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2022

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# Trademarks Are Not Tarnished Just Yet: How the Dilution by Tarnishment Statute Survives the First Amendment

Nicholas Prainito

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A trademark is a species of property that denotes a particular standard of quality embedded in a product or service, symbolizes the goodwill of its owner, and represents an advertising investment.<sup>1</sup> Trademarks have been around for 150 years.<sup>2</sup> In that time, changes have been made to the controlling federal statute, the Lanham Act.<sup>3</sup> Two major changes to the Lanham Act occurred in the form of two recent Supreme Court Cases: *Matal v. Tam* and *Iancu v. Brunetti*.<sup>4</sup> In the aftermath of those cases, some scholars have raised additional questions about whether the dilution by tarnishment provision in the Lanham Act is unconstitutional.<sup>5</sup> These scholars argue that the dilution by tarnishment provision constitutes viewpoint discrimination.

This note will analyze the constitutionality of the dilution by tarnishment provision after the holding of these two landmark Supreme Court Cases. Part II of this note will set out the general legislative and social history of trademark law. It will explore how trademark law has changed over time, how the dilution by tarnishment provision has evolved, and how freedom of speech and the concept of viewpoint neutrality have influenced recent trademark decisions.<sup>6</sup>

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<sup>1</sup> 1 Gilson on Trademarks § 1.03 (2020).

<sup>2</sup> 1 Gilson on Trademarks § 1.01 (2020) (noting that under the Federal Trade Mark Act of 1870, 121 trademarks were registered in the year 1870).

<sup>3</sup> See Generally Kenneth L. Port, *The Expansion Trajectory: Trademark Jurisprudence in the Modern Age*, 92 J. PAT. & TRADEMARK OFF. SOC'Y 474, 478-81 (2010).

<sup>4</sup> See generally *Iancu v. Brunetti*, 139 S. Ct. 2294 (2019); *Matal v. Tam*, 137 S. Ct. 1744 (2017).

<sup>5</sup> See Generally, Ryder Hogan, *Examining the Unconstitutionality of Dilution By Tarnishment After Tam*, 27 AM. U.J. Gender SOC. POL'Y & L. 465 (2019); Lisa Ramsey, *Symposium: Increasing First Amendment Scrutiny of Trademark Law After Matal v. Tam*, SCOTUSblog (June 20, 2017, 2:33 PM)

<https://www.scotusblog.com/2017/06/symposium-increasing-first-amendment-scrutiny-trademark-law-matal-v-tam/>.

<sup>6</sup> See Generally Leslie Kendrick, *Content Discrimination Revisited*, 98 VA. L. REV. 231, 235 (2012).

Part III of this note will argue that the dilution by tarnishment provision is constitutional because it is not as broad as other struck down provisions of the Lanham Act that have been struck down and is not aimed at viewpoints, but instead reflects the underlying goal of trademarks. Finally, Part IV will consider solutions for trademark law if courts reject the arguments in this comment. Arguments about the dilution by blurring statute are beyond the scope of this article.<sup>7</sup>

## PART II

### TRADEMARK LAW

Congress enacted the first federal trademark statute in 1870 and prohibited counterfeiting six years later.<sup>8</sup> Originally trademark law was not intended to protect consumers.<sup>9</sup> Instead, it was designed to protect producers from illegitimate deviations of their trade by competitors.<sup>10</sup> But the emphasis has shifted from viewing a trademark as a source of information about the product, to viewing the trademark as the product.<sup>11</sup> Trademarks hold immense value for trademark owners, who range from individuals to Fortune 500 companies. Trademarks are now seen as a commodity in a fast-paced globalized world.

Fast-forward seventy-six years, and Congress enacted the Lanham Act as the all-encompassing trademark statute. The chief concern of Congress was to ensure that registered marks receive uniform, national protection.<sup>12</sup> Registration occurs when an applicant files an application with the Patent and Trademark Office.<sup>13</sup> The application must include a statement

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<sup>7</sup> See Generally Derek A. Hawkins, *Likelihood of Destruction- Restructuring the Trademark Dilution by Blurring Factors in the Trademark Dilution Revision Act of 2006*, 18 MARQ. INTELL. PROP. L. REV. 409, 413-29 (2014) (“Dilution by blurring is the association arising from similarity between a mark or trade name and a famous mark that impairs the distinctiveness of the famous mark.”).

<sup>8</sup> 1 Gilson on Trademarks § 1.06 (2020).

<sup>9</sup> Mark P. McKenna, *The Normative Foundations of Trademark Law*, 82 Notre Dame L. REV. 1839, 1840 (2007).  
<sup>10</sup> *Id.*

<sup>11</sup> Glynn S. Lunney, Jr., *Trademark Monopolies*, 48 Emory L.J. 367, 372 (1999).

<sup>12</sup> *Clairol Inc. v. Gillette Co.*, 389 F.2d 264, 267 (2d. Cir. 1968).

<sup>13</sup> U.S.C. § 1051(a)(1).

that to the “best of the verifier’s knowledge and belief, no other person has the right to use such mark in commerce either in the identical form...or such resemblance...as to be likely...to cause confusion.”<sup>14</sup> If and when approved, a registered trademark serves public notice that it must not be used without permission, but it gives the creator no new rights in its adoption.<sup>15</sup> Trademarks may be classified as running from strong to weak and receive varying degrees of protection accordingly.<sup>16</sup> A strong trademark will be afforded higher protections with a broader range of product lines, while a weaker trademark will be awarded a narrow scope of protection in the specified line of goods or services noted in the application.

Overall, trademarks seek to signify a source, distinguish that source from competitors, and prevent confusion in the marketplace.<sup>17</sup> Though registration of a trademark does not afford the creator any new benefits, it puts the marketplace on notice and provides legal remedies if the trademark is improperly used.<sup>18</sup> Two landmark Supreme Court Cases in the past several years have changed the way trademarks are viewed and have raised questions about other provisions of the Lanham Act.<sup>19</sup>

### **TAM and BRUNETTI DECISIONS**

In *Tam*, Simon Tam, the lead singer of the rock group “The Slants,” sought federal registration of the mark “THE SLANTS.”<sup>20</sup> Federal registration “serves as constructive notice of the registrant’s claim of ownership of the mark...and can make a mark incontestable once it has

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<sup>14</sup> U.S.C. § 1051(a)(3)(D).

<sup>15</sup> Cal. Prune & Apricot Growers’ Ass’n v. H.R. Nicholson Co., 69 Cal. App. 2d 207, 222-23 (1945).

<sup>16</sup> See *Proxite Prods. v. Bonnie Brite Prods. Corp.*, 206 F. Supp. 511, 515 (S.D.N.Y. 1962).

