

**RINGLING BROS.-BARNUM & BAILEY COMBINED
SHOWS, INC. v. UTAH DIVISION OF TRAVEL
DEVELOPMENT &
NABISCO, INC. v. PF BRANDS, INC.**

By Matthew S. Voss

What could the “The Greatest Show On Earth” and goldfish crackers possibly have in common? As it happens, both are at the center of a controversy between the Fourth and Second Circuit Courts of Appeal over precisely what a plaintiff must demonstrate in order to establish dilution under the Federal Trademark Dilution Act (“Dilution Act”).¹ While ostensibly a disagreement over interpretation, the split between the two circuits goes to the heart of an ongoing debate over the need for federal dilution protection,² and what many commentators perceive as an unjustified propertization of trademark law.³

© 2000 Berkeley Technology Law Journal; Berkeley Center for Law & Technology.

1. 15 U.S.C. § 1125(c) (1998). The Federal Trademark Dilution Act of 1995 (effective January 16, 1996) amended section 43 of the Lanham Act to provide a federal cause of action for trademark dilution.

2. Compare Milton W. Handler, *Are the State Antidilution Laws Compatible with the National Protection of Trademarks?*, 75 TRADEMARK REP. 269, 281 (1985) (questioning the rationale of dilution doctrine), and Kenneth L. Port, *The “Unnatural” Expansion of Trademark Rights: Is a Federal Dilution Statute Necessary?*, 18 SETON HALL LEGIS. J. 433, 438 n.9 (1994) (opining that a federal trademark dilution act would create a remedy without a wrong, and would be at odds with the fundamental principles of trademark law), with Beverly W. Pattishall, *Dawning Acceptance of the Dilution Rationale for Trademark-Trade Identity Protection*, 74 TRADEMARK REP. 289, 290 (1984) (“[T]he dilution rationale is a sound basis for affording needed protection to the immense but fragile ‘commercial magnetism’ values of trademarks.” (citations omitted)).

3. See, e.g., Mark A. Lemley, *The Modern Lanham Act and the Death of Common Sense*, 108 YALE L.J. 1687, 1695-96 (1999) (“Vesting trademarks with the mantle of property . . . defeats the purpose of linking trademarks to goods in the first place.”); Port, *supra* note 2, at 466-67 (opining that trademark principles are based in tort and are therefore incompatible with dilution, which creates a property ownership in the mark itself). Not all commentators, however, view the propertization of trademarks as a bad thing. See, e.g., Stephen L. Carter, *Does it Matter Whether Intellectual Property Is Property?*, 68 CHICAGO-KENT L. REV. 715, 721 (1993) (“How simple and elegant it would be to conclude that secondary meaning is unnecessary because the first to appropriate the mark owns it. . . .”); Simone A. Rose, *Will Atlas Shrug? Dilution Protection for “Famous” Trademarks: Anti-Competitive “Monopoly” or Earned “Property” Right?*, 47 FLA. L. REV. 653, 739-40 (1995) (opining that dilution protection is necessary to protect the earned property interest in a trademark’s “persona” and “quality image.”).

Dilution offers much broader protection than traditional trademark infringement law, which seeks to prevent consumer confusion as to product source and requires a showing of likelihood of confusion.⁴ In contrast, dilution seeks to prevent the loss of a mark's distinctiveness as a unique identifier, regardless of the likelihood of confusion.⁵ Consequently, unlike traditional trademark law, dilution can be applied to prevent use of a mark on completely unrelated, noncompeting goods.

Dilution doctrine has been criticized as monopolistic, anticompetitive, and at odds with the consumer protection rationale of trademark law.⁶ Proponents, however, have maintained that a properly limited dilution doctrine provides a much-needed remedy for a harm inadequately addressed by traditional trademark infringement.⁷ The latter view was presumably adopted by Congress with the passage of the Dilution Act. However, the language of the Dilution Act, while providing guidance for determining whether a mark is sufficiently famous to qualify for protection,⁸ is silent on the issue of how to prove dilution.⁹

Because dilution offers such a potentially expansive exclusionary right, determining precisely what a plaintiff must prove to establish dilution is vital to maintaining the proper balance between fair competition

4. See 15 U.S.C. §§ 1114, 1125(a) (1999); see also *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 779-80 (1992).

5. See H.R. REP. NO. 104-374, at 3 (1995), reprinted in 1995 U.S.C.C.A.N. 1029, 1030 ("[Dilution] applies when the unauthorized use of a famous mark reduces the public's perception that the mark signifies something unique, singular, or particular.").

6. See, e.g., *Toho Co., Ltd. v. Sears, Roebuck & Co.*, 645 F.2d 788, 793 (9th Cir. 1980) ("We have regarded the antidilution doctrine with some concern lest it swallow up all competition in the claim of protection against trade name infringement. . . ." (citations and quotations omitted)); Handler, *supra* note 2, at 282 ("Much of the problem stems from the general orientation of the dilution theory. While it strongly enhances the rights of plaintiffs, it fails to consider those of defendants."); Port, *supra* note 2, at 485.

7. See Pattishall, *supra* note 2, at 290; see also J. THOMAS MCCARTHY, 4 MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 24.114 (4th ed. 1999) ("There is a place in our jurisprudence for a legal remedy to protect strong, famous marks from dilution of their distinctiveness. . . . However, this is a potent legal tool, which must be used as a scalpel, not a sledgehammer.").

8. See 15 U.S.C. § 1125(c)(1)(A)-(H) (1999) (providing eight non-exclusive factors courts may consider in determining whether a mark is sufficiently distinctive and famous).

9. The Dilution Act sets forth four general elements to be proven: 1) famousness, 2) commercial use in commerce, 3) use beginning after the mark became famous, and 4) use which causes dilution of the distinctive quality of the mark. See 15 U.S.C. § 1125(c). The disagreement between the two circuits and the focus of this Note is on establishing the "causes dilution" element.

and free competition.¹⁰ An overbroad interpretation would effectively give trademark owners property rights in gross, and thereby upset the careful balance achieved in the existing system where similar marks can coexist on noncompeting products. An overly-restrictive reading, however, would provide no remedy at all, and thereby defeat the Dilution Act's purpose—to protect truly famous and distinctive marks from a loss in distinctiveness.

The Fourth and Second Circuit opinions represent opposite approaches to solving the dilution dilemma. The Fourth Circuit, in *Ringling Brothers-Barnum & Bailey Combined Shows, Inc. v. Utah Division of Travel Development*,¹¹ adopted a highly restrictive test requiring a plaintiff to show actual harm through proof of economic loss, thereby making it virtually impossible to establish dilution in all but the most extreme case. The Second Circuit, on the other hand, in *Nabisco, Inc. v. PF Brands, Inc.*,¹² adopted an expansive multi-factor test incorporating likelihood of confusion factors, which in practice merely serves as a fallback for plaintiffs unable to meet a traditional likelihood of confusion test. Ultimately, neither approach properly balances the need for a dilution remedy with the need for adequate limitations on the doctrine. An approach which rigorously applies the key dilution inquiries into fame, distinctiveness, similarity, and mental association can better address these problems, and more accurately reflect Congressional intent to provide an effective remedy for that narrow class of marks most likely to suffer dilution.¹³

I. FEDERAL TRADEMARK DILUTION ACT OF 1995

Dilution theory is generally traced to a 1927 article by Frank I. Schechter.¹⁴ According to Schechter, the value of a modern trademark is its selling power, and this power derives not only from the quality of the goods on which it is used, but equally from the mark's "uniqueness and

10. See RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 25 cmt. b (1995) ("[B]road interpretation of the [dilution] statutes would undermine the balance between private and public rights reflected in the traditional limits of trademark protection. . .").

