

## AVERY DENNISON CORP. V. SUMPTON

*By Leslie F. Brown*

The need for federal trademark dilution protection has been a hotly debated issue for several decades.<sup>1</sup> The debate did not end with the passage of the Federal Trademark Dilution Act of 1995 ("Dilution Act").<sup>2</sup> Commentators disagreed over the necessity of federal dilution protection. Critics of the Act argued that the similarity between the language of existing trademark law and the proposed law would result in inconsistent applications and that the new law would give trademark holders monopolies or "ownership" of their marks.<sup>3</sup> In contrast, supporters of the amendment felt that a federal dilution statute would create consistency by federalizing existing state law.<sup>4</sup> Furthermore, supporters felt the Dilution Act would function as a weapon to prevent trademark infringement on the Internet.<sup>5</sup>

Recently, in *Avery Dennison Corp. v. Sumpton*,<sup>6</sup> the court applied the Dilution Act in a way that supporters will herald, but critics will condemn. In Avery Dennison, the Dilution Act was used to force Jerry Sumpton, a businessman, to transfer two of his registered domain names to Avery

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1. For background on the Dilution Act debate, see generally James West Marco-vitz, *Ronald@McDonalds.com—"Owning a Bitchin" Corporate Trademark as an Internet Address—Infringement?*, 17 CARDOZO L. REV. 85 (1995) (arguing that in order to protect holders from misuse of their marks as Internet addresses, the Lanham Act must be amended to include anti-dilution protection), and Kenneth L. Port, *The "Unnatural" Expansion of Trademark Rights: Is a Federal Dilution Statute Necessary?*, 18 SETON HALL LEGIS. J. 433 (1994) (arguing that a federal anti-dilution statute would overlap with existing state and federal trademark protection, be applied inconsistently, and expand trademark holder's right beyond the stated objectives of the Lanham Act).

2. 15 U.S.C. § 1125(c) (1998).

3. See Port, *supra* note 1, at 447-63.

4. See H.R. REP. NO. 104-374, § 5 (1995). The House Report stated that the purpose of the bill was to "bring uniformity and consistency to the protection of famous marks." *Id.*

5. As Senator Patrick Leahy of Vermont stated, "Although no one else has yet considered this application, it is my hope that this antidilution statute can help stem the use of deceptive Internet addresses taken by those who are choosing marks that are associated with the products and reputations of others." *Intermatic, Inc. v. Toeppen*, 947 F. Supp. 1227, 1238 (N.D. Ill. 1996) (quoting 141 CONG. REC. S19312 (daily ed. Dec. 29, 1995) (statement of Sen. Leahy)).

6. 999 F. Supp. 1337 (C.D. Cal. 1998).

Dennison Corp., the registered trademark holder of the names.<sup>7</sup> While this decision may have furthered the legislative goal of stemming trademark abuse on the Internet, it also extended trademark protection beyond the scope of the Dilution Act and previous case law. This Note examines how two previous cases involving “cybersquatters” were decided using the Dilution Act and compares their outcome to the decision of Avery Dennison. The discussion focuses on the interpretation of the factors articulated in the Dilution Act and the inconsistencies in analyzing these factors as illustrated by the cases. Finally, this Note addresses the far reaching and unfair effects the *Avery Dennison* decision may have on future cases in which the Internet and trademark law intersect.

## I. FEDERAL TRADEMARK DILUTION ACT OF 1995

Traditionally, trademark infringement exists where there is a “likelihood of confusion … or mistake” as to the origin of competing products.<sup>8</sup> Marks only conflict if their use causes consumer confusion. Confusion results from merchants using the marks to promote competing goods or goods within the same marketing region.<sup>9</sup> While the Lanham Act provides protection against this traditional type of infringement, trademark holders are also concerned with damage to their marks caused by uses of their mark in the absence of confusion or competition. This idea of expanding trademark law to protect a trademark’s value in the marketplace was first articulated by Professor Frank Schechter in 1927.<sup>10</sup>

According to Professor Schechter the traditional “confusion” basis for trademark protection was not sufficient in the modern consumer setting.<sup>11</sup>

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7. A domain name is a unique alphanumeric identifier assigned to each computer that has access to the Internet. Domain names consist of at least two parts - the “top level” domain and the “second level” domain. The rightmost string is called the “top level” domain and gives some indication of the type of organization administering the system. There are seven generic top level domains: “com” (commercial organizations), “edu” (educational), “gov” (government), “mil” (military), “org” (other organizations), “int” (organizations established by international treaties), and “net” (network providers). See Jon Postel, *Domain Name System Structure and Delegation*, RFC 1591 (Mar. 1994) (visited Oct. 14, 1998) <<http://info.internet.isi.edu/in-notes/rfc/files/rfc1591.txt>>. The second level domain name is typically used to identify the entity maintaining the Internet web site. For example, in avery.com, “avery” is the second level domain name.

8. See 15 U.S.C. § 1125 (1998).

9. For example, no conflict would be found between a mark used to sell toothbrushes and an identical mark used to sell shoes.

10. See Frank Schechter, *The Rational Basis of Trademark Protection*, 40 HARV. L. REV. 813 (1927).

11. See *id.* at 814-19.

Schechter maintained that the true value of a trademark “lies in its selling power,” which is partly based upon a mark’s “uniqueness and singularity” in the marketplace.<sup>12</sup> Consequently, a mark used on a non-competing product could devalue an original mark’s selling power.<sup>13</sup> Schechter defined the resultant injury to the original mark as “the gradual whittling away or dispersion of the identity” of the mark caused from the mark’s use on non-competing goods.<sup>14</sup>

Although many states adopted anti-dilution statutes, a federal dilution statute was not enacted until 1995 when Congress amended the Lanham Act to include the Federal Trademark Dilution Act.<sup>15</sup> The Dilution Act adopted anti-dilution law similar to existing state laws.<sup>16</sup> Unlike traditional federal trademark law, which focuses on protection of the consumer, the Dilution Act’s primary focus is the protection of “famous marks.”<sup>17</sup> The amendment eliminated the need to prove consumer confusion in an action to bar the use of “another person’s commercial use in commerce of a mark ... if such use begins after the mark has become famous and causes dilution of the distinctive quality of the mark.”<sup>18</sup> The Dilution Act defines dilution as “the lessening of the capacity of a famous mark to identify and distinguish goods and services.”<sup>19</sup> Only injunctive relief is available under the Dilution Act; however, if there is a showing that the defendant “willfully intended to trade on the owner’s reputation or to cause dilution of the famous mark,” then the trademark holder is entitled to the additional remedies of lost profits, attorneys fees, and costs.<sup>20</sup> Consistent with its intent to only prohibit dilution in the context of “commercial use,” the Dilution Act explicitly exempts fair use, non-commercial use, and use in news reporting and commentary.<sup>21</sup>

Application of the statute usually addresses one of two forms of dilution—“blurring” or “tarnishment.”<sup>22</sup> The more common type of dilutive harm is blurring. Blurring occurs when a well-known mark is used in con-

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12. *See id.* at 831.