<sup>17</sup> Laura D. Steele, *Actual or Hypothetical: Determining the Proper Test for Trademark Licensee Rights in Bankruptcy*, 14 MARQ. INTELL. PROP. L. REV. 411, 416 (2010).

<sup>18</sup> See Generally U.S.C. § 1125(a).

<sup>19</sup> See Generally Sara Gold, *Does Dilution “Dilute” the First Amendment?: Trademark Dilution and the Right to Free Speech After Tam and Brunetti*, 59 IDEA 483, 502 (2019).

<sup>20</sup> *Matal v. Tam*, 137 S. Ct. 1744, 1747 (2017).

been registered for five years.”<sup>21</sup> The Patent Trademark Office (PTO) rejected the mark because of the disparagement clause in the Lanham Act.<sup>22</sup> This provision prohibits the registration of a trademark “which may disparage...persons, living or dead, institutions, beliefs, or national symbols, or bring them into contempt, or disrepute.”<sup>23</sup> An examiner at the Patent Trademark Office (PTO) applied a two-part test to determine whether the mark violated the disparagement clause.<sup>24</sup> The examiner first considered the likely meaning of the matter in question, and if that meaning is found to refer to identifiable persons, institutions, beliefs or national symbols, the examiner moved onto the second step.<sup>25</sup> Next, the examiner questioned whether that meaning may be disparaging to a substantial composite of the referenced group.<sup>26</sup> The question was whether this particular portion of the Lanham Act violates the Free Speech Clause of the First Amendment.<sup>27</sup>

The Government first defended the use of the disparagement provision by arguing federal trademarks are government speech.<sup>28</sup> Its main reason was that the PTO is “an arm” of the federal government.<sup>29</sup> The Court pushed back and stated “the Federal Government does not dream up these marks, and it does not edit marks submitted for registration.”<sup>30</sup> The PTO has made it clear that registration does not constitute approval of a mark.<sup>31</sup> As has been noted by previous cases, the Free Speech Clause does not regulate government speech.<sup>32</sup> When a government entity

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<sup>21</sup> *Id.* at 1753.

<sup>22</sup> *Id.* at 1751.

<sup>23</sup> *Id.*

<sup>24</sup> *Id.*

<sup>25</sup> *Id.*

<sup>26</sup> *Matal v. Tam*, 137 S. Ct. 1744, 1754 (2017).

<sup>27</sup> *See Generally* U.S. CONST. amend. I (stating “Congress shall make no law...abridging the freedom of speech”).

<sup>28</sup> *See Matal v. Tam*, 37 S. Ct. 1744, 1757 (2017).

<sup>29</sup> *Id.* at 1758.

<sup>30</sup> *Id.*

<sup>31</sup> *Id.*

<sup>32</sup> *See Pleasant Grove City v. Summum*, 555 U.S. 460, 467 (2009); *Johanns v. Livestock Marketing Assn.*, 544 U.S. 550, 553 (2005).

embarks on a course of action, it takes a particular viewpoint and rejects others.<sup>33</sup> The Free Speech Clause “does not require government to maintain viewpoint neutrality when its officers and employees speak about that venture.”<sup>34</sup> With this great “immunity” from the Free Speech Clause, the government speech doctrine is susceptible to dangerous misuse.<sup>35</sup> Justice Alito noted that, “if private speech could be passed off as government speech by simply affixing a government seal of approval, government could silence or muffle the expression of disfavored viewpoints.”<sup>36</sup>

The Government next argued that federal registration of trademarks constituted government-subsidized speech.<sup>37</sup> Case precedent has held that “the Government may not deny a benefit to a person on a basis that infringes his constitutionally protected...freedom of speech even if he has no entitlement to that benefit.”<sup>38</sup> The Court responded by distinguishing that case precedent as cases that all involved cash subsidies or their equivalent.<sup>39</sup> The PTO does not pay money to parties seeking registration of a mark.<sup>40</sup> For that reason, federal registration of trademark does not constitute government-subsidized speech.

Finally, the government finally argued that the disparagement clause was designed to prevent underrepresented groups from being bombarded with demeaning messages in commercial advertising.<sup>41</sup> Therefore, it serves a substantial interest and is narrowly drawn. To

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<sup>33</sup> *Matal v. Tam*, 137 S. Ct. 1744, 1757 (2017).

<sup>34</sup> *Id.*

<sup>35</sup> *Id.* at 1758

<sup>36</sup> *Id.*

<sup>37</sup> *Id.* at 1760.

<sup>38</sup> *Id.* at 1760-61.

<sup>39</sup> *Matal v. Tam*, 137 S. Ct. 1744, 1761 (2017).

<sup>40</sup> *Id.*

<sup>41</sup> *Id.* at 1764

this, the Court notes that, “the clause reaches any trademark that disparages any person, group, or institution. It is not an anti-discrimination clause; it is a happy-talk clause.”<sup>42</sup>

Justice Kennedy did note that “this case does not present the question of how other provisions of the Lanham Act should be analyzed under the First Amendment.”<sup>43</sup> He found solace on relying in the substantial safeguards of free and open discussion in a democratic society.<sup>44</sup> All the Justices did agree that if a trademark registration bar is viewpoint-based, it is unconstitutional.<sup>45</sup> Viewpoint discrimination occurs when the government chooses among similarly situated speakers to advance or suppress a specific point of view.<sup>46</sup> With this portion of the Lanham Act struck down because of its broadness and its failure to qualify as government speech or government-subsidized speech, the disparagement provision can no longer be used in the PTO’s registration process.

Two years after *Tam* the stage was set for the Supreme Court to analyze a different section of the statute. *Iancu v. Brunetti* was another landmark case for trademarks that struck another provision of the Lanham Act. Erik Brunetti is an artist and entrepreneur who founded a clothing line that uses the trademark FUCT.<sup>47</sup> The Court analyzed the Lanham Act’s registration prohibition on marks that consist of or comprise immoral or scandalous matter.<sup>48</sup> The PTO applied the bar as a unitary provision rather than treating the two adjectives in it separately.<sup>49</sup> The PTO board concluded that the term is extremely offensive and therefore barred

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<sup>42</sup> *Id.* at 1765.

<sup>43</sup> *Matal v. Tam*, 137 S. Ct. 1744, 1768 (2017) (J. Kennedy. Concur).

<sup>44</sup> *Id.* at 1769.

<sup>45</sup> *Iancu v. Brunetti*, 139 S. Ct. 2294, 2299 (2019).

<sup>46</sup> Leslie Kendrick, *Content Discrimination Revisited*, 98 VA. L. REV. 231, 235 (2012).

<sup>47</sup> *Iancu v. Brunetti*, 139 S. Ct. 2294, 2297 (2019).