11. 170 F.3d 449 (4th Cir.), cert. denied, 120 S. Ct. 286 (1999).

12. 191 F.3d 208 (2d Cir. 1999).

13. See S. REP. NO. 100-515, at 41-42 (1988) ("Section 43(c) of the [Lanham] Act is to be applied selectively and is intended to provide protection only to those marks which are both truly distinctive and famous. . ."). See generally 4 MCCARTHY, *supra* note 7, § 24.92.

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

singularity.”¹⁵ Schechter argued that even a noncompeting, nonconfusing use of a unique mark would result in a “gradual whittling away or dispersion of the identity and hold upon the public mind of the mark. . . .”¹⁶ Schechter proposed abandoning the consumer protection model for trademark law entirely and basing trademark law on preventing the “dilution” of unique marks.¹⁷ Under Schechter’s model, dilution protection would be limited to coined, fanciful or arbitrary marks, and to situations where the senior and junior marks were identical and used on noncompeting products.¹⁸

Early attempts at incorporating dilution theory into federal law failed,¹⁹ but with the urging of the International Trademark Association,²⁰ states slowly began to adopt anti-dilution statutes, starting with Massachusetts in 1947.²¹ By 1995, twenty-six states had adopted some form of dilution, almost exclusively by statute. While state anti-dilution statutes vary in minor details, most are based on or are similar to section 12 of the 1964 United States Trademark Association Model State Trademark Bill, which states:

Likelihood of . . . dilution of the distinctive quality of a mark . . . shall be a ground for injunctive relief notwithstanding the absence of competition between the parties or the absence of confusion as to the sources of goods or services.²²

Courts applying state anti-dilution statutes have traditionally distinguished between two types of dilution: “blurring” and “tarnishment.”²³ Dilution through blurring refers to the classic dilution injury posited by Schechter; it is the “whittling away” of a mark’s ability to serve as a unique and distinctive identifier because the mark is used for more than one product, regardless of the likelihood of confusion.²⁴ Oft-quoted exam-

15. *Id.*

16. *Id.* at 829.

17. *See id.* at 831-32.

18. *See id.* at 825-30; *see also* Handler, *supra* note 2, at 274-75.

19. *See* 4 MCCARTHY, *supra* note 7, § 24.68.

20. At the time, the International Trademark Association was known as the United States Trademark Association.

21. *See* Port, *supra* note 2, at 438.

22. *Reprinted in* 3 MCCARTHY, *supra* note 7, § 22.8.

23. *See* 4 MCCARTHY, *supra* note 7, §§ 24.68-.69. McCarthy also identifies a third type of dilution for “cybersquatting,” where courts have applied dilution to enjoin a party who obtains internet domain name registration for the sole purpose of selling it to the holder of the trademark with the same or similar name. *See id.* § 24.69.1. *See, e.g.,* Panavision Int’l, L.P. v. Toppen, 141 F. 3d 1316 (9th Cir. 1998).

24. *See* 4 MCCARTHY, *supra* note 7, § 24.68.

ples of blurring include “DUPONT shoes, BUICK aspirin, SCHLITZ varnish, KODAK pianos and BULOVA gowns.”²⁵ Dilution by tarnishment, on the other hand, occurs when an identical or similar junior mark is used in such a way as to “tarnish, degrade, or dilute the distinctive quality of the [senior] mark.”²⁶ Tarnishment focuses on injury to the senior mark holder’s business reputation that results from the association of the senior mark with the unwholesome, unsavory, or degrading aspects of the junior mark’s products.²⁷

Between 1930 and 1977, courts remained openly hostile to the concept of dilution. Since 1977, only a handful of cases have resulted in sustained injunctions based solely on dilution.²⁸ However, in 1987, proponents of a federal statute received a much-needed boost when the Supreme Court suggested in dicta that Congress could choose to protect trademarks from dilution.²⁹ In 1996, after one failed attempt,³⁰ Congress enacted the Federal Trademark Dilution Act of 1995.³¹ According to the House Report, the statute was enacted to provide uniform nationwide protection for famous marks, and to address international treaty obligations and international enforcement concerns.³²

The Dilution Act provides:

The owner of a famous mark shall be entitled . . . to an injunction against another person’s commercial use in commerce of a mark or trade name, if such use begins after the mark has become famous and causes dilution of the distinctive quality of the mark. . . .³³

25. *Id.* § 24.68.

26. *Id.* § 24.69.

27. *See id.*

28. *See Port, supra* note 2, at 440 (observing that of 159 state law dilution cases heard by federal circuit courts between 1977 and 1995, only ten resulted in preliminary injunctions and only four of those resulted in sustained injunctions based exclusively on dilution).

29. *See San Francisco Arts & Athletics, Inc. v. United States Olympic Comm.*, 483 U.S. 522, 539 (1987) (“[Congress] could determine that unauthorized uses, even if not confusing, nevertheless may harm the [trademark owner] by lessening the distinctiveness and thus the commercial value of the marks.”); *Report of the T.R.C.*, 77 TRADEMARK REP. 375, 455 (1987) (“[S]everal positive decisions on dilution laws in recent years make the adoption of a federal law timely.”).

30. *See S. REP. NO. 100-515*, at 41-43 (1988); *see also* 4 MCCARTHY, *supra* note 7, § 24.86.

31. Trademark Dilution Act of 1995, Pub. L. No. 104-98, 109 Stat. 985 (codified at 15 U.S.C. §§ 1125, 1127).

32. *See H.R. REP. NO. 104-374*, at 3-4 (1995).

33. 15 U.S.C. § 1125(c) (1999).

The term "dilution" means the lessening of the capacity of a famous mark to identify and distinguish goods or services, regardless of (1) competition, . . . or (2) likelihood of confusion, mistake, or deception.³⁴

Several key differences exist between the Dilution Act and most state anti-dilution statutes. First, the Dilution Act, unlike state statutes, specifically requires that a mark be famous and distinctive to qualify for protection, and provides eight nonexclusive factors courts may weigh in determining whether a mark is sufficiently famous and distinctive.³⁵ Second, the Dilution Act, unlike state statutes, does not contain explicit "likelihood of dilution" language; rather, it simply proscribes use which "causes dilution,"³⁶ suggesting that, unlike state statutes, the plaintiff must prove actual rather than likely harm. Third, unlike state statutes, the Dilution Act specifically defines dilution in terms of a loss in a mark's ability to "identify and distinguish goods or services."³⁷

While the language of the Dilution Act provides substantial guidance for determining the threshold requirements of fame and distinctiveness, it is silent as to how a court should establish dilution. Courts applying state anti-dilution laws generally: (1) establish dilution by inference from balancing certain "relevant" factors (the so called *Mead Data* test),³⁸ or (2) simply presume dilution based on the similarity of the two marks.³⁹ Early lower court decisions applying the federal Dilution Act generally applied some variation of the *Mead Data* test.⁴⁰

34. *Id.* § 1127.

35. *See id.* § 1125(c)(1)(A)-(H).

36. *Id.*

37. 15 U.S.C. § 1127 (1999).