13. *See id.* at 825.

14. *See id.* at 825.

15. *See* 15 U.S.C. § 1125 (1998).

16. Today over twenty-five states have adopted anti-dilution statutes. *See RESTATEMENT (THIRD) OF UNFAIR COMPETITION* § 25 (1995).

17. *See* 15 U.S.C. § 1125(c) (1998).

18. *Id.*

19. 15 U.S.C. § 1127 (1998).

20. *See* 15 U.S.C. § 1125(c)(2).

21. *See id.* § 1125(c)(4).

22. *See* J. THOMAS McCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION §§ 24.15 -16 (1998).

nection with a non-competing product.<sup>23</sup> Either because of a high degree of uniqueness or the extensive advertising efforts of the trademark holder, the mark becomes associated with a positive image. The harm occurs when a subsequent party ("junior user") uses the same mark on a different non-competing product or service, thereby creating in the consumer's mind a new association with the mark. The original mark is blurred to the extent that this new association decreases the mark's selling power.<sup>24</sup> Some examples are "DuPont shoes" and "Kodak pianos."

The more direct and offensive form of dilution, tarnishment, occurs when the unauthorized use of a mark results in negative associations with the mark.<sup>25</sup> In a recent tarnishment case, a defendant faced dilution charges for using a mark similar to the plaintiff's mark for advertising pornographic products and services on the Internet.<sup>26</sup> The district court found that the defendant's use of the mark "Adults R Us" tarnished the "Toys R Us" family of marks "by associating them with a line of sexual products that are inconsistent with the image Toys 'R' Us has striven to maintain for itself."<sup>27</sup>

In analyzing liability for federal trademark dilution, courts consider several elements: 1) the famousness of a mark; 2) the commercial use of the trademark in commerce; 3) whether the use began after the mark became famous; and 4) whether the use has caused dilution of the distinctive quality of the mark.<sup>28</sup> In determining the famousness or distinctiveness of a mark the Dilution Act suggests eight factors to consider in determining whether a mark is distinctive or famous.<sup>29</sup>

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23. See JEROME GILSON, TRADEMARK PROTECTION AND PRACTICE § 5.11[4] (1996).

24. See, e.g., WAWA, Inc. v. Haaf, 1996 WL 460083 (E.D. Pa. 1996) (results of market survey showed that 29% of those interviewed at defendant's HAHA market associated it with plaintiff's WAWA market).

25. See, e.g., Hasbro, Inc. v. Internet Entertainment Group, 1996 WL 84853 (W.D. Wash. 1996) (holding that defendant's use of candyland.com for a pornographic web site tarnished plaintiff's Candy Land mark, used to identify a children's board game).

26. See Toys "R" Us, Inc. v. Akkaoui, 1996 WL 772709, \*3 (N.D. Cal. 1996).

27. See *id.*

28. See 15 U.S.C. § 1125(c) (1998).

29. The Dilution Act provides:

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

(A) the degree of inherent or acquired distinctiveness of the mark;

(B) the duration and extent of use of the mark in connection with the goods or services with which the mark is used;

(C) the duration and extent of advertising and publicity of the mark;

(D) the geographical extent of the trading area in which the mark is used;

Although the language of the statute appears straightforward, recent court decisions demonstrate that the courts have had difficulty in interpreting all of these elements and that they have found dilution even where elements may be lacking. The following sections examine three Internet domain name disputes that applied the Dilution Act. Part II.A provides a factual background for each of the cases. Part II.B compares each court's analysis of the dilution claim elements. Finally, Part III discusses the effects the *Avery Dennison* decision may have on future dilution claims.

## II. APPLYING THE FEDERAL TRADEMARK DILUTION ACT TO DOMAIN NAME DISPUTES: THREE CASES

### A. Background

#### 1. *Panavision International, L.P. v. Toeppen*<sup>30</sup>

Dennis Toeppen, the defendant in the first two cases, has been accused by many people of being a "cybersquatter." A cybersquatter is someone who registers Internet addresses using popular trademarks as the domain name identifier and then attempts to sell the domain name to the registered trademark holder for profit.<sup>31</sup> The typical cybersquatter will register a domain name using the mark of a business with "deep pockets." Cybersquatters operate under the assumption that it is cheaper for the trademark holder to pay them to hand over the domain name than it is for the holder to litigate. By 1996, Toeppen had registered over 240 domain names including, deltaairlines.com, eddiebauer.com, neiman-marcus.com, and yankeestadium.com.<sup>32</sup> Panavision International is a well-established manu-

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(E) the channels of trade for the goods or services with which the mark is used;

(F) the degree of recognition of the mark in the trading areas and channels of trade used by the marks' owner and the person against whom the injunction is sought;

(G) the nature and extent of use of the same or similar marks by third parties; and

(H) whether the mark was registered under the Act of March 3, 1881, or the Act of February 20, 1905, or on the principal register.

*Id.* § 1125 (c)(1)(A)-(H).

30. 945 F. Supp. 1296 (C.D. Cal. 1996), *aff'd* by *Panavision Int'l, L.P. v. Toeppen*, 141 F. 3d 1316 (9th Cir. 1998). For a complete discussion of the *Panavision* holding, see Ughetta Manzone, *Panavision Int'l. v. Toeppen*, 13 BERKELEY TECH. L.J. 249 (1998).

31. See Greg Miller, *Cyber Squatters Give Carl's Jr., Others Net Loss*, L.A. TIMES, July 12, 1996, at A1 (discussing growing number of domain name and cybersquatting disputes).

