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LIKELIHOOD OF DILUTION BY BLURRING: A CIRCUIT COMPARISON AND EMPIRICAL ANALYSIS

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I. Introduction

Everyone is familiar with Starbucks Coffee Company. Starbucks is so prevalent in American life that hardly anyone has not had a hot cup of the wonderful black goodness. The author has even seen a homeless person in ***386** downtown Houston collect change from passers by and head straight to a Starbucks for a cup of coffee. Starbucks is everywhere. Starbucks is also a registered, distinctive trademark.

Now imagine another company called Starbutch Meat Processors. Under dilution law, Starbucks has a right to ask a court to enjoin Starbutch from using the Starbutch name. For Starbucks to win, it must prove that use of "Starbutch" is likely to dilute the distinctive quality of the Starbucks mark.

Under state dilution laws, Starbucks would need to be distinctive for dilution protection,[1] which is what Frank Schechter's original dilution concept required.[2] Under the Federal Trademark Dilution Act (FTDA), Starbucks needed to be famous and not necessarily distinctive to qualify for federal trademark protection;[3] however, this requirement was changed in 2006 in the Trademark Dilution Revision Act (TDRA). The Starbucks trademark must be distinctive and famous under current federal law.[4]

The rule for likelihood of dilution, however, depends on where Starbucks decides to bring suit against Starbutch. As this Article will show, courts have three types of rules for proving a likelihood of dilution. The first rule is consumer-oriented and focuses on how consumers perceive the Starbucks and Starbutch marks.[5] The second rule is still consumer-oriented, but different from the first rule, in that it focuses on the similarity of the Starbucks and Starbutch marks and finds dilution if consumers mentally associate the Starbutch mark with Starbucks.[6] The third rule is mark-oriented and centers on the distinctiveness of the Starbucks mark and only analyzes the similarity between the Starbucks mark and the Starbutch ***387** mark to find a likelihood of dilution.[7] Thus a split, or more precisely, a splinter, among the circuits as to the rule for likelihood of dilution does exist.

Part II discusses state and federal dilution statutes, emphasizing that liability requires a finding of a likelihood of dilution. Part III discusses how the circuits disagree as to the appropriate rule for finding a likelihood of dilution under state and federal dilution laws. Part IV, through empirical analysis, determines whether each circuit's application of the various tests for likelihood of dilution actually follows its espoused dilution rules. Part V concludes with a summary and some final thoughts.

II. Dilution Statutes Require a Likelihood of Dilution

The first state dilution statute appeared in 1947.[8] Since then, thirty-six states have enacted anti-dilution statutes.[9] These state statutes have required that a mark be either distinctive[10] or both distinctive and famous to qualify for protection from ***388** dilution.[11] Secondly, state statutes have for the most part, required a likelihood of dilution as proof of liability.[12]

Forty-eight years after the first state dilution law was made and sixty-eight years after Schechter's seminal article,[13] federal law addressed dilution in 1995 when Congress passed the FTDA. As codified, the federal anti-dilution provision read:
Remedies for Dilution of Famous Marks.

(1) The owner of a famous mark shall be entitled, subject to the principles of equity and upon such terms as the court deems reasonable, 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 . . . .[14]

The standard for proving dilution under the FTDA was proving that a junior mark causes the dilution.[15] The United States Supreme Court interpreted "causes dilution" to mean that the alleged diluting mark must cause actual dilution of the distinctiveness of the famous mark, as opposed to a mere likelihood that the alleged diluting mark dilutes the distinctiveness of the famous mark.[16]

Amending the federal anti-dilution statute,[17] the TDRA now reads:
Dilution by Blurring; Dilution by Tarnishment.

(1) Injunctive Relief. Subject to the principles of equity, the owner of a famous mark that is distinctive, inherently or through acquired distinctiveness, shall be entitled to an injunction against another person who, at any time after the owner's mark has become famous, commences use of a mark or trade name in commerce that is likely to cause dilution by blurring or dilution by tarnishment of the famous mark, regardless of the ***389** presence or absence of actual or likely confusion, of competition, or of actual economic injury.[18]

The federal anti-dilution statute was amended to change the standard of dilution, as set forth in Moseley,[19] from actual dilution to a likelihood of dilution.[20] Moreover, an alleged diluter can dilute a famous and distinctive mark regardless of actual or likely confusion, competition, or actual economic injury.[21]

The amended federal anti-dilution statute is now more consistent with state anti-dilution statutes that require a likelihood of dilution in proving dilution. For example, the Texas anti-dilution statute reads:

> Injury to Business Reputation or Trade Name or Mark. A person may bring an action to enjoin an act likely to injure a business reputation or to dilute the distinctive quality of a mark registered under this chapter or Title 15, U.S.C., or a mark or trade name valid at common law, regardless of whether there is competition between the parties or confusion as to the source of goods or services. An injunction sought under this section shall be obtained pursuant to Rule 680 et seq. of the Texas Rules of Civil Procedure.[22]

It is clear that the standard for finding dilution is to prove a likelihood of dilution. However, an examination of how federal courts apply the likelihood of dilution test reveals that there exists an issue of what likelihood of dilution means and the proof thereof.

III. Inconsistent Circuit Rules for Likelihood of Dilution by Blurring Create a Split Among the Circuits

Rules were gathered for two time periods. The periods were examined based on important dates in dilution law: the effective date of the FTDA (January 16, 1996) and the date of the Moseley decision (March 4, 2003). Before the FTDA, state laws required a likelihood of dilution, so an examination of state laws is appropriate for determining the test for likelihood of dilution. While the FTDA was effective, some courts used a likelihood of dilution test until the Moseley decision, so an examination of federal law is also appropriate for determining the test for likelihood of dilution. The first time period consists of those cases decided in the ten years before the existence of federal dilution law--from January 16, 1986, to January 16, 1996. The second period consists of those cases decided under federal law in the years between the effective date of the FTDA and the Moseley decision--from January 16, 1996, to March 4, 2003.

*390 A. The Rules Proposed by the Circuits Concerning State Dilution Statutes from January 16, 1986, to January 16, 1996[23]

During this time period the circuits generally agreed that the threshold issue for a mark to qualify for dilution protection was that it must be distinctive, either inherently or through acquired secondary meaning.[24] If a mark is not distinctive, the test for dilution by blurring stops and no dilution is found.[25] If a mark is distinctive, the rule moves to the second issue--the plaintiff must prove a likelihood of dilution of the distinctive quality of its mark. The circuits are largely inconsistent in what they require the plaintiff to prove in order to find a likelihood of dilution. However, their rules for likelihood of dilution can be grouped into three general categories: (1) mark rules which focus on the similarity between the plaintiff's mark and the defendant's mark; (2) consumer rules that borrow factors from trademark infringement's likelihood of confusion test in order to make a test for likelihood of dilution, thus focusing on the consumer's perspective of the marks; and (3) hybrid rules which focus on the mark itself (distinctiveness) but also use the consumer's mental association between the plaintiff's mark and the defendant's mark to find a likelihood of dilution.

The First Circuit's state law rule for likelihood of dilution by blurring is a consumer rule. Likelihood of dilution occurs when the plaintiff shows (1) actual or potential confusion or (2) diminution in the distinctiveness of the plaintiff's mark.[26] The first prong of the First Circuit's rule for likelihood of dilution is consumer-oriented in that it borrows from the likelihood of confusion test for trademark infringement by allowing a plaintiff to show actual or potential consumer confusion as to the source of the mark to find a likelihood of dilution. The second prong is mark-oriented in that it focuses on the diminution of the distinctiveness of the mark. While the consumer's perspective is irrelevant in the second prong, the first prong makes the rule as a whole a consumer rule.

The Third Circuit's state law rule for likelihood of dilution by blurring is a hybrid rule. Likelihood of dilution requires the plaintiff to show the defendant's ***391** use of its mark creates some mental association between the defendant's mark and the plaintiff's mark that blurs the distinctiveness of the plaintiff's mark.[27] It emphasizes blurring of the mark's distinctiveness. However, it uses the consumers' perspective of the mark by requiring some mental association between the defendant's mark

and the plaintiff's mark. As stated above, even though the rule uses a consumers' perspective, it is a hybrid rule because it is the consumers' mental association and not confusion that proves a likelihood of dilution.

The Seventh Circuit's state law rule for likelihood of dilution by blurring is a mark rule. Under this rule, courts will find a likelihood of dilution if the junior mark is deceptively similar to the senior mark.[28] A complete defense to finding dilution arises if the defendant was a competitor of the plaintiff.[29] The Seventh Circuit's likelihood of dilution rule is mark-oriented because it focuses only upon the similarity between the plaintiff's mark and defendant's mark.