38. *See Mead Data Central, Inc. v. Toyota Motor Sales, U.S.A., Inc.*, 875 F.2d 1026, 1035 (2d Cir. 1989) (Sweet, J., concurring) (holding six factors must be weighed to determine likelihood of dilution under New York statute: "1) similarity of the marks 2) similarity of the products covered by the marks 3) sophistication of consumers 4) predatory intent 5) renown of the senior mark [and] 6) renown of the junior mark.").

39. *See Ringling Bros.-Barnum & Bailey Combined Shows, Inc. v. Celozzi-Ettelson Chevrolet, Inc.*, 855 F.2d 480, 484 (7th Cir. 1988) (presuming likelihood of dilution under Illinois law based on the similarity of the marks).

40. *See, e.g., Ringling Bros.-Barnum & Bailey Combined Shows, Inc. v. B.E. Windows Corp.*, 937 F. Supp. 204, 211-14 (S.D.N.Y. 1996) (adopting multi-factor test to establish dilution under the Dilution Act).

II. PROVING DILUTION: A SPLIT BETWEEN THE CIRCUITS

A. Ringling Bros.-Barnum & Bailey Combined Shows, Inc. v. Utah Division of Travel Development

1. *The facts*

Ringling Bros.-Barnum & Bailey Combined Shows, Inc. ("Ringling") has promoted its circus as The Greatest Show On Earth ("Greatest Show") since 1872, and obtained federal registration for the mark in 1961.⁴¹ In 1997, it spent approximately \$19 million on advertising with its Greatest Show mark, reaching over 70 million people, and generating revenues exceeding \$103 million.⁴²

Utah Division of Travel ("Utah"), a Utah state agency, began using its mark, The Greatest Snow On Earth ("Greatest Snow"), to promote winter tourism as early as 1962.⁴³ Utah's primary use of its mark is on vehicle license plates, but it has also spent approximately \$375,000 annually in advertising the mark.⁴⁴ Utah registered its mark with the State of Utah in 1975, and received federal registration in 1997 after an unsuccessful opposition by Ringling.⁴⁵

2. *District court decision*

After the unsuccessful opposition, Ringling brought an action against Utah under the Dilution Act alleging dilution of its Greatest Show mark.⁴⁶ It attempted to establish dilution merely by demonstrating a mental association between the two marks by consumers, but the district court held that dilution required more than a mere association: it also required that the association cause actual harm to the senior mark's capacity to identify and distinguish goods and services.⁴⁷ Applying this test, the district court found Ringling's consumer survey failed to establish actual harm, and Ringling had therefore failed to prove dilution.⁴⁸ In a separate analysis, the

41. See Ringling Bros.-Barnum & Bailey Combined Shows, Inc. v. Utah Div. of Travel Dev., 170 F.3d 449, 451 (4th Cir.), *cert. denied*, 120 S. Ct. 286 (1999).

42. See *id.*

43. See *id.*

44. See *id.*

45. See *id.* at 451-52.

46. See Ringling Bros.-Barnum & Bailey Combined Shows, Inc. v. Utah Div. of Travel Dev., 955 F. Supp. 605 (E.D. Va.), *aff'd*, 170 F.3d 449 (4th Cir.), *cert. denied*, 120 S. Ct. 286 (1999).

47. See *id.* at 615-16.

48. See *id.* at 618. Ringling's survey asked consumers to complete the statement, "THE GREATEST ___ ON EARTH". *Id.* at 612. Among the results, 21% of Utah respondents filled in SHOW and associated that phrase with Ringling and also completed

district court applied a multi-factor balancing test using the *Mead Data* factors, and also found that, on balance, Utah's mark had not diluted Ringling's mark.⁴⁹

3. *Fourth Circuit opinion*

On appeal, the Fourth Circuit Court of Appeals agreed with the lower court that Ringling had failed to prove dilution, but it adopted a somewhat different "actual cause" test, and rejected the lower court's alternative application of the *Mead Data* factors to establish dilution.⁵⁰ Instead, the court interpreted the Dilution Act to require actual economic loss to a mark's selling power demonstrated by evidence that the defendant's use of the junior mark had in fact caused such a loss.⁵¹

The court reached this decision by first comparing state anti-dilution laws with the federal Dilution Act. Noting that the Dilution Act only proscribes use of a famous mark when it "causes dilution,"⁵² not when it is *likely* to cause dilution, as with state anti-dilution statutes,⁵³ the court concluded that the Dilution Act requires actual, consummated dilution. Second, by defining dilution as "the lessening of the capacity of a famous mark to identify and distinguish goods or services,"⁵⁴ the court found that the Dilution Act, unlike state statutes, specifically defines the end harm at which it is aimed as a loss of selling power, rather than a loss of distinctiveness.⁵⁵

The court rejected Ringling's argument that the Dilution Act protects "the senior mark's distinctiveness as such," holding that such an interpretation would effectively grant a property right in gross, giving mark holders the right to enjoin the commercial use of a mark simply on the grounds of similarity.⁵⁶ The court also refused to allow a presumption of actual economic harm based only on the similarity of the marks, because similarity in and of itself did not create enough probability of the actual eco-

the statement with SNOW and associated it with Utah; outside of Utah, fewer than 0.5% of respondents did the same. *Id.*

49. *See id.* at 616-18.

50. *See Ringling Bros.-Barnum & Bailey Combined Shows, Inc. v. Utah Div. of Travel Dev.*, 170 F.3d 449, 464 (4th Cir.), *cert. denied*, 120 S. Ct. 286 (1999).

51. *See id.* at 461.

52. 15 U.S.C. § 1125(c) (1999).

53. *See, e.g.*, N.Y. GEN. BUS. LAW § 360-1 (McKinney 1998); *see also* Model State Trademark Bill, *reprinted in* 3 MCCARTHY, *supra* note 7, § 22.8.

54. 15 U.S.C. § 1127 (1999).

55. *See Ringling*, 170 F.3d at 458.

56. *See id.* at 459.

conomic harm required under the Dilution Act.⁵⁷ Finally, the court rejected the argument that its interpretation would institute an impossible burden of proof by suggesting that economic loss could be shown by (1) proof of an actual loss of revenues and elimination of other causes, or (2) a skillfully constructed consumer survey.⁵⁸

Ultimately, the court interpreted the Dilution Act to require proof of:

(1) a sufficient similarity between the junior and senior marks to evoke an instinctive mental association of the two by a relevant universe of consumers which (2) is the effective cause of (3) an actual lessening of the senior mark's selling power, expressed as "its capacity to identify and distinguish goods or services."⁵⁹

Applying this test to the facts of the case, the court found that the district court had not erred: Ringling's survey evidence was designed to prove its theory that it need only show an instinctive mental association, and not actual economic harm.⁶⁰ It had therefore failed to meet all the requirements to prove dilution.⁶¹

B. Nabisco, Inc. v. PF Brands, Inc.

1. The facts

Pepperidge Farms ("Pepperidge") has produced goldfish-shaped, bite-sized cheese crackers continuously since 1962 and has obtained numerous trademark registrations for its Goldfish design.⁶² Between 1995 and 1998, Pepperidge spent more than \$120 million marketing Goldfish crackers, during which time net sales more than doubled to \$200 million per year.⁶³

In 1998, Nabisco also began producing animal shaped crackers as part of a licensing agreement to promote Nickelodeon Television's "CatDog" cartoon program.⁶⁴ Nabisco's product contained three character shapes based on the cartoon, with a quarter of the crackers shaped and colored like Pepperidge's Goldfish cracker, although Nabisco's fish cracker was somewhat larger and flatter, and had markings on its sides.⁶⁵

57. *See id.* at 459-60.