32. See *Panavision*, 945 F. Supp. at 1300.

facturer of camera and filming equipment, that holds many federally registered trademarks, including the Panavision and Panaflex marks.<sup>33</sup>

In December of 1995, Toeppen applied for and received registration of the Internet domain name panavision.com.<sup>34</sup> The associated web page displayed an aerial photograph of Pana, Illinois.<sup>35</sup> Soon after, Panavision attempted to register the same address with InterNIC (the domain name registration service of Network Solutions, Inc., ("NSI")),<sup>36</sup> but was informed that the domain name was already in use by Toeppen.<sup>37</sup> When Panavision notified Toeppen of its desire to use the panavision.com domain name, Toeppen replied that he was willing to relinquish his use of the domain name for \$13,000.<sup>38</sup> After Panavision refused to pay, Toeppen registered the domain name panaflex.com.<sup>39</sup> At the panaflex.com address, Toeppen created a web page that simply said "Hello."<sup>40</sup> Panavision then sued alleging, among other claims, federal trademark dilution.<sup>41</sup>

On a motion for summary judgment, the district court held in favor of Panavision. The court found that Panavision was a famous mark,<sup>42</sup> that Toeppen's business of registering domain names to be sold later qualified as commercial use,<sup>43</sup> and that Toeppen's use diluted Panavision's mark by preventing it from identifying and distinguishing its products on the Internet.<sup>44</sup> The court enjoined Toeppen from further use of the web site and ordered him to relinquish the registration of the domain names to Panavision.<sup>45</sup>

The court in *Panavision* concluded by stressing that their decision was very narrow in scope. They were not granting carte blanche to trademark owners. The court's decision preserved the many fair uses available under the Dilution Act. One such use, the court discussed, was protection for a

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33. See *id.* at 1298.

34. See *id.* at 1300.

35. See *id.*

36. InterNIC handles administration of Internet addresses in the top level domains ".com," ".net," ".org," ".edu," and ".int." *InterNIC Frequently Asked Questions* (visited Oct. 28, 1998) <<http://rs.internic.net/faq/new-reg.html>>.

37. See *Panavision International, L.P. v. Toeppen*, 945 F. Supp. 1296, 1300 (C.D. Cal. 1996).

38. See *id.*

39. See *id.*

40. See *id.*

41. See *id.* at 1298.

42. See *Panavision International, L.P. v. Toeppen*, 945 F. Supp. 1296, 1302 (C.D. Cal. 1996).

43. See *id.* at 1303.

44. See *id.*

45. See *id.* at 1306.

party who innocently registers a famous trademark as a domain name.<sup>46</sup> For example, someone from Pana, Illinois could register the panavision.com web site to provide a community political forum.<sup>47</sup>

## 2. *Intermatic Incorporated v. Toeppen*<sup>48</sup>

The facts of *Intermatic* are very similar to *Panavision*. Intermatic is a manufacturer and distributor of electrical and electronic products, sold under the name and trademark "Intermatic." In 1995, Toeppen registered the domain name intermatic.com with NSI.<sup>49</sup> In addition to using the mark as his Internet address, he advertised a software product with the name "Intermatic" on the web page.<sup>50</sup> Subsequently, when Intermatic wished to register the domain name and to begin conducting business on the web, they learned that Toeppen had already registered the domain name. Intermatic demanded that Toeppen discontinue use of the mark and relinquish the web site.<sup>51</sup> Toeppen agreed to discontinue use of the Intermatic mark for his software product, but refused to relinquish his domain name registration.<sup>52</sup> At Intermatic's request, NSI placed Toeppen's registration on hold.<sup>53</sup> Intermatic then filed suit, like Panavision, alleging trademark dilution.

The district court granted summary judgment for Intermatic.<sup>54</sup> The court found as a matter of law that the Intermatic mark is famous.<sup>55</sup> Next, the court found the commercial use requirement was satisfied by Toeppen's "intention to arbitrage" the domain name.<sup>56</sup> Simple "use of the Internet" was sufficient to fulfill the "in commerce" requirement.<sup>57</sup> Finally, Toeppen's use caused dilution by preventing Intermatic from using its own mark as a domain name.<sup>58</sup> The court ordered Toeppen to transfer

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46. See *id.* at 1304.

47. See *id.*

48. 947 F. Supp. 1227 (N.D. Ill. 1996).

49. See *id.* at 1232.

50. See *id.*

51. See *id.*

52. See *id.*

53. According to Network Solutions Domain Name Dispute Policy, when the right to use a particular domain name is disputed, the domain in dispute may be placed on hold pending litigation. Network Solutions, Inc., *Network Solutions' Domain Name Dispute Policy* (visited Nov. 1, 1998) <<http://rs.internic.net/domain-info/internic-domain-6.html>>.

54. See *Intermatic, Inc. v. Toeppen*, 947 F. Supp. 1227, 1241 (N.D. Ill. 1996).

55. See *id.* at 1239.

56. See *id.*

57. See *id.*

58. See *id.* at 1240.

the domain name registration to Intermatic and enjoined him from any use of the Intermatic mark.<sup>59</sup>

### 3. *Avery Dennison v. Sumpton*<sup>60</sup>

Jerry Sumpton is a principal owner of a Canadian based domain name leasing company, Freeview Listings Ltd., which does business on the Internet as "Mailbank" (located at <<http://www.mailbank.com>>).<sup>61</sup> Freeview registered over 12,000 domain names with NSI and leases e-mail and web site addresses to persons on these domains. Freeview classifies the domain names into an assortment of categories including places, people, hobbies, and family names.<sup>62</sup> Freeview's business profits from an Internet user's desire to have an e-mail or web site address that incorporates their surname or some special interest they may have, somewhat similar to a vanity license plate. For example, if Freeview owned barker.net, a user could lease the e-mail address "bob@barker.net" or the web site "<http://bob.barker.net>". Among the domain names Freeview registered were avery.net and dennison.net.<sup>63</sup> Freeview listed both under the "Family Name" category.<sup>64</sup> Like the other domain names registered by Sumpton, these addresses were available for lease as an e-mail or web site address.<sup>65</sup>

Avery Dennison, a manufacturer and distributor of office products, does business under the names "Avery" and "Avery Dennison." Avery Dennison holds a number of federally registered trademarks, including "Avery" and "Dennison."<sup>66</sup> Avery Dennison is the owner of the domain names avery.com and averydennison.com, located in the commercial top level domain, ".com," and conducts business at these web sites.<sup>67</sup> Nonetheless, when Avery Dennison became aware that Freeview had registered the avery.net and dennison.net domain names, they offered to purchase the

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59. See *id.* at 1241.

