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WHEN SCANDAL BECOMES VOGUE: THE REGISTRABILITY OF SEXUAL REFERENCES IN TRADEMARKS AND PROTECTION OF TRADEMARKS FROM TARNISHMENT IN SEXUAL CONTEXTS *

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I. INTRODUCTION

Sexual imagery, innuendo and other types of sexual references are virtually ever-present in modern American society. Overt sexual references have become commonplace in advertising, in the media, and even in politics. Though the right to express oneself through sexual references is constitutionally protected in the United States, the ability to gain government protection of trademarks containing such references is not nearly as broad. The Lanham Trademark Act prohibits the registration of trademarks consisting of scandalous or immoral subject matter. The standard for judging what may be considered immoral or scandalous

[*436] under the statute is one that has generally followed societal mores. Accordingly, in recent years, as society's use of (and tolerance for) sexually explicit language has increased, applicants have been granted registration for a wider variety of sexually suggestive marks.

The unauthorized, commercial use of trademarks or verisimilitudes on products in sexual or otherwise scandalous contexts is actionable under state and federal anti-dilution statutes. Thus, the owner of a strong or famous mark may obtain protection from unauthorized, commercial use of that owner's mark in connection with products or services that may tarnish the mark's reputation. Courts have recognized that the use of certain marks in such a way may damage their value, and therefore courts have provided protection through injunctive relief depending on a variety of factors. The tolerance for sexually oriented trademark usage seen in the registration arena has not been paralleled in dilution standards, however. The courts have shown little tolerance for offensive commercial uses of others' marks, while noncommercial, sexual parody of trademarks has been upheld with few limits.

II. THE REGISTRABILITY OF TRADEMARKS CONTAINING SEXUAL REFERENCES

A. Scandalous or Immoral Trademarks

1. Interpreting the Meaning of "Scandalous" and "Immoral"

In recent years, sexual references and sexually oriented language have become commonplace in advertising, the media and politics. This prevalence of sexual imagery and language has led to an increase in the incidence of sexually oriented trademarks or service marks. As a result, the registrability of sexually oriented marks has been tested with greater frequency. Section 2(a) of the Lanham Trademark Act permits the United States Patent and Trademark Office ("PTO") to refuse registration of any mark that "consists of or comprises immoral, deceptive, or scandalous matter." n1 The legal meaning of the terms "immoral" and "scandalous" is, therefore, central to the determination of the registrability of sexually oriented marks. The PTO has interpreted this language as prohibiting the registration of such marks. n2 The definition of "scandalous" has remained fairly consistent throughout the history of the statute.

[*437] Court decisions have merely refined and reinforced the basic framework of the statute. However, the interpretation of this standard in relation to specific marks has varied widely over time as society's morals, tastes and sensitivities have changed.

In the absence of legislative history or comment clarifying Congress' intended interpretation of the terms "scandalous" and "immoral," early court decisions turned to the common and ordinary meanings of the terms, most often referring to the definitions found in dictionaries. In one of the first cases to address this issue, *In re Riverbank Canning Co.*,³ the Court of Customs and Patent Appeals ("CCPA") defined "scandalous" as "shocking to the sense of truth, decency, or propriety" or "giving offense to the conscience or moral feelings."⁴ These definitions remained virtually unchanged for decades.⁵ The Trademark Trial and Appeal Board ("TTAB" or "the Board") elaborated on the meaning of "scandalous" in 1978, again referring to dictionary definitions: "that which offends established moral conception or disgraces all who are associated or involved" and "to horrify or shock the moral sense."⁶

Early interpretations of the term "scandalous" survived constitutional attack based on vagueness. In *In re McGinley*,⁷ the CCPA held that the term was sufficiently precise to satisfy the requirements of due process, and relied on a series of cases using the consistent, dictionarybased meanings of "'shocking to the sense of . . . propriety,' would give 'offense to the conscience or moral feelings,' or would call 'out condemnation.'"⁸ Following *McGinley*, the TTAB and federal courts consistently have relied upon these definitions. Even the most recent significant appellate court decision addressing scandalous and immoral

[*438] trademarks based its decision on definitions dating back to *McGinley* and *Riverbank Canning*. n9

Although the statute appears to differentiate between "immoral" and "scandalous" as two separate types of unregistrable marks, examiners, the TTAB, and the courts have focused their registration analysis on the meaning of "scandalous" rather than "immoral." The two words have been virtually treated as a single basis for refusal of registration. n10 The reported decisions reflect courts' treatment of "scandalous" alone as the standard, or use the two terms together or interchangeably. n11 The question for determination by an examiner, the TTAB, or the courts is whether the *mark* is scandalous, not whether the specified goods or services, standing alone, are scandalous. n12 Although an examiner may consider the nature of the goods or services in making the scandalousness determination, the content or nature of the goods themselves is not in question, only the mark whose registration is being sought. n13

Although only the mark is to be judged for its scandalousness, and not the product or service with which the mark is used, the nature of the marketplace in which the mark will be used also may be considered in determining whether the mark is unregistrable under § 2(a) of the Lanham Act. n14 For example, in *In re Hershey*, n15 BIG PECKER BRAND clothing was determined not to be scandalous, and therefore registrable. n16 The Board held that a bird design that frequently accompanied the word mark

[*439] would serve to dissociate the mark from its potentially vulgar interpretation. n17 The Board noted that the PTO must consider the mark "in the context of the marketplace" as relating to only "the goods or services described in the application." n18 Thus, context and usage are critical in determining whether a mark is scandalous.

2. Impact of Societal Mores on the Application of Definitions

What types of marks, then, are considered scandalous under the definitions followed by the courts and the Trademark Trial and Appeal Board? Not surprisingly, the dividing line between registrable and unregistrable trademarks has shifted over the years as society's standards and mores have changed. This has not been an unconscious shift, but a factor the courts have held must be considered in making the determination of a mark's registrability. In *In re Thomas Laboratories, Inc.*, n19 the TTAB held that, in evaluating the issue of whether a mark is scandalous, "it is imperative that fullest consideration be given to the moral values and conduct which contemporary society has deemed to be appropriate and acceptable." n20 Eighteen years later, in *In re Old Glory Condom Corp.*, n21 the Board further elaborated: "What was considered scandalous as a trademark or service mark twenty, thirty or fifty years ago may no longer be considered so, given the changes in societal attitudes. Marks once thought scandalous may now be thought merely humorous (or even quaint)." n22 Even before the enactment of the Lanham Act, courts interpreted the predecessor trademark statute's prohibitions against registration of immoral and scandalous marks by considering current social mores in determining whether a mark was scandalous. n23 Thus, what

[*440] constitutes a scandalous mark will vary with the times, and current liberal attitudes accordingly have eased the standards for registration of sexually oriented trademarks and service marks.

Various segments of the population may have widely differing views on what may be shockingly offensive, regardless of broader societal standards of morality; public discourse is often bound only by the lowest common denominator of good taste. Consequently, in determining whether a mark is scandalous, one must judge whether it offends a significant portion of the public. n24 "Whether or not the mark, including innuendo, is scandalous is to be ascertained from the standpoint of not necessarily a majority, but a substantial composite of the general public." n25 Courts' ideas about how large a group constitutes a "substantial composite of the public" have varied over time. In 1959, the registration of SENUSSI, the name of a Moslem sect prohibiting smoking, as the brand name for cigarettes was refused because it was considered to be offensive and disparaging to that group, even though the number of adherents to that sect in the United States at that time was most likely rather small. n26

Based on recent decisions, however, the current definition of "substantial composite of the public" seems to have grown closer in size to that of a majority. BIG PECKER BRAND t-shirts was held not to be offensive to a substantial composite of the public. n27 OLD GLORY CONDOM CORP., with a stars-and-stripes condom design, was likewise found not offensive. n28 Both marks were registered, even though it would be reasonable to think that many people might be offended by both trademarks. The courts have noted the disparity of views present in American society and the difficulty of applying the "substantial composite" standard:

[*441] Although constantly at odds, progressive views and conservative or traditional thinking participate alike in the formation of the composite of the general public. While we recognize the inherent difficulty in fashioning a single objective measure like a substantial composite of the general public from the myriad of subjective viewpoints, we are duty bound to apply the standard set forth by our predecessor court. n29

In light of these decisions and the varied cultural and sexual sensitivities of the American public, it is difficult to determine exactly what constitutes a "substantial composite." n30 Clearly, a substantial composite must reflect the views of a significant portion of the public.

3. Constitutional Challenges to Refusals to Register

The statutory proscription against registration of scandalous or immoral trademarks also has withstood attack on the grounds that it is an unconstitutional limit on the First Amendment right to freedom of speech. Courts have held that the Constitution does not require the government to register trademarks in the interest of free speech. In *In re McGinley*, n31 the Court of Customs and Patent Appeals stated:

It is clear that the PTO's refusal to register appellant's mark does not affect his right to use it. No conduct is proscribed, and no tangible form of expression is suppressed. Consequently, appellant's First Amendment rights would not be abridged by the refusal to register his mark. n32

As may be evident from the definition of "scandalous," the threshold for non-registrability of trademarks is lower than the threshold for obscenity, a category of speech which, constitutionally, may be subjected to substantial government regulation. n33 In other words, something may be scandalous without being obscene, but if something is obscene, it would very likely be considered scandalous.

[*442] B. *The Liberalization of Societal Mores as Reflected in the Registrability of Sexual Trademarks: Case-by-Case Evolution*

Though the definitions of "scandalous" espoused by the courts and applied by the PTO have remained fairly consistent over the years, the application of those definitions has changed greatly over time, as society's morals and attitudes have liberalized. The PTO and the courts have generally followed the evolution of societal attitudes by broadening the range of innuendo and sexual references that are registrable under the Lanham Act. So great has been the liberalization of the "scandalous" standard, one might argue that today only the most obviously vulgar or profane marks will be refused registration.