The Eighth Circuit's state law rule for likelihood of dilution by blurring is also a mark rule. Likelihood of dilution is found when the junior mark is similar to the senior mark.[30] The Eighth Circuit's rule, like the Seventh Circuit's, is mark-oriented because it compares only the similarity of the marks to find a likelihood of dilution.

The Ninth Circuit's state law rule for likelihood of dilution by blurring is not yet defined. While the dilution rule seems to be that (1) the plaintiff's mark must be distinctive and (2) the defendant's use of a mark must create a likelihood of dilution,[31] the Ninth Circuit, during this time period, had no defined rule for finding a likelihood of dilution.

The Eleventh Circuit's state law rule for likelihood of dilution by blurring is a hybrid rule. Likelihood of dilution is proved by showing that purchasers of products bearing the defendant's mark associate that mark with the plaintiff's ***392** mark.[32] This likelihood of dilution rule requires similarity between the two marks and uses the purchaser's mental association of the marks to prove a likelihood of dilution.

The Second Circuit has two state law rules for dilution by blurring.[33] The general rule is (1) the plaintiff's mark must be distinctive and (2) the plaintiff must show a likelihood of dilution.[34] This rule is qualified by the caveat that the defendant's mark be "very" or "substantially" similar to the plaintiff's mark[35] and that a court may use the defendant's predatory intent an as equitable consideration for liability.[36] Second Circuit courts disagree, however, as to what the rule is for proving a likelihood of dilution by blurring. This disagreement is a direct result of the majority and concurring opinions set forth in Mead. A subsequent case, Deere & Co., eloquently states the schism:

> The majority opinion in Mead . . . indicated only that "some mental association" must exist between the plaintiff's and defendant's marks. Otherwise, however, the Mead court did not provide guidelines for determining what constitutes blurring. In a concurring opinion in Mead, . . . Judge Sweet, borrowing from Judge Friendly's multi-factor balancing test for identifying confusion in the trademark infringement context, suggested a test involving the balancing of six factors: (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[.][37]

As a result of the Mead decision, subsequent Second Circuit decisions used the hybrid majority rule in Mead,[38] Judge Sweet's concurring consumer rule,[39] or some variation thereof to find a likelihood of dilution by blurring.[40]

***393** The table below summarizes the type of likelihood of dilution rule for each Circuit from January 16, 1986, to January 16, 1996.[41]

Table 1. State Law Likelihood of Dilution Rule Type, by Circuit

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***394** As can be seen, the First and Second Circuits favor a consumer rule. The Second, Third, and Eleventh Circuits favor a hybrid rule, and the Seventh and Eighth Circuits favor a mark rule. As far as state laws for likelihood of dilution are concerned, there is a splinter as to which rule to use among the circuits.

B. The Rules Proposed by the Circuits Concerning Likelihood of Dilution in the FTDA from January 16, 1996, to March 4, 2003

During this time period the courts generally agreed that the threshold issues for finding dilution under the FTDA were: (1) the senior mark is famous, (2) the junior mark is used in commerce, and (3) the junior mark is used after the senior mark became

famous.[42] If any of these issues were not met, the court stopped its analysis at the failed issue and found no dilution under the FTDA.[43] It was only after all of these requirements were satisfied (or uncontested) that courts proceeded to a likelihood of dilution analysis.[44] While ten out of the twelve circuits addressed dilution under the FTDA during this time period, not all used a likelihood of dilution test.[45] The circuits that did use a likelihood of dilution test continue to disagree whether likelihood of dilution focuses on public perception of the mark with a narrow or hybrid rule or on the distinctive quality of the mark itself with a broad rule.[46] Like the 1986 to 1996 data set, the rules of the circuits can be classified as (1) mark, (2) hybrid, or (3) consumer.

The First Circuit federal rule for likelihood of dilution by blurring is a hybrid rule. Likelihood of dilution requires proof that the "target customers are likely to ***395** view the products 'as essentially the same.'"[47] The First Circuit abandoned the use of the Second Circuit's consumer rule,[48] stating that "[t]he district court's finding of likelihood of dilution depended on its use of inappropriate Sweet factors."[49] The First Circuit further stated, "As [trademark scholar J. Thomas] McCarthy points out, use of factors such as predatory intent, similarity of products, sophistication of customers, and renown of the junior mark work directly contrary to the intent of a law whose primary purpose was to apply in cases of widely differing goods, i.e. Kodak pianos and Kodak film."[50] "The Sweet factors have been criticized by both courts and commentators for introducing factors that 'are the offspring of classical likelihood of confusion analysis and are not particularly relevant or helpful in resolving the issues of dilution by blurring.'"[51] The First Circuit is a hybrid because it does not use consumer confusion to find a likelihood of dilution but does take the consumer's view of the senior and junior mark owners' products into account.[52]

The Second Circuit federal rule for likelihood of dilution by blurring is a consumer rule. Likelihood of dilution is found using a number of factors: (1) similarity of the marks; (2) distinctiveness; (3) proximity of the products and likelihood of bridging the gap; (4) the interrelationship of the first three factors; (5) shared consumers and geographic limitations; (6) sophistication of consumers; (7) actual confusion; (8) adjectival or referential quality of the junior user's use; (9) harm the junior user will experience by finding a likelihood of dilution; and (10) the effect of the senior user's laxity in bringing the dilution claim.[53] These factors are a non-exclusive list for proving likelihood of dilution and are to "develop gradually over time."[54] Moreover, these factors were admittedly derived from "the related question of infringement by reason of likelihood of consumer confusion."[55] Because the factors were borrowed from infringement's likelihood of confusion test, they are consumer oriented, and the rule is a consumer rule.

***396** The Third Circuit federal rule for likelihood of dilution by blurring is a consumer rule. Likelihood of dilution is found by looking to Judge Sweet's likelihood of dilution factors in his concurring opinion in Mead.[56] In Times Mirror Magazines, Inc. v. Las Vegas Sports News, L.L.C., the district court found a likelihood of dilution using: (1) similarity of the marks; (2) similarity of the products using the marks; (3) consumer sophistication; (4) intent of the junior user; (5) renown of the senior mark; and (6) renown of the junior mark.[57] The Third Circuit affirmed the district court's finding of likelihood of dilution by saying the district court's use of the factors in Mead satisfied the Nabisco test (a consumer rule, as explained above).[58] This rule uses factors similar to those used in proving likelihood of confusion; however, considering the Second Circuit has since developed a test for likelihood of dilution under federal law in Nabisco, it is confusing as to why the Third Circuit has followed the older case of Mead, which concerns New York state law. Regardless, whether the Third Circuit follows the Second Circuit's rule for state law or federal law, the Third Circuit uses a consumer rule for likelihood of dilution.

The Sixth Circuit federal rule for likelihood of dilution by blurring is a consumer rule. Specifically, the Sixth Circuit adopted the Second Circuit's Nabisco ten-factor test: (1) similarity of the marks; (2) distinctiveness; (3) proximity of the products and likelihood of bridging the gap; (4) the interrelationship of the first three factors; (5) shared consumers and geographic limitations; (6) sophistication of consumers; (7) actual confusion; (8) adjectival or referential quality of the junior user's use; (9) harm the junior user will experience by finding a likelihood of dilution; and (10) the effect of the senior user's laxity in bringing the dilution claim.[59] As discussed above for the Second Circuit, this rule is a consumer rule because it uses the consumer's perspective, and in particular, consumer confusion, to find a likelihood of dilution.

The Seventh Circuit federal rule for likelihood of dilution by blurring is a mark rule. The rule weighs the similarity of the marks and the renown of the senior mark.[60] The Seventh Circuit, like the First Circuit, disagrees with the consumer rule endorsed by the Second, Third, and Sixth circuits. The Seventh Circuit differs ***397** from the First Circuit because it uses conceptually different factors to prove likelihood of dilution. Specifically, the Seventh Circuit uses no factor that focuses on the consumer's perspective. Neither does the Seventh Circuit use the factors for federal dilution as set forth by the Second Circuit in Nabisco. Instead, the Seventh Circuit considered factors set forth by Judge Sweet's opinion in Mead, which concerned a state dilution claim.[61] Interestingly, the Seventh Circuit still abandoned the Second Circuit's interpretation of Judge Sweet's likelihood of dilution factors because it rejected those factors "more suited to an inquiry into the likelihood of

confusion."[62] Thus, the Seventh Circuit rule is a mark rule.