58. *See id.* at 464.

59. *Id.* at 458.

60. *See id.* at 462.

61. *See id.* at 462-63.

62. *See Nabisco, Inc. v. PF Brands, Inc.*, 191 F.3d 208, 212 (2d Cir. 1999).

63. *See id.* at 213.

64. *See id.*

65. *See id.*

Upon learning of Nabisco's product plans, Pepperidge sent Nabisco a cease and desist demand,⁶⁶ and Nabisco responded with a suit for declaratory judgment. Pepperidge counterclaimed that Nabisco's goldfish constituted trademark infringement and dilution under federal law, as well as unfair competition and dilution under New York law.

2. District court decision

The district court found that Pepperidge would likely prevail on both the federal and state dilution claims, and entered a preliminary injunction.⁶⁷ In considering the dilution claims, the court applied the multi-factor *Mead Data* test, and found that each of the six factors weighed in favor of a finding of dilution.⁶⁸

3. Second Circuit opinion

On appeal, the Second Circuit Court of Appeals affirmed the district court's finding that Pepperidge would likely prevail on the dilution claims, but rejected the lower court's use of the *Mead Data* test for establishing dilution as too mechanical, and as containing factors irrelevant to the dilution inquiry.⁶⁹ It also declined to adopt the Fourth Circuit's "actual consummated harm" interpretation which it viewed as "excessive literalism to defeat the intent of the statute."⁷⁰ The court noted that because relief under the Dilution Act, absent a showing of willfulness, is limited to an injunction, waiting until actual harm has occurred would result in an uncompensated injury, and would also be disadvantageous for the junior user who would want to know if use of a mark causes dilution before investing.⁷¹ Similarly, the court rejected the Fourth Circuit's economic loss requirement, finding it "an arbitrary and unwarranted limitation on the methods of proof."⁷² It noted that a senior user may never be able to show loss attributable to dilution, no matter how obvious the dilution.⁷³

66. *See id.*

67. *See Nabisco, Inc. v. PF Brands, Inc.*, 50 F. Supp. 2d 188, 212 (S.D.N.Y. 1999), *aff'd*, 191 F.3d 208 (2d Cir. 1999).

68. *See id.* at 210. On the infringement claims, the district court found confusion unlikely because Nabisco's fish cracker made up only a fraction of the shapes in the package, noting that the "products are just not visually similar." *Id.* at 211.

69. *See Nabisco*, 191 F.3d at 227. The court criticized the *Mead Data* test for conflating the fame and distinctiveness factors, and omitting other factors it found relevant. *See id.*

70. *Id.* at 224.

71. *See id.*

72. *Id.* at 223.

73. *See id.* at 223-24.

The court adopted a new test consisting of an expanded non-exclusive list of ten factors for establishing likelihood of dilution: (a) distinctiveness; (b) similarity of the marks; (c) proximity of the products and likelihood of bridging the gap; (d) interrelationship between the first three factors; (e) shared consumers and geographic limitations; (f) sophistication of consumers; (g) actual confusion; (h) adjectival or referential quality of the junior use; (i) harm to the junior user and delay by the senior user; and (j) effect of senior's prior laxity in protecting the mark.⁷⁴

In formulating this test, the court emphasized the importance of the distinctiveness factor as a limit to the dilution remedy—both as a statutory threshold and as a separate factor in weighing likelihood of dilution.⁷⁵ It also emphasized the interdependent relationship between the distinctiveness, similarity, and proximity factors, noting that “[t]he weaker any of the three factors may be, the stronger the others must be to make a case for dilution.”⁷⁶ While it found Pepperidge's selection of a goldfish shape arbitrary and therefore only moderately distinctive, the court ultimately held that the strong similarity and proximity of the two products on balance favored Pepperidge.⁷⁷

The court went on to find that as direct competitors with similar products, “shared consumers” would be likely.⁷⁸ It also found that while Nabisco's use of a fish shaped cracker might be “referential” to the CatDog cartoon, if placed in a bowl, the product would appear confusingly similar to Pepperidge's goldfish.⁷⁹ The court held the “harm to the junior user” and “actual confusion” factors irrelevant because no actual use had yet occurred, and it held the prior use of the goldfish shape for crackers by others too insignificant to constitute prior laxity by Pepperidge.⁸⁰ At the end of its exhaustive analysis, the court ultimately found that on balance, Pepperidge had established it would likely prevail in its dilution claim, and sustained the injunction.⁸¹

III. DISCUSSION

The Fourth Circuit's actual harm through proof of economic loss test in *Ringling* erects a barrier insurmountable by all but the strongest of dilu-

74. See *id.* at 217-24.

75. See *id.* at 215-17.

76. *Id.* at 219.

77. See *id.* at 218-19.

78. See *id.* at 219.

79. See *id.* at 222.

80. See *id.*

81. See *id.*

tion claims, and can be challenged both on its own terms as a textual interpretation, and as sharply at odds with the intent and purpose of the statute. The Second Circuit's test in *Nabisco*, while avoiding the problem of no remedy, unnecessarily lengthens and obfuscates the dilution inquiry by incorporating likelihood of confusion factors, which in practice provides a fallback for plaintiffs unable to meet a traditional likelihood of confusion test. Ultimately, neither approach properly balances the need for a dilution remedy and the need for adequate limitations on the doctrine.

A. Fourth Circuit: Proof of Actual Economic Loss

The Fourth Circuit's interpretation of the Dilution Act in *Ringling* requiring actual dilution and proof of economic harm addresses the issue of overprotection, but provides no effective remedy even for famous and distinctive marks, and is therefore at odds with the intent and purpose of the Dilution Act.

1. Textual interpretation

In interpreting the Dilution Act to require actual consummated harm, the Fourth Circuit in *Ringling* relies almost exclusively on the plain meaning rule,⁸² but its textual interpretation can be challenged by applying interpretive corollaries to the rule. As the case the court itself cites makes clear, the plain meaning interpretation must involve "no absurdity, nor any contradiction with other parts of the instrument."⁸³ Because the Dilution Act only provides damages in those rare cases where willful dilution is shown, interpreting the Act to require proof of actual rather than likely harm creates an uncompensable injury by forcing a plaintiff to wait until its mark has actually suffered a material loss in distinctiveness before an injunction can be issued. More subtly, requiring actual harm rather than likely future harm logically leads to requiring a higher standard of proof.⁸⁴ When considered in light of the nature of the dilution injury, which occurs through a gradual whittling away of a mark's distinctiveness, interpreting the Dilution Act to require actual harm creates not only an uncompensable injury, it makes it unlikely the holder of a famous mark could enjoin any

82. The court's textual interpretation requiring actual harm relies largely on the lack of "likelihood of dilution" language in the Dilution Act, which only proscribes use which "causes dilution." See *Ringling Bros.-Barnum & Bailey Combined Shows, Inc. v. Utah Div. of Travel Dev.*, 170 F.3d 449, 458-60 (4th Cir.), *cert. denied*, 120 S. Ct. 286 (1999). For general background on statutory interpretation, see WILLIAM N. ESKRIDGE, JR. & PHILIP P. FRICKEY, *CASES AND MATERIALS ON LEGISLATION STATUTES AND THE CREATION OF PUBLIC POLICY* (2d ed. 1995).