1. QUEEN MARY

One of the earliest recorded PTO refusals for a scandalous trademark occurred when Martha Maid Manufacturing Company was refused registration for a design mark incorporating the name QUEEN MARY for a line of women's underwear. ⁿ³⁴ Though this early example does not include a specific sexual reference or allusion, the mark was held on appeal to be "shocking to the sense of propriety" as used by the applicant in connection with women's underwear. ⁿ³⁵ Presumably, the mere connection of the name of the former Queen of England with intimate apparel including female undergarments was too scandalous and offensive to allow registration in pre-World War II American society. ⁿ³⁶ The court did not elaborate on its reasoning, but the contemporary social standards at work at the time seem clear. ⁿ³⁷

[*443] 2. MADONNA

Though not a sexual reference--at least not in 1938--the trademark MADONNA for wine was held to be scandalous by the United States Court of Customs and Patent Appeals in *In re Riverbank Canning Co.* n38 The court accordingly upheld a refusal of registration. n39 The *Riverbank Canning* court held that the "shocking" and "offensive" nature of the mark derived from the term's association with the Virgin Mary for members of the Christian faith. n40 Though the primary meaning of "Madonna" was defined by dictionaries as an Italian form of formal address for women, like "madame" or "signora," n41 the court held that the secondary association of "Madonna" with the Virgin Mary, in the context of a label for wine, was scandalous. n42 The *Riverbank Canning* decision illustrates the application of the definition of "scandalous" in the social and moral context of 1930s America. First, the court considered the fact that the sale of wine had only recently become legal again following the repeal of Prohibition. n43 Second, the court observed that a substantial portion of the public may consider drinking intoxicating beverages to excess an evil activity. n44 Finally, the court noted that "it is a matter of common knowledge that the United States is not a winedinking country." n45 The court thus answered the "scandalous" question in the affirmative based on contemporary societal values.

3. LIBIDO

Almost fifteen years later, LIBIDO was registered as a trademark for perfume after successful appeal of an examiner's refusal in *Ex parte Parfum L'Orle, Inc.* n46 The Patent Office Examiner in Chief acknowledged that one of the common meanings of "libido" was "sexual desire," n47 but accepted the fact that many perfumes used trade names of a similarly

[*444] suggestive nature n48 and overturned the examiner's refusal of registration. n49 In reaching this decision, the Chief Examiner referred specifically to the usage of the term at the time:

The word involved in this case has more general meanings than the particular one mentioned, notably in psychoanalysis, and is probably not a word in every day use. I do not think that, when used in ordinary writing or speech, particularly among the class of persons who would be apt to use such a word, it would be considered shocking or offensive, or obscene n50

With approval of the registration for LIBIDO perfume, the door to sexually suggestive trademarks began to open, even during the conservative days of the early 1950s. The door was not thrown wide open, however.

4. BUBBY TRAP

Even during the so-called "sexual revolution," the TTAB found the term "bubby," n51 meaning "breast," too scandalous for government protection. In the 1971 case of *In re Runsdorf*, n52 the TTAB refused registration of BUBBY TRAP as a mark for brassieres, on the grounds that the term was too vulgar and offensive to public morals. n53 Though the *Runsdorf* decision reflects a conservative approach to the § 2(a) inquiry of scandalousness, the increasingly liberal morals of the 1970s were quickly reflected in subsequent cases involving potentially scandalous marks.

5. WEEK-END SEX

One of the first reported decisions approving registration of a mark containing the word "sex" was *In re Madsen*. n54 In *Madsen*, the TTAB held that WEEK-END SEX for a magazine was not scandalous. n55 In overturning the examiner's refusal to register, the TTAB stated:

[*445] Consideration must be given to the moral values and conduct fashionable at the moment, rather than that of past decades, and when the mark is viewed in the light of the present mores . . . WEEK-END SEX is not so offensive to the public sense of propriety or morality as to preclude registration n56

The Board acknowledged that WEEK-END SEX would be applied to a magazine which might contain various forms of erotica, but decided the content of the magazine was an inappropriate issue to be considered by the Board. n57 According to the Board, WEEK-END SEX, as a magazine title, when viewed in the light of present mores, is not offensive to the public's sense of propriety or morality. n58 Consequently, following the approval of the registration of a mark including the word "sex," other applicants continued to push the envelope in their efforts to register marks that included sexual terms, images, or references.

6. LEGEND LENGTHENER Design

Sexually suggestive words are not the only subject of potentially scandalous trademarks. In *In re Thomas Laboratories, Inc.*, n59 the following visual representation for a penis enlargement product was approved for registration by the TTAB:

Though the cartoon character is clearly shown to be staring at his implicitly undersized genitalia, the Board found that, in the context of the product and media in which it was to be advertised, this cartoon image representing the LEGEND LENGTHENER brand penis enlarger was not shockingly offensive. n60 The Board once again turned to the "moral values and conduct which contemporary society has deemed to be

[*446] appropriate and acceptable" in overturning an examiner's original refusal to register the mark. n61 Indeed, the Board called the image "innocuous in character . . . [without any] threat to present-day public morals or sense of propriety." n62 In *Thomas Laboratories*, the object of the depicted character's stare was hidden from view. Future applicants would not be so circumspect.

7. "Embracing Nudes" Design

In *In re McGinley*, n63 the applicant sought to register a mark consisting of a photograph of a nude man and woman embracing and kissing, with the man's genitalia exposed. n64 The mark in question was to be used for newsletters and other publications associated with various discussions of sex and so-called "swingers" clubs. n65 The examiner and the TTAB refused registration on the grounds that the mark was scandalous. n66 The refusal to register was upheld by the United States Court of Customs and Patent Appeals. n67 Contrasted with the depiction of the LEGEND LENGTHENER cartoon figure in *Thomas Laboratories*, the depiction of the nude couple in *McGinley* was graphic and left little to the imagination. n68 Unlike the LEGEND LENGTHENER character, which was used in advertisements in adult magazines, the nude couple featured in the photographic logo would be used for public display where it could be viewed by people of all ages. n69 Accordingly, the court held that such a mark was scandalous and affirmed the refusal of registration. n70 The outer boundary of registrability under the liberal moral standards of late twentieth century America appeared to have been drawn--for the moment.

[*447] 8. BULLSHIT

The limits of registrability seemed to be drawn even tighter in *In re Tinseltown, Inc.*,ⁿ⁷¹ in which the TTAB refused registration of the trademark BULLSHIT as a clothing label.ⁿ⁷² Though not sexual in nature, this mark included the use of a profane word, a circumstance the Board noted had not been previously addressed by it or the courts.ⁿ⁷³ The Board held the mark scandalous due to its profanity and concomitant offensiveness, despite "an increase in the amount of usage of profanities in our contemporary society and a diminution of the social inhibitions to such usage."ⁿ⁷⁴ The Board in *Tinseltown* endeavored to draw the distinction between the increased use of profanity in society, on the one hand, and references to current social context to determine registrability, on the other.ⁿ⁷⁵ Despite increasingly liberal moral standards, the Board's prohibition on the use of profanity in trademarks represented another limit on the registrability of potentially scandalous material from which registrable trademarks could be drawn.

9. BIG PECKER BRAND

Any thought that the *McGinley* and *Tinseltown* decisions represented a major contraction of registration standards was dispelled in 1988. In *In re Hershey*,ⁿ⁷⁶ the TTAB allowed registration of BIG PECKER BRAND as a trademark for t-shirts and other imprinted clothing, despite the innuendo.ⁿ⁷⁷ The Board held that the vulgar use of the term "pecker" in reference to the male genitalia was becoming so archaic as to render the innuendo too marginal to be considered vulgar or offensive,ⁿ⁷⁸ particularly when combined with the rooster logo that frequently accompanied the name on imprinted items.ⁿ⁷⁹ The Board admitted that

[*448] BIG PECKER may be a double entendre, but decided that the innuendo was defused by the archaic nature of the term and rooster symbol. n80 The TTAB seemed to ignore the presumed hope of the manufacturer that the innuendo itself would generate sales. The popularity of such t-shirts among certain segments of the population may itself be a testament to the offensiveness of the mark, a factor seemingly overlooked by the Board in its decision. It seemed that, in 1988, the standard had boiled down to the following rough distinction: double entendres were registrable, but profanities or graphic sexual images were not.

10. Old Glory Condom Corporation

The PTO faced the frontier of scandalousness yet again when Old Glory Condom Corporation filed an application for a design mark consisting of its name and a condom decorated to resemble the American flag. n81 Though originally refused registration by the examiner, n82 the TTAB held that the mark was not scandalous and overturned the refusal. n83 The applicant's apparent patriotic concern for the AIDS epidemic, as evidenced by a pledge appearing on the packaging, n84 was taken into account by the Board in allowing registration of the mark. n85 The Board could not find any vulgarity or shocking offensiveness in the mark sufficient to deny registration. n86 Though it can be reasonably assumed that many Americans would find such a trademark distasteful, n87 it apparently did not rise to the level of "scandalous." Having avoided using profanity, vulgar imagery or even a strong innuendo, the mark was granted registration. n88

[*449] 11. BLACK TAIL

Another recent case testing the limits of registrability of trademarks also represents a pushing of the limits of innuendo. In *In re Mavety Media Group Ltd.*,ⁿ⁸⁹ the applicant sought to register BLACK TAIL as the title for a pornographic magazine featuring African-American women.ⁿ⁹⁰ The examiner had denied registration of the mark on the grounds that the mark was scandalous.ⁿ⁹¹ The TTAB upheld the examiner's refusal stating:

Although we live in liberal times and recognize that marks which [would] have been found to be scandalous in the past hardly would raise an eyebrow today, we are convinced that a substantial composite of the general public would find the mark to be "offensive," "disreputable," "disgraceful to reputation," and shocking to their "sense of decency or propriety."ⁿ⁹²

The Circuit Court of Appeals for the Federal Circuit ("CAFC" or "Federal Circuit") vacated the Board's decision, holding that the facts did not support a refusal on scandalousness grounds.ⁿ⁹³ Despite the obvious innuendo, the court embraced an alternative meaning for the potentially scandalous and vulgar usage of "tail" as referring to women as sexual objects or sexual partners.ⁿ⁹⁴ The court was persuaded that an equally plausible meaning of "tail" referred to the rear or hind-quarters of an individual.ⁿ⁹⁵ This, the Federal Circuit held, was enough to avoid a holding that BLACK TAIL was shockingly offensive to a substantial composite of the public.ⁿ⁹⁶ The *Mavety Media* court reminded us:

We must be mindful of ever-changing social attitudes and sensitivities. Today's scandal can be tomorrow's vogue. Proof abounds in nearly every quarter, with the news and entertainment media today vividly portraying degrees of violence and sexual activity that, while popular today, would have left the average audience of a generation ago aghast.ⁿ⁹⁷

In addition, in *Mavety Media*, the court clarified that it is the PTO's burden to prove that the registration of a mark is prohibited by § 1052(a)

[*450] as being scandalous or immoral matter. n98 The Federal Circuit held that there was an absence of evidence in the record as to which definition of "tail" a substantial composite of the public would choose. n99 Accordingly, the court stated that "the PTO failed to meet its burden of proving that Mavety's mark is within the scope of § 1052(a) prohibition." n100

Based on the Federal Circuit's analysis, BLACK TAIL is not today's scandal. n101

12. DICK HEADS' Bar and Grill Design

While the precise location of the line between the "scandalous" and the merely crude remains unclear, from time to time the PTO faces applications for marks that clearly transcend the boundaries of registrability. For example, in *In re Wilcher Corp.*, n102 the applicant filed an application to register the following mark for bar and restaurant services:

The examiner refused registration on the grounds that the mark was scandalous. n103 The TTAB refused to accept the applicant's creative argument that the mark was merely a double entendre representing the

[*451] name of a putative owner, Richard Head. n104 The Board might have accepted the argument if not for the rather graphic logo depicting a person's head in the anatomically correct shape of a man's genitalia. n105 The Board was similarly dissuaded by the unavoidably offensive phrase appearing on one of the applicant's bumper stickers: "Give Me Head . . . 'Til I'm Dead." n106 Referring to the graphic cartoon, the Board stated: "There can be no doubt that this design has vulgar significance, and that because of its inclusion in the mark, it is the vulgar, anatomical significance of the mark which first strikes the viewer and dominates the commercial impression created by the mark as a whole." n107

Despite having registered BIG PECKER BRAND, n108 BIG JOHNSON n109 and BIG DICK'S, n110 the graphic imagery and unavoidably profane reference of DICK HEADS' was apparently too much for the examiner or the TTAB to bear, even under society's current, liberal mores. For a mark consisting of crude terms or references to be registrable, something must still be left to the viewer's imagination other than the vulgar or profane meaning.

C. A Final Word on Registrability of Sexually Oriented Marks

Though the standards for what constitutes sexually scandalous subject matter under § 2(a) have become increasingly liberal, in step with society's liberalizing mores, the PTO clearly will not allow every crude or vulgar mark to be registered. Outright vulgarity, profanity or offensively graphic visual representations are still refused registration, but innuendo or sexually suggestive marks will rarely be refused. The PTO and the courts will accept nearly any plausible explanation or other means of defusing offensive interpretations of the mark in allowing registration, absent profanity or unavoidably disgusting imagery.

The definition of "scandalous" or "immoral" is clearly subjective. What is scandalous to one viewer may be merely racy or clever to

[*452] another. As society becomes more accustomed to usage of sexually charged words and phrases in politics, news media, entertainment and advertising, one can only surmise that today's scandal may one day become tomorrow's registrable trademark.

III. THE ENFORCEMENT AND PROTECTION OF TRADEMARKS FROM DILUTION IN SEXUAL CONTEXTS

The increased use of sexually oriented language in our society also has led to an increase in unauthorized uses of well-known marks in sexual contexts. The commercial use of another's registered trademark, or a similar mark, in a sexual or otherwise scandalous context may be actionable under the doctrine of dilution. By contrast, parodies of trademarks are not legally actionable as long as the parodies are not made for commercial purposes. Though federal and state anti-dilution statutes allow owners of famous trademarks to prevent the scandalous misappropriation of their marks by others for commercial gain, the constitutional right to freedom of speech protects one's right to use another's trademark, no matter how scandalous or sexually charged the use, for social expression or parody. Stated differently, trademark rights do not provide a legal basis for absolute control over the use of one's mark.

A. Trademark Dilution by Tarnishment

The concept of trademark dilution and anti-dilution statutes have only developed in the last fifty or sixty years. n111 Dilution is the weakening or reduction in the ability of a mark to clearly distinguish the source of goods or services to which it is attached. n112 Dilution may occur either by blurring or by tarnishment. n113 As defined in the Federal Trademark Dilution Act of 1995, n114 which amended the Lanham Act:

The term "dilution" means the lessening of the capacity of a famous mark to identify and distinguish goods or services, regardless of the presence or absence of-

- (1) competition between the owner of the famous mark and other parties, or

[*453] (2) likelihood of confusion, mistake, or deception. n115

As further explained by the First Circuit:

The law of trademark dilution has developed to combat an unauthorized and harmful appropriation of a trademark by another for the purpose of identifying, manufacturing, merchandising, or promoting dissimilar products or services. The harm occurs when a trademark's identity and integrity--its capacity to command respect in the market--is undermined due to its inappropriate and unauthorized use by other market actors. n116

The liability standard in a dilution case is distinct from the traditional likelihood-of-confusion standard in a trademark infringement case. n117 The state and federal anti-dilution statutes have been enacted to protect the value of marks where confusion is unlikely and, therefore, a cause of action for trademark infringement will not lie. n118 Nevertheless, the same acts of an unauthorized user may give rise to both a cause of action for infringement and a cause of action for dilution by tarnishment or blurring. n119

Dilution by blurring is the most commonly envisioned means by which the non-infringing use of one's trademark by others can diminish the value of the mark. The use of a mark on another's goods or services, unrelated to the goods or services provided under the original mark, will reduce the unique and distinctive significance of the mark in question to identify and distinguish a single source of goods and services, even without any confusion as to source identity, sponsorship or affiliation. n120

Dilution by tarnishment, by contrast, is the whittling away of the value of a trademark when an unauthorized party has used the mark in a degrading or unwholesome way. n121 The unauthorized use of famous trademarks in sexual contexts is most often cast as dilution by tarnishment. The First Circuit has explained:

[*454] A trademark is tarnished when consumer capacity to associate it with the appropriate products or services has been diminished. The threat of tarnishment arises when the goodwill and reputation of a plaintiff's trademark is linked to products which are of shoddy quality or which conjure associations that clash with the associations generated by the owner's lawful use of the mark n122

In the case of sexual parody or sexually charged use of a trademark, it is the "associations that clash" with those created by the famous mark that most often concern the mark's owner, though the quality of goods and services may be at issue, as well.

1. State Anti-Dilution Laws

Though most of the reported cases based on trademark dilution by tarnishment have been tried in the federal courts, the overwhelming majority of these cases are based on state law. The federal anti-dilution statute was not enacted until 1996, and prior to 1996 the Lanham Act itself did not contain any provision for protection against dilution. Though a few states have recognized a common law action for trademark dilution, Illinois and Ohio among them, most states recognizing trademark dilution actions have done so by statute. n123 *The Restatement of Unfair Competition* suggests that dilution is only actionable under statute. n124 By 1994, twenty-six states had adopted anti-dilution statutes modeled after the 1964 United States Trademark Association ("USTA") Model State Trademark Bill. n125 New York's statute is one example:

Likelihood of injury to business reputation or of dilution of the distinctive quality of a mark or trade name shall be a ground for injunctive relief in cases of infringement of a mark registered or not registered or in cases of unfair competition, notwithstanding the absence of competition between the parties or the absence of confusion as to the source of goods or services. n126

The 1992 version of the Model State Trademark Bill addressed the issue of dilution even more specifically. n127

[*455] Once established by state legislation, further development of the law of dilution was left to the courts. Courts have not always been favorable to plaintiffs seeking injunctive or other relief for claims of dilution by tarnishment. For example, in one early case of potentially offensive, sexual use of another's trademark, *Girl Scouts of America v. Personality Posters Mfg. Co.*,¹²⁸ the plaintiff was denied protection under New York State's anti-dilution law by the district court.¹²⁹ The *Girl Scouts* court held that a showing of confusion between the marks was

[*456] required to obtain relief, despite statutory language plainly rejecting the requirement of such confusion. n130 However, courts gradually warmed to the concept of dilution and provided the protection intended by statute. Early cases sought to protect famous marks from dilution by relaxing the meaning of "confusion" even when it seemed unlikely that any consumer would actually confuse the two products or their sources. n131 This court-created requirement of a likelihood of confusion in dilution cases has since been discarded by most courts. n132

Despite some courts' early departure from the statutory language and their inclusion of likelihood of confusion as an element of dilution, courts have been reasonably consistent in defining the other elements of trademark dilution. Two elements of trademark dilution required under most states' anti-dilution statutes are 1) that the mark allegedly being diluted is strong and distinctive in the mind of the public and 2) that there is a likelihood of dilution of the mark's distinctive character through the unauthorized use. n133 A third element, the presence of predatory intent by

[*457] the unauthorized user, is also considered by some courts as a relevant factor.
n134

The strength and distinctiveness of a mark must be established for one to make a successful claim of trademark dilution under most state anti-dilution statutes. The courts addressing the issue of trademark strength have done so by equating the analysis of strength under dilution claims with that required by the Lanham Act: "The strength of a mark essentially reflects its distinctiveness . . . its tendency to identify the goods sold under the mark as emanating from a particular, although possibly anonymous, source."
n135

In *Dallas Cowboys Cheerleaders, Inc. v. Pussycat Cinema, Ltd.*, n136 the Second Circuit did not address distinctiveness per se, but referred only to "trademarkability" as being sufficient to satisfy the first element of dilution. n137 In addition to the distinctiveness requirement, the mark must not have already become diluted or weakened in the marketplace prior to the instant case. n138 KODAK, n139 ENJOY COCA-COLA, n140 TARZAN and related characters and depictions, n141 and DALLAS COWBOYS CHEERLEADERS and the Dallas Cowboys Cheerleaders' distinctive uniforms n142 all are examples of marks found strong enough by the courts to warrant protection from dilution.