The Eighth Circuit does not have a federal rule for likelihood of dilution by blurring. The only case reported during this time period concerned only whether the FTDA preempted the use of a state law dilution claim.[63]

The Ninth Circuit federal rule for likelihood of dilution by blurring is a hybrid rule. Likelihood of dilution results when the junior mark is sufficiently similar to evoke a mental association of the senior and junior marks.[64] The Court of Appeals for the Ninth Circuit has yet to define likelihood of dilution.[65]

The Eleventh Circuit does not have a federal rule for likelihood of dilution by blurring because both cases addressing dilution found that the senior mark was found not famous.[66]

The table below summarizes the type of likelihood of dilution rule for each circuit from January 16, 1996 to March 4, 2003.

***398 Table 2. Federal Law Likelihood of Dilution Rule Type, by Circuit**

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As can be seen in Table 2, there is a splinter of rule types under federal dilution law just as there is under state law. The Second, Third, and Sixth Circuits favor a consumer rule. The First and Ninth Circuits favor a hybrid rule, and the Seventh Circuit favors a mark rule. The next table compares those circuits that stated a rule for both time periods:

Table 3. Comparison of Those Circuits Having a Likelihood of Dilution Rule for Both Time Periods

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For some reason, the First and Third Circuits changed their rules for likelihood of dilution even though they had existing case law as precedent. One would think that a test for likelihood of dilution is the same whether under state or federal law, but as the above table shows, this is not the case. It is interesting to ***399** note that if one brings a dilution claim in the First or Third Circuits, proof of likelihood of dilution may be different depending whether it is a federal or state law dilution claim. The above table also shows that the Second Circuit finally decided on a single rule for likelihood of dilution. The Seventh Circuit, by having a mark rule for both time periods, is the only circuit that had any sort of consistency between the two time periods.

IV. Empirical Analysis of the Circuits' Actual Application of Their Likelihood of Dilution Rules

A. The Data Set and Method of Data Collection

All case searches used the LexisNexis search engine. The following search terms and connectors were used: likelihood of dilution and date aft xx/xx/xxxx and date bef xx/xx/xxxx and not notice(publ! or unpublish!). Two time periods were used: (1) from 1/16/86 to 1/16/96 and (2) from 1/16/96 to 3/4/03. The first time period of ten years was arbitrarily chosen in length but intentionally chosen in date because the effective date of the FTDA was January 16, 1996. The second time period was the time between the effective date of the FTDA and the U.S. Supreme Court's Moseley decision.[67] The data set was obtained by searching for federal cases mentioning "likelihood of dilution."[68] This approach yielded an initial sample of seventy reported cases for the first time period and ninety-four reported cases for the second time period, as shown in Tables 4 and 5.

Table 4. Federal cases reported on dilution from January 16, 1986, to January 16, 1996.

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***400 Table 5. Federal cases reported on dilution from January 16, 1996, to March 4, 2003.**

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The author then sifted through the cases, keeping only those cases relating to dilution by blurring.[69] This approach yielded a data set of sixty-two reported cases for the first time period, as shown in Table 6.

Table 6. Federal cases reported on dilution by blurring from January 16, 1986, to January 16, 1996.

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The second time period from January 16, 1996, to March 4, 2003, was further refined because of the introduction of federal dilution law in addition to state dilution statutes. Decisions that only addressed a state dilution claim were removed from the data set because the circuits' rules interpreting state dilution statutes were discussed in the 1986 to 1996 data set.[70] Notably, the Fifth Circuit had no state ***401** dilution claim cases during 1986 to 1996, but it had fifteen dilution cases from 1996 to 2003, eight of which were decided only under the Texas dilution statute.[71] The Fifth Circuit cases that were decided only under state law were removed from the 1996 to 2003 data set. This resulted in sixty cases reported on dilution by blurring in the 1996 to 2003 time period data set, as shown in Table 7.

Table 7. Federal cases reported on dilution by blurring from January 16, 1996 to March 4, 2003.

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Before the enactment of the federal dilution statute, approximately seventy-five percent of all dilution cases were filed in the Second Circuit.[72]

***402 Figure 1. Showing ratio of dilution cases by circuit from January 16, 1986, to January 16, 1996.**

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After the enactment of the federal dilution statute, less than half of the cases were filed in Second Circuit, and the use of dilution actions in other circuits was noticeable. After filtering the data set as specified above, the average number of filings, M, for dilution by blurring cases was about the same.[73]

***403 Figure 2. Showing ratio of dilution cases by circuit from January 16, 1996, to March 4, 2003.**

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B. Results of the Compilation: Do the Circuits Practice What They Preach?

1. An Explanation of How Results Were Compiled

A spreadsheet was constructed to organize each of the cases in the data set.[74] The cases were first generally organized by tracking information, cause of action information, the court's dilution rule, the court's analysis, and the outcome of the case. The tracking information includes the circuit the court was in, the reporter abbreviation, and the year of the decision. The cause of action information includes what types of trademark claims were brought, whether the claims were brought under federal or state law, and which state's law applied, if state law was applicable. The court's dilution rule includes whether fame was required, whether distinctiveness of the senior mark was required, and whether any other factors were required for a dilution cause of action. The court's dilution analysis includes whether the court used similarity of marks analysis, whether the court used any factors focusing on the public/consumer perspective of the marks, and whether the court used any other factors in its analysis. Finally, the outcome of the case indicates whether the senior trademark owner or the junior trademark owner won.

***404** The next step in the analysis is to show how the application of the court's rules matches with their proposed rule types.

2. How the Circuits' Analyses Matched Their Proposed Likelihood of Dilution Rules from January 16, 1986, to January 16,

1996

This discussion will be classified into four groups. The first group of circuits consistently followed the rule type espoused. The Third Circuit's hybrid rule is followed by a hybrid analysis.[75] The Seventh Circuit's mark-oriented analysis adhered to its mark rule.[76] The Eleventh Circuit's hybrid analysis adhered to its hybrid rule.[77]

The second group espoused a rule for likelihood of dilution but never reached an analysis. The First Circuit's consumer rule was analyzed for dilution by tarnishment but was not analyzed for dilution by blurring.[78]

The third group proposed a certain rule for likelihood of dilution and analyzed another type. The lone circuit in this group is the Eighth Circuit, which stated a mark rule and analyzed a consumer rule. In particular, two out of the three cases reported referred to a trademark infringement analysis (a consumer-oriented analysis) to find a likelihood of dilution.[79]

Because of the variety of rules in the Second Circuit, it is by itself the third group. As discussed supra, the seminal case spawning these different rules is Mead.[80] Appendix Table A-2 shows a matrix of cases decided after Mead (until January 16, 1996, the cutoff date for this time period), which rule type the court of each case used, and which analysis the court used. Of the thirty-two Second Circuit cases decided after Mead,[81] nine found no dilution because of a lack of ***405** distinctiveness of the plaintiff's mark.[82] Another four cases did not reach a likelihood of dilution analysis for various reasons.[83] The remaining nineteen cases decided subsequent to Mead are classified in Appendix Table A-2. Only three of the nineteen cases actually analyzed likelihood of dilution under the corresponding rule type.[84] Ten of the nineteen cases did not specify exactly the rule type--they simply called the test "likelihood of dilution" and impliedly classified the rule in the analysis. Of these ten cases, seven were a consumer-oriented analysis,[85] two were a mark-oriented analysis,[86] and one was a hybrid analysis.[87] Perhaps most appalling are those cases where the court stated a consumer rule and had a mark-oriented analysis[88] or the court stated a mark rule and had a consumer-oriented analysis.[89] Of the remaining four cases, two espoused a consumer rule and used a ***406** hybrid or partial consumer-oriented analysis[90] and two espoused a hybrid rule and used a mark-oriented analysis.[91]

It is bothersome that the Second Circuit's rules and analyses for likelihood of dilution are so discombobulated. Given the sheer number of cases and the large percentage of all cases that were brought in this circuit, it is disheartening to think that other circuits look to the Second Circuit for guidance on the issue of likelihood of dilution. The Second Circuit's problem is a big one, and it is partly due to the importation of trademark infringement tests--that is, tests that consider the viewpoint of the consumer--to find law for trademark dilution. "Very little attention has been given to date to the distinction between the confusion necessary for a claim of infringement and the blurring necessary for a claim of dilution."[92] This statement by the Mead court clearly indicates the root of the problem--that the Second Circuit has attempted to define dilution through trademark infringement. The table below summarizes the above results.