<sup>48</sup> *Id.*

<sup>49</sup> *Id.*

registration.<sup>50</sup> All the Justices in *Tam* agreed that if a trademark registration bar is viewpoint-based, it is unconstitutional.<sup>51</sup>

The Court again found this portion viewpoint-based, concluding that it distinguishes between two opposed sets of ideas: “those aligned with conventional moral standards and those hostile to them.”<sup>52</sup> The PTO rejected marks conveying approval of drug use because it is scandalous to “inappropriately glamorize drug abuse.”<sup>53</sup> Also, the PTO rejected marks reflecting support for al-Qaeda, but approved registration of a mark approving the war against terrorism.<sup>54</sup> In response, the government argued the idea is to “narrow the statutory bar to marks that are offensive or shocking to a substantial segment of the public because of their mode of expression, independent of any views that they may express.”<sup>55</sup> The immoral or scandalous bar that the PTO sets stretches far beyond the government’s proposed construction.<sup>56</sup> Again, the statute is too broad for the Court, which unsubtly urged Congress that a “more carefully focused statute” would be appropriate.<sup>57</sup>

Justice Breyer, in his partial concurrence and dissent, preferred a proportionality analysis to determine whether trademark provisions offend the First Amendment.<sup>58</sup> In Justice Breyer’s opinion, the question should be: “Does the regulation at issue work harm to First Amendment interests that is disproportionate in light of the relevant regulatory objectives?”<sup>59</sup> He recognized trademark law’s “specialized mission” and that mission, by its very nature, requires the

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<sup>50</sup> *Id.* at 2298.

<sup>51</sup> *Id.* at 2299.

<sup>52</sup> *Id.* at 2300.

<sup>53</sup> *Iancu*, 139 S. Ct. 2294, 2300 (2019).

<sup>54</sup> *Id.*

<sup>55</sup> *Id.* at 2301.

<sup>56</sup> *Id.* at 2301.

<sup>57</sup> *Id.* at 2303.

<sup>58</sup> *Iancu*, 139 S. Ct. 2294, 2306 (2019).

<sup>59</sup> *Id.*

government to impose limitations on speech.<sup>60</sup> Attention-grabbing words threaten to distract consumers and disrupt commerce.<sup>61</sup> Justice Breyer provides valuable insight and another perspective on the balance of trademark law and the First Amendment.

Both *Tam* and *Brunetti* found portions of the Lanham Act viewpoint-based and thus found the respective federal trademark registration bars unconstitutional. Another provision of the Lanham Act, dilution by tarnishment, is seen by some as viewpoint-based and requires further analysis of why that could be.

### **DILUTION LAW**

“Dilution is a use of the same or similar mark, trade name, label, or advertisement that diminishes the distinctive quality of the plaintiff’s mark, trade name, label, or form of advertisement or injures plaintiff’s business reputation.”<sup>62</sup> The enactment of federal dilution law was “a landmark upgrade of a legal concept...that was largely ineffectual.”<sup>63</sup> Beginning with Massachusetts in 1947, a number of states enacted statutes that offered protection against a dilution of the distinctive quality of a trademark.<sup>64</sup> Some courts, and numerous commentators, expressed fear that the uncertain limits of the anti-dilution cause of action would unduly expand the ability of trademark owners to monopolize language and inhibit free competition.<sup>65</sup> There are two forms of dilution, blurring and tarnishment and both undermine the selling power of a mark; the latter displacing positive with negative associations.<sup>66</sup>

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<sup>60</sup> *Id.* (noting that the mission of trademark law is to “help consumers identify goods and services that they wish to purchase, as well as those they want to avoid.”).

<sup>61</sup> *Id.* at 2307.

<sup>62</sup> 1 Ln Practice Guide: FL Business Torts §9.09 (2021).

<sup>63</sup> *Id.*

<sup>64</sup> Restatement (Third) of Unfair Competition § 25 cmt. b (Am. Law. Inst. 1995).

<sup>65</sup> *Id.*

<sup>66</sup> Restatement (Third) of Unfair Competition § 25 cmt. c (Am. Law. Inst. 1995).

This note focuses on dilution by tarnishment, which is defined as “association arising from the similarity between a mark or trade name and a famous mark that harms the reputation of the famous mark.”<sup>67</sup> Courts typically follow a four-part test to determine if there is dilution. A plaintiff must show that (1) the mark is famous and distinctive; (2) the defendant is making use of the mark in commerce; (3) the defendant’s use began after the mark became famous; and (4) the defendant’s use of the mark is likely to cause dilution by blurring or dilution by tarnishment.<sup>68</sup> There are four statutory factors for determining whether a mark is sufficiently famous.<sup>69</sup>

- (i) The duration, extent, and geographic reach of advertising and publicity of the mark, whether advertised or publicized by the owner or third parties.
- (ii) The amount, volume, and geographic extent of sales of goods or services offered under the mark.
- (iii) The extent of actual recognition of the mark.
- (iv) Whether the mark was registered under the Act of March 3, 1881, or the Act of February 20, 1905, or on the principal register.

To support a dilution by tarnishment claim, the use of marks must cause an association of different products that would embarrass the senior mark holder.<sup>70</sup> The justification for adopting this standard would be that it “creates consumer aversion to the famous brand...because the public will associate the lack of quality or lack of prestige in the defendant’s goods with the plaintiff’s unrelated goods.”<sup>71</sup> The purpose of the statute is not to protect all trademarks and their owners, but only those with the most powerful trademarks in commerce. The Ninth Circuit, which hears most trademark claims (because of the big entertainment industry in California) has

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<sup>67</sup> 15 U.S.C. § 1125(c)(2)(B), (C) (2020).

<sup>68</sup> *Jada Toys, Inc. v. Mattel, Inc.*, 518 F.3d 628, 634 (9th Cir. 2008).

<sup>69</sup> GILSON, *supra* note 1.

<sup>70</sup> *See Sensient Techs. Corp. v. SensoryEffects Flavor Co.*, 613 F.3d 754, 771; *Window World Int’l v. O’Toole* No. 4:19-cv-2363, 2020 U.S. Dist. LEXIS 223071, at \*14 (E.D. Mo.R. Nov. 30, 2020).

<sup>71</sup> *Rosetta Stone Ltd. V. Google, Inc.*, 676 F.3d 144, 167 (4th Cir. 2012) (citing *Scott Fetzer Co. v. House of Vacuums Inc.*, 381 F.3d 477, 589 (5th Cir. 2004)).

concluded that dilution protection extends only to marks that are household names.<sup>72</sup> Courts have described dilution fame as a difficult and demanding requirement.<sup>73</sup> Time after time, whether it be the craft beer industry or coffee roasting, plaintiffs have failed to show a violation of dilution by tarnishment.<sup>74</sup>

The statute protects only the top of the commercial food chain and does not restrict all damaging speech from occurring. This protection of famous marks also occurs because of the potential of free riding. Free riding occurs when the owner of a lesser-known mark creates an association with a more famous mark to improve the lesser-known mark's reputation or reach by exploiting the famous mark's success.<sup>75</sup> This problem occurs with both dilution by tarnishment and dilution by blurring.