Once the strength or distinctiveness of the mark has been established, the plaintiff must prove a likelihood of dilution of his mark by the unauthorized user to state a claim upon which relief may be granted. Courts have admitted that analyzing this "likelihood" requires a look into the future and not merely an analysis of past events. n143 To prevail, the

[*458] plaintiff must establish that the unauthorized use will whittle away the identity or reputation of the mark, reduce its distinctiveness or otherwise diminish its value. n144

Courts have found the placement of strong marks, typically associated with mainstream consumer goods or services of a high quality or stature, in sexually oriented contexts often constitutes dilution by tarnishment. n145 The potential diminishment of a mark's value comes from these unauthorized associations with objectionable or sexual behavior. Unlike the registrability issue of whether a mark is scandalous or immoral, there is no firm test to determine what may or may not be considered sufficient to tarnish a mark's image. The question is merely whether the unauthorized use is likely to reduce the value of the mark; sexually scandalous or immoral use of a mark or its facsimile is only one means by which this may occur.

For an unauthorized use of a mark or close approximation of a mark to have tarnishing effect, the unauthorized mark must be similar to the original mark. In tarnishment cases, similarity of the two marks is rarely at issue and, consequently, a legal standard for measuring similarity has not been widely promulgated. In *Coca-Cola Co. v. Gemini Rising, Inc.*, n146 for example, the defendant was not using the identical slogan to that of the plaintiff's ENJOY COCA-COLA. The court found that although the defendant had "not used plaintiff's trademark precisely . . . on the facts it is altogether clear that [defendant] here exactly and successfully trespassed on just that area of unmistakable identifications of the word ['Coca-Cola'] with plaintiff that did exist." n147 Thus, a misappropriation sufficiently evoking the original mark that lessens the original mark's value will typically satisfy the similarity requirement for dilution.

Predatory intent typically is not required for a finding of dilution under most state anti-dilution statutes. The presence of predatory intent on the part of the unauthorized user serves to bolster the claim of a plaintiff alleging dilution. n148 Predatory intent will be found when the

[*459] unauthorized user is shown to have intended to take advantage of the recognizable nature of plaintiff's marks for commercial gain. n149

2. Federal Anti-Dilution Law

In 1996, the Federal Trademark Dilution Act of 1995 n150 was signed into law. The federal statute added § 43(c) to the Lanham Act. Section 43(c) states, in pertinent part:

(1) The owner of a famous mark shall be entitled, subject to 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, and to obtain such other relief as is provided in this subsection

(2) In an action brought under this subsection, the owner of the famous mark shall be entitled only to injunctive relief unless the person against whom the injunction is sought willfully intended to trade on the owner's reputation or to cause dilution of the famous mark

(3) The ownership by a person of a valid registration . . . shall be a complete bar to an action against that person, with respect to that mark, that is brought by another person under the common law or a statute of a State and that seeks to prevent dilution of the distinctiveness of a mark, label, or form of advertisement.

(4) The following shall not be actionable under this section:

(A) Fair use of a famous mark by another person in comparative commercial advertising or promotion to identify the competing goods or services of the owner of the famous mark.

(B) Noncommercial use of a mark.

(C) All forms of news reporting and news commentary. n151

"Dilution" is defined by the federal statute as:

the lessening of the capacity of a famous mark to identify and distinguish goods or services, regardless of the presence or absence of-

[*460] (1) competition between the owner of the famous mark and other parties, or
(2) likelihood of confusion, mistake, or deception. n152

There are relatively few reported cases analyzing the federal antidilution statute. The reported cases illustrate a degree of subjectivity similar to that found in decisions under state anti-dilution laws. One federal case even analyzed state and federal claims of dilution in identical fashion, using a single discussion of the elements in deciding the issue. n153

The Ninth Circuit has interpreted the statute as requiring the following four elements for dilution: 1) the mark must be famous; 2) the defendant must be using the mark for commercial gain; 3) the unauthorized use must have begun after the mark became famous; and 4) the defendant's use must dilute the mark's quality by diminishing its capacity to identify and distinguish goods and services. n154 In one of the few cases decided under the federal statute concerning the dilution of a trademark by use in a sexual context, the court did not analyze the facts element by element. n155 Rather, the court considered whether the mark was distinctive and famous, and whether the unauthorized use tarnished the mark. n156

Professor McCarthy has stated that the federal statute requires the following elements for a prima facie case of dilution:

1. The plaintiff is the owner of a mark which qualifies as a "famous" mark as measured by the totality of the eight factors listed in § 43(c)(1),
2. The defendant is making commercial use,
3. In interstate commerce,
4. Of a mark or trade name,
5. And defendant's use began after the plaintiff's mark became famous,

[*461] 6. And defendant's use causes dilution by lessening the capacity of the plaintiff's mark to identify and distinguish goods or services. n157

a) "Famous" Mark

The federal anti-dilution statute suggests that, in determining whether a mark is famous, courts should consider at least eight factors:

[1] the degree of inherent or acquired distinctiveness of the mark;

[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 geographical extent of the trading area in which the mark is used;

[4] the duration and extent of advertising and publicity of the mark;

[5] the channels of trade for the goods or services with which the mark is used;

[6] the degree of recognition of the mark in the trading areas and channels of trade used by the marks' owner and the person against whom the injunction is sought;

[7] the nature and extent of use of the same or similar marks by third parties; and

[8] whether the mark was registered under the Act of March 3, 1881, or the Act of February 20, 1905, or on the principal register. n158

Consideration of these factors is a subjective task that is well illustrated in *Toys "R" Us Inc. v. Akkaoui*. n159 In *Toys "R" Us*, the court considered the plaintiff's long history of continuous use of the mark, widespread local and national advertising using the mark, the peculiarity inherent in the mark, the registration of the mark and many similar or related marks, and the history of litigation by the plaintiff to protect the mark as evidence of its famous nature under the statute. n160

[*462] In a federal dilution case, a court must determine whether the plaintiff's mark acquired fame prior to the unauthorized use. n161 The determination requires the court to answer two questions: 1) when did the defendant first make unauthorized use of the mark? and 2) when did the plaintiff's mark become famous? n162 Although the law concerning the "famous mark" element of trademark dilution under federal law is still developing, none of the reported cases involving dilution by sexual references has involved a senior mark of questionable fame. In these cases, the issue has either been uncontested, or the fame of the mark has been so obvious that the issue has not required in-depth analysis. n163

b) Commercial Use

The commercial use requirement, explicitly required by the Ninth Circuit in *Panavision* and implicit in most analyses of trademark dilution, is typically satisfied if the defendant has used the mark for the purposes of selling goods or services. n164 However, courts addressing the issue of dilution of famous marks in the context of Internet Web sites have had little difficulty finding that such use satisfies the commercial use requirement. n165 The use of the mark for the selling of goods or services or for other direct, commercial gain is sufficient for purposes of the trademark dilution analysis.

c) Likelihood of Dilution

Finally, the likelihood of dilution of the quality or distinctiveness of the mark itself must be addressed by the court. Under the federal statute, dilution is defined as the lessening of the mark's capacity to

[*463] identify and distinguish goods or services, regardless of whether there is competition or confusion between the two uses. n166 Courts have been faithful to the federal statutory language and have not shown the propensity for creative interpretation demonstrated in the past by courts interpreting state anti-dilution statutes. n167 Courts interpreting the federal statute have recognized Congress' intent in defining dilution to "protect famous marks from subsequent uses that blur the distinctiveness of the mark or tarnish or disparage it." n168

3. Use of Trademarks in Noncommercial Parody

Neither state nor federal anti-dilution laws protect the owner of a famous mark from use by another in off-color or profane parody, as long as the parody is not primarily created for commercial gain. n169 The use of trademarks in parody or other noncommercial contexts is governed by the constitutional right of free speech. n170 As stated by the First Circuit in *L.L. Bean, Inc. v. Drake Publishers, Inc.*: n171 "It offends the Constitution . . . to invoke the [Maine] anti-dilution statute as a basis for enjoining the noncommercial use of a trademark by a defendant engaged in a protected form of expression" n172 The *L.L. Bean* court further stated that "trademark parodies, even when offensive, do convey a message," and are a protected form of speech. n173

Thus, while commercial uses of famous marks in sexual contexts may be proscribed as dilution by tarnishment, courts are willing to protect the unauthorized uses of famous marks in parody or other forms of protected, noncommercial speech, regardless of the distastefulness of the context.

[*464] B. Case Development of Trademark Tarnishment Involving Sexual References

Cases brought under anti-dilution statutes first appeared in the 1960s, and those in which the defendants used the plaintiffs' marks in allegedly degrading or damaging sexual contexts began to proliferate in the 1970s. Although the standards for judging trademark dilution have not so clearly followed the evolution of social mores as seen in the area of trademark registrability, the scandalous uses to which popular trademarks have been put by unauthorized users do reflect America's increasingly liberal sexual mores.

1. *Girl Scouts of America v. Personality Posters Manufacturing Co.*

An early case involving the unauthorized use of a trademark in a sexually related context was *Girl Scouts of America v. Personality Posters Manufacturing Co.* n174 In *Girl Scouts*, the defendant had produced and distributed a poster depicting an obviously pregnant girl dressed in a Girl Scout uniform. The image was accompanied by the motto "Be Prepared." n175

The poster's imagery clearly implied that the Girl Scout had engaged in irresponsible or unprotected sex, contrary to the tenets of the Girl Scouts organization. Though a far cry from the later uses of other trademarks in graphic sexual depictions, this poster did raise the issue of whether the Girl Scouts' image was tarnished by being placed in such a context. The Girl Scouts of America brought suit against the poster producer under Section 43(a) of the Lanham Act and under New York's anti-dilution statute. n176 The *Girl Scouts* court required a showing of a likelihood of consumer confusion between the Girl Scouts' mark and that depicted in the poster. n177 The court could find none in the record. n178 The court likewise held that there was no dilution under New York law. n179

[*465] 2. *Edgar Rice Burroughs, Inc. v. Manns Theatres*

In *Edgar Rice Burroughs, Inc. v. Manns Theatres*, n180 the owner of the trademark rights in the Tarzan characters took issue with the use of take-offs of those characters in an X-rated film entitled *Tarz & Jane & Boy & Cheetah*, in which the characters were shown engaging in a variety of graphic sexual acts. The plaintiff based its cause of action on dilution and copyright infringement. n181 In *Burroughs*, the court required the plaintiff to show a likelihood of confusion in ascertaining whether this unauthorized use of the characters constituted trademark dilution. n182 The court held that a likelihood of confusion existed and enjoined the defendant from using the trademarked characters and title. n183 *Burroughs* represents one of the first of many sexually charged misappropriations of popular trademarks seen by the courts.