83. *Lake County v. Rollins*, 130 U.S. 662, 670 (1889).

84. See *Ringling*, 170 F.3d at 459.

diluting use until substantial injury had already occurred. By inevitably leading to a substantial uncompensated injury, the court's actual harm interpretation arguably creates an absurdity.⁸⁵

The absurdity argument gains force when considered in light of the Fourth Circuit's further requirement that dilution be established through evidence of economic harm. This raises the possibility of not only a substantial uncompensated injury, but worse, no remedy at all. The court itself acknowledged that establishing facts showing economic harm may be impossible.⁸⁶ Ultimately, the court's plain meaning interpretation requiring actual harm may have resulted in a statute that effectively provides no remedy at all—an arguably absurd result.

The court's application of the plain meaning rule to interpret "causes dilution" to mean actual dilution may also be inappropriate given the acquired legal meaning of "dilution." Another corollary to the plain meaning rule is that words which have acquired specific legal meaning should be given that meaning unless the statute otherwise dictates.⁸⁷ The overwhelming history of state anti-dilution law has been not only to permit the injunction of actual harm, but also to prevent likely future harm.⁸⁸ Perhaps more importantly, the very nature of dilution as a "gradual whittling away" or "an infection, which if allowed to spread, will inevitably destroy the advertising value of the mark,"⁸⁹ represents a slow, gradual type of harm that is simply not amenable to proof through a showing of actual economic harm.

85. Depending on how one views the injury of dilution, however, a substantial uncompensated injury may be a necessary evil to prevent over-protection. For example, some commentators have questioned whether the dilution injury is a recognizable harm at all. *See, e.g.*, Port, *supra* note 2, at 447 (opining that the Dilution Act creates a remedy without a harm); Note, *Dilution: Trademark Infringement or Will-O'-the-Wisp?*, 77 HARV. L. REV. 520, 528 (1964) ("An owner's interest in the distinctiveness of his mark . . . is not only bewilderingly intangible, but must be weighed against countervailing interests in preventing impoverishment of the supply of available marks. . . .").

86. *See Ringling*, 170 F.3d at 460. The court went on to hold that difficulty in establishing facts showing economic harm did not support a judicial presumption of those facts. *See id.* at 464.

87. *See NLRB v. Amax Coal Co.*, 453 U.S. 322, 329 (1981) ("Where Congress uses terms that have accumulated settled meaning under either equity or the common law, a court must infer, unless the statute otherwise dictates, that Congress means to incorporate the established meaning of these terms.").

88. *See* 4 MCCARTHY, *supra* note 7, § 24.90.

89. *Mortellito v. Nina of California, Inc.*, 335 F. Supp. 1288, 1296 (S.D.N.Y. 1972). This characterization of the nature of dilution was quoted from *Mortellito* in the Dilution Act's legislative history. *See H.R. REP. NO. 104-374*, at 3 (1988).

The court rejected Ringling's argument that the word "capacity" in the Dilution Act's definition of dilution imports an element of futurity.⁹⁰ However, viewed in light of the arguably absurd results reached by the court's "plain meaning" interpretation, the word "capacity" may well bear the meaning of "future capacity," and may ultimately be the better interpretation.⁹¹

2. *Intent and purpose: legislative history*

While purely textual arguments undoubtedly carry the greatest interpretive weight, legislative history plays a useful role in the interpretive process.⁹² The court in *Ringling*, however, makes no attempt to reconcile its interpretation requiring actual harm and proof of economic loss with the Dilution Act's legislative history.⁹³

If there is a smoking gun in the legislative history, it is that Congress specifically sought to address the problems that an overly-expansive application of dilution would create by limiting the dilution remedy to truly famous and distinctive marks.⁹⁴ The legislative history is replete with discussion of the fame and distinctiveness barrier,⁹⁵ but nowhere in the legislative history of either the 1988 dilution bill, the Dilution Act, or the Report of the Trade Mark Commission is it suggested that a plaintiff must demonstrate not only fame and distinctiveness, but must also make the far

90. See *Ringling*, 170 F.3d at 459.

91. See 4 MCCARTHY, *supra* note 7, § 24.90. McCarthy notes that the Dilution Act's definition of dilution as "the lessening of the capacity of a famous mark to identify and distinguish" may be a "likelihood or probability test built right into the definition of what constitutes dilution," *id.* at 24-142 to 24-143, and opines that such an interpretation is "more in accord with traditional anti-dilution law," *id.* 24-143 n.21.

92. See *Wisconsin Public Intervenor v. Mortier*, 501 U.S. 597, 610 n.4 (1991) ("As for the propriety of using legislative history at all, common sense suggests that inquiry benefits from reviewing additional information rather than ignoring it. . . . Our precedents demonstrate that the Court's practice of utilizing legislative history reaches well into its past. . . . We suspect that the practice will likewise reach well into the future.").

93. In his treatise on trademark law, McCarthy notes that the Dilution Act is a direct descendant of both the nearly identical 1988 dilution bill, S. 1883, 100th Cong. (1988), passed by the Senate, but ultimately not enacted, and the Report of the Trade Mark Review Commission. Given the Dilution Act's sparse legislative history, McCarthy argues that these two additional sources provide helpful guidance in interpreting the Dilution Act. See 4 MCCARTHY, *supra* note 7, § 24.87.

94. See, e.g., S. REP. NO. 100-515, at 41-42 (1988) ("[T]o ensure that the bill does not supplant the current protection of trademarks based on likelihood of confusion, the committee amended the legislation to place greater emphasis on the factors the courts must weigh in determining whether a mark possesses a sufficient level of fame and distinctive quality to qualify for federal protection. . . .").

95. See *id.*

more difficult showing of actual consummated harm to establish dilution. The House Report flatly states, "The use of DUPONT shoes, BUICK aspirin, and KODAK pianos would be actionable under this legislation."⁹⁶ It seems strange that Congress would omit any mention of an actual harm requirement in its example—a substantial additional hurdle—if one was intended. When Ringling argued this very point, the court rejected it in a footnote, stating that an identical replication was not involved in the case before it.⁹⁷ The court seems to suggest that a separate standard would be applied for a case such as "BUICK aspirin," but fails to provide any justification for such differential treatment under a statute that makes no such distinction.

The Fourth Circuit's limitation of proof to economic loss is also at odds with congressional intent. The "loss" Congress sought to remedy was a loss in a mark's distinctiveness, not solely its economic value. The Senate Judiciary Report on the 1988 dilution bill envisioned that the Act would apply "when the unauthorized use of a famous mark reduces the public's perception that the mark signifies something unique, singular, or particular," and noted that "[t]he distinctive quality of a mark could be materially reduced during a period of rising sales."⁹⁸ While an economic loss may indicate a loss in distinctiveness, as the Judiciary Report indicates, a loss in distinctiveness can also occur where there is an economic gain.

In the final analysis, the Fourth Circuit's test for dilution can be challenged on its own terms as a textual interpretation, and it can also be challenged as at odds with congressional intent and purpose as discernable from the Dilution Act's legislative history.

