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▪ EASL Bylaws (Current)

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▪ EASL Index of Articles

▪ EASL Articles by Topic

▪ EASL Research Links

▪ EASL Document Archives

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▪ EASL Executive Council

EASL History

▪ Past Officers

▪ Past Events Before 6/4

▪ View All Events Past 6/4

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It's Not Just Victoria's Secret Trademark Dilution

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By David R. Ellis  
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It's not just Victoria's Secret: In a case of comparative negligees, a federal appeals court declares Victoria the victor on trademark dilution.

A federal appeals court in Cincinnati has ruled in favor of Victoria's Secret in a split decision interpreting recent amendments to the Federal Trademark Dilution Act. The case is entitled V Secret Catalogue, Inc. and Victoria's Secret Stores, Inc. v. Victor Moseley and Cathy Moseley, dba Victor's Little Secret (6th Cir., May 19, 2010).

In the case, the operators of the Victoria's Secret retail chain specializing in lingerie and negligees, owners of the famous "Victoria's Secret" trademark, sued a mom-and-pop retail store called "Victor's Little Secret," which sold adult novelty items, including sex toys and other sexually oriented products. At the time it brought suit in 1998, the plaintiffs operated over 750 retail stores, including two in Louisville, which was a short drive from the defendants' store in a mall in Elizabethtown, Kentucky.

In its suit, Victoria's Secret claimed that the defendants' use of the name "Victor's Little Secret" constituted trademark infringement, unfair competition, and dilution. The federal district court granted summary judgment in favor of the defendants on the claims for trademark infringement and unfair competition, concluding that there was no likelihood of confusion because there was no actual confusion and the parties did not compete.

However, because the Victoria's Secret mark was famous, the court granted judgment for the plaintiffs on their trademark dilution claim and enjoined the defendants from using the name "Victor's Little Secret". (They then changed it to "Cathy's Little Secret"). The court concluded that the name "Victor's Little Secret" was sufficiently similar to the "Victoria's Secret" mark to cause dilution and that use of the name "Victor's Little Secret" had a tarnishing effect on the "Victoria's Secret" mark. The court did not, however, find that any "blurring" had occurred.

The Federal Trademark Dilution Act was enacted in 1996 as an amendment to the Lanham Trademark Act of 1946, 15 U.S.C. §1051, and codified in Section 43(c), 15 U.S.C. §1125(c). The purpose of the statute is to protect a famous trademark from subsequent uses that blur the mark's distinctiveness or tarnish or disparage it, even when there is no likelihood of confusion.

Examples of dilution, as noted by Congress when it enacted the law, are such uses as DUPONT shoes, BUICK aspirin, and KODAK pianos. If KODAK were used for pianos, the distinctive character of that famous mark could be blurred, reduced and weakened. As another example, if TIFFANY were used for an X-rated adult movie theater (as it once was), Tiffany's mark could be tarnished and degraded.

Trademark dilution is different from trademark infringement, which occurs when a subsequent user adopts the same or similar trademark on competing or closely related goods so that consumers are likely to be confused as to the source of the goods. Trademark dilution, however can occur when a famous trademark is used by another on non-competing goods or when there is no likelihood of confusion between the two uses of the mark.

The Victoria's Secret case was appealed to the U.S. Supreme Court, which ruled unanimously in favor of the defendants in 2003. The Court said that under the law as it was then written, the owner of a famous mark was entitled to injunctive relief against another person's commercial use of a mark or trade name only if there was actual dilution, rather than a likelihood of dilution, and that the plaintiffs here had not shown actual harm or dilution.

In response to the Supreme Court's decision, Congress enacted the Trademark Dilution Revision Act of 2006, amending the statute to adopt a likelihood of dilution test, rather than requiring actual dilution, a standard similar to trademark law's requirement of likelihood of confusion. After remand to the district court and subsequent appeal, the Sixth Circuit decided that there was indeed a likelihood of dilution by tarnishment of Victoria's Secret's famous name. The court found that the amended statute seemed designed to protect trademarks from unfavorable sexual associations, and therefore a new mark with a lewd or offensive-to-some sexual association raised a strong inference of tarnishment.

As a result of this decision, it seems clear that in order to be the victor in a dilution case, the plaintiff need only present evidence of likelihood of dilution, not actual harm, thus giving owners of well-known brand names a stronger hand when they seek protection for their famous trademarks.

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