Table 8. State Law Likelihood of Dilution Rule and Analysis, by Circuit

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***407** Of the Circuits that have analyzed a likelihood of dilution, the Second and Eighth Circuits did not match their analysis with their rule.[93] Looking at all the analyses, though, it can be seen that a splinter truly exists in how to analyze likelihood of dilution. There is no preference for a mark-oriented, hybrid, or consumer-oriented analysis. As was stated in Part I, it really does depend where Starbucks brings suit for knowing which rule to use--at least for state dilution laws.

3. How the Circuits' Analyses Matched Their Proposed Likelihood of Dilution Rules from January 16, 1996, to March 4, 2003

The circuits in this discussion will be classified into four groups: circuits that followed their stated rule in their analysis, circuits that stated a rule but did not reach an analysis, circuits that never defined a rule, and circuits whose analysis did not match the rule.

The first group of cases followed the espoused rule in the analysis. The First Circuit's hybrid rule is followed by a hybrid analysis.[94] The Second Circuit's consumer rule is followed by a consumer-oriented analysis.[95] The Third Circuit's consumer rule is followed by a consumer-oriented analysis.[96] The Seventh Circuit's mark rule is followed by a mark-oriented analysis.[97]

The second group espoused a rule for likelihood of dilution but never reached an analysis. The Ninth Circuit stated a hybrid rule and never reached a likelihood of dilution analysis.[98]

The third group, consisting of the Eighth Circuit as well as the Eleventh Circuit, never formed a rule for likelihood of dilution.[99]

***408** The fourth group espoused one rule type and performed another type of analysis. The Sixth Circuit has a consumer rule, but applies a hybrid rule.[100] Three factors are used to find a likelihood of dilution: (1) distinctiveness, (2) similarity of the marks, and (3) consumer sophistication.[101] The analysis is classified as hybrid because it not quite consumer oriented in that the consumer's view of the marks is not considered; however, the consumer's sophistication, independent of the consumer's perception of the mark, is used. For lack of a better classification, this is called a hybrid analysis. Upon discussing the distinctiveness of the senior mark, similarity between the senior and junior marks, and the sophistication of the senior's consumers, the Sixth Circuit concluded that "classic" dilution had occurred "even without an exhaustive consideration of all ten of the Nabisco factors."[102]

The Sixth Circuit's decision not to use all the Nabisco factors is quite interesting. The Sixth Circuit endorses the Nabisco test that utilizes factors from trademark infringement's likelihood of confusion test.[103] However, in applying the test, the Sixth Circuit only used three Nabisco factors: (1) distinctiveness of the senior mark, (2) similarity between the junior and senior marks, and (3) the sophistication of the senior's consumers.[104] Therefore, although the Sixth Circuit endorsed the Second Circuit's Nabisco test (a consumer rule), its analysis is closer to that of the Seventh Circuit, which rejects the Nabisco test.[105] The Seventh Circuit uses the similarity of the marks and the distinctiveness of the senior mark to determine a likelihood of dilution[106]; therefore, the Sixth Circuit's test adds only one factor (sophistication of the senior's consumers) to the Seventh Circuit test, while it disregards seven of the ten factors in the Nabisco test.

The Seventh Circuit's application of its federal likelihood of dilution rule creates an interesting and more compelling split between the circuits as to the correct rule for likelihood of dilution. The consumer-oriented analyses of the Second and Third Circuits are not outnumbered by the hybrid- and mark-oriented analyses of the First, Sixth, and Seventh Circuits. Table 9 illustrates this conclusion.

***409 Table 9. Federal Law Likelihood of Dilution Rule and Analysis, by Circuit**

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As it can be seen, the Ninth Circuit has not analyzed a likelihood of dilution rule. The Second Circuit has a consumer-oriented analysis with a consumer rule under the FTDA--unlike the rule and analyses of the Second Circuit for state laws. The Seventh Circuit is the only circuit that has a mark-oriented analysis, but there is still a splinter because the First and Sixth Circuits favor a hybrid analysis while the Second and Third Circuits favor a consumer-oriented analysis.

Compared to the results in Table 8, the circuits are much better about consistently matching their analyses with their rules. There is, however, still a splinter concerning which concept to use in finding a likelihood of dilution. In particular, there is no majority favoring either a consumer-oriented, hybrid, or mark-oriented analysis. When looking at the espoused rule types, it seems that a consumer rule is the majority, but in actually applying the rules, this is not the case. As stated in Part I, where Starbucks brings suit against Starbutch will determine what rule is used.

The table below compares the circuits that analyzed the rule for likelihood of dilution during the two time periods:

Table 10. Comparison of Those Circuits Analyzing a Likelihood of Dilution Rule for Both Time Periods

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***410** For some reason, the Third Circuit changed its analysis during the two time periods. The Second Circuit finally decided on a single analysis during the second time period. As Table 3 showed for likelihood of dilution rules, the Seventh Circuit's analyses were consistent for both time periods. When looking at Table 3 and Table 7, the Seventh Circuit is the only circuit that had the same rule and analysis for both time periods. It is amazing to think that only one circuit was consistent. This really highlights that likelihood of dilution is far from being of any singular definition. Even after the introduction of federal

law, the rules and analyses are far from homogeneous.

V. Conclusion

The rules and analyses of likelihood of dilution come in three flavors: 1) consumer-oriented, 2) hybrid, and 3) mark-oriented. The data sets out a detailed picture of what the circuits have done in the past with their state law and federal law likelihood of dilution rules and analyses. These rules are still good law because the United States Supreme Court has never addressed the validity of a likelihood of dilution rule. The Supreme Court's Moseley decision addressed the interpretation of "causes dilution" under the FTDA, deciding that "causes dilution" meant "actual dilution" as opposed to "likelihood of dilution."[107] However, now that Congress has made clear that likelihood of dilution is the only standard for finding dilution in the TDRA, it only makes sense that the trademark community revisits the case law already in place discussing the likelihood of dilution standard.

It is these cases that courts will follow,[108] and it is these cases that can give litigants more predictability in the meaning of "likelihood of dilution" for cases brought under the TDRA than they experienced under the FTDA for the meaning of "causes dilution." Hopefully, this is the power of the empirical analysis set forth in this Article. Practitioners can examine exactly how courts in a given circuit interpret the likelihood of dilution standard-- namely through a consumer, hybrid, or mark rule. Further, practitioners can see that, even if a certain rule is used, a court may use a conceptually different analysis. It could make a difference between winning and losing for the client. Knowing the classification of the likelihood of dilution rule in a given circuit will aid determining which evidence will be most helpful in proving a likelihood of dilution under the TRDA.

***411** Lastly, this Article highlights a good case for dilution before the United States Supreme Court--a case that precisely highlights that the circuits are in dispute about whether to apply a rule that is consumer oriented, mark oriented, or a hybrid thereof. Proponents of the mark-oriented analysis might argue that dilution is becoming a useless cause of action in some circuits because the rule is borrowed from trademark infringement, making dilution the same as infringement and not really a separate cause of action.

This Article has shown that a circuit split, or splinter, exists. It has existed for many years (at least back to 1986, the starting date of the data set of this Article), and it will continue to exist because the consumer, hybrid, and mark rules for likelihood of dilution in the circuits continue today as good law. We must now wait for the ripe opportunity to make a more homogenous body of law.

*412 VI. Appendix

Table A-1. Cases Concerning State Dilution Statutes from Jan. 16, 1986, to Jan. 16, 1996

TABULAR OR GRAPHIC MATERIAL SET FORTH AT THIS POINT IS NOT DISPLAYABLE

*418 Table A-2. Cases decided after Mead until January 16, 1996.

TABULAR OR GRAPHIC MATERIAL SET FORTH AT THIS POINT IS NOT DISPLAYABLE

*419 Table A-3. Cases Concerning State Dilution Statutes from Jan. 16, 1996, to Mar. 4, 2003

TABULAR OR GRAPHIC MATERIAL SET FORTH AT THIS POINT IS NOT DISPLAYABLE

Footnotes

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[1] See cases cited infra app., tbl.A-1.

[2] Frank I. Schechter, The Rational Basis of Trademark Protection, 40 Harv. L. Rev. 813, 831 (1927).

[3] Federal Trademark Dilution Act of 1995 §3(a), 15 U.S.C. §1125(c) (2000). The Third, Fourth, Seventh, and Ninth Circuits interpreted the FTDA to require only fame and not distinctiveness. See cases cited infra app., tbl.A-3. Contrastingly, the First, Second, Fifth, Sixth, and Eleventh Circuits interpreted the FTDA to also require distinctiveness. Id.