B. Second Circuit: Proof of Likely Dilution through Inference

The Second Circuit's dilution test in *Nabisco* offers significant improvements over the *Ringling* test. First, by permitting the inference of *likelihood* of dilution from multiple relevant factors, and not limiting proof to evidence of economic loss, the test avoids the problem of providing no remedy. Second, by not confining its test to a mechanical set of factors, the court establishes that the dilution analysis is a dynamic inquiry for which different factors may prove relevant in different cases. Finally, by emphasizing the importance of the distinctiveness inquiry, the court's test brings the dilution analysis more in line with the plain meaning of the

96. H.R. REP. NO. 104-374, at 3 (1995).

97. See *Ringling Bros.-Barnum & Bailey Combined Shows, Inc. v. Utah Div. of Travel Dev.*, 170 F.3d 449, 459 n.5 (4th Cir.), *cert. denied*, 120 S. Ct. 286 (1999).

98. S. REP. NO. 100-515, at 41-45 (1988).

statute, its legislative history, and the conception of dilution theory's originator. However, the Second Circuit's analysis ignores relevant differences between the Dilution Act and state statutes, unnecessarily lengthens and obfuscates the inquiry by considering confusion factors irrelevant to dilution, and ultimately fails to achieve a proper balance between over- and under-protection.

1. Ignoring important differences

If *Ringling* relies too heavily on textualism, *Nabisco* goes too far the other way—completely ignoring the significant differences between state anti-dilution statutes and the federal Dilution Act. Without analysis, the court simply assumed the New York anti-dilution statute and the Dilution Act require the same showing despite substantially different language. As a practical matter, such a finding is understandable; the exponential increase in factors to be considered, and the complexity of dilution in general provide strong pragmatic reasons for ignoring the differences. However, such an approach tends to de-emphasize differences in the Dilution Act such as the fame and distinctiveness requirements, which mandate a much narrower scope of protection, and tends to merge an arguably more permissive body of state law precedent with the federal Dilution Act.⁹⁹

2. Confusing dilution

The Second Circuit's opinion in *Nabisco* is subject to further criticism for adopting contextual factors that speak to consumer confusion rather than dilution—an approach widely criticized by other courts and commentators.¹⁰⁰ Even more troubling, the court departs from dilution by blurring as it is generally understood, and it does so in precisely the type of case in which an expansive, imprecise interpretation can do the most harm to free competition: trade dress.¹⁰¹

99. For example, in holding that the Dilution Act applies to competitors, the court in *Nabisco* stated, “[w]e have already held that New York’s antidilution statute applies to ‘competitors as well as noncompetitors,’ and we now so hold under the [Dilution Act].” *Nabisco, Inc. v. PF Brands, Inc.*, 191 F.3d 208, 223 (2d Cir. 1999) (citations omitted).

100. See *I.P. Lund Trading v. Kohler Co.*, 163 F.3d 27, 49 (1st Cir. 1998); see also 4 MCCARTHY, *supra* note 7, § 24.94.1.

101. In *Nabisco*, the court creates an expansive dilution test, which, in effect, provides Pepperidge with a quasi-patent on the shape of a cheese cracker, unlimited in time, and not justified on grounds of preventing source confusion. The ramifications of applying dilution doctrine to protect trade dress are beyond the scope of this Note. For more on this topic, see *I.P. Lund*, 163 F.3d at 53 (Boudin, J., concurring) (“[T]he threat to the public interest, ordinarily countered by the time limit on patent protection, is acute where a permanent protection is offered not to a word or symbol but to the design of an article of manufacture.”); *Syndicate Sales, Inc. v. Hampshire Paper Corp.*, No. 98-4217, 1999

The state of mind required for confusion and dilution are distinct and dissimilar. The essence of dilution by blurring is a loss of distinctiveness as a unique identifier that occurs when consumers realize the same mark is used for more than one product, and are *not* confused as to source.¹⁰² If consumers are confused, blurring of the mark cannot occur simply because in their minds the mark remains the sole identifier for the senior user's product. This is in contrast to traditional trademark infringement, which requires precisely the opposite: consumer confusion as to the source of the mark. Thus, it is impossible for unauthorized use of a trademark to cause both confusion and dilution by blurring in the mind of any one person.¹⁰³

Despite this well-accepted definition of dilution, the court in *Nabisco* appears to equate consumer confusion with dilution when it flatly states: "When consumers confuse the junior mark with the senior, blurring has occurred."¹⁰⁴ The court makes this and similar statements in rejecting the argument that dilution should not apply to competing products, and in support of the inclusion of confusion factors in its new test.¹⁰⁵ While the observation that dilution can be found in circumstances that would also support an action for infringement is undoubtedly true, it is a logical flaw to conclude that where confusion is present, so too must be dilution.¹⁰⁶ In

WL 707786, *6 (7th Cir. 1999) (suggesting that application of dilution to protect product configuration may be unconstitutional and textually unjustified by the Dilution Act); and Lemley, *supra* note 3, at 1700-01.

102. See H.R. REP. NO. 104-374, at 3 (1988) ("Dilution does not rely upon the standard test of infringement, that is likelihood of confusion, deception or mistake."); *Avery Denison Corp. v. Sumpton*, 189 F.3d 868, 875 (9th Cir. 1999) ("In the dilution context, likelihood of confusion is irrelevant."); *Community Federal Savings and Loan Assoc. v. Orondorff*, 678 F.2d 1034, 1036 (11th Cir. 1982) ("[Confusion is] a factor totally absent from the state antidilution statutes . . . [and is] contrary to the plain meaning of those statutes."); *Toho Co., Ltd. v. Sears, Roebuck & Co.*, 645 F.2d 788, 793 (9th Cir. 1980) ("The focus [in dilution] is on damage to the mark's inherent value as a symbol, rather than on whether consumers have been misled as to origin or sponsorship."); *Allied Maintenance Corp. v. Allied Mechanical Trades, Inc.*, 42 N.Y.2d 538, 544 (1977) ("The evil which the Legislature sought to remedy [with the New York anti-dilution statute] was not public confusion caused by similar products or services sold by competitors. . ."). See generally 4 MCCARTHY, *supra* note 7, § 24.94.

103. See 4 MCCARTHY, *supra* note 7, § 24.94.1.

104. *Nabisco, Inc. v. PF Brands, Inc.*, 191 F.3d 208, 221 (2d Cir. 1999).

105. For example, in its analysis of the proximity factor, the court states that "[c]onsumer confusion would undoubtedly dilute the distinctive selling power of a trademark," *id.* at 219, and goes on to state that "[a] junior use that confuses consumers as to which mark is which surely dilutes the distinctiveness of the senior mark," *id.*

106. See 4 MCCARTHY, *supra* note 7, § 24.71 ("[I]t is erroneous to conclude from a finding of a likelihood of confusion that dilution automatically and logically follows. It

some cases, the stronger the likelihood of confusion factors like similarity and proximity, the *less* likely it is that dilution will occur simply because most consumers will still see the mark as representing the same source.