60. 999 F. Supp. 1337 (C.D. Cal. 1998).

61. See David M. Kelly and Marjorie Goux, *Taking Thy Name in Vain*, IP MAGAZINE (July 1998) (visited Sep. 15, 1998) <<http://www.ipmag.com/98-july/goux.html>>.

62. See *id.*; Mailbank, *Mailbank Homepage* (visited Oct. 2, 1998) <<http://www.mailbank.com>>.

63. See *Avery Dennison Corp. v. Sumpton*, 999 F. Supp. 1337, 1338 (C.D. Cal. 1998).

64. See Kelly and Goux, *supra* note 61.

65. See *id.*

66. See *Avery Dennison*, 999 F. Supp. at 1338.

67. The ".com" top level domain is most commonly used for commercial businesses. See Postel, *supra* note 7. The ".net" TLD is used for network related organizations. See *id.*

domain names from Freeview. After Freeview refused to sell, Avery Dennison brought suit alleging trademark dilution.<sup>68</sup>

The district court began its analysis by assuming that Sumpton was a "cybersquatter."<sup>69</sup> Because Sumpton had registered so many domain names, the court assumed that his purpose "was to make a financial return by exacting a price before consenting to allow others to use the domain on which they ... 'squat.'"<sup>70</sup> Once that determination was made, the court went on to apply the decisions of two prior cybersquatting cases, *Panavision* and *Intermatic*, which held that registration of a domain name that makes use of a famous mark for the purpose of trading on the value of the mark is dilution under the Dilution Act.<sup>71</sup> The court ordered Sumpton to relinquish registration of the domain names to Avery Dennison.<sup>72</sup> Despite the fact that the court began its opinion by declaring Sumpton a cybersquatter, it appears that it did not believe that the facts conclusively supported such a finding. Instead of simply demanding that Sumpton relinquish the sites, the court ordered Avery Dennison to compensate Sumpton \$300 for each domain name.<sup>73</sup>

## B. Analysis of the Federal Dilution Claims

The *Avery Dennison* court relied heavily on the "uniform outcome of decided cases involving cybersquatters and the holders of famous trademarks."<sup>74</sup> This reliance may have been misplaced for two reasons. First, cybersquatters should be a very narrow group of people (those who register a mark as a domain name purely for the opportunity to trade on the value of the mark), and there are very few decisions on record, other than *Panavision* and *Intermatic*, explicitly dealing with cybersquatting.<sup>75</sup> In ad-

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68. See *Avery Dennison Corp. v. Sumpton*, 999 F. Supp. 1337, 1338 (C.D. Cal. 1998).

69. See *id.*

70. See *id.*

71. See *id.* at 1340.

72. See *id.* at 1342.

73. See *id.*

74. *Avery Dennison Corp. v. Sumpton*, 999 F. Supp. 1337, 1338 (C.D. Cal. 1998). This reliance may be misplaced because there appear to be very few decisions, other than *Panavision* and *Intermatic*, explicitly dealing with cybersquatting.

75. In other recent domain name disputes in which courts have found violation of the Dilution Act, there has been a showing of blurring or tarnishment. See *Planned Parenthood, Inc. v. Bucci*, 1997 WL 133313 (S.D.N.Y. 1997) (blurring); *Jews for Jesus v. Brodsky*, 993 F. Supp. 282 (D. N.J. 1998) (blurring); *Toys "R" Us, Inc. v. Akkaoui*, 1996 WL 772709 (N.D. Cal. 1996) (tarnishment); *Hasbro, Inc. v. Internet Entertainment Group, Ltd.*, 1996 WL 84853 (W.D. Wash. 1996) (tarnishment). See generally The John Marshall Law School, *Domain Name Disputes* (last modified Sept. 8, 1998)

dition, it should not be a foregone conclusion that Sumpton *is* a cybersquatter. Just because someone registers a domain name that incorporates a trade or service mark, it does not automatically mean that they are using the mark inappropriately. In fact, several disputes have been reported in which the trade or service mark holder ultimately chose not to litigate against a domain name registrant who used their mark as a domain name.<sup>76</sup> These instances, like *Avery Dennison*, typically involve registration of a domain name for its “name” value rather than its “mark” value. Nonetheless, it appears that the *Avery Dennison* court decided that Sumpton was close enough to a cybersquatter and used that as the basis for its decision.

Even if the court had not declared Sumpton a cybersquatter, it would be instructive at least to consider the Dilution Act analysis articulated earlier in Section I. Unfortunately, in *Avery Dennison*, the court’s opinion did not include as exhaustive an analysis as earlier Dilution Act decisions. It appears from the tone of the opinion that the court did not believe any of the defenses Sumpton raised.<sup>77</sup> Nevertheless, the court purports to have conducted a four part analysis to determine whether Sumpton’s use of the domain names diluted Avery Dennison’s marks. The analysis, a slight variation of traditional dilution analysis, examines whether: 1) the mark is famous, 2) it has been used in the ordinary course of trade, 3) the use has diluted the mark, and 4) the principles of equity require an injunction.<sup>78</sup>

The *Panavision* and *Intermatic* cases illustrate thoughtful application of the Dilution Act. The courts conducted fairly thorough analyses of all the suggested factors and the two holdings contained boundaries. In contrast, the court in *Avery Dennison* did not conduct a similar analysis as

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<<http://www.jmls.edu/cyber/index/domain.html>> (archiving cases and other news relating to domain name disputes).

76. Two such disputes involved the registration of pokey.org (mark owned by Prema Toy Co.) and veronica.org (mark owned by Archie comics). In these disputes, parents had registered the domain names for their children. Because neither instance involved any type of commercial activity at the site, litigation would have probably not proven successful. In addition, both situations drew loud public outcry—the court of public opinion demanded the children keep their web addresses. See Jeri Clauzing, *Boys Web Site Becomes a Domain Name Cause*, NY Times, *Cybertimes* (visited Dec. 2, 1998) <<http://www.nytimes.com/library/tech/98/03/cyber/articles>>.

77. A visit to a domain name registered by Sumpton could have allayed any doubts that the court had regarding Sumpton’s business. For example, a visit to <[www.smith.net](http://www.smith.net)> displays a Mailbank web page. An Internet user is able to see a list of all people who have registered an e-mail or a web address with Mailbank using the “smith” domain name. MailBank, *Smith.net* (visited Jan. 30, 1998) <<http://www.smith.net>>.