This can be seen in the dilution by tarnishment case of *Bentley Motors Corp.*<sup>76</sup> Bentley, a high-end automobile manufacturer, sued the defendant for unlawfully manufacturing Bentley body kits that transformed ordinary and inexpensive Chrysler and Ford Vehicles into knockoff Bentley vehicles.<sup>77</sup> The Court concluded that Congress intended to protect from dilution marks so inherently distinctive and famous as to rise to the level of "Buick" or "DuPont."<sup>78</sup> The Court also concluded that all the other elements of trademark dilution were satisfied. "When identical marks are used on similar goods, dilution- the capacity of the famous mark to identify and distinguish the goods of the trademark holder- obviously occurs."<sup>79</sup>

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<sup>72</sup> Nissan Motor Co. v. Nissan Computer Corp., 378 F.3d 1002, 1011 (9th Cir. 2004).

<sup>73</sup> Stone Brewing Co., LLC v. MillerCoors LLC, 445 F.Supp. 3d 1113, 1145-46.

<sup>74</sup> See *id.* at 1147; Planet Coffee Roasters, Inc. v. Dam, No. SACV09-00571-MLG, 2009 U.S. Dist. LEXIS 70775, at \*3 (C.D. Cal. Aug. 12, 2009).

<sup>75</sup> Ryder Hogan, *Examining the Unconstitutionality of Dilution By Tarnishment After Tam*, 27 AM. U.J. Gender SOC. POL'Y & L. 465, 471 (2019).

<sup>76</sup> See Generally *Bentley Motors Corp. v. McEntegart*, 976 F. Supp. 2d 1297, 1312-14 (M.D. Fla. 2013).

<sup>77</sup> *Id.* at 1303.

<sup>78</sup> *Id.* at 1313 (quoting *Provide Commerce, Inc. v. Preferred Commerce, Inc.*, No. 07-80185CIV, 2008 U.S. Dist. LEXIS 27697, at \*5 (S.D. Fla. Apr. 4, 2008).

<sup>79</sup> *Am. Honda Motor Co., Inc., v. Pro-Line Protoform*, 325 F. Supp. 2d 1081, 1085 (C.D. Cal. 2004).

Famous trademarks do not always cover products; they also can cover entities, such as professional sports teams. The Dallas Cowboys have used “America’s Team” since 1979.<sup>80</sup> In *Dallas Cowboys Football Club*, the defendant was a sports shop in Minnesota who used the “America’s Team” phrase on various t-shirts and other sports apparel.<sup>81</sup> Even without federal registration of the mark, the inferior quality of the defendant’s products and website tarnished plaintiff’s trademark and met the federal threshold.<sup>82</sup> But just because a trademark is famous does not mean that a dilution by tarnishment claim will succeed. In another case, Starbucks sued Wolfe’s Borough Coffee because it was selling a blend of roasted coffee under the name “Charbucks Blend.”<sup>83</sup> The Court noted that the Starbucks mark is famous within the meaning of the FTDA.<sup>84</sup> A survey done on behalf of Starbucks offered no evidence that Wolfe’s Borough Coffee incorporated negative perceptions to Starbucks products.<sup>85</sup> No dilution by tarnishment was found even though Starbucks was considered a famous mark. The mental association between a famous mark and a lesser known mark is at the heart of any dilution by tarnishment claim.<sup>86</sup> The next section will take a look at the meaning of viewpoint discrimination and some judicial examples.

## VIEWPOINT DISCRIMINATION

The First Amendment means that Government has no power to restrict expression because of its message, its ideas, its subject matter, or its content.<sup>87</sup> Content discrimination

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<sup>80</sup> *Dallas Cowboys Football Club, Ltd. v. Am’s Team Props.*, 616 F. Supp. 2d 622, 631 (N.D. Tex. 2009).

<sup>81</sup> *Id.* at 630.

<sup>82</sup> *Id.* at 643 (noting that in 2006 the defendant distributed thousands of “America’s Team” wristbands with the word “basketball” misspelled).

<sup>83</sup> *Starbucks Corp. v. Wolfe’s Borough Coffee, Inc.*, No. 01CIV5981, 2005 U.S. Dist. LEXIS33578, at \*3 (S.D.N.Y. Dec. 23, 2005).

<sup>84</sup> *Id.*

<sup>85</sup> *Id.* at \*28.

<sup>86</sup> Hogan, *supra* note 51, at 475.

<sup>87</sup> *Police Dep’t of Chi. v. Mosley*, 408 U.S. 92, 95 (1972).

includes the sub-categories of subject matter and viewpoint discrimination. Subject matter discrimination occurs when a state regulates speech based on its topic or subject matter irrespective of the viewpoint expressed by the speaker.<sup>88</sup> Laws that only target sexual speech or only allow picketing on the subject of labor are examples of subject matter discrimination.<sup>89</sup> These laws are subject to strict scrutiny, which means they must: (1) advance a compelling governmental interest; (2) be directly and substantially related to advancing those ends; and (3) be the least restrictive and effective means to advance the ends.<sup>90</sup> The basic idea behind the content-discrimination principle is that it is usually wrong for the government to regulate speech because of what the speech is saying.<sup>91</sup>

Viewpoint discrimination is a sub-category of content discrimination. Courts have held that viewpoint discrimination occurs when the government chooses among similarly situated speakers to advance or suppress a specific point of view.<sup>92</sup> There is a great deal of agreement that viewpoint discrimination is at the core of what the First Amendment forbids.<sup>93</sup> The Supreme Court has noted that viewpoint discrimination is “an egregious form of content discrimination.”<sup>94</sup> While content discrimination is allowed in some fora, the Court has made clear that viewpoint discrimination is not allowed in any fora.<sup>95</sup> According to Justice Kennedy, the test for viewpoint discrimination turns on whether “the government has singled out a subset of messages for

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<sup>88</sup> *People v. Aleem*, 149 P.3d 765, 778 (Colo. 2007).

<sup>89</sup> See *United States v. Playboy Entm't Group, Inc.*, 529 U.S. 803, 811-12 (2000); *Carey v. Brown*, 447 U.S. 455, 461-62 (1980).

<sup>90</sup> R. Randall Kelso, *Clarifying Viewpoint Discrimination in Free Speech Doctrine*, 52 IND. L. REV. 355, 368 (2019).