The court's conclusion that consumer confusion factors are relevant to establishing dilution is troubling because dilution was never intended as a mere fallback for traditional infringement claims.¹⁰⁷ Merging the two doctrines effectively creates a watered-down infringement doctrine where weak infringement factors can be used to buttress an otherwise weak dilution claim.¹⁰⁸

This is not to say that all confusion factors are completely irrelevant to determining dilution; however, their inclusion without properly distinguishing their probative purpose obfuscates the dilution inquiry, and unnecessarily lengthens what is already an exhaustive multifactor analysis. For example, actual confusion is only probative for dilution as an inquiry into similarity and mental association: a product is likely to confuse if it is the same type of product bearing a similar mark. If it is likely to confuse, it is likely to be *similar*, and if it is the same type of product, it is likely that a relevant universe of consumers will see marks used on both products. However, some consumers may be confused as to source, while others may perceive the same mark as being used to identify two separate sources. Using actual confusion as a proxy for these considerations merely hides the real inquiry and is unnecessarily redundant.

In the final analysis, the court's multi-factor test represents an improvement over previous tests, but by inserting confusion factors into dilution it ultimately converts dilution into a fallback provision for weak infringement claims, and unnecessarily lengthens what is already an exhaustive multi-factor analysis. In so doing, the court reduces the emphasis on the key dilution inquires into fame, distinctiveness, similarity, and mental association.

does not follow because dilution is a separate legal theory positing a different kind of damage to a mark caused by a different form of consumer perception.”).

107. See *I.P. Lund Trading v. Kohler Co.*, 163 F.3d 27, 48 (1st Cir. 1998) (“Dilution laws are intended to address specific harms; they are not intended to serve as mere fall back protection for trademark owners unable to prove trademark infringement.”).

108. See *id.*; see also S. REP. NO. 100-515, at 41-42 (1988) (“[T]o ensure that the bill does not supplant the current protection of trademarks based on likelihood of confusion, the committee amended the legislation to place greater emphasis on the [fame and distinctiveness factors]. . .”).

IV. REMOVING CONFUSION FROM DILUTION

There is a solution to establishing dilution under the Dilution Act which both addresses the concerns raised by the *Ringling* and *Nabisco* courts, and overcomes many of the problems arising from the approaches taken by each. The “solution” is really nothing new; it is simply a rigorous application of existing doctrine in light of the new limitations imposed by the Dilution Act.

A. Identifying the Test

1. *Inference of factors, proof of harm, or both*

Permitting plaintiffs to establish dilution through inference based on a relevant set of contextual factors is consistent with a plain meaning interpretation of the Dilution Act, and is more consistent with the intent and purpose of the statute as expressed from its structure and legislative history. Using this test does not mean that *Ringling*'s actual harm test should not be used at all, but rather, that plaintiffs should not be limited to it.

2. *Key limitations on the dilution doctrine: fame, distinctiveness, similarity, and mental association*

The primary factors relevant to any dilution inquiry under the Dilution Act are fame, distinctiveness, similarity, and mental association. By focusing on the paradigm case, and applying the existing limitations on the dilution doctrine rigorously, the fear of creating property rights in gross or providing a mere fallback provision for a weak infringement claim can be adequately addressed, and the problem of providing no remedy at all can be avoided.

a) Fame

The fame requirement is critical to limiting the risk of trademark overprotection that dilution presents. Congress took pains to ensure that the extraordinary remedy of dilution would be confined to truly famous marks by providing a list of eight factors courts may weigh in determining whether a mark is sufficiently famous.¹⁰⁹ However, there is tremendous pressure on courts to lower the bar as to what constitutes a famous mark,

109. See 15 U.S.C. § 1125(c)(1)(A)-(H) (1999). These factors include: 1) the degree of inherent or acquired distinctiveness; 2) the duration and extent of use of the mark in connection with the goods or services with which the mark is used; 3) the duration and extent of advertising; 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 channels of trade used by the mark owner and the defendant; 7) the extent of use of the mark by third parties; and 8) whether the mark is registered. See *id.*

leading to what one commentator has termed “doctrinal creep.”¹¹⁰ This occurs when a remedy developed for an extraordinary case is increasingly applied to the ordinary case. The prospect of obtaining near property right status, avoidance of having to prove confusion, and obtaining a back up cause of action, coupled with the risk of permanently losing these rights if they are not vigorously pursued, have all created enormous incentives for trademark owners to assert that their marks are famous. In addition, some courts eager to apply dilution to the domain name cybersquatting problem have permitted relatively obscure marks to receive protection under the Dilution Act.¹¹¹ To ensure that dilution does not swallow up all trademark law, courts must remain vigilant, and rigorously apply the Dilution Act’s fame requirement, permitting only truly famous marks to qualify for the “extraordinary” remedy of dilution.

b) Distinctiveness

In addition to being famous, the Dilution Act specifically requires that a mark be “distinctive” to qualify for protection.¹¹² However, the distinctiveness requirement is far more rigorous for dilution than it is for traditional infringement analysis.¹¹³ Distinctiveness is the very thing the Dilu-

110. Lemley, *supra* note 3, at 1698 (“If Congress creates a new statute that protects some but not all trademark owners, every trademark owner will want his or her mark to be included in the new group. . .”).

111. *See, e.g., Avery Dennison Corp. v. Sumpton*, 999 F. Supp. 1337 (C.D. Cal. 1998) (finding the marks AVERY and DENNISON sufficiently famous under the Dilution Act), *rev’d*, 189 F.3d 868, 875 (9th Cir. 1999) (emphasizing the importance of the fame limitation in reversing the lower court); *see generally* Diane K. Wong, Note, *Avery Dennison Corp. v. Sumpton*, 15 BERKELEY TECH. L.J. 245 (2000). The new anti-cybersquatting bill recently passed by Congress should reduce the need to apply dilution to the domain name problem. *See Anticybersquatting Consumer Protection Act*, Pub. L. No. 106-113, § 1000(a)(9), 113 Stat. 1501, 36 (Consolidated Appropriations Act, 2000, enacting S. 1948, 106th Cong., §§ 3001-3010 (1999)) (to be codified at 15 U.S.C. § 1125(d)) (1999); *see also Sparty’s Farm L.L.C. v. Sportsman’s Market, Inc.*, Nos. 98-7452(L), 98-7538(XAP), 2000 WL 124389 (2d Cir. Feb. 2, 2000) (applying the Anticybersquatting Act to a case on appeal, even though the district court decided the case based on the Dilution Act).

112. 15 U.S.C. § 1125(c)(1) (1999) (“In determining whether a mark is *distinctive* and famous, a court may consider. . .” (emphasis added)).

113. *See Nabisco, Inc. v. PF Brands, Inc.*, 191 F.3d 208, 215-16 (2d Cir. 1999) (“A mark that, notwithstanding its fame, has no distinctiveness is lacking the very attribute that the antidilution statute seeks to protect.”); *see also* Handler, *supra* note 2, at 278 (“An overbroad view of the distinctiveness requirement could result in an undesirable monopolization of language.”). Even strong proponents of dilution protection recognize the importance of a high distinctiveness barrier. *See, e.g.,* Rose, *supra* note 3, at 739-40 (opining that the Dilution Act should be amended to better define when a mark has reached a sufficiently high level of distinctiveness to qualify for protection).

tion Act seeks to preserve; accordingly, the less distinctive a mark is, the less there is to preserve.¹¹⁴ The Second Circuit emphasized the higher distinctiveness standard in the dilution inquiry by considering distinctiveness both as a threshold barrier, and as an individual factor that must be weighed against other factors in determining whether dilution is likely.¹¹⁵ Thus, while a moderately distinctive mark may cross the threshold, other factors such as similarity and mental association must be particularly strong in order to find dilution.¹¹⁶

c) Similarity

The similarity requirement recognizes the ephemeral harm that dilution seeks to protect,¹¹⁷ and is absolutely critical to establishing a claim for dilution. Dilution by blurring occurs only when consumers see the same mark used on more than one product and are not confused as to source, notwithstanding the *Nabisco* court's statements to the contrary. If the senior and junior mark are not identified as the same or substantially the same in the minds of consumers, there simply can be no blurring.

d) Mental association

As the court in *Ringling* noted, logic dictates that at a minimum, dilution requires that there be some mental association between the junior and senior marks in the minds of a relevant universe of consumers.¹¹⁸ The mental association factor is particularly important to ensure that dilution is not simply a fallback for infringement.¹¹⁹ There must be a legally significant percentage of consumers who recognize that the junior and senior marks identify separate sources, but see them as essentially the same mark.¹²⁰ It is critical to distinguish this from the confusion inquiry, which requires that consumers see the two marks representing the same source.