[4] Trademark Dilution Revision Act of 2006, Pub. L. No. 109-312 §2(1), 120 Stat. 1730, 1730 (amending 15 U.S.C. §1125(c)). Frank Schechter's original concept of dilution does not require a mark to be famous-- his concept only requires a mark be distinctive because it is the "whittling away" of the distinctive quality that causes dilution. Schechter, supra note 2, at 831 ("[T]he preservation of the uniqueness of a trademark should constitute the only rational basis for its protection....").

[5] Some courts use an infringement analysis to prove dilution. See infra app., tbls.A-1 & A-3. This rule is referred to hereinafter as a "consumer rule." Often this type of rule for likelihood of dilution is virtually the same as the rule for likelihood of confusion in trademark infringement.

[6] This type of rule is referred to hereinafter as a "hybrid rule" because, while it focuses on consumers, it uses a supposedly different consumer-oriented test--mental association--as opposed to confusion. The hybrid rule is used by many courts.

[7] This rule is referred to hereinafter as a "mark rule" because it only compares the distinctiveness of a mark with other, similar marks--the consumer viewpoint is not considered. A distinctive mark could be diluted by many more marks under a mark rule because not only is competition irrelevant, so is the consumers' perspective. Frank Schechter's dilution concept is most compatible with a mark-oriented rule for likelihood of dilution. Barton Beebe, A Defense of the New Federal Trademark Antidilution Law, 16 Fordham Intell. Prop. Media & Ent. L.J. 1143, 1147 n.17 (2006) ("As is not well-appreciated, Schechter deplored the operation of trademark infringement analysis, in which the court must estimate whether a consumer of ordinary sophistication would be confused as to the true source of the defendant's good."). Schechter would not appreciate a consumer-oriented test for dilution, either. See Frank I. Schechter, The Historical Foundations of the Law Relating to Trade-Mark Law 166 (Columbia Univ. Press 1925). In his book, Schechter stated:

Any theory of trade-mark protection which...does not focus the protective function of the court upon the good-will of the owner of the trade-mark, inevitably renders such owner dependent for protection, not so much upon the normal agencies for the creation of good-will, such as the excellence of his product and the appeal of his advertising, as upon the judicial estimate of the state of the public mind. This psychological element is in any event at best an uncertain factor, and "the so-called ordinary purchaser changes his mental qualities with every judge."

Id.

[8] Caroline Chicoine & Jennifer Visintine, The Role of State Trademark Dilution Statutes in Light of the Trademark Dilution Revision Act of 2006, 96 Trademark Rep. 1155, 1158 (2006). The first state to enact an anti-dilution statute was Massachusetts. Id. This statute required a mark to be distinctive, but did not require the mark be famous. Mass. Gen. Laws ch. 110B, §12 (repealed by Acts of 2006 ch. 195; now found at Mass. Gen. Laws ch. 110H, §13 (Oct. 30, 2006)).

[9] For an excellent discussion of state statutes, see Chicoine & Visintine, supra note 8, at 1158-61.

[10] Ala. Code §8-12-17 (2007); Del. Code Ann. tit. 6, §3313 (2008); Fla. Stat. §495.151 (2007); Ga. Code Ann. §10-1-451(b) (2007); Iowa Code §548.113 (2008); La. Rev. Stat. Ann. §51:223.1 (2007); Me. Rev. Stat. Ann. tit. 10, §1530 (2007); Mass. Gen. Laws Ann. ch. 110H, §13 (West 2007); Mo. Rev. Stat. §417.061(l) (2008); Mont. Code Ann. §30-13-334 (2007); N.H. Rev. Stat. Ann. §350-A:12 (2008); N.Y. Gen. Bus. Law §360-l (McKinney 2007); Or. Rev. Stat. §647.107 (2007); 54 Pa. Cons. Stat. §1124 (2008); R.I. Gen. Laws §6-2-12 (2007); Tex. Bus. & Com. Code Ann. §16.29 (Vernon 2008); Wash. Rev. Code §19.77.160 (2008).

[11] Alaska Stat. §45.50.180(d) (2008); Ariz. Rev. Stat. Ann. §44-1448.01 (2007); Ark. Code Ann. §4-71-213 (2008); Conn. Gen. Stat. §35-11i(c) (2008); Haw. Rev. Stat. §482-32 (2007); Idaho Code Ann. §48-513 (2008); 765 Ill. Comp. Stat. 1036/65 (2007); Kan. Stat. Ann. §81-214 (2006); Minn. Stat. §333.285 (2008); Miss. Code Ann. §75-25-25 (2008); Neb. Rev. Stat. §87-140 (2007); Nev.

Rev. Stat. Ann. §600.435 (West 2007); N.J. Stat. Ann. §56:3-13.20 (2007); N.M. Stat. Ann. §57-3B-15 (West 2008); S.C. Code Ann. §39-15-1165 (2007); Tenn. Code Ann. §47-25-513 (2007); W. Va. Code §47-2-13 (2007); Wyo. Stat. Ann. §40-1-115 (2007); Federal Trademark Dilution Act of 1995 §3(a), 15 U.S.C. §1125(c) (2000); Trademark Dilution Revision Act of 2006 §2(1), Pub. L. No. 109-312, 120 Stat. 1730, 1730.

[12] See supra notes 10-11.

[13] Frank I. Schechter, The Rational Basis of Trademark Protection, 40 Harv. L. Rev. 813 (1927).

[14] Federal Trademark Dilution Act of 1995 §3(c)(1).

[15] Id.

[16] Moseley v. V Secret Catalogue, Inc., 537 U.S. 418, 432-33 (2003).

[17] Trademark Dilution Revision Act of 2006 §2(1).

[18] Id. (emphasis added).

[19] Moseley, 537 U.S. at 418 ("The FTDA requires proof of actual dilution.").

[20] Trademark Dilution Revision Act of 2006 §2(1).

[21] Id.

[22] Tex. Bus. & Com. Code Ann. §16.29 (Vernon 2007).

[23] This subsection focuses on the circuits' interpretations of the state dilution statutes. The Fourth, Fifth, Tenth, and D.C. Circuits reported no cases concerning likelihood of dilution during this time period. See infra app., tbl.A-1.

[24] See cases cited infra app., tbl.A-1. Some cases do require inherent distinctiveness, but because the thrust of this Article is on the rule for likelihood of dilution, this inconsistency is not addressed for the sake of brevity.

[25] See, e.g., Trustco Bank, N.A. v. Glens Falls Nat'l Bank & Trust Co., N.A., 903 F. Supp. 335, 341 (N.D.N.Y. 1995).

[26] Black Dog Tavern Co. v. J. Peter Hall, 823 F. Supp. 48, 59 (D. Mass. 1993). The court in Black Dog refers to diminution of the uniqueness of the mark. Id. For purposes of this Article, uniqueness is synonymous with distinctiveness--that is, a mark that is unique is distinctive and vice versa.

[27] Barnes Group, Inc. v. Connell L.P., 793 F. Supp. 1277, 1304 (D. Del. 1992).

[28] Ringling Bros.-Barnum & Bailey Combined Shows, Inc. v. Celozzi-Ettelson Chevrolet, Inc., 855 F.2d 480, 482-83 (7th Cir. 1988) (finding that the slogan 'The Greatest Used Car Show on Earth' was deceptively similar to the plaintiff's slogan 'The Greatest Show on Earth.').

[29] See AHP Subsidiary Holding Co. v. Stuart Hale Co., 1 F.3d 611, 619 (7th Cir. 1993); FASA Corp. v. Playmates Toys, Inc., 869 F. Supp. 1334, 1358 (N.D. Ill. 1994); Abbott Labs. v. Nutramax Prods., Inc., 844 F. Supp. 443, 447 (N.D. Ill. 1994).

[30] See Midwest Research Inst. v. S & B Promotions, Inc., 677 F. Supp. 1007, 1017 (W.D. Mo. 1988) (holding defendant's use of the term "Midwest Research" created a likelihood of dilution as to the plaintiff's service marks "Midwest Research Institute" and "MRI").

[31] See E & J Gallo Winery v. Consorzio del Gallo Nero, 782 F. Supp. 457, 469 (N.D. Cal. 1991) ("[The plaintiff] need show only that 'the distinctive value of the ['Gallo'] mark is likely to be diluted.'"); Plasticolor Molded Prods. v. Ford Motor Co., 713 F. Supp. 1329, 1342, 1344 (C.D. Cal. 1989) ("Courts have interpreted [the California dilution statute] to protect the holder of a distinctive mark against four overlapping types of injury.... Ford can prevail on its dilution claim if it proves that Plasticolor's use of its marks causes the likelihood of any of these four types of injury."), vacated, 767 F. Supp. 1036 (C.D. Cal. 1991).

