issued after enactment of the TDRA demonstrate a variety of approaches in considering survey evidence of dilution. Even so, the case law discussed above presents an early opportunity to assess survey-related issues and to develop strategies for effective and doctrinally-sound surveys. In light of these decisions, several issues emerge that are worthy of further consideration, and which have yet to be definitively resolved by the courts applying the TDRA:

- Whether it is more appropriate (1) to conduct a single survey measuring both confusion and dilution or (2) to conduct separate surveys for confusion and dilution.
- Whether and to what extent confusion surveys can be relevant evidence for claims of dilution by blurring and/or dilution by tarnishment.

186. *See id.* at 372.

187. *Id.* at 390 & n.144.

188. *See id.* at 390. Even though the court purported to "assess the other elements" of Louis Vuitton's dilution claim, *id.* at 390-91, the court did not make reference to any aspect of the TDRA. Instead, the court discussed applicable FTDA law under *Moseley*, and stressed that Louis Vuitton's "anecdotal evidence" of actual dilution, including evidence that "consumers mentally associate the junior user's mark with a famous mark," was insufficient. *Id.* at 391-92.

- How a successful dilution by tarnishment survey should be constructed.

For the sake of businesses, their attorneys, and survey experts alike, the hope remains that courts will continue to clarify their expectations and to establish meaningful guidelines for conducting dilution surveys under the TDRA.