3. *General Electric Co. v. Alumpa Coal Co.*

A less conventional use of General Electric's ("GE") trademarked name and distinctive monogram was developed by Alumpa Coal Co., which sold t-shirts and underwear emblazoned with GENITAL ELECTRIC in GE's well-known script. n184 In *General Electric Co. v. Alumpa Coal Co.*, n185 GE sought an injunction against Alumpa Coal based on trademark infringement and Massachusetts' anti-dilution statute. GE asserted that the defendant's unauthorized, off-color facsimile of GE's famous mark was both an infringing and a tarnishing use. n186 The court held in favor of GE and enjoined such use by Alumpa Coal. n187 The court held that because of the overwhelming similarity of the two marks and the "great probability of confusion" between the marks, injunctive relief was warranted, even though the parties' respective products were not in competition. n188

[*466] 4. *Dallas Cowboys Cheerleaders, Inc. v. Pussycat Cinema, Ltd.*

One of the most widely cited tarnishment cases concerned a pornographic film, the infamous *Debbie Does Dallas*, and the Dallas Cowboys Cheerleaders. In *Dallas Cowboys Cheerleaders, Inc. v. Pussycat Cinema Ltd.*,¹⁸⁹ the defendant had produced a film and promotional posters featuring women clad in scanty simulations of the distinctive Dallas Cowboys Cheerleaders uniform and engaging in various sex acts.¹⁹⁰ The court held that the use of this widely recognized symbol in such a sexually charged manner would impugn and injure the Cheerleaders' reputation.¹⁹¹ The court was unpersuaded by Pussycat Cinema's claims that the movie contained constitutionally protected parody and social commentary, and affirmed the lower court's decision to issue an injunction.¹⁹²

5. *Pillsbury Co. v. Milky Way Productions, Inc.*

The Pillsbury Doughboy, a.k.a Poppin' Fresh, was granted similar protection from unauthorized, sexually oriented use by a federal district court in *Pillsbury Co. v. Milky Way Productions, Inc.*¹⁹³ In 1977, a cartoon in *Screw* magazine depicted the pudgy character involved in sexual intercourse and fellatio, accompanied by the text of the "Pillsbury Baking Song."¹⁹⁴ Pillsbury sought an injunction against the publisher based on Georgia's anti-dilution statute.¹⁹⁵ The *Pillsbury* court held that the defendant publisher's use would impair the Pillsbury trademark's reputation and lower its value, and that Pillsbury was entitled to injunctive relief.¹⁹⁶ A review of the case suggests either that the defendant failed to invoke the constitutional defense of noncommercial parody or expression, or that the court failed to so limit dilution protection under

[*467] the Georgia statute. n197 In any event, Pillsbury successfully kept Poppin' Fresh out of the bedroom and confined to America's kitchens.

6. *Community Federal Savings & Loan Ass'n v. Orondorff*

Baked goods seem to provide especially fertile ground for placing trademarks in sexual contexts. In *Community Federal Savings & Loan Ass'n v. Orondorff*, n198 a topless bar in Florida began using the name COOKIE JAR in conjunction with a cookie jar logo on t-shirts, match-books and billboards. n199 A local savings and loan had been using a similar design and identical COOKIE JAR moniker, registered prior to the defendant's use, on its automatic teller machines, one of which was located at its main branch across the street from one of the defendant's billboards. n200 The savings and loan filed suit against the topless bar, seeking injunctive relief under Florida's anti-dilution statute. n201 The *Community Federal* court held that the adult entertainment club's use of the mark was likely to whittle away the reputation established by the bank's unique mark, despite the fact that they represented such disparate services. n202 The court therefore reversed a lower court holding denying the bank injunctive relief. n203 Even though the unauthorized use itself was not overtly sexual in nature, the mere association of adult entertainment with the savings and loan's mark was enough in the eyes of the court to tarnish the bank's mark. n204

[*468] 7. *L.L. Bean, Inc. v. Drake Publishers, Inc.*

The publishers of *High Society* magazine found freedom where *Screw* magazine could not. In *L.L. Bean, Inc. v. Drake Publishers, Inc.*,ⁿ²⁰⁵ L.L. Bean sued the adult magazine publisher based on a fictionalized advertisement appearing in the October, 1984 issue of *High Society*.ⁿ²⁰⁶ The sham advertisement sought to parody the L.L. Bean mail-order catalog in the form of the "L.L. Bean Back-to-School Sex Catalog," ostensibly advertising sexual products using nude models in sexually explicit positions.ⁿ²⁰⁷ This advertisement, labeled "humor" and "parody,"ⁿ²⁰⁸ occupied only two of the more than 100 pages in that issue of the magazine, and no products were actually offered for sale.ⁿ²⁰⁹ The First Circuit held that Maine's anti-dilution statute did not proscribe noncommercial use of a mark for parody, humor or any other constitutionally protected form of expression.ⁿ²¹⁰ The *L.L. Bean* court reversed a lower court's decision enjoining publication of the "catalog."ⁿ²¹¹ Unlike the court in *Pillsbury*, the First Circuit recognized that even offensive trademark parodies convey a message.ⁿ²¹² It stated: "Denying parodists the opportunity to poke fun at symbols and names which have become woven into the fabric of our daily life, would constitute a serious curtailment of a protected form of expression."ⁿ²¹³ Thus, the appearance of the parody in an item that is sold (*e.g.*, a magazine) does not render the use commercial; the use itself must be more directly connected with the buying and selling of goods or services.

[*469] 8. *American Express Co. v. Vibra Approved Laboratories Corp.*

In 1989, a wily entrepreneur attempted to use the fame of another American institution to promote a cleverly packaged condom. In *American Express Co. v. Vibra Approved Laboratories Corp.*,²¹⁴ the defendant had marketed a product called the AMERICA EXPRESS card, emblazoned with a color scheme and design similar to that of the world-renowned AMERICAN EXPRESS card, to which was attached a condom and the slogan "NEVER LEAVE HOME WITHOUT IT."²¹⁵ American Express sued Vibra, alleging that the condom card tarnished American Express' famous mark, in violation of New York's anti-dilution statute. The court held for American Express and enjoined the novelty company from selling or distributing its products.²¹⁶ The court recognized the strength of American Express' mark, the fact that the defendant clearly had tried to capitalize in a predatory fashion on the recognition of the plaintiff's mark, and the likelihood of damage to the mark's strength and positive associations.²¹⁷ The court held that the sale of the AMERICA EXPRESS condom cards violated the state anti-dilution statute, and explicitly rejected, as inapplicable, its own, earlier holding in the *Girl Scouts* case.²¹⁸ Even without any graphic sexual representations, pictures or other references beyond the product's association with sexual activity, the court found American Express' mark sufficiently besmirched by such a product to prevent its distribution and sale.²¹⁹ The court observed that Vibra's product could not "be shrugged off as a mere bawdy jest."²²⁰

9. *Hasbro Inc. v. Internet Entertainment Group Ltd.*

Recently, the Internet has exposed trademarks to a whole new medium for potential dilution. In one of the first cases decided under the federal anti-dilution statute, *Hasbro Inc. v. Internet Entertainment Group*

[*470] *Ltd.*, n221 Hasbro sought to enjoin the use of "candyland.com" as a domain name for a sexually explicit Web site. n222 Hasbro alleged that such use tarnished its well-known CANDYLAND trademark, which Hasbro used for a children's game. With minimal analysis, the *Hasbro* court found that the defendant's use would cause irreparable harm to Hasbro's trademark and enjoined Internet Entertainment Group from using the domain name. n223 "Candyland.com" is now the Internet address for the child-friendly world of Hasbro games and toys.

10. Toys "R" Us Inc. v. Akkaoui

Toys "R" Us experienced similar problems with the developer of an adult-oriented Web site. In *Toys "R" Us Inc. v. Akkaoui*, n224 the well-known toy store chain sought to enjoin the use of "adultsrus.com" for a Web site marketing adult sexual devices and clothing. n225 Toys "R" Us alleged that the defendant's use of the "adultsrus.com" domain name tarnished the "R US" portion of the toy retailer's mark, distinctive to TOYS "R" US, KIDS "R" US and the company's other "R US" marks, in violation of the newly enacted federal anti-dilution statute. n226 Toys "R" Us asserted that such use created a degrading association with the retailer's mark. n227 The court agreed with Toys "R" Us: "'Adults R Us' tarnishes the 'R Us' family of marks by associating them with a line of sexual products that are inconsistent with the image Toys 'R' Us has striven to maintain for itself." n228 The *Toys "R" Us* court found that dilution did not require the blatant hijacking of a domain name, as occurred with "candyland.com," but that unauthorized use of a distinctive portion of mark, in a diluting fashion, was sufficient to enjoin the unauthorized use. n229

[*471] IV. CONCLUSION: COVER STORIES AND NONCOMMERCIAL USES

Society's increasing sexual permissiveness and the open discussion of sex in contemporary America has caused the PTO, the TTAB and the courts to allow an increasingly broader range of sexually oriented marks to be registered. Barring the most obvious forms of vulgarity or graphic imagery, the PTO appears willing to register crude, sexually oriented or suggestive marks, as long as there is some "clean" association or symbol to defuse the scandalous alternative. Roosters, owls and individuals with unfortunate names may become the crude applicant's best friend.