[32] See, e.g., Babbit Elecs. Inc. v. Dynascan Corp., 38 F.3d 1161, 1182 (11th Cir. 1994).

[33] During this time period the Second Circuit had substantially more cases than any other circuit. See infra Part IV.A, tbl.6 & fig.1. Interestingly, every case in the Second Circuit was brought in the state of New York. See infra app., tbl.A-1. Therefore, not only were almost three quarters of all cases in this time period brought in the Second Circuit, but they were nearly all brought in New York.

[34] Mead Data Cent., Inc. v. Toyota Motor Sales, U.S.A., Inc., 875 F.2d 1026, 1030 (2d Cir. 1989).

[35] Id. at 1029.

[36] Id. at 1028 (citing Sally Gee, Inc. v. Myra Hogan, Inc., 699 F.2d 621, 626 (2d Cir. 1983)). Another line of Second Circuit cases uses predatory intent as the third element of dilution by blurring. See, e.g., W.W.W. Pharm. Co. v. Gillette Co., 984 F.2d 567, 576-77 (2d Cir. 1993).

[37] Deere & Co. v. MTD Prods., Inc., 860 F. Supp. 113, 119 (S.D.N.Y. 1994) (citing Mead, 875 F.2d at 1035 (Sweet, J., concurring)).

[38] See, e.g., Hormel Foods Corp. v. Jim Henson Prods., Inc., 73 F.3d 497, 506 (2d Cir. 1996); Schieffelin & Co. v. Jack Co., 850 F. Supp. 232, 251 (S.D.N.Y. 1994); Jordache Enters., Inc. v. Levi Strauss & Co., 841 F. Supp. 506, 523 (S.D.N.Y. 1994); Sports Auth., Inc. v. Prime Hospitality Corp., 877 F. Supp. 124, 130-31 (S.D.N.Y. 1995), vacated, 89 F.3d 955 (2d Cir. 1996).

[39] See, e.g., Merriam-Webster, Inc. v. Random House, 35 F.3d 65, 73 (2d Cir. 1994) (stating the likelihood of dilution factors: renown of senior mark, renown of junior mark, similarity of the marks, sophistication of consumers, and predatory intent); Computer Assocs. Int'l, Inc. v. AJV Computerized Data Mgmt., Inc., 889 F. Supp. 630, 639 (E.D.N.Y. 1995) (stating Judge Sweet's factors for likelihood of dilution); Philip Morris, Inc. v. Star Tobacco Corp., 879 F. Supp. 379, 389 (S.D.N.Y. 1995) (referring to a likelihood of confusion test to prove likelihood of dilution); Deere & Co., 860 F. Supp. at 119-120.

[40] Ten cases did not explain in detail the rule for likelihood of dilution, yet they analyzed dilution in detail according to the Mead majority, Judge Sweet's Mead concurrence, or some other variation. See Giorgio Beverly Hills, Inc. v. Revlon Consumer Prods. Corp., 869 F. Supp. 176 (S.D.N.Y. 1994); Jim Beam Brands Co. v. Beamish & Crawford, Ltd., 852 F. Supp. 196 (S.D.N.Y. 1994); Eastman Kodak Co. v. Rakow, 739 F. Supp. 116, 117 (W.D.N.Y. 1989); Kraft Gen. Foods, Inc. v. Allied Old English, Inc., 831 F. Supp. 123, 133-34 (S.D.N.Y. 1993); Merriam-Webster, Inc. v. Random House, Inc., 815 F. Supp. 691, 704 (S.D.N.Y. 1993), vacated, 35 F.3d 65 (2d Cir. 1994); Stern's Miracle-Gro Prods., Inc. v. Shark Prods., Inc., 823 F. Supp. 1077, 1090-91 (S.D.N.Y. 1993); Girl Scouts of the U.S. v. Bantam Doubleday Dell Publ'g Group, Inc., 808 F. Supp. 1112, 1130-31 (S.D.N.Y. 1992); Nikon, Inc. v. Ikon Corp., 803 F. Supp. 910, 927 (S.D.N.Y. 1992); W.W.W. Pharm. Co. v. Gillette Co., 808 F. Supp. 1013, 1027 (S.D.N.Y. 1992), aff'd, 984 F.2d 567 (2d Cir. 1993); Am. Express Co. v. Am. Express Limousine Serv. Ltd., 772 F. Supp. 729

(E.D.N.Y. 1991).

41 The Fifth Circuit did not discuss likelihood of dilution during this time period in any cases where dilution was a cause of action. See, e.g., Serv. Merch. Co. v. Serv. Jewelry Stores, Inc., 737 F. Supp. 983, 999 (N.D. Tex. 1990) (declining to espouse or apply a likelihood of dilution rule).

42 See, e.g., I.P. Lund Trading ApS v. Kohler Co., 163 F.3d 27, 45 (1st Cir. 1998).

43 See, e.g., Interactive Prods. Corp. v. a2z Mobile Office Solutions, Inc., 195 F. Supp. 2d 1024, 1033-34 (S.D. Ohio 2001), aff'd on other grounds, 326 F.3d 687 (6th Cir. 2003) (stopping analysis of dilution upon finding that junior's use was not a trademark use); Corbitt Mfg. Co. v. GSO Am., Inc., 197 F. Supp. 2d 1368, 1379 (S.D. Ga. 2002) (stopping analysis of dilution upon finding the senior mark was not distinctive); GTFM, Inc. v. Solid Clothing, Inc., 215 F. Supp. 2d 273, 299 (S.D.N.Y. 2002) (stopping analysis of dilution upon finding that the senior mark was not famous and distinctive).

44 See, e.g., Ringling Bros.-Barnum & Bailey Combined Shows, Inc. v. Utah Div. of Travel Dev., 955 F. Supp. 605, 613 (E.D. Va. 1997), aff'd, 170 F.3d 449 (4th Cir. 1999) (stating fame and junior's use of mark after senior's mark became famous not at issue).

45 This is the circuit split addressed in the U.S. Supreme Court's Moseley decision. See Moseley v. V Secret Catalogue, Inc., 537 U.S. 418, 425-28 (2003). Some circuits interpreted the FTDA's language of "causes dilution" to mean a likelihood of dilution, and some circuits interpreted the language to mean actual dilution. Id. Because the standard under the TDRA is now likelihood of dilution, those circuits espousing actual dilution as the rule will be ignored during this discussion.

46 See infra notes 47-66. It should be noted, however, that the focus on the distinctive quality of the mark is less during this time period than before because the FTDA required a mark to be famous, but not necessarily distinctive, for protection. Some courts did read the FTDA to require distinctiveness; however, there was no general consensus as to this issue. See id.

47 I.P. Lund Trading ApS v. Kohler Co., 163 F.3d 27, 50 (1st Cir. 1998) (citing 3 J. Thomas McCarthy, McCarthy on Trademarks and Unfair Competition §29:94.1 (4th ed. 2006)).

48 Id. at 49-50.

49 Id. at 49.

50 Id.

51 Id.

52 Id. at 50.

53 Nabisco, Inc. v. PF Brands, Inc., 191 F.3d 208, 217-22 (2d Cir. 1999). This ten-factor test is referred to as the Nabisco test.

54 See id. at 217.

55 Id.; see also Mead Data Cent., Inc. v. Toyota Motor Sales, U.S.A., Inc., 875 F.2d 1026, 1035 (2d Cir. 1989) (Sweet, J. concurring).

[56] See Times Mirror Magazines, Inc. v. Las Vegas Sports News, L.L.C., 212 F.3d 157, 158 (3d Cir. 2000) (using the factors set forth by Judge Sweet in Mead).

[57] Id. at 168.

[58] Id. at 169.

[59] V Secret Catalogue, Inc. v. Moseley, 259 F.3d 464, 476 (6th Cir. 2001), rev'd on other grounds Moseley v. V Secret Catalogue, Inc., 537 U.S. 418 (2003).

[60] See Eli Lilly & Co. v. Natural Answers, Inc., 233 F.3d 456, 468-69 (7th Cir. 2000) (referring to the factors listed in Mead, but using only similarity of the marks and renown of the senior mark); see also AM Gen. Corp. v. Daimlerchrysler Corp., 311 F.3d 796, 804, 812 (7th Cir. 2002) (citing Eli Lilly, 233 F.3d 456).

[61] Eli Lilly, 233 F.3d at 468-69.

[62] Id. at 468.

[63] See Viacom Inc. v. Ingram Enters., Inc., 141 F.3d 886 (8th Cir. 1998).