78. See *Avery Dennison*, 999 F. Supp. at 1339.

recommended by the Dilution Act. By comparing the analyses of the three courts, this Note illustrates how the *Avery Dennison* court misapplied the Dilution Act tests and, in doing so, broadened trademark protection beyond what the Dilution Act or precedent supports.

### 1. Famous Mark

The first element a plaintiff must prove in a trademark dilution claim is that their mark is famous. The Dilution Act only protects "famous marks."<sup>79</sup> Although a mark may be in common usage or even federally registered, the Dilution Act does not apply if a mark does not meet this standard.<sup>80</sup> The Dilution Act sets forth eight nonexclusive factors that may be used to determine whether a mark is distinctive and famous.<sup>81</sup> These factors include: 1) the degree of inherent or acquired distinctiveness, 2) the duration and extent of use of the mark in association with the goods or services with which the mark is used, 3) the duration and extent of advertising the mark, 4) the geographical area in which the mark is used, 5) the channels of trade in which the mark is used, 6) the degree of recognition of the mark within the trading areas and channels of trade used by the mark owner and the defendant, 7) the extent of the use of the mark by third parties, and 8) whether the mark is registered.<sup>82</sup> If a mark does not meet the threshold status of famous, the holder must seek an injunction under the higher standards of infringement.

The first factor requires that the plaintiff's mark possess a distinctive quality capable of dilution.<sup>83</sup> Marks that are arbitrary, fanciful, or coined are considered inherently distinctive and, therefore, "strong."<sup>84</sup> Marks that are not distinct are denominated "weak" and require a showing of acquired distinctiveness and secondary meaning for protection.<sup>85</sup>

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79. See 15 U.S.C. § 1125(c)(1) (1998).

80. See *Star Markets, Ltd. v. Texaco, Inc.*, 950 F. Supp. 1030 (D. Haw. 1996) (declining to address remaining elements of Dilution Act claim after finding that plaintiff's mark was not nationally famous).

81. See 15 U.S.C. § 1125(c)(1)(A)-(H) (1998).

82. See *id.*

83. See *Knaak Mfg Co. v. Rally Accessories, Inc.*, 955 F. Supp. 991, 1002 (N.D. Ill. 1997) (finding no possibility of dilution where mark was not unique and had not acquired secondary meaning); *Star Markets*, 950 F. Supp. at 1033 ("A mark must be especially famous and distinctive to merit protection under the Act.").

84. See *WAWA, Inc., v. Haaf*, 1996 WL 460083 (E.D. Pa. 1996) (holding plaintiff's mark was arbitrary and fanciful and, as such, satisfied first element in establishing a dilution claim).

85. See *Star Markets*, 950 F. Supp. at 1033. (finding that acquired distinctiveness is merely a minimum threshold, mark must still have secondary meaning to merit protection).

In *Avery Dennison*, Sumpton argued that the Avery and Dennison marks are not famous or distinctive.<sup>86</sup> The court did not address Sumpton's argument nor did the opinion support its finding that the marks are famous—it merely draws a conclusion based on the plaintiff's previous fact-finding that the Avery Dennison marks are famous.<sup>87</sup> Thus, its conclusion may be somewhat hasty.

It can be argued that "Avery" and "Dennison" are not inherently distinctive marks. In fact, Avery and Dennison are common surnames.<sup>88</sup> Surnames are considered weak marks and, as such, must acquire secondary meaning in order to obtain trademark protection.<sup>89</sup> "Secondary meaning" is the consumer's understanding that the mark refers not to what the descriptive mark ordinarily describes, but to the particular business that the mark is meant to identify.<sup>90</sup> The remaining seven factors enumerated in the Dilution Act address whether or not a mark has acquired distinctiveness and secondary meaning. There was no need to look at these factors if both parties agreed to the plaintiff's findings of uncontested facts. However, Sumpton argued that the marks were not famous. Nonetheless, the court does not address these factors and Avery Dennison made no showing that the marks had acquired distinctiveness and secondary meaning.

At this point in the analysis, it is useful to examine the two surnames independently. Because Avery Dennison markets products under the "Avery" name and the "Avery Dennison" label, the Avery mark and the

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86. See *Avery Dennison Corp. v. Sumpton*, 999 F. Supp. 1337, 1339 (C.D. Cal. 1998).

87. The court appears to reach its decision based on the plaintiff's Statement of Uncontested Facts and Conclusions of Law. See *id.* Yet, it is still instructive to examine this important factor.

88. Avery is the 775th most common name and Dennison is the 1786th most common name of 88,799 possible names in the United States. See Kelly and Goux, *supra* note 61.

89. See *R. J. Toomey Co. v. Toomey*, 683 F. Supp. 873, 878 (Mass. 1988) (finding that surnames when used as trademarks are inherently indistinctive). See also, *Perini Corp. v. Perini Construction, Inc.*, 915 F. 2d 121, 125 (4th Cir. 1990); *Hyatt Corp. v. Hyatt Legal Services*, 726 F. 2d 1153, 1158 (7th Cir. 1984). See also, 15 U.S.C. § 1052(c) (providing that names are not registrable without secondary meaning). See generally, Quentin R. Wittrock, *Use of Personal Names in Noncompeting Businesses - Doctrines of Unfair Competition, Trademark Infringement, and Dilution*, 70 IOWA L. REV. 995, 1012 (1995) (finding that dilution doctrine rarely applied in the context of personal name cases because only unique and distinctive business marks are protected).

90. See *Gazette Newspapers, Inc. v. New Paper, Inc.*, 934 F. Supp. 688, 694 (D. Md. 1996) ("To establish secondary meaning, ... a[mark must] identify the source of the product rather than the product itself") (quoting *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 766 n.4 (1992)).

two marks together are likely to have secondary meaning. However, it is not clear that the Dennison mark alone should be granted this standing. This is important because Avery Dennison claims that the marks are diluted even though Freeview has registered the domain names using the names individually.<sup>91</sup> Freeview has not registered averydennison.net or any variation thereof. There is nothing to indicate that Avery Dennison ever conducted business solely using the "Dennison" mark. Dennison is not used in connection with a product, is not used by itself in advertising, and would probably not be recognized as a source of office products. Additionally, the Dennison name is used by many others in a commercial context.<sup>92</sup> In fact, the trademark disclaimer on the Avery Dennison web site does not include "Dennison" among its trademarks.<sup>93</sup> Thus, the "Avery" mark should be considered weak and the "Dennison" mark should fail the "famous" requirement for protection.