<sup>91</sup> Leslie Kendrick, *Content Discrimination Revisited*, 98 VA. L. REV. 231, 235 (2012).

<sup>92</sup> *Id.*

<sup>93</sup> Kendrick, *supra*, at 56.

<sup>94</sup> *Rosenberger v. Rector and Visitors of Univ. of Va.*, 515 U.S. 819, 829 (1995).

<sup>95</sup> See, e.g., *Minn. Voters Alliance v. Mansky*, 138 S. Ct. 1876, 1885 (2018) (viewpoint discrimination prohibited in non-public forums); *Pleasant Grove City v. Summum*, 555 U.S. 460, 469-70 (2009) (viewpoint discrimination prohibited in traditional, designated, and limited public forums).

disfavor based on the views expressed.”<sup>96</sup> The broad nature of the statute in *Tam* made the registration process highly subjective and put the government in a position to pick and choose which trademarks it favored.<sup>97</sup>

There have been several examples of alleged viewpoint discrimination in recent years that have made their way up to the United States Court of Appeals and subsequently found as not viewpoint discrimination. In *First Resort*, a San Francisco ordinance was passed to protect indigent woman facing unexpected pregnancies from the harms posed by false or misleading advertising by limited services pregnancy centers (“LSPC”).<sup>98</sup> The “Findings” section of the ordinance explained that “in recent years, out of the clinics that seek to counsel clients against abortion some of those seek to mislead women contemplating abortion into believing that their facilities offer abortion services and unbiased counseling.”<sup>99</sup> The justification that San Francisco noted is “when a woman is misled into believing that a clinic offers services that it does not in fact offer, she loses time crucial to the decision whether to terminate a pregnancy.”<sup>100</sup> The Ninth Circuit claims that there is no viewpoint discrimination present because the Ordinance regulates LSPCs because they engage in false or misleading speech, irrespective of their viewpoints.<sup>101</sup> The Ordinance in no way restricts those entities from expressing their views about abortion to the public or their clients.<sup>102</sup> No viewpoint discrimination was found in this case because the underlying legislative motive was to prevent false advertising and misinformation from being spread.

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<sup>96</sup> *Matal v. Tam*, 137 S. Ct. 1744, 1766 (2017) (Kennedy, J., concurring).

<sup>97</sup> See Ned Snow, *Immoral Trademarks After Brunetti*, 58 HOUS. L. REV. 401, 434 (2020).

<sup>98</sup> *First Resort, Inc. v. Herrera*, 850 F.3d 1263, 1266 (9th Cir. 2017).

<sup>99</sup> *Id.* at 1269.

<sup>100</sup> *Id.*

<sup>101</sup> *Id.* at 1277-78.

<sup>102</sup> *Id.* at 1278.

Similar to dilution by tarnishment, there is an overarching legislative motive that does not include discriminating on the basis of viewpoint. For dilution by tarnishment, the goal is the same as trademark law in general; protect consumers and trademark holders alike.<sup>103</sup>

An example of where provisions were too broad to qualify as viewpoint discrimination can be seen in *Gerlich*.<sup>104</sup> Iowa State University (ISU) has a policy that student groups may use ISU's trademarks on merchandise if ISU's Trademark Licensing Office determines that the use complies with ISU's Guidelines for University Trademark Use by Student and Campus Organizations.<sup>105</sup> NORML ISU is a recognized student organization at ISU whose purpose is to reform federal and state marijuana laws.<sup>106</sup> It requested permission from ISU's Trademark Office to use their t-shirt design, which included a cannabis leaf on it.<sup>107</sup> After rejection of the use, the guidelines were revised to prohibit "designs that suggest promotion of the below listed items...dangerous, illegal, or unhealthy products, actions or behaviors...or drugs and drug paraphernalia that are illegal or unhealthful."<sup>108</sup> After an article was published in the *Des Moines Register*, NORML ISU was required to obtain approval from upper management. This method of approval was unheard of at the University.<sup>109</sup> The unusual trademark approval process with respect to all of the trademark design applications showed evidence that the university was motivated by viewpoint discrimination.<sup>110</sup> The unusual procedure and revised policies for approval served as key indicators for the Court that the process was motivated by viewpoint

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<sup>103</sup> 1 Gilson on Trademarks § 1.06 (2020).

<sup>104</sup> See Generally *Gerlich v. Leath*, 861 F.3d 697, 697-720 (8th Cir. 2017).

<sup>105</sup> *Id.* at 701.

<sup>106</sup> *Id.*

<sup>107</sup> *Id.* at 702.

<sup>108</sup> *Id.* at 703.

<sup>109</sup> *Gerlich v. Leath*, 861 F.3d 697, 705 (8th Cir. 2017).

<sup>110</sup> *Id.* at 707.

discrimination. This is yet another provision that was found to be too broad, which implicated discrimination on the basis of viewpoint.

Both of these cases provide examples of when viewpoint discrimination is and is not found. If there is a clear underlying legislative motive that is subsequently met, then a court is more inclined to find against viewpoint discrimination. But, if a provision is too broad and leaves too much room for interpretation, then a court has no problem determining that there is viewpoint discrimination.

### PART III

#### **DILUTION BY TARNISHMENT VIEWED UNDER STRICT SCRUTINY**

As noted above, dilution by tarnishment is the association arising from the similarity between a mark or trade name and a famous mark that harms the reputation of the famous mark.<sup>111</sup> To consider whether a mark is deemed “famous” the PTO considers: (1) the duration, extent, and geographic reach of advertising and the publicity of the mark; (2) the amount, volume, and geographic extent of sales of goods or services offered under the mark; and (3) the extent of actual recognition of the mark.<sup>112</sup> The judicial standard of strict scrutiny is the regulation or law must be narrowly tailored to serve a compelling interest.<sup>113</sup> In *Tam* and *Brunetti*, the standard of strict scrutiny was applied because both sections of the Lanham Act constituted viewpoint discrimination.<sup>114</sup> The Court in *Brunetti* noted that in *Tam* a majority of justices did not agree that any viewpoint-based restrictions on trademarks would be subject to strict scrutiny.<sup>115</sup> This section will look at two different arguments that could be made to look at

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<sup>111</sup> 15 U.S.C. § 1125(c)(C) (2020).

<sup>112</sup> 15 U.S.C. § 1125(c)(2)(a) (i-iii) (2020).

<sup>113</sup> *Dotson v. Kander*, 464 S.W.3d 190, 197 (Mo. 2015).

<sup>114</sup> See *Iancu v. Brunetti*, 139 S. Ct. 2294, 2303 (2019); *Matal v. Tam*, 137 S. Ct. 1744, 1754 (2017).