[64] Playboy Enters., Inc. v. Netscape Commc'ns Corp., 55 F. Supp. 2d 1070, 1075 (C.D. Cal. 1999), aff'd on other grounds, 202 F.3d 278 (9th Cir. 1999).

[65] Thane Int'l, Inc. v. Trek Bicycle Corp., 305 F.3d 894 (9th Cir. 2002) (concluding the senior mark was not famous and not getting to a likelihood of dilution analysis).

[66] See Corbitt Mfg. Co. v. GSO Am., Inc., 197 F. Supp. 2d 1368, 1378 (S.D. Ga. 2002); Michael Caruso & Co. v. Estefan Enters., Inc., 994 F. Supp. 1454, 1464 (S.D. Fla. 1998).

[67] Moseley v. V Secret Catalogue, Inc., 537 U.S. 418 (2003) (making the standard for dilution under the federal statute actual dilution).

[68] A similar case search was done for state court cases in these two time periods. Interestingly, there were only three state court cases mentioning "likelihood of dilution" for the first time period. See Williams v. Spelic, 844 S.W.2d 305 (Ark. 1992); Cushman v. Mutton Hollow Land Dev., Inc., 782 S.W.2d 150 (Mo. Ct. App. 1990); Gaeta Cromwell, Inc. v. Banyan Lakes Village, 523 So. 2d 624 (Fla. Dist. Ct. App. 1988). Likewise, there were only three state court cases during the second time period. See Tri-County Funeral Serv. v. Eddie Howard Funeral Home, 957 S.W.2d 694 (Ark. 1997); Express One Int'l, Inc. v. Steinbeck, 53 S.W.3d 895 (Tex. App.--Dallas 2001, no pet. h.); Horseshoe Bay Resort Sales Co. v. Lake Lyndon B. Johnson Improvement Corp., 53 S.W.3d 799 (Tex. App.--Austin 2001, pet. denied).

[69] Cases relating to dilution by tarnishment were the following: Exxon Corp. v. Oxxford Clothes, Inc., 109 F.3d 1070 (5th Cir. 1997); Avery Dennison Corp. v. Sumpton, 189 F.3d 868 (9th Cir. 1999); Deere & Co. v. MTD Prods., Inc., 41 F.3d 39 (2d Cir. 1994); Jordache Enters., Inc. v. Hogg Wyld, Ltd., 828 F.2d 1482 (10th Cir. 1987); L.L. Bean, Inc. v. Drake Publishers, Inc., 811 F.2d 26 (1st Cir. 1987); Kraft Foods Holdings, Inc. v. Stuart Helm, 205 F. Supp. 2d 942 (N.D. Ill. 2002); World Wrestling Fed'n Entm't, Inc. v. Bozell, 142 F. Supp. 2d 514 (S.D.N.Y 2001); Am. Dairy Queen Corp. v. New Line Prods., Inc., 35 F. Supp. 2d 727 (D. Minn. 1998); Playboy Entm't Enters., Inc., v. Webbworld, Inc., 991 F. Supp. 543 (N.D. Tex. 1998); Am. Online, Inc. v. LCGM, Inc., 46 F. Supp. 2d 444 (E.D. Va. 1998); Am. Online, Inc. v. IMS, 24 F. Supp. 2d 548 (E.D. Va. 1998); Graham Webb Int'l L.P. v. Emporium Drug Mart, Inc., 916 F. Supp. 909 (E.D. Ark. 1995); Anheuser-Busch, Inc. v. Balducci Publ'ns, 814 F. Supp. 791 (E.D. Mo. 1993); L.L. Bean, Inc. v. Drake Publ'g, Inc., 625 F. Supp. 1531 (D. Me. 1986).

[70] Cases removed because they only discussed state dilution claims were: Sports Auth., Inc. v. Prime Hospitality Corp., 89 F.3d 955 (2d Cir. 1996), vacated, 89 F.3d 955 (2d Cir. 1996); Bebe Stores, Inc. v. May Dep't Stores Int'l, Inc., 230 F. Supp. 2d 980 (E.D. Mo. 2002); U-Neek, Inc. v. Wal-Mart Stores, Inc., 147 F. Supp. 2d 158 (S.D.N.Y. 2001); Landscape Forms, Inc. v. Columbia Cascade Co., 117 F. Supp. 2d 360 (S.D.N.Y. 2000); E. Am. Trio Prods., Inc. v. Tang Elec. Corp., 97 F. Supp. 2d 395 (S.D.N.Y. 2000); Paco Sport, Ltd. v. Paco Rabanne Parfums, 86 F. Supp. 2d 305 (S.D.N.Y. 2000); Sparaco v. Lawler, Matusky, Skelly Eng'rs, L.L.P., 60 F. Supp. 2d 247 (S.D.N.Y. 1999); Brown v. It's Entm't, Inc., 34 F. Supp. 2d 854 (E.D.N.Y. 1999); Tri-Star Pictures, Inc. v. Unger, 14 F. Supp. 2d 339 (S.D.N.Y. 1998); Regal Jewelry Co., Inc. v. Kingsbridge Int'l, Inc., 999 F. Supp. 477 (S.D.N.Y. 1998); Franklin Res., Inc. v. Franklin Credit Mgmt. Corp., 988 F. Supp. 322 (S.D.N.Y. 1997); Simon & Schuster, Inc. v. Dove Audio, Inc., 970 F. Supp. 279 (S.D.N.Y. 1997); Haven Capital Mgmt., Inc. v. Havens Advisors, L.L.C., 965 F. Supp. 528 (S.D.N.Y. 1997); Horn's, Inc. v. Sanofi Beaute, Inc., 963 F. Supp. 318 (S.D.N.Y. 1997); Trustees of Columbia Univ. v. Columbia/HCA Healthcare Corp., 964 F. Supp. 733 (S.D.N.Y. 1997); Tsiolis v. Interscope Records, Inc., 946 F. Supp. 1344 (N.D. Ill. 1996); Tap Publ'ns, Inc. v. Chinese Yellow Pages (New York), Inc., 925 F. Supp. 212 (S.D.N.Y. 1996); Warnervision Entm't, Inc. v. Empire of Carolina, Inc., 915 F. Supp. 639 (S.D.N.Y. 1996), vacated, 101 F.3d 687 (2d Cir. 1996); Judith Ripka Designs, Ltd. v. Preville, 935 F. Supp. 237 (S.D.N.Y. 1996).

[71] Accordingly, in the dilution rules discussion from 1986 to 1996, the Fifth Circuit has no rule. See infra app., tbl.A-1. One Fifth Circuit case did mention the Texas anti-dilution statute in 1990; however, the court did not interpret the statute. See Serv. Merch. Co. v. Serv. Jewelry Stores, Inc., 737 F. Supp. 983, 999 (N.D. Tex. 1990). Thus, Service Merchandise is not included in the 1986 to 1996 data set because it did not espouse or apply a likelihood of dilution rule.

[72] In Figs. 1 and 2, N equals the total number of cases and M equals the average number of cases filed per year.

[73] In Fig. 1, M=7 and in Fig. 2, M=6. This is a little misleading because the 1996 to 2003 data set does not include many state cases according to the author's chosen method of data selection. Including these data in the 1996 to 2003 time period raises the average number of filings per year to M=11.

[74] App., tbls.A-1, A-3.

[75] See Barnes Group, Inc. v. Connell L.P., 793 F. Supp. 1277, 1304 (D. Del. 1992) (considering both distinctiveness of the marks and mental association between the marks).

[76] See Ringling Bros.-Barnum & Bailey Combined Shows, Inc. v. Celozzi-Ettelson Chevrolet, Inc., 855 F.2d 480, 482 (7th Cir. 1988) (considering distinctiveness only).

[77] See, e.g., Babbit Elecs., Inc. v. Dynascan Corp., 38 F.3d 1161, 1182 (11th Cir. 1994) (analyzing likelihood of dilution by considering whether the distinctive quality of the mark might be diluted and whether purchasers might associate plaintiff's products with defendant's products); Glen Raven Mills, Inc. v. Ramada Int'l, Inc., 852 F. Supp. 1544 (M.D. Fla. 1994) (analyzing likelihood of dilution using defendant's significant use of its mark, advertising, and marketing); Jaguar Cars Ltd. v. Skandrani, 771 F. Supp. 1178 (S.D. Fla. 1991) (analyzing likelihood of dilution by consumer's mental association between the plaintiff and defendant's marks).

[78] See Black Dog Tavern Co. v. Hall, 823 F. Supp. 48, 59 (D. Mass. 1993).