## 2. *Used in the Ordinary Course of Trade (Commercial Use in Commerce)*

Next, the court in *Avery Dennison* must address whether Sumpton used the marks in the ordinary course of commerce. Most courts break this element into two components—was the use "in commerce" and was the use "commercial" in nature.<sup>94</sup> The "in commerce" requirement is construed liberally and, as such, most courts find that simple use of the Inter-

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91. See *Avery Dennison Corp. v. Sumpton*, 999 F. Supp. 1337, 1338 (C.D. Cal. 1998).

92. A search of the Internet, using the Excite search engine, revealed several web sites for businesses using the name Dennison, including, Dennison Int'l (dennison-intl.com); Dennison Ford (dennisonford.com); Dennison Online Internet School (dennisononline.com). Search conducted Nov. 10, 1998.

93. See *Avery Dennison, Trademark Notice and Disclaimer* (visited Nov. 2, 1998) <<http://www.averydennison.com/ad/copyright.htm>>. The Disclaimer notes:

### TRADEMARK NOTICE

The following brands and product names mentioned in this web site are trademarks of Avery Dennison Corporation: Avery, Avcoat, Avery Computer Central, Avery Dennison, Avery Kids, Avery Personal Creations, Avery Wizard, Avloy, Bar-Lok, BinderPack, CD Tracs, ClearADvantage, Direct Print, Dry Paint, DualSharp, EverBold, Exact, FasClear, Fasson, GraphiColor, Hi-Liter, Index Maker, LabelPro for Windows, MacLabelPro, Marks-A-Lot, Metalure, Mirage, NotePack, Presidax, Primax, Ready Index, SmartFolio, Soabar, Plastic Staple, StaySharp, Swiftach, Therimage, Thermark, and Ticket Express.

*Id.*

94. See *Panavision International, L.P. v. Toeppen*, 945 F. Supp 1296, 1303 (9th Cir. 1998); *Intermatic, Inc., v. Toeppen*, 947 F. Supp. 1227, 1239 (N.D. Ill. 1996).

net is sufficient to meet the “in commerce” requirement of the Dilution Act.<sup>95</sup>

However, assessing the second requirement of “commercial use” is more difficult, even when the Internet is not involved. Once you involve the Internet, you get a spectrum of possibilities—at one end, mere registration of a famous mark as an Internet address, without more, is not commercial use within the prohibitions of the Dilution Act.<sup>96</sup> However, at the other end of the spectrum, it is not necessary that an Internet web site propose a commercial transaction in order to meet the commercial use requirement.<sup>97</sup> The *Intermatic* and *Panavision* courts found that Toeppen’s “business” was to arbitrage the marks by hoping that their registered owner would find it cheaper to buy the domain names from him rather than sue.<sup>98</sup> The courts held that trading on the value of the domain names meets the requirement of “commercial use” as defined in the statute.<sup>99</sup>

In *Avery Dennison*, Sumpton’s business is to lease vanity e-mail addresses and web sites. He does not trade on the value of the domain names as trademarks. Unlike Toeppen, the *Panavision* and *Intermatic* defendant, Sumpton has not attempted to sell the domain names to the trademark holder. Nonetheless, Sumpton conceded that leasing the domain names was a commercial use of the *domains*, but argued that the domain names were used as addresses and, as such, were not used as “commercial marks” within the meaning of the Lanham Act. The court in *Avery Dennison* disagreed and established its own definition that a mark is “used in the ordinary course of trade”

when (a) it is registered as a domain name by a registrant who is not otherwise identified by or associated with any of the commonly accepted meanings of the domain name, and (b) it is not used by the registrant as its own domain name, but rather is held by the registrant for sale or license to others.<sup>100</sup>

This is rather broad language that implies that any time a domain name that is not inherently distinctive is registered for use as an e-mail server or

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95. See *Intermatic*, 947 F. Supp. at 1239.

96. See *id.* at 1303.

97. See *Panavision*, 945 F. Supp. at 1325 (“It does not matter that he did not attach the marks to a product. Toeppen’s commercial use was his attempt to sell the trademarks themselves.”).

98. See *id.*; *Intermatic*, 947 F. Supp. at 1239.

99. See *Panavision*, 945 F. Supp. at 1303; *Intermatic*, 947 F. Supp. at 1239. See also Planned Parenthood Federation of America v. Bucci, 1997 WL 133313, \*2 (S.D.N.Y. 1997).

100. *Avery Dennison Corp. v. Sumpton*, 999 F. Supp. 1337, 1339 (C.D. Cal. 1998).

Internet Service Provider, the domain name takes the status of a trade or service mark. This is in direct opposition to the position taken by the United States Patent and Trademark Office ("PTO"). The PTO states that a domain name is not automatically a trade or service mark unless it does something more than merely provide directional information.<sup>101</sup> Thus, Sumpton's domain names only direct e-mail to subscribers and Internet users to personal web pages; they are not marks that represent a good or service promoted at the web site.

Finally, the court acknowledged that the court could allow Sumpton to retain registration of the marks so long as they were used in a non-infringing way. However, the court surmised that this would "eliminate 12,000 words from their highest and best use as domain names."<sup>102</sup> The court brushed aside the fact that Avery Dennison already had registered the domain names "avery" and "averydennison" on the ".com" namespace—the namespace specified for commercial use.<sup>103</sup> In the year since the decision that forced Sumpton to transfer the domain names to Avery Dennison, Avery Dennison has not used the disputed domain names to promote its business. In fact, the web sites no longer exist.<sup>104</sup> The court argued that the best use for the domain names was to hand over registration to Avery-Dennison, yet in doing so, the two web sites were removed from use rather than put to their "highest use" of identifying a product.

In fact, one might argue that the "highest and best use of a domain name" is one that maximizes the number of users. Sumpton's business is to lease "personal" web sites. Instead of restricting the use of avery.net and dennison.net to one user, Sumpton's service allows the sites to host as many web sites as people wish to register. If there are 3,000 people who wish to have a web address that uses the Avery or Dennison domain name, there is no restriction. Nonetheless, the court endorsed a solution that basically discarded the avery.net and dennison.net addresses.