<sup>115</sup> *Iancu*, 139 S. Ct. at 2298-99.

dilution by tarnishment as viewpoint discrimination. At the end of each argument, will also be a rebuttal as to why dilution by tarnishment should not be viewed in that light.

The first argument is the focus on the “tarnish” aspect of the dilution by tarnishment provision. Some may argue that the tarnishment aspect, taken in the literal sense constitutes viewpoint discrimination.<sup>116</sup> The worry is that determining whether a similar trademark tarnishes another trademark effectively creates a favored viewpoint.<sup>117</sup> Or in other words, it regulates based on a negative perceived opinion of the trademark.<sup>118</sup> In *Tam*, the Court struck down the disparagement clause of the Lanham Act.<sup>119</sup> The disparagement clause prohibited the registration of a trademark “which may disparage...persons, living or dead, institutions, beliefs, or national symbols, or bring them into contempt, or disrepute.”<sup>120</sup> The Court found that further analysis into the type of speech was not necessary because the clause constituted viewpoint discrimination.<sup>121</sup> Similarly in *Brunetti*, the Court had a difficult time narrowly construing the broad language of the “immoral or scandalous” clause.<sup>122</sup> A narrowing construction is not plausible and it “cannot stand in the shoes of the legislature and rewrite a statute.”<sup>123</sup>

Dilution by tarnishment is not viewpoint discrimination because “tarnishment” is not as broad as previously struck down clauses and does not turn on viewpoint.

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<sup>116</sup> See generally Ryder Hogan, *Examining the Unconstitutionality of Dilution By Tarnishment After Tam*, 27 AM. U.J. Gender SOC. POL’Y & L. 465 (2019); Lisa Ramsey, *Symposium: Increasing First Amendment Scrutiny of Trademark Law After Matal v. Tam*, SCOTUSblog (June 20, 2017, 2:33 PM) <https://www.scotusblog.com/2017/06/symposium-increasing-first-amendment-scrutiny-trademark-law-matal-v-tam/>.

<sup>117</sup> See generally Ryder Hogan, *Examining the Unconstitutionality of Dilution By Tarnishment After Tam*, 27 AM. U.J. Gender SOC. POL’Y & L. 465,471 (2019).

<sup>118</sup> *Id.*

<sup>119</sup> *Matal v. Tam*, 137 S. Ct. 1744, 1751 (2017).

<sup>120</sup> *Id.*

<sup>121</sup> *Id.* at 1765.

<sup>122</sup> *Iancu v. Brunetti*, 139 S. Ct. 2294, 2300 (2019).

<sup>123</sup> *In re Brunetti*, 877 F.3d 1330, 1356 (Fed Cir. 2017).

Dilution by tarnishment only occurs against famous trademarks.<sup>124</sup> To even determine if a trademark is famous, there are several statutory factors a court must weigh.<sup>125</sup> These statutory factors narrow the scope of the provision. What Justice Alito and Justice Kennedy worried about with the broadness of the disparagement clause is not present here. The dilution by tarnishment provision has a narrow scope, and there is a multi-layered analysis to determine if there is a cause of action. The verb “tarnishment” only attaches to famous trademarks. Unlike “immoral” or “scandalous” there is not a wide range of trademarks that can be affected. In *Brunetti*, the Government urged the Court to interpret the “immoral or scandalous” provision to be limited to “refusing marks that are vulgar.”<sup>126</sup> The Court left the door open that the Government proposed bar could be constitutional under the First Amendment.<sup>127</sup> Justice Kagan even ends the plurality opinion by stating that “there are a great many immoral and scandalous ideas in the world and the Lanham Act covers them all. It therefore violates the First Amendment.”<sup>128</sup> A second ground-breaking opinion for trademark law ends with a hint that the “immoral or scandalous” bar covered just too much for the Court’s liking.

The second reason why dilution by tarnishment does not constitute viewpoint discrimination is because the broader purpose of the provision does not turn on any particular viewpoint. Dilution by tarnishment falls under the purview of the Lanham, which is federal trademark statute. The Senate recognized two goals of the Lanham Act: the protection of consumers and the protection of the individual trademark holder.<sup>129</sup> The Senate also

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<sup>124</sup> 15 U.S.C. § 1125(c)(2)(B), (C) (2020).

<sup>125</sup> GILSON, *supra* note 1.

<sup>126</sup> *Iancu v. Brunetti*, 139 S. Ct. 2294, 2301 (2019).

<sup>127</sup> *See id.*

<sup>128</sup> *Id.* at 2302.

<sup>129</sup> Paul Frederick Stibbe, *Pushing the Boundaries of the Trademark Dilution by Tarnishment Claim: The Tarnishment Claim in an Ever-Expanding Keyword Search Market*, 17 VA. J.L. & TECH. 244, 251 (2012).

contemplated that the Act should protect the goodwill and reputation of a trademark owner that spends significant resources in creating public confidence in the trademark owner's brand.<sup>130</sup>

The Act defined dilution as “the legal theory that seeks to protect a trademark owner directly against the diminution of a trademark's commercial...selling power by the unauthorized junior of the same or substantially similar mark.”<sup>131</sup> The dilution by tarnishment provision serves that exact purpose. Tarnishment occurs when the “goodwill and reputation of a plaintiff's trade dress are linked to products which will conjure associations that clash with the associations generated by the owner's lawful use of a mark.”<sup>132</sup> Goodwill and reputation is the foundation of the associations generated by a famous mark.<sup>133</sup> Tarnishment of a famous trademark does not turn on what the offender has to say. It aims to protect trademark owners who have spent significant time and money on building the goodwill of their brand. If the dilution by tarnishment provision is struck down, then the entire Lanham Act may fail First Amendment scrutiny.

Tarnishment causes a likelihood of confusion and/or a negative association of the famous trade mark.<sup>134</sup> This confusion arises from consumers, not the Government.<sup>135</sup> Because consumers link the famous mark to other products, the subsequent mark weakens, or dilutes, the famous mark's unique and distinctive link to a particular product.<sup>136</sup> This is an important

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<sup>130</sup> *Id.*

<sup>131</sup> Elliot B. Staffin, *The Dilution Doctrine: Towards a Reconciliation with the Lanham Act*, 6 Fordham INTELL. PROP. MEDIA & ENT. L.J. 105, 107 (1995).

<sup>132</sup> *Bell Helicopter Textron Inc. v. Islamic Republic of Iran*, 764 F.Supp.2d 122, 128 (D.D.C. 2011).

<sup>133</sup> *See id.*

<sup>134</sup> *See generally* *Bayer Corp. v. Custom Sch. Frames, LLC*, 259 F.Supp.2d 503 (E.D. La. 2003); *Perkins Sch. for the Blind v. Maxi-Aids, Inc.*, 274 F.Supp.2d 319 (E.D.N.Y. 2003).