[79] See Gilbert/Robinson, Inc. v. Carrie Beverage-Missouri, Inc., 758 F. Supp. 512, 528 (E.D. Mo. 1991) (finding likelihood of dilution because of a likelihood of confusion exists); Midwest Research Inst. v. S & B Promotions, Inc., 677 F. Supp. 1007, 1017 (W.D. Mo. 1988) (finding likelihood of dilution because the plaintiff's mark had acquired secondary meaning).

[80] Mead Data Cent., Inc. v. Toyota Motor Sales, U.S.A., Inc., 875 F.2d 1026 (2d Cir. 1989).

[81] See infra app., tbl.A-1. (listing the cases after the 1989 Mead decision).

[82] See Trustco Bank v. Glens Falls Nat'l Bank & Trust Co., 903 F. Supp. 335 (N.D.N.Y. 1995); CBS Inc. v. Liederman, 866 F. Supp. 763 (S.D.N.Y. 1994); Sizes Unlimited, Inc. v. Sizes to Fit, Inc., 871 F. Supp. 1558 (E.D.N.Y. 1994); Pfizer, Inc. v. Astra Pharm. Prods., Inc., 858 F. Supp. 1305 (S.D.N.Y. 1994); Windsor, Inc. v. Intravco Travel Ctrs., 799 F. Supp. 1513 (S.D.N.Y 1992); Bachellerie v. Z. Cavaricci, Inc., 762 F. Supp. 1070 (S.D.N.Y 1991) (withdrawn from bound volume by request of the court); Brown v. Quiniou, 744 F. Supp. 463 (S.D.N.Y. 1990); Parenting Unlimited, Inc. v. Columbia Pictures Television, Inc., 743 F. Supp. 221 (S.D.N.Y. 1990); Wonder Labs, Inc. v. Procter & Gamble Co., 728 F. Supp. 1058 (S.D.N.Y. 1990).

[83] See Revlon Consumer Prods. Corp. v. Jennifer Leather Broadway, Inc., 858 F. Supp. 1268 (S.D.N.Y. 1994) (stating no appropriation of plaintiff's mark because defendant was using plaintiff's mark to identify plaintiff's product); W.W.W. Pharm. Co. v. Gillette Co., 984 F.2d 567, 577 (2d Cir. 1993) (stating that plaintiff has put forth no evidence and performing no likelihood of dilution analysis as a result); Sterling Drug, Inc. v. Bayer AG, 792 F. Supp. 1357 (S.D.N.Y. 1992) (deciding unlicensed use of plaintiff's mark is diluting); Bristol-Myers Squibb Co. v. McNeil-P.P.C., Inc., 786 F. Supp. 182 (E.D.N.Y. 1992), aff'd in part, vacated in part, 973 F.2d 1033 (2d Cir. 1992) (deciding there is no likelihood of dilution for direct competitor).

[84] See Hormel Foods Corp. v. Jim Henson Prods., Inc., 73 F.3d 497, 506 (2d Cir. 1996); Schieffelin & Co. v. Jack Co. of Boca, Inc., 850 F. Supp. 232, 251 (S.D.N.Y. 1994); Jordache Enters., Inc. v. Levi Strauss & Co., 841 F. Supp. 506, 522 (S.D.N.Y. 1993).

[85] See Kraft Gen. Foods, Inc. v. Allied Old English, Inc., 831 F. Supp. 123 (S.D.N.Y. 1993); Merriam-Webster, Inc. v. Random House, Inc., 815 F. Supp. 691 (S.D.N.Y. 1993), vacated, 35 F.3d 65 (2d Cir. 1994); Stern's Miracle-Gro Prods., Inc. v. Shark Prods., Inc., 823 F. Supp. 1077 (S.D.N.Y. 1993); Girl Scouts of the U.S. v. Bantam Doubleday Dell Publ'g Group, Inc., 808 F. Supp. 1112 (S.D.N.Y. 1992); Nikon, Inc. v. Ikon Corp., 803 F. Supp. 910 (S.D.N.Y. 1992); W.W.W. Pharm. Co. v. Gillette Co., 808 F. Supp. 1013 (S.D.N.Y. 1992), aff'd, 984 F.2d 567 (2d Cir. 1993); Am. Express Co. v. Am. Express Limousine Serv. Ltd., 772 F. Supp. 729 (E.D.N.Y. 1991).

[86] See Giorgio Beverly Hills, Inc. v. Revlon Consumer Prods. Corp., 869 F. Supp. 176, 186 (S.D.N.Y. 1994); Jim Beam Brands Co. v. Beamish & Crawford, Ltd., 852 F. Supp. 196, 201 (S.D.N.Y. 1994).

[87] See Eastman Kodak Co. v. Rakow, 739 F. Supp. 116, 117-19 (W.D.N.Y. 1989).

[88] Merriam-Webster, 35 F.3d at 73.

[89] See Philip Morris Inc. v. Star Tobacco Corp., 879 F. Supp. 379, 389 (S.D.N.Y. 1995).

[90] See Deere & Co. v. MTD Prods., Inc., 860 F. Supp. 113, 119 (S.D.N.Y. 1994) (using consumer rule with hybrid-oriented analysis); Computer Assocs. Int'l, Inc. v. AJV Computerized Data Mgmt., Inc., 889 F. Supp. 630, 639 (E.D.N.Y. 1995) (using consumer rule with partial-consumer-oriented analysis).

[91] See Sports Auth., Inc. v. Prime Hospitality Corp., 877 F. Supp. 124, 130-31 (S.D.N.Y. 1995), vacated, 89 F.3d 955 (2d Cir. 1996); Pristine Indus., Inc. v. Hallmark Cards, Inc., 753 F. Supp. 140, 147-48 (S.D.N.Y. 1990).

[92] Mead Data Cent., Inc. v. Toyota Motor Sales, U.S.A., Inc., 875 F.2d 1026, 1031 (2d Cir. 1989).

[93] Some Second Circuit cases had matching rules and analyses and others did not. See supra, notes 80-91 and accompanying text.

[94] See I.P. Lund Trading ApS v. Kohler Co., 163 F.3d 27, 45-50 (1st Cir. 1998).

[95] See New York Stock Exch., Inc. v. New York, New York Hotel, 293 F.3d 550, 556-57 (2d Cir. 2002); Nabisco, Inc. v. PF Brands, Inc., 191 F.3d 208, 217-22 (2d Cir. 1999).

[96] See Times Mirror Magazines, Inc. v. Las Vegas Sports News, L.L.C., 212 F.3d 157, 168-69 (3d Cir. 2000).

[97] See AM Gen. Corp. v. Daimlerchrysler Corp., 311 F.3d 796, 811-12, 816-18 (7th Cir. 2002); Eli Lilly & Co. v. Natural Answers, Inc., 233 F.3d 456, 466-69 (7th Cir. 2000).

[98] See Thane Int'l, Inc. v. Trek Bicycle Corp., 305 F.3d 894, 904-05 (9th Cir. 2002). Not a single district court case reached a likelihood of dilution analysis, either. See cases cited infra app., tbl.A-3.

[99] See Viacom Inc. v. Ingram Enters., 141 F.3d 886 (8th Cir. 1998); Corbitt Mfg. Co. v. GSO Am., Inc., 197 F. Supp. 2d 1368 (S.D. Ga. 2002); Michael Caruso & Co. v. Estefan Enters., 994 F. Supp. 1454, 1464 (S.D. Fla. 1998) (referring to a six-factor rule used in other jurisdictions but never definitively stating a rule).

[100] See V Secret Catalogue, Inc. v. Moseley, 259 F.3d 464, 476 (6th Cir. 2001), rev'd on other grounds, Moseley v. V Secret Catalogue, Inc., 537 U.S. 418 (2003).

[101] Id.

[102] Id. at 477.

[103] Id. at 476.

[104] Id. at 476-77.

[105] See supra notes 60-62 and accompanying text.

[106] See supra notes 60-62 and accompanying text.

[107] Moseley v. V Secret Catalogue, Inc., 537 U.S. 418, 432-33 (2003).

[108] The Fourth Circuit has already looked to the Second Circuit's likelihood of dilution test. See Louis Vuitton Malletier S.A. v. Haute Diggity Dog, LLC, 464 F. Supp. 2d 495, 505 (E.D. Va. 2006) ("Since the Fourth Circuit has not offered opinion on the new 'likelihood of dilution' standard, for guidance this Court looks to the Second Circuit's application of New York General Business Law §360-l, which incorporates the likelihood of dilution standard now adopted by Congress.").