114. See *Nabisco*, 191 F.3d at 215-16 ("The degree of distinctiveness of a mark governs in part the breadth of the protection it can command. . .").

115. See *id.* at 217.

116. Whether descriptive marks that have acquired distinctiveness solely through secondary meaning are eligible for dilution protection remains unclear; at least one court has recently held that they are not. See *New York Stock Exchange, Inc. v. New York, New York Hotel, LLC*, 1999 WL 787195, *10 (S.D.N.Y. 1999) ("[A] famous mark that has acquired secondary meaning is not 'distinctive' as that term is used in the federal antidilution statute, and is thus not entitled to protection thereunder.").

117. See sources cited *supra* note 85.

118. See *Ringling Bros.-Barnum & Bailey Combined Shows, Inc. v. Utah Div. of Travel Dev.*, 170 F.3d 449, 457 (4th Cir.), *cert. denied*, 120 S. Ct. 286 (1999); *Mead Data Central, Inc. v. Toyota Motor Sales, U.S.A., Inc.*, 875 F.2d 1026, 1031 (2nd Cir. 1989).

119. See *I.P. Lund Trading v. Kohler Co.*, 163 F.3d 27, 48 (1st Cir. 1998).

120. See 4 MCCARTHY, *supra* note 7, § 24.70.

In some cases of identical use on directly competing products, the possibility of confusion greatly increases while the possibility that consumers will recognize that the same mark identifies two different sources decreases.

B. Applying the Test

In both *Ringling* and *Nabisco*, the fame requirement has almost certainly been met. Both marks have been advertised and distributed on a nationwide basis for many years.

Ringling's Greatest Show mark is a descriptive phrase that has acquired distinctiveness only through secondary meaning. Even if descriptive marks with secondary meaning may qualify for dilution protection, the other dilution factors such as similarity and mental association must be particularly strong for dilution to be likely.

The similarity between the Greatest Show mark and the Greatest Snow mark is moderate at best. While differing only in a single word, that word is arguably the most important part of the slogan. While "show" and "snow" may be visually similar, they sound different, and have vastly different meanings. At least one other court has come to the same conclusion.¹²¹ The mental association factor, based solely on Ringling's consumer survey evidence, also indicates a weak-to-moderate showing. The survey failed to show a statistically significant number of respondents who recognized and associated both marks, but remained unconfused as to source.¹²² The district court found that the survey tended to show no mental association.¹²³ In the final analysis, Ringling's mark, while sufficiently famous and possibly sufficiently distinctive to qualify for dilution protection, is an otherwise descriptive phrase, and its relatively weak showing in both the similarity and mental association factors weigh decidedly against a finding of dilution.

In *Nabisco*, the court found that the choice of a goldfish color and shape for a cheese flavored cracker was arbitrary, and therefore moderately distinctive,¹²⁴ but when weighed against the similarity and proximity

121. See *Ringling Bros.-Barnum & Bailey Combined Shows, Inc. v. B.E. Windows Corp.*, 937 F. Supp. 204, 209-11 (S.D.N.Y. 1996) (Finding "show" is the most important word in senior's "The Greatest Show On Earth" mark, and is not similar enough to "Bar" for "The Greatest Bar On Earth" mark to infringe senior's mark).

122. See *Ringling Bros.-Barnum & Bailey Combined Shows, Inc. v. Utah Div. of Travel Dev.*, 955 F. Supp. 605, 616 (E.D. Va. 1997), *aff'd*, 170 F.3d 449 (4th Cir.), *cert. denied*, 120 S. Ct. 286 (1999).

123. See *id.*

124. See *Nabisco, Inc. v. PF Brands, Inc.*, 191 F.3d 208, 217 (2d Cir. 1999).

factors, the court held that dilution was likely.¹²⁵ Arguably, however, the goldfish design is merely suggestive: the orange color of a goldfish suggests the cheddar cheese flavor of the cracker much like Coppertone suggests suntan lotion. As a weaker suggestive mark,¹²⁶ the strength of the dilution factors must be that much stronger to find likelihood of dilution.

In considering the similarity factor, the court in *Nabisco* made a substantial leap from what the two products would look like on the store shelf, to what they would look like served in dish or bowl.¹²⁷ Even using the court's "bowl" test, the two goldfish crackers differ in several significant respects: the Nabisco cracker is flatter, larger, and has markings on its sides,¹²⁸ and is arguably, therefore, only moderately similar to Pepperidge's goldfish.¹²⁹

The *Nabisco* court did not consider mental association as laid out above, but it did consider the "relevant universe of consumers" aspect under its "shared consumers" factor, and found that as competing products, they would share consumers.¹³⁰ The court muddled the analysis, however, by including confusion factors in its finding that consumers would likely confuse Nabisco's goldfish crackers with the Pepperidge Goldfish cracker when seen in a bowl.¹³¹ Of course, dilution, not confusion, is the relevant inquiry. While the "bowl" test could conceivably demonstrate a likelihood of mental association, a consumer survey would arguably be a more accurate, less subjective gauge. Given the low-to-moderate distinctiveness of the goldfish design, the moderate degree of similarity, and the lack of any evidence of likely mental association, the *Nabisco* decision could easily have come out the opposite way.

125. *See id.* at 219-20.

126. *See* Brookfield Communications, Inc. v. West Coast Entertainment Corp., 174 F.3d 1036, 1058 (9th Cir. 1999) ("[U]nlike arbitrary or fanciful marks which are typically strong, suggestive marks are presumptively weak.").

127. *See Nabisco*, 191 F.3d at 218-22.

128. *See id.* at 213.

129. The court brushed aside these differences in appearance by finding that someone "intent on popping the crackers into his mouth" would not notice them. *Id.* at 218. This is troubling, as it seems to suggest that a brief, inattentive viewing is sufficient to find a product "very similar." *Id.* The court also ignored the obvious distinguishing effect shape and texture would have when "popping" the crackers into the mouth. *See id.*

130. *See id.* at 220.

131. *See id.* at 219.

V. CONCLUSION

The approaches taken by each circuit represent opposite extremes to solving the problem of how to permit plaintiffs to establish dilution without being so permissive as to risk creation of property rights in gross, nor so restrictive as to effectively preclude a remedy even for those marks most deserving. A fair reading of the Dilution Act provides a remedy for both actual and potential future harm, and permits establishing that harm through either evidence of actual economic loss, or inferred through a set of relevant contextual factors, rigorously applying the key dilution inquiries of fame, distinctiveness, similarity and mental association.