

**Class 22: Dilution**

Administrative

Next Time: 798-807; 821-31

Review Useful Articles (Class 12) and Acuff-Rose/Parody (Class 17)

Last Time

Likelihood of Confusion

The essential test for TM infringement. The use of a similar mark is only infringement if it is likely to confuse the consuming public.

Threshold: The closer the market segments, the less similar the marks need to be to confuse.

- 1. Directly competing products
- 2. If products are related but don't compete directly
- 3. If products are completely unrelated

Basic Facts ⊕

Sleekcraft

- 1. Strength of the Mark — for D.
- 2. Proximity of the Goods — for P
- 3. Similarity of the Marks — for P
- 4. Actual Confusion
- 5. Marketing Channels
- 6. Type of Goods / Purchaser Care
- 7. Intent
- 8. Likelihood of Expansion

The Eight Factors

Result:

WHO must be confused?

Problems ⊕

Trademark Use

Elements Required for Infringement

- Valid Mark
- Trademark Use
- In Commerce
- In Connection with the Sale or Advertising of Goods or Services
- Without P's Consent
- Likelihood of Confusion

Tests

Rescuecom ⊕

Class 22: Dilution

Last Time

Geographic Limitations on TM Use

Class 12. Geographic Limitations of TM Game

For Unregistered Marks

General Rule: Common Law TMs are protected only where the goods or services are SOLD or ADVERTISED.

Two Exceptions

- 1. Even without sales, if reputation is established.
- 2. Against bad faith / palming off.

e.g. 1: National advertising.  
 e.g. 2: likely normal expansion if no likelihood of confusion.

For Registered Marks

Nationwide Protection AS OF THE DATE OF FILING.

Unregistered Mark

Facts

Facts: Max invents a product (a clickable sharpie) that he calls the "Maxtastic"

2000: Max begins to sell the Maxtastic in Boulder and some of the various L towns

Max doesn't seek federal registration.

Early 2005: Eleanor begins to sell a pencil case that she calls "The Maxtastic"

Max Sues

- 1. Eleanor sells only in Southern California
- 2. Eleanor sells in Denver
- 3. Eleanor sells only in Southern California. Max buys ads with Nationwide advertising firm, and ads are aired on Southern California TV before Eleanor begins to sell.
- 4. Eleanor knew about Max's product before she named her product.

Advertising is purely local.

Aside: Likelihood of Confusion?  
 Assume for the first three questions: Eleanor didn't know about Max's product.

Registered Mark

Facts

Facts: Max invents a product (a clickable sharpie) that he calls the "Maxtastic"

2000: Max begins to sell the Maxtastic in Boulder and some of the various L towns

Eleanor begins to sell a pencil case that she calls "The Maxtastic"

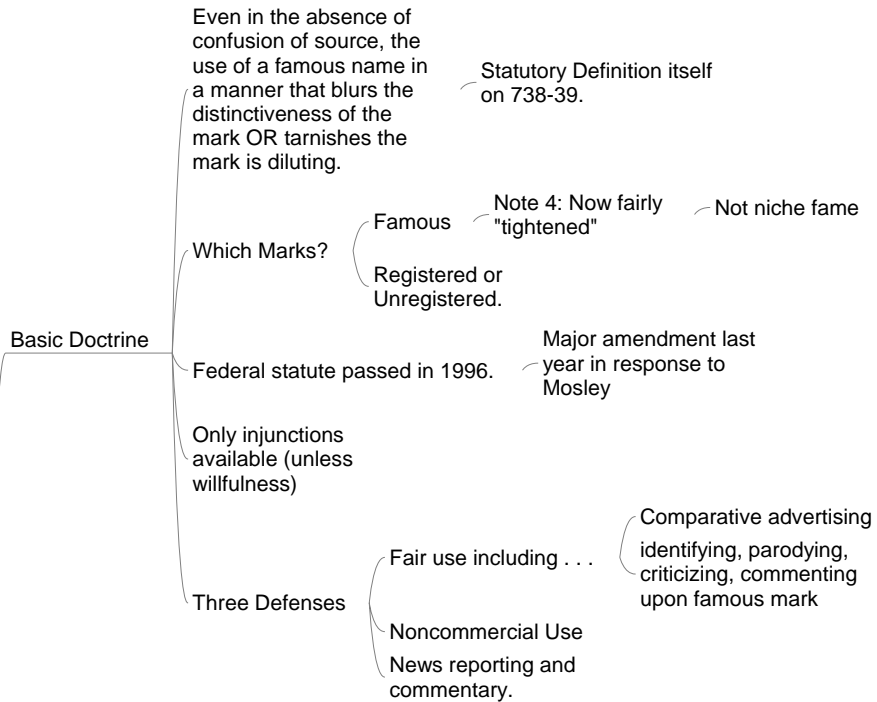
Max DOES register federally in Early 2006.

Max Sues

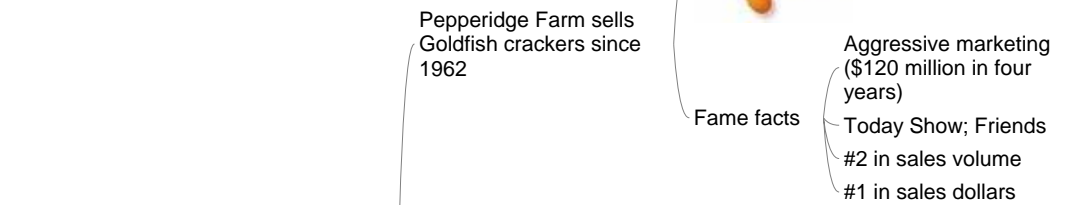
- 5. Eleanor begins to sell in mid-2006 in Southern California
- 6. Eleanor began selling in mid-2005 in Southern California.
- 7. Same facts as #6, but Eleanor tries to expand to NYC in mid-2006

**Class 22: Dilution**

**Dilution**



**Policy Rationale**



**Basic Facts**

**Nabisco v. PF Brands**

**Nickelodeon's CatDog**



Asked Nabisco to sell crackers including "bones" for dog and "fish" for cat "closely resembles" plaintiff's

**District Court Held**

**Reasoning**

Three elements not in dispute

- 2. Distinctive
- 5. Dilution of the Distinctive Quality of the Mark ⊕

- 1. Fame
- 3. Commercial use in commerce
- 4. Def. is junior user

**Tarnishment ⊕**