By contrast, courts thus far have refused to allow the liberalization of society's mores to translate into greater permissiveness in the dilution context. The courts have remained steadfast in protecting famous marks from unauthorized, commercial uses in sexual contexts. The continuing development of state anti-dilution law and the enactment of the federal anti-dilution statute in 1996 have increased the protection afforded famous mark holders and restricted sexually charged, commercial uses of famous marks. In dilution cases, the only sign of society's sexual liberalization appears to lie in the extremity of the defendants' actions; courts have not similarly liberalized the standards for tarnishment. Nevertheless, sexually oriented trademarks and trademark uses appear likely to be a more frequent issue for trademark practitioners.

n1 *15 U.S.C. § 1052(a)* (1994).

n2 *MANUAL OF TRADEMARK EXAMINING PROCEDURE § 1203.01* (1997).

n3 *95 F.2d 327, 37 U.S.P.Q. (BNA) 268 (C.C.P.A. 1938)*.

n4 *Id. at 328, 37 U.S.P.Q. at 269* (interpreting predecessor statute to Lanham Act by quoting *FUNK & WAGNALLS NEW STANDARD DICTIONARY* and *WEBSTER'S NEW INTERNATIONAL DICTIONARY* (1932)).

n5 *See, e.g., Ex Parte Parfum L'Orle, Inc., 93 U.S.P.Q. (BNA) 481, 482* (Pat. Off. Exam'r - Chief 1952); *In re P.J. Valckenberg, GmbH, 122 U.S.P.Q. (BNA) 334, 334* (Trademark Tr. & App. Bd. 1959); *In re Runsdorf, 171 U.S.P.Q. (BNA) 443, 443* (Trademark Tr. & App. Bd. 1971); *In re Mavety Media Group Ltd., 33 F.3d 1367, 1371, 31 U.S.P.Q.2d (BNA) 1923, 1925 (Fed. Cir. 1994)*.

n6 *Bromberg v. Carmel Self Serv., Inc., 198 U.S.P.Q. (BNA) 176, 178* (Trademark Tr. & App. Bd. 1978) (quoting *WEBSTER'S NEW COLLEGIATE DICTIONARY* (2d ed.)).

n7 *660 F.2d 481, 211 U.S.P.Q. (BNA) 668 (C.C.P.A. 1981)*.

n8 *Id. at 485, 211 U.S.P.Q. at 673* (quoting *Riverbank Canning, 95 F.2d at 328, 37 U.S.P.Q. at 269*).

n9 *See Mavety Media, 33 F.3d at 1371, 31 U.S.P.Q.2d at 1925*.

n10 *McGinley, 660 F.2d at 484, 211 U.S.P.Q. at 672*. The *McGinley* court stated: "Because of our holding, *infra*, that appellant's mark is 'scandalous,' it is unnecessary to consider whether appellant's mark is 'immoral.' We note the dearth of reported trademark decisions in which the term 'immoral' has been directly applied." *Id. at 484 n.6, 211 U.S.P.Q. at 672 n.6*.

n11 *Id. at 484, 211 U.S.P.Q. at 672* (deciding the case solely on "scandalous" definition, while referring to statute's prohibition of "immoral" or "scandalous" marks); *In re Madsen, 180 U.S.P.Q. (BNA) 334, 335* (Trademark Tr. & App. Bd. 1973) (TTAB considered registrability on "immoral" or "scandalous" grounds, holding that WEEK-END SEX was neither scandalous nor immoral as magazine title).

n12 *Madsen, 180 U.S.P.Q. at 335; McGinley, 660 F.2d at 485, 211 U.S.P.Q. at 673; In re Thomas Labs., Inc., 189 U.S.P.Q. (BNA) 50, 51* (Trademark Tr. & App. Bd. 1975).

n13 *McGinley, 660 F.2d at 485, 211 U.S.P.Q. at 673* ("The Lanham Act does not require . . . any inquiry into the specific goods or services not shown in the application itself."); *Madsen, 180 U.S.P.Q. at 335* ("The question of whether or not the contents of the magazine may be pornographic in nature, is not an issue to be decided by this Board.").

n14 *Thomas Labs., 189 U.S.P.Q. at 52.*

n15 *6 U.S.P.Q.2d (BNA) 1470* (Trademark Tr. & App. Bd. 1988).

n16 *Id. at 1472.*

n17 *Id.*

n18 *Id. at 1471* (quoting *McGinley, 660 F.2d at 485, 211 U.S.P.Q. at 673*); *see also In re Mavety Media Group Ltd., 33 F.3d 1376, 1371, 31 U.S.P.Q.2d (BNA) 1923, 1925 (Fed. Cir. 1994)* (TTAB's refusal to register BLACK TAIL for pornographic magazine vacated and remanded for further proceedings).

n19 *189 U.S.P.Q. (BNA) 50* (Trademark Tr. & App. Bd. 1975).

n20 *Id. at 52* (logo design consisting of cartoon depiction of man peering forlornly at unseen genitals held not to be scandalous trademark for penis enlargement device).

n21 *26 U.S.P.Q.2d (BNA) 1216* (Trademark Tr. & App. Bd. 1993).

n22 *Id. at 1219* (Old Glory Condom Corporation trademark including depiction of condom emblazoned with American flag held not scandalous).

n23 *See, e.g., In re Riverbank Canning Co., 95 F.2d 327, 328-29, 37 U.S.P.Q. (BNA) 268, 269-70 (C.C.P.A. 1938)* (denying registration of MADONNA as mark for wines based on prevailing moral attitudes immediately following repeal of Prohibition that drinking could be considered an evil, and that United States was not a "wine drinking country").

n24 *See In re McGinley, 660 F.2d 481, 485, 211 U.S.P.Q. (BNA) 668, 673 (C.C.P.A. 1981); Old Glory, 26 U.S.P.Q.2d at 1218; In re Mavety Media Group Ltd., 33 F.3d 1367, 1371, 31 U.S.P.Q.2d (BNA) 1923, 1926 (Fed. Cir. 1994).*

n25 *McGinley, 660 F.2d at 485, 211 U.S.P.Q. at 673.*

n26 *In re Reemtsma Cigarettenfabriken GmbH, 122 U.S.P.Q. (BNA) 339, 339* (Trademark Tr. & App. Bd. 1959).

n27 *In re Hershey, 6 U.S.P.Q.2d (BNA) 1470, 1472* (Trademark Tr. & App. Bd. 1988) ("Considering the relative paucity of evidence concerning the public's perception of 'pecker' as referring to penis and considering the bird head design . . . reinforcing the

more conventional meaning of the term, we believe the mark neither offends morality nor raises scandal.").

n28 *Old Glory*, 26 U.S.P.Q.2d at 1221.

n29 *Mavety Media*, 33 F.3d at 1371, 31 U.S.P.Q.2d at 1926.

n30 Judge Rich makes this argument in his dissent in *McGinley*, 660 F.2d at 487, 211 U.S.P.Q. at 675.

n31 660 F.2d 481, 211 U.S.P.Q. (BNA) 668 (C.C.P.A. 1981).

n32 *Id.* at 484, 211 U.S.P.Q. at 672 (citations omitted).

n33 "The threshold for objectionable matter is lower for what can be described as 'scandalous' than for 'obscene.'" *Id.* at 485 n.9, 211 U.S.P.Q. at 673 n.9 (rejecting an analogy to obscenity cases).

n34 *Ex parte Martha Maid Mfg. Co.*, 37 U.S.P.Q. (BNA) 156, 156 (Com'r Pats. 1937).

n35 *Id.*

n36 The examiner stated, in the appeal, that "the use of the former Queen's name in the sense used by applicant is 'shocking to the sense of propriety.'" *Id.*

n37 Although the Assistant Commissioner agreed with the examiner's statement, the Assistant Commissioner added his own grounds for refusal:

I have carefully considered the arguments . . . but I am constrained to agree with the examiner's conclusion. Furthermore I am of the opinion, and so hold, that within the meaning of Section 5 of the Trade Mark Act of 1905 the mark as presented "consists merely in the name of an individual" not distinctively displayed, and is unregistrable . . . for this additional reason.

Id.

n38 95 F.2d 327, 37 U.S.P.Q. (BNA) 268 (C.C.P.A. 1938).

n39 *Id.* at 329, 37 U.S.P.Q. at 270.

n40 *Id.*

n41 *Id.* at 328, 37 U.S.P.Q. at 269.

n42 *Id.* at 329, 37 U.S.P.Q. at 270.

n43 *Id.*

n44 *Id.*

n45 *Id.*

n46 93 U.S.P.Q. (BNA) 481 (Pat. Off. Exam'r - Chief 1952).

n47 *Id.*

n48 *Id.* at 482.

n49 *Id.*

n50 *Id.*

n51 A slang term, tamer to many ears than even the relatively innocuous equivalent "booby." *See* WEBSTER'S NINTH NEW COLLEGIATE DICTIONARY (1987).

n52 171 *U.S.P.Q. (BNA)* 443 (Trademark Tr. & App. Bd. 1971).

n53 *Id. at* 443-44.

n54 180 *U.S.P.Q. (BNA)* 334 (Trademark Tr. & App. Bd. 1973).

n55 *Id. at* 335.

n56 *Id.*

n57 *Id.*

n58 *Id.*

n59 189 *U.S.P.Q. (BNA)* 50 (Trademark Tr. & App. Bd. 1975).

n60 *Id. at* 52.

n61 *Id.*

n62 *Id.*

n63 660 *F.2d* 481, 211 *U.S.P.Q. (BNA)* 668 (*C.C.P.A.* 1981).

n64 *Id. at* 482, 211 *U.S.P.Q. at* 670.

n65 *Id. at* 482-83, 211 *U.S.P.Q. at* 670.

n66 *Id.*, 211 *U.S.P.Q. at* 671.

n67 *Id. at* 487, 211 *U.S.P.Q. at* 674.

n68 *Id. at* 482 n.2, 211 *U.S.P.Q. at* 670 n.2.

n69 *Id. at* 486, 211 *U.S.P.Q. at* 674.

n70 *Id. at* 487, 211 *U.S.P.Q. at* 674.

n71 212 *U.S.P.Q. (BNA)* 863 (Trademark Tr. & App. Bd. 1981).

n72 *Id. at* 866.

n73 *Id. at* 864-65.

n74 *Id. at* 866.

n75 *Id.* The Board stated: "The fact that profane words may be uttered more freely does not render them any the less profane. Nor does this fact amend the statute by which we are required to determine the registrability of such matter as marks." *Id.*

n76 6 *U.S.P.Q.2d (BNA)* 1470 (Trademark Tr. & App. Bd. 1988).

n77 *Id. at* 1471.