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101. See , United States Patent and Trademark Office, *Trademark Examination of Domain Names* (visited Sept. 15, 1998) <<http://uspto.gov/web/offices/tac/domain/tmdomain.htm>> ("The use of an internet domain name as a mere directional reference, similar to use of a telephone number or business address on stationery, business cards, or advertisements, is not use of the name as a source identifier."). See also *In re Advertising & Marketing Development, Inc.*, 821 F.2d 614 (Fed. Cir. 1987).

102. See *Avery Dennison*, 999 F. Supp. at 1340. Is the court suggesting that all of the domain names should be relinquished?

103. See *id.* at 1341 n.5.

104. Entering the addresses <www.avery.net> and <www.dennison.net> produced error messages stating that the web sites could not be found. Searches conducted on Oct. 1, 1998, Nov. 28, 1998, and Jan. 10, 1999.

### 3. *Dilution of the Distinctive Quality of Avery Dennison's Marks*

The *Panavision* and *Intermatic* courts found that Toeppen's conduct varied from the two standard dilution theories—blurring and tarnishment.<sup>105</sup> Toeppen had neither associated the mark with products of poor quality nor used the mark in a way that "whittled away" at the value of the mark.<sup>106</sup> Nonetheless, the courts concluded that Toeppen's registration of the domain names diluted the marks because he had "eliminated the capacity of the Panavision marks to distinguish goods and services on the Internet."<sup>107</sup> The *Intermatic* court further concluded that

if Toeppen were allowed to use 'intermatic.com', Intermatic's name and reputation would be at his mercy and could be associated with an unimaginable amount of messages on Toeppen's web page.... Attaching Intermatic's name to a myriad of possible messages, even something as innocuous as a map of Urbana, Illinois, is something that the Act does not permit.<sup>108</sup>

Citing the holdings of *Panavision* and *Intermatic*, the court in *Avery Dennison* concluded that it "lessens the capacity of a famous mark to identify and distinguish goods or services" when someone other than the trademark holder registers the domain name.<sup>109</sup>

However, *Avery Dennison* is distinguishable from *Intermatic* and *Panavision* for various reasons. In *Panavision* and *Intermatic*, the marks at issue were highly distinctive. In addition, Toeppen's registrations denied the rightful mark owners from using their marks as their commercial domain names. In contrast, in *Avery Dennison*, the marks at issue were not unique. Furthermore, Avery Dennison already had ownership of the domain names that will most likely be entered by their prospective customers—avery.com and averydennison.com. Sumpton is not preventing Avery Dennison from using its trademark as its domain name. Avery Dennison's ability to identify its goods and services is not significantly diminished by the existence of the ".net" addresses. Consumers searching for Avery Dennison products on the Internet are not likely to begin a search using a

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105. See *supra* Part I.

106. See *Panavision International, L.P. v. Toeppen*, 945 F. Supp. 1296, 1304 (C.D. Cal. 1996).

107. See *id.*

108. *Intermatic, Inc. v. Toeppen*, 947 F. Supp. 1227, 1240 (N.D. Ill. 1996).

109. See *Avery Dennison Corp. v. Sumpton*, 999 F. Supp. 1337, 1340 (C.D. Cal. 1998).

TLD of ".net."<sup>110</sup> Likewise, web users are not likely to start their search with "Avery" alone. Finally, web users are even less likely to begin their search solely using "Dennison." With this in mind, it is difficult to see how Sumpton's registration of avery.net and dennison.net had "lessened the ability of the marks to identify goods or services."

#### 4. *Balancing the Equities*

Because plaintiffs seek equitable relief for dilution, the court must balance the factors to determine if equity demands an injunction.<sup>111</sup> Courts should not only examine the elements of the statute, but also balance additional factors, such as, the legislative intent of the Dilution Act, whether the defendant acted with predatory intent, public interest considerations, and the resulting harm to the losing party.<sup>112</sup>

The intent of the Dilution Act is to protect famous marks from the damaging effects of use by another in a non-competing environment.<sup>113</sup> The court's analysis in *Avery Dennison* does not strongly support the legislative intent for either of these components. The court's opinion does not support a finding that the Avery and Dennison marks are famous enough for protection. In addition, there is little in the opinion to support a holding that Sumpton's registration of avery.net and dennison.net have in any way lessened Avery Dennison's trademark. The opinion does not reveal tarnishment or blurring, but it does reveal that Avery Dennison is still able to use the optimal domain name for conducting business on the Internet.

Furthermore, courts must address the intent of the defendant as a relevant factor in assessing a dilution claim.<sup>114</sup> When a defendant has acted willfully, courts are more likely to find dilution.<sup>115</sup> The court in *Panavision* used very deliberate language to make clear that its decision balanced

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110. For a discussion of how Internet users locate web sites, see Malcolm MacLachlan, *Keywords Threaten Domain Name System*, TechWeb (visited Nov. 30, 1998) <<http://www.techweb.com>>.

111. See *Mead Data Central, Inc. v. Toyota Motor Sales, U.S.A., Inc.*, 875 F.2d 1026, 1028 (2d Cir. 1989) (citing *Sally Gee, Inc. v. Myra Hogan, Inc.*, 699 F.2d 621, 626 (2d Cir. 1983)).

112. See *id.* See also *Hyatt Corp. v. Hyatt Legal Services*, 736 F.2d 1153, 1159 (7th Cir. 1984).

113. See Jerome Gilson, TRADEMARK DILUTION NOW A FEDERAL WRONG: AN ANALYSIS OF THE FEDERAL TRADEMARK DILUTION ACT OF 1995 (1996).

114. See *Mead Data Central*, 875 F.2d at 1028 (quoting *Sally Gee*, 699 F. 2d 621, 626 (2d Cir. 1983)) ("The absence of predatory intent by the junior user is a relevant factor in assessing a claim under the anti-dilution statute.").