<sup>135</sup> *Gateway, Inc. v. Companion Products, Inc.* 320 F. Supp. 2d 912, 925 (S.S.D. 2002).

<sup>136</sup> *Id.*

distinction from the provisions struck down in *Tam* and *Brunetti*.<sup>137</sup> The Court in both cases had trouble reconciling with the fact that the Government had broad discretion in determining which trademarks were offensive.<sup>138</sup> Case precedent has further shown the main purpose of the dilution by tarnishment provision is to protect trademark owners rather than discriminate based on viewpoint.

An example of where a likelihood of confusion between trademarks equates to dilution by tarnishment can be found in *Bayer*.<sup>139</sup> The plaintiff, Bayer Corporation, had sold tens of millions of dollars worth of animal flea control preparations under their ADVANTAGE trademark throughout the United States.<sup>140</sup> The ADVANTAGE mark has become famous, and “represents an extraordinarily valuable goodwill owned by Bayer Corporation.”<sup>141</sup> This is the exact type of trademark that qualifies for protection by the dilution by tarnishment provision. The defendant, Custom School Frames (CSF), created and used a website named [www.nofleas.com](http://www.nofleas.com) to advertise and sell foreign products of Bayer without Bayer’s permission.<sup>142</sup> CSF also uses the ADVANTAGE mark on its website without Bayer’s consent.<sup>143</sup>

There are material differences between the foreign products that CSF is selling and what Bayer sells.<sup>144</sup> The Court noted that trademark dilution, “by its very nature results in irreparable injury since the attendant loss of goodwill, reputation and business cannot adequately be

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<sup>137</sup> See generally *Iancu v. Brunetti*, 139 S. Ct. 2294, 2297 (2019) (striking down the Lanham Act’s “immoral or scandalous” provision); *Matal v. Tam*, 137 S. Ct. 1744, 1751 (2017) (striking down the Lanham Act’s disparagement clause).

<sup>138</sup> See *Brunetti*, 139 S. Ct. 2300 (2019); *Tam* 137 S. Ct. 1765 (2017).

<sup>139</sup> See *Bayer Corp. v. Custom Sch. Frames, LLC*, 259 F. Supp. 2d 503, 509 (E.D. La. 2003).

<sup>140</sup> *Id.* at 505.

<sup>141</sup> *Id.*

<sup>142</sup> *Id.* at 506.

<sup>143</sup> *Id.*

<sup>144</sup> *Id.* (noting material differences such as CSF’s products not being registered with the United States Environmental Protection Agency, no veterinarian consultation, and no quality control procedures for shipment and storage).

quantified and the trademark owner cannot adequately be compensated.”<sup>145</sup> Clearly, the court was more concerned with the injury to the trademark owner than what the infringer’s point was. A famous mark’s goodwill was tarnished by another trademark that has several material differences.

The exceptions to dilution by tarnishment also provide another example of the core function of this section of the Lanham Act. These exceptions are fair use, all forms of news reporting and news commentary, and any noncommercial use of a mark.<sup>146</sup> The fair use exception applies to parodies and/or criticisms.<sup>147</sup> Similar statutory exceptions can be found in regards to copyrights and their respective fair use exception.<sup>148</sup> This provides another example that the dilution by tarnishment poses a high bar for plaintiffs and is not as broad as the other struck down provisions of the Lanham Act.

The *World Wrestling* case shows how the dilution by tarnishment exception are applied in practice.<sup>149</sup> The Worldwide Wrestling Federation Entertainment, Inc. (WWE) “is an integrated media and entertainment company engaged in the development, promotion, and marketing of television programming, pay-per-view programing and live area events.”<sup>150</sup> The defendant, Big Dog, “develops, markets, and retails a branded lifestyle collection of unique, high quality, popular priced consumer products.”<sup>151</sup> Big Dog alleges that its t-shirts appeal to customers who enjoy mocking pop phenomena.<sup>152</sup> Some of WWE’s most popular wrestling characters have

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<sup>145</sup> Bayer Corp. 259 F.Supp. 2d, 510 (E.D. La. 2003).

<sup>146</sup> 15 U.S.C. § 1125 (c)(3) (A-C) (2020).

<sup>147</sup> 15 U.S.C. § 1125 (c)(3) (A) (2020).

<sup>148</sup> See 17 U.S.C. 107 (2020).

<sup>149</sup> See generally *World Wrestling Fedn. Entm’t, Inc. v. Big Dog Holdings, Inc.*, 280 F. Supp. 2d 413 (W.D. Pa. 2003).

<sup>150</sup> *Id.* at 417.

<sup>151</sup> *Id.*

<sup>152</sup> *Id.* at 418.

trademarks registered for themselves.<sup>153</sup> Big Dog has made several t-shirt designs that depicted these wrestling characters and the Court was tasked with deciding whether these t-shirts were a parody and therefore could not cause any confusion.<sup>154</sup>

The Court did not deny that there are similarities between the two marks, but the “mere fact that consumers mentally associate the junior user’s mark with a famous mark is not sufficient to establish actionable dilution.<sup>155</sup> A junior use of a mark that serves a parodic purpose will not be unlawful under the dilution by tarnishment provision.

This is yet another example limiting the section’s prospective reach. It is a section of the Lanham Act that truly embodies trademark law and the protections it seeks to afford. Dilution by tarnishment is not concerned with offensive expression as much as it is with consumer confusion. Without dilution by tarnishment, there is no protection for trademark owners who have spent an immense amount of time and money on perfecting their reputation. Viewpoint discrimination is per se unlawful because it clashes with the First Amendment principles of free speech. The dilution by tarnishment provision embodies the ultimate goal of trademark law: protection for consumers and trademark owners alike. This principle been manifested through its statutory factors and its application by various courts.

## **IMPLICATIONS**

The question presented in this note is the viability of the dilution by tarnishment statute after the decisions in *Tam* and *Brunetti*. Commentators are worried about the viability of the dilution section, but upholding its constitutionality can possibly provide some clarity in the world

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<sup>153</sup> *Id.* at 419. (for example “THE ROCK”, “STONE COLD STEVE AUSTIN”, and “UNDERTAKER”).

<sup>154</sup> *Id.* at 431.