n78 *Id.*

n79 *Id. at 1472.*

n80 *Id.*

n81 *In re Old Glory Condom Corp.*, 26 *U.S.P.Q.2d (BNA) 1216, 1217* (Trademark Tr. & App. Bd. 1993). The mark in question appeared only on the packaging for the condom; the stars-and-stripes design was not emblazoned on the product contained in the package. *Id.*

n82 *Id. at 1217, 1220.*

n83 *Id. at 1221.*

n84 Each Old Glory package contains the following pledge: "We believe it is patriotic to protect and save lives. We offer only the highest quality condoms. Join us in promoting safer sex. Help eliminate AIDS. A portion of Old Glory profits will be donated to AIDS related services." *Id. at 1217.*

n85 *Id.*

n86 *Id. at 1220.*

n87 *Id.*

n88 *Id.*

n89 33 *F.3d 1367, 31 U.S.P.Q.2d (BNA) 1923 (Fed. Cir. 1994).*

n90 *Id. at 1368-69, 31 U.S.P.Q.2d at 1923.*

n91 *Id. at 1369, 31 U.S.P.Q.2d at 1924.*

n92 *Id. at 1370, 31 U.S.P.Q.2d at 1925.*

n93 *Id. at 1375, 31 U.S.P.Q.2d at 1929.*

n94 *Id. at 1373, 31 U.S.P.Q.2d at 1928.*

n95 *Id.*

n96 *Id. at 1374, 31 U.S.P.Q.2d at 1928.*

n97 *Id. at 1371, 31 U.S.P.Q.2d at 1926.*

n98 *Id.*, 31 *U.S.P.Q.2d at 1925.*

n99 *Id. at 1373, 31 U.S.P.Q.2d at 1926.*

n100 *Id. at 1374, 31 U.S.P.Q.2d at 1928.*

n101 As one commentator noted, rather pointedly: "Why 'Black Buttocks' is a nonvulgar magazine title, one can only speculate." Jendi B. Reiter, *Redskins and Scarlet Letters: Why "Immoral" and "Scandalous" Trademarks Should Be Federally Registerable*, 6 *FED. CIRCUIT B.J.* 191, 194 (1996).

n102 40 *U.S.P.Q.2d (BNA) 1929* (Trademark Tr. & App. Bd. 1996).

n103 *Id. at 1930.*

n104 *Id. at 1933.*

n105 *Id. at 1934.*

n106 *Id.* The applicant had submitted, as specimens with the application, photocopies of bumper stickers bearing the logo design and the phrase "Give Me Head . . . 'Til I'm Dead." *Id. at 1932.*

n107 *Id. at 1933.*

n108 U.S. Reg. No. 1,492,301.

n109 U.S. Reg. No. 1,864,778.

n110 U.S. Reg. No. 1,738,434.

n111 3 J. THOMAS McCARTHY, McCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 24:67, at 24-115 (rel. no. 8, Dec. 1998).

n112 *Id.*

n113 *Id.*, § § 24:68-69, at 24-115 to 24-116 (rel. no. 8, Dec. 1998).

n114 Pub. L. No. 104-98, 109 Stat. 985.

n115 15 U.S.C. § 1127 (Supp. I 1995).

n116 *L.L. Bean, Inc. v. Drake Publishers, Inc.*, 811 F.2d 26, 31, 1 U.S.P.Q.2d (BNA) 1753, 1757 (1st Cir. 1987).

n117 *See* 3 McCARTHY, *supra* note 111, § 24:70, at 24-117 (rel. no. 8, Dec. 1998).

n118 *Id.*

n119 *Id.*

n120 *Id.* § 24:68, at 24-225 (rel. no. 8, Dec. 1998). Professor McCarthy uses the following examples of "blurring" marks: Dupont shoes, Buick aspirin, Kodak pianos, Tiffany as a restaurant in Boston. *Id.* (paraphrasing *Sally Gee, Inc. v. Myra Hogan, Inc.*, 699 F.2d 621 (2d Cir. 1983)). The use of such marks would reduce the unique and distinctive value of the marks for their more widely known and highly respected uses.

n121 3 McCARTHY, *supra* note 111, § 24:104, at 24-189 (rel. no. 8, Dec. 1998).

n122 *L.L. Bean*, 811 F.2d at 31, 1 U.S.P.Q.2d at 1757.

n123 3 McCARTHY, *supra* note 111, § 24:78, at 24-129 (rel. no. 4, Dec. 1997).

n124 RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 25(1) (1995); 3 McCARTHY, *supra* note 111, § 24:78, at 24-129 (rel. no. 4, Dec. 1997).

n125 3 McCARTHY, *supra* note 111, § 24:80, at 24-129 (rel. no. 4, Dec. 1997).

n126 N.Y. GEN. BUS. LAW § 368-d (McKinney 1972).

n127 Relevant provisions of the Model State Trademark Bill include the following:

§ 1(K). The term "dilution" as used herein means the lessening of the capacity of a mark to identify and distinguish goods or services, regardless of the presence or absence of (a) competition between the parties, or (b) likelihood of confusion, mistake or deception.

§ 13. The owner of a mark which is famous in this state shall be entitled, subject to the principles of equity, to an injunction against another's use of a mark, commencing after the owner's mark becomes famous, which causes dilution of the distinctive quality of the owner's mark, and to obtain such other relief as is provided in this section. In determining whether a mark is famous, a court may consider factors such as, but not limited to:

- (A) the degree of inherent or acquired distinctiveness of the mark in this state;
- (B) the duration and extent of use of the mark in connection with the goods and services;
- (C) the duration and extent of advertising and publicity of the mark in this state;
- (D) the geographical extent of the trading area in which the mark is used;
- (E) the channels of trade for the goods or services with which the mark is used;
- (F) the degree of recognition of the mark in its and in the other's trading areas and channels of trade in this state; and
- (G) the nature and extent of use of the same or similar mark by third parties.

The owner of a famous mark shall be entitled only to injunctive relief in this state in an action brought under this section, unless the subsequent user willfully intended to trade on the owner's reputation or to cause dilution of the owner's mark. If such willful intent is proven, the owner shall also be entitled to the remedies set forth in this chapter, subject to the discretion of the court and the principles of equity.

3 McCARTHY, *supra* note 111, § 24:81, at 24-130 (rel. no. 4, Dec. 1997) (quoting 1992 USTA Model State Trademark Bill).

n128 *304 F. Supp. 1228, 163 U.S.P.Q. (BNA) 505 (S.D.N.Y. 1969)*.

n129 *Id. at 1234, 1236, 163 U.S.P.Q. at 509, 510* (refusing to issue injunction preventing defendant from marketing poster of pregnant Girl Scout with motto "Be Prepared").

n130 *Id. at 1233-34, 163 U.S.P.Q. at 508*.

n131 *See, e.g., Coca-Cola Co. v. Gemini Rising, Inc., 346 F. Supp. 1183, 1190-92, 175 U.S.P.Q. (BNA) 56, 60-62 (E.D.N.Y. 1972)* (issuing preliminary injunction against seller of "Enjoy Cocaine" posters incorporating Coca-Cola's trademarked script style); *Edgar Rice Burroughs, Inc. v. Manns Theatres, 195 U.S.P.Q. (BNA) 159, 161-62 (C.D. Cal. 1976)* (finding that use of Tarz, Jane, and other characters very similar to trademarked Tarzan film characters in pornographic films would confuse consumers and create negative image for mark holder); *Dallas Cowboys Cheerleaders, Inc. v. Pussycat Cinema, Ltd., 604 F.2d 200, 205, 203 U.S.P.Q. (BNA) 161, 164 (2d Cir. 1979)* (finding public's belief that mark's owner sponsored or approved use of mark satisfied confusion requirement).

n132 *See, e.g., Pillsbury Co. v. Milky Way Prods., Inc., 215 U.S.P.Q. (BNA) 124, 135 (N.D. Ga. 1981)* (not requiring a showing of likelihood of confusion between plaintiff's

trademark and defendant's unauthorized use of Pillsbury Doughboy shown engaging in sexual intercourse); *American Express Co. v. Vibra Approved Labs. Corp.*, 10 U.S.P.Q.2d (BNA) 2006, 2012 (S.D.N.Y. 1989) (not requiring proof of likelihood of confusion between authorized and unauthorized use in use of AMERICA EXPRESS and NEVER LEAVE HOME WITHOUT IT on "condom card" with design similar to American Express' card); *Community Fed. Sav. & Loan Ass'n v. Orondorff*, 678 F.2d 1034, 1036, 215 U.S.P.Q. (BNA) 26, 27 (11th Cir. 1982) (rejecting lower court's use of confusion in analysis of trademark dilution case in which topless bar used COOKIE JAR name and picture similar to that used by plaintiff's ATMs, one of which was located across the street from topless establishment).

n133 *See Dallas Cowboys Cheerleaders*, 604 F.2d at 203-06, 203 U.S.P.Q. at 162-65; *Coca-Cola*, 346 F. Supp. at 1188-89, 175 U.S.P.Q. at 58-59; *Pillsbury*, 215 U.S.P.Q. at 135; *Community Federal*, 678 F.2d at 1036-37, 215 U.S.P.Q. at 27-28; *American Express*, 10 U.S.P.Q.2d at 2012-13.

n134 *American Express*, 10 U.S.P.Q.2d at 2012-13.

n135 *Id.* at 2012 (quoting *Sally Gee, Inc. v. Myra Hogan, Inc.*, 699 F.2d 621, 625 (2d Cir. 1983)).

n136 604 F.2d 200, 203 U.S.P.Q. (BNA) 161 (2d Cir. 1979).

n137 *Id.* at 204, 203 U.S.P.Q. at 163-64.

n138 *Community Federal*, 678 F.2d at 1036, 215 U.S.P.Q. at 27.

n139 *Eastman Kodak Co. v. Rakow*, 739 F. Supp. 116, 117, 15 U.S.P.Q.2d (BNA) 1631, 1632 (W.D.N.Y. 1989).

n140 *Coca-Cola Co. v. Gemini Rising, Inc.*, 346 F. Supp. 1183, 1188, 175 U.S.P.Q. (BNA) 56, 58 (E.D.N.Y. 1972).

n141 *Edgar Rice Burroughs, Inc. v. Manns Theatres*, 195 U.S.P.Q. (BNA) 159, 161-62 (C.D. Cal. 1976).

n142 *Dallas Cowboys Cheerleaders*, 604 F.2d at 203-04, 203 U.S.P.Q. at 162-63.