115. See *Hyatt*, 736 F. 2d at 1037.

the principles of "fair competition and free competition."<sup>116</sup> It specifically noted that the Dilution Act excepts certain uses of famous marks and protects persons who "innocently" register a famous mark as a domain name.<sup>117</sup> Even the egregious behavior of Toeppen was not enough to find "willful" dilution of the Intermatic mark.<sup>118</sup> Unlike the *Panavision* and *Intermatic* cases, there is nothing in the *Avery Dennison* opinion to suggest that Sumpton's intent was to cash in on the Avery Dennison mark. Many domain names are registered using famous marks, but when there is no showing of predatory intent, there is no cause for dilution.<sup>119</sup>

Courts must also examine how their decisions will serve the public interest and potentially harm the losing party.<sup>120</sup> The *Avery Dennison* court asserts that its decision will result in the "highest and best use"<sup>121</sup> of the domain names. Supporting Avery Dennison's argument that the Internet "does not authorize the registration of any domain names that are commonly used by others to identify themselves ... for sale or license to others,"<sup>122</sup> the court summarily declares that Sumpton does not have a legitimate business,<sup>123</sup> that Sumpton is merely a cybersquatter,<sup>124</sup> and that the Internet registration system simply does not authorize cybersquatting.<sup>125</sup> This argument should fail because it is common practice for Internet Service Providers ("ISPs") to sell and license e-mail addresses to others.<sup>126</sup> As Sumpton commented, "We can share domain names much cheaper than if a person or firm registers it themselves for their own sole use."<sup>127</sup>

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116. See *Panavision Int'l, L.P. v. Toeppen*, 945 F. Supp. 1296, 1304 (C.D. Cal. 1996) (quoting J. THOMAS McCARTHY, *McCARTHY ON TRADEMARKS AND UNFAIR COMPETITION*, § 24 (1996)).

117. See *id.* at 1404.

118. See *Intermatic, Inc. v. Toeppen*, 947 F. Supp. 1227, 1241 (N.D. Ill. 1996).

119. For a discussion on "innocent" web site registration, see Clauzing, *supra* note 67.

120. See *Hyatt Corp. v. Hyatt Legal Services*, 736 F. 2d 1153, 1159 (7th Cir. 1984).

121. See *Avery Dennison Corp. v. Sumpton*, 999 F. Supp. 1337, 1341 (C.D. Cal. 1998).

122. *Id.*

123. See *id.*

124. See *id.*

125. See *id.*

126. There are numerous Internet Service Providers that license e-mail addresses to subscribers. These include Netcom, America Online, and Mindspring.

127. See Sami Menefee, *Canadian Firm Appeals Domain Name Restriction By US Court*, NEWSBYTE NEWS NETWORK, (Apr. 21, 1998) (visited Oct. 28, 1998) <<http://www.newsbytes.com>>.

Despite the fact that Sumpton has invested a great deal of money in the Mailbank business,<sup>128</sup> and the information before the court is insufficient to conclude that Sumpton's business is a sham,<sup>129</sup> the court still does not believe that licensing domain names for e-mail addresses is Sumpton's true business.<sup>130</sup> There cannot be a true balancing of the equities if the court does not adequately weigh the harm to the defendant.

If there had been dilution, the court simply would have enjoined Sumpton's use of the domain names. Instead, the court creates a new dilution remedy and orders Avery Dennison to compensate Sumpton for the transfer of the domain names. This is tantamount to an admission by the court that the decision is not firmly based in the law.

### III. THE EFFECTS OF THE AVERY DENNISON DECISION

The most immediate and frightening effect of the *Avery Dennison* decision is that it establishes a very low threshold for a finding of trademark dilution. The court purports to conduct a thorough analysis of the Dilution Act factors, but, in reality, the court simply looks at the outcome of two prior cases involving Internet domain name disputes and applies the same reasoning. The court in *Avery Dennison* appears to suggest that *any* use of a trademark on the Internet is dilution—regardless of the strength of the mark, regardless of the type of usage on the Internet, and regardless of what equity demands.

Fair application of the Dilution Act demands that analysis be made on a case-by-case basis. Instead, the court makes many broad assumptions in determining the outcome of the *Avery Dennison* case. The court makes the assumption that because Avery Dennison has registered the Avery and Dennison marks and conducts business using these marks, that the marks are famous. This cursory evaluation is at odds with earlier decisions that established a much higher standard for determining whether a mark is famous.<sup>131</sup>

The court also assumes that any use of a mark on the Internet is commercial use of the mark. It does this by ignoring the many ways the Internet is used to communicate educational and other information, and rede-

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128. Sumpton invested approximately \$1,200,000 in registration fees for the Mailbank domain names. *See Avery Dennison Corp. v. Sumpton*, 999 F. Supp. 1337, 1341 (C.D. Cal. 1998). *See also* Kelly and Goux, *supra* note 61.

129. *See Avery Dennison*, 999 F. Supp. at 1342.

130. *See id.* at 1341.

131. *See generally* Star Markets, Ltd. v. Texaco, Inc., 950 F. Supp. 1030 (D. Haw. 1996).

fines the Internet as a commercial enterprise. With that definition, any domain name takes on a trademark meaning and will always meet the "commercial use" requirement of the Dilution Act. This would eliminate all fair uses within the Dilution Act.

Finally, the court makes the assumption that if any investment is made to promote a mark in association with a particular good or service, any other use of the mark is diluting. This means that the "Big Guy" will always win in a dilution dispute.

If the decision of *Avery Dennison* is allowed to stand on appeal, it will be an unfortunate over-expansion of trademark rights. If we allow a standard as low as that set in the *Avery Dennison* opinion, then we are granting trademark holders a monopoly in their trademark, and potential copyright and property privileges. In fact, making *Avery Dennison* compensate Sumpton suggests that forcing the transfer of a domain name is akin to a "taking" of property.

#### IV. CONCLUSION

Trademark battles on the Internet are certainly a growing problem, and use of the Dilution Act is one possible method of resolving domain name disputes. Nonetheless, the *Avery Dennison* decision could have a far reaching impact on the way courts apply the Dilution Act to domain name disputes, as well as other non-Internet related litigation. The Dilution Act is vague. It is not clear when it should be applied and, when it is applied, the terms of the Dilution Act themselves are not well defined. Although, earlier decisions greatly varied in their application of the Dilution Act, in *Panavision* and *Intermatic*, the courts attempted to clarify the basis for use of the Dilution Act. After *Avery Dennison*, it is unclear under what circumstances the Dilution Act would *not* be applicable—the court does not address fair use issues. Nor does the court add new case law to assist in defining the high standards that should be used in interpreting just what qualifies as a famous mark and what type of use is dilutive. In fact, this ruling would support the contention that once a mark is deemed famous, dilution is a foregone conclusion.

Jerry Sumpton has filed an appeal to the district court's ruling. On review, it can only be hoped that the Court of Appeals will apply an analysis similar to *Panavision* and *Intermatic* and establish a sufficiently high bar for successful dilution claims. The Dilution Act is a powerful legal weapon and courts should not allow it to be abused.