n143 *American Express Co. v. Vibra Approved Labs. Corp.*, 10 U.S.P.Q.2d (BNA) 2006, 2013 (S.D.N.Y. 1989); *Dallas Cowboys Cheerleaders*, 604 F.2d at 205, 203 U.S.P.Q. at 164; *Pillsbury Co. v. Milky Way Prods., Inc.*, 215 U.S.P.Q. (BNA) 124, 135 (N.D. Ga. 1981); *Community Federal*, 678 F.2d at 1037, 215 U.S.P.Q. at 28.

n144 *American Express*, 10 U.S.P.Q.2d at 2013; *Dallas Cowboys Cheerleaders*, 604 F.2d at 205, 203 U.S.P.Q. at 164; *Pillsbury*, 215 U.S.P.Q. at 135; *Community Federal*, 678 F.2d at 1037, 215 U.S.P.Q. at 28.

n145 *Community Federal*, 678 F.2d at 1037, 215 U.S.P.Q. at 28; *Pillsbury*, 215 U.S.P.Q. at 135; *Dallas Cowboys Cheerleaders*, 604 F.2d at 205, 203 U.S.P.Q. at 164; *American Express*, 10 U.S.P.Q.2d at 2013.

n146 346 F. Supp. 1183, 175 U.S.P.Q. (BNA) 56 (E.D.N.Y. 1972).

n147 *Id.* at 1189, 175 U.S.P.Q. at 59 (paraphrasing *Hobart Mfg. Co. v. Kitchen Aid Serv., Inc.*, 260 F. Supp. 559, 561, 151 U.S.P.Q. (BNA) 325, 326-27 (E.D.N.Y. 1966)).

n148 *American Express*, 10 U.S.P.Q.2d at 2013 (finding use of "condom card" product closely resembling American Express card was done with intent of using association of unauthorized product with established American Express card to sell novelty items).

n149 *Id.*

n150 15 U.S.C. § 1125(c) (Supp. I 1995).

n151 *Id.*

n152 15 U.S.C. § 1127 (Supp. I 1995).

n153 *Ringling Bros.-Barnum & Bailey Combined Shows v. B.E. Windows Corp.*, 937 F. Supp. 204, 208, 40 U.S.P.Q.2d (BNA) 1010, 1014 (S.D.N.Y. 1996) (relying on the various factors considered under New York's anti-dilution statute for both analyses in holding that GREATEST BAR ON EARTH did not dilute plaintiff's mark, GREATEST SHOW ON EARTH).

n154 *Panavision Int'l, L.P. v. Toeppen*, 141 F.3d 1316, 1324, 46 U.S.P.Q.2d (BNA) 1511, 1518-19 (9th Cir. 1998) (mark held diluted by cyber-squatter's use as domain name).

n155 *See Toys "R" Us Inc. v. Akkaoui*, 40 U.S.P.Q.2d (BNA) 1836, 1838 (N.D. Cal. 1996) (use of "adultsrus.com" as domain name for web site selling sexual products held to dilute "R Us" mark).

n156 *Id.*

n157 3 McCARTHY, *supra* note 111, § 24:89, at 24-137 to 24-138 (rel. no. 5, Mar. 1998). The U.S. District Court for the Eastern District of Virginia has held that the Federal Trademark Dilution Act is not retroactive. *Circuit City Stores, Inc. v. OfficeMax, Inc.*, 949 F. Supp. 409, 42 U.S.P.Q.2d (BNA) 1194 (E.D. Va. 1996).

n158 15 U.S.C. § 1125(c)(1) (Supp I. 1995).

n159 40 U.S.P.Q.2d (BNA) 1836 (N.D. Cal. 1996).

n160 *Id.* at 1838.

n161 3 McCARTHY, *supra* note 111, § 24:96, at 24-169 (rel. no. 4, Dec. 1997).

n162 *Id.*

n163 *See, e.g., Toys "R" Us*, 40 U.S.P.Q.2d at 1838; *Hasbro, Inc. v. Internet Entertainment Group Ltd.*, 40 U.S.P.Q.2d (BNA) 1479, 1480 (W.D. Wash. 1996).

n164 *See generally* 3 McCARTHY, *supra* note 111, § 24:90, at 24-144 (rel. no. 8, Dec. 1998).

n165 *Panavision Int'l, L.P. v. Toeppen*, 141 F.3d 1316, 1325-26, 46 U.S.P.Q.2d (BNA) 1511, 1519-20 (9th Cir. 1998) (speculator's domain name registration for "panavision.com" held to constitute dilution even though not actually selling anything at web site). "Adultsrus.com" and "candyland.com" were used in connection with adult web sites with sexual content where pornography or sexual toys were sold. Both activities were considered commercial in nature, and held to constitute unlawful dilution of the

owners' respective marks. *Toys "R" Us*, 40 U.S.P.Q.2d at 1838; *Hasbro*, 40 U.S.P.Q.2d at 1479-80.

n166 15 U.S.C. § 1127 (Supp. I 1995).

n167 *See supra* notes 123 through 135 and accompanying text.

n168 *See, e.g., Toys "R" Us*, 40 U.S.P.Q.2d at 1838; *Ringling Bros.-Barnum & Bailey Combined Shows v. B.E. Windows Corp.*, 937 F. Supp 204, 208, 40 U.S.P.Q.2d (BNA) 1010, 1013 (S.D.N.Y. 1996); *Panavision*, 141 F.3d at 1326, 46 U.S.P.Q.2d at 1520.

n169 3 McCARTHY, *supra* note 111, § 24:105, at 24-192 (rel. no. 8, Dec. 1998).

n170 *Id.*

n171 811 F.2d 26, 1 U.S.P.Q.2d 1753 (1st Cir. 1987).

n172 *Id.* at 32, 1 U.S.P.Q.2d at 1758 ("L.L. Beam Back-to-School Sex Catalog" parody advertising fictional sex toys in *High Society* magazine passage held not to constitute trademark dilution) (emphasis added).

n173 *Id.* at 34, 1 U.S.P.Q.2d at 1759.

n174 304 F. Supp. 1228, 163 U.S.P.Q. (BNA) 505 (S.D.N.Y. 1969).

n175 *Id.* at 1230, 163 U.S.P.Q. at 506.

n176 *Id.* at 1230-31, 163 U.S.P.Q. at 506.

n177 *Id.* at 1231, 163 U.S.P.Q. at 506-07.

n178 *Id.*

n179 *Id.* at 1234, 163 U.S.P.Q. at 508-09.

n180 195 U.S.P.Q. (BNA) 159 (C.D. Cal. 1976).

n181 *Id.* at 161.

n182 *Id.* at 162.

n183 *Id.*

n184 *General Elec. Co. v. Alumpa Coal Co.*, 205 U.S.P.Q. (BNA) 1036, 1036 (D. Mass. 1979).

n185 *Id.*

n186 *Id.*

n187 *Id.* at 1037. The *General Electric* court based its injunction on GE's likelihood of success on the merits of its infringement claim, and never reached the issue of whether Alumpa Coal's actions diluted GE's marks. *Id.* at 1036 n.1.

n188 *Id.* at 1037.

n189 604 F.2d 200, 203 U.S.P.Q. (BNA) 161 (2d Cir. 1979).

n190 *Id.* at 203, 203 U.S.P.Q. at 162.

n191 *Id.* at 205, 203 U.S.P.Q. at 164.

n192 *Id. at 206-07, 203 U.S.P.Q. at 165-66.*

n193 *215 U.S.P.Q. (BNA) 124, 136 (N.D. Ga. 1981).*

n194 *Id. at 126.*

n195 *Id.*

n196 *Id. at 135.*

n197 *See id. at 136-37.* The *Pillsbury* court also held that the defendants' use of Pillsbury's characters constituted fair use under the Copyright Act, 17 U.S.C. § 107 (1994). *See id. at 131.* Nevertheless, the court enjoined the publication on the grounds that the publication violated the Georgia anti-dilution statute. *Id. at 136-37. Cf. L.L. Bean, Inc. v. Drake Publishers, Inc., 811 F.2d 26, 1 U.S.P.Q.2d (BNA) 1753 (1st Cir. 1987)* (holding that satiric fictional advertisement for sexual product catalog was constitutionally protected parody, exempt from Maine anti-dilution statute).

n198 *678 F.2d 1034, 215 U.S.P.Q. (BNA) 26 (11th Cir. 1982).*

n199 *Id. at 1035, 215 U.S.P.Q. at 27.*

n200 *Id.*

n201 *Id.*

n202 *Id. at 1037, 215 U.S.P.Q. at 28.*

n203 *Id.*

n204 *Id.*

n205 *811 F.2d 26, 1 U.S.P.Q.2d (BNA) 1753 (1st Cir. 1987).*

n206 *Id. at 27, 1 U.S.P.Q.2d at 1753.*

n207 *Id.*

n208 *Id. at 27, 32, 1 U.S.P.Q.2d at 1753, 1757.*

n209 *Id. at 32, 1 U.S.P.Q.2d at 1757.*

n210 *Id. at 33, 1 U.S.P.Q.2d at 1758.*

n211 *Id. at 34, 1 U.S.P.Q.2d at 1759.*

n212 *Id.*

n213 *Id.; accord Jordache Enters., Inc. v. Hogg Wyld, Ltd., 828 F.2d 1482, 1490, 4 U.S.P.Q.2d (BNA) 1216, 1223 (10th Cir. 1987)* (LARDASHE mark for jeans held, as a valid intentional parody, not to dilute JORDACHE mark for jeans under New Mexico's anti-dilution statute).

n214 *10 U.S.P.Q.2d (BNA) 2006 (S.D.N.Y. 1989).*

n215 *Id. at 2007.*

n216 *Id. at 2014.*

n217 *Id. at 2012-13.*

n218 *Id.* at 2014 (declining to follow *Girl Scouts of America v. Personality Posters Mfg. Co.*, 304 F. Supp. 1228, 163 U.S.P.Q. (BNA) 505 (S.D.N.Y. 1969)).

n219 *Id.* at 2013.

n220 *Id.* at 2013-14.

n221 40 U.S.P.Q.2d (BNA) 1479 (W.D. Wash. 1996).

n222 *Id.* at 1480.

n223 *Id.*

n224 40 U.S.P.Q.2d (BNA) 1836 (N.D. Cal. 1996).

n225 *Id.* at 1837.

n226 *Id.* at 1838.

n227 *Id.*

n228 *Id.*

n229 *Id.*