<sup>155</sup> *World Wrestling*, 280 F. Supp. 2d, 443 (W.D. Pa. 2003).

of trademarks.<sup>156</sup> If the provision is upheld, trademark owners of famous trademarks will still be able to receive federal protection for their registered trademarks. Federal protection would eliminate most worries for defendants of plaintiffs raising First Amendment issues in dilution cases. Even if claims are still being raised the statutory exceptions to dilution by tarnishment might be used more frequently. Those defenses are fair use, all forms of news reporting and news commentary, and any noncommercial use of a mark.<sup>157</sup>

On the other hand, there are huge ramifications if dilution by tarnishment is struck down and deemed unconstitutional. If that occurs, lawmakers might have to go back to the drawing board to rewrite the provision. The broadness of dilution by tarnishment might hurt the section's constitutionality.<sup>158</sup> The *Tam* opinion invites trademark litigants to raise constitutional claims and courts to experiment with free-speech doctrines in trademark law.<sup>159</sup> For example, companies accused of trademark dilution may be able to argue that the dilution statute is an unconstitutional content-based regulation of non-misleading expression and is facially invalid under the First Amendment.<sup>160</sup> Trademarks do not need to be federally registered and can still exist in the commercial world without federal registration. Famous marks would take a potential hit because dilution by tarnishment serves to protect only the most recognizable trademarks in commerce.

## PART IV

## CONCLUSION

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<sup>156</sup> Lisa Ramsey, *Symposium: Increasing First Amendment Scrutiny of Trademark Law After Matal v. Tam*, SCOTUSblog (June 20, 2017, 2:33 PM) <https://www.scotusblog.com/2017/06/symposium-increasing-first-amendment-scrutiny-trademark-law-matal-v-tam/>.

<sup>157</sup> 15 U.S.C. § 1125 (c)(3) (A-C) (2020).

<sup>158</sup> Christine Farley, *Symposium: Free Speech Comes to Trademark Law*, SCOTUSblog (June 20, 2017, 2:25 PM) <https://www.scotusblog.com/2017/06/symposium-free-speech-comes-trademark-law/>.

<sup>159</sup> *Id.*

<sup>160</sup> Ramsey, *supra* note 89.

It is also important to note a possible solution if dilution by tarnishment does not become classified as commercial speech or is classified as viewpoint discrimination. As previously mentioned the ramifications of completely striking down dilution would be massive, so instead a different solution should be considered. One possible solution is to narrow the scope of the section even further. The Court in both *Tam* and *Brunetti* expressed serious concerns with the breadth of the provisions at issue in those cases.<sup>161</sup> If a broad statute seems to be the problem, then narrowing the dilution by tarnishment provision could be a possible solution. Scholars have suggested that the phrase “harming the reputation of” has no measurable context.<sup>162</sup> If Congress matches the statutory factors it puts forth to define a “famous mark” with statutory factors to defining “harming the reputation”, then defendants may have a tougher time arguing that dilution by tarnishment is too broad. A narrower statute may also lead to less claims. It will be more difficult to meet the statutory threshold and will hopefully deter frivolous claims. This note argues for the constitutionality of dilution by tarnishment, but if found unconstitutional, narrowing the scope of the section may suffice in the eyes of the Court.

This note sought to analyze if the dilution by tarnishment section of the Lanham Act would be upheld after the recent decisions in *Brunetti* and *Tam* for two reasons.

First, the term “tarnish” in the aforementioned provision does not turn on viewpoint like its other Lanham Act counterparts. There is an extensive process to determine which trademarks even qualify for the trademark provision and tarnishing does not pick out viewpoints, but rather goes through a thorough factual analysis. Unlike the “disparagement” or the “immoral or

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<sup>161</sup> See *Iancu v. Brunetti*, 139 S. Ct. 2294, 2302 (2019) (noting “the immoral or scandalous bar is substantially overbroad”); *Matal v. Tam*, 137 S. Ct. 1744, 1764-65 (2017) (noting that “the disparagement clause is not narrowly drawn to drive out trademarks that support invidious discrimination”).

<sup>162</sup> See Christopher R. Kinkade, *Is Trademark Dilution Law Diluting Rights? A Survey of the Trademark Dilution Revision Act of 2006*, 31 Seton Hall Legis. J. 433, 455 (2007) (noting that “The ALCU asserts that all successful criticism may be classified as dilution by tarnishment; after all, one purpose of criticism is to harm the target of the criticism”).

scandalous” provisions, there is not an infinite number of trademarks that could be affected. The PTO is not picking and choosing which trademarks fit these broad terms. Instead, the dilution by tarnishment provision stands as a remedy for famous trademarks, which leads to the second reason.

The provision fits right into the goals of trademark law. Trademark law seeks to protect owners and consumers alike. Case precedent has proven that the dilution by tarnishment provision fits right into that principle. Courts have repeatedly emphasized the importance of the protection of famous trademarks and all the time and money that has been spent in creating their goodwill and reputation.<sup>163</sup> These two reasons provide an explanation why the dilution by tarnishment provision is not viewpoint discrimination and therefore should not be struck down by the Supreme Court.

The ramifications of a decision either way would be huge for trademark owners. If struck down, that leaves a slippery slope for the rest of Lanham Act and questions of what Congress can do will begin to be suggested. If upheld, as this note concludes, then that would be a huge landmark achievement for the world of trademark law and consumers and famous mark owners can rejoice. With a growing globalized United States, trademarks are pivotal in protecting business persons from suffering injury. Famous trademarks have dedicated an expansive amount of time and money to ensure their goodwill and pristine reputation. Consumers expect a certain service and/or product when they deal with a certain trademark. This note has displayed various cases of famous trademarks and the positive mental associations consumers make with them. The federal protections that are conferred upon owners is invaluable. If the Court strikes down

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<sup>163</sup> See generally *Bayer Corp. v. Custom Sch. Frames, LLC*, 259 F. Supp. 2d 503, (E.D. La. 2003); *World Wrestling Fedn. Entm't, Inc. v. Big Dog Holdings, Inc.*, 280 F. Supp. 2d 413 (W.D. Pa. 2003).

another portion of the Lanham Act, then claimants and users of trademarks would not know whether their works were still protection, or whether protection had evaporated.<sup>164</sup>

Anyone can file for federal trademark protections and that is symbolic of true American entrepreneurship. Dilution by tarnishment does not constitute viewpoint discrimination because Congress has laid out very specific statutory factors to even meet the threshold of a famous mark.<sup>165</sup> These specific statutory factors serve as the guideline for trademark owners and potential trademark infringers. The problem with *Tam* and *Brunetti* was the broadness of the statute and the Court felt that the Government was controlling speech.<sup>166</sup>

This question of constitutionality could be on the Supreme Court's docket in a year or two. This note provides a preview of what could be to come and the ramifications of such a decision. Other portions of the Lanham Act are inevitably going to be closely looked at for their constitutionality. It would be fair to ask whether Congress should scrap the current statute and rewrite it with the words of the Court in mind. The opinions in *Brunetti* and *Tam* gave a lot of "suggestions" on how the respective sections could survive viewpoint analysis.<sup>167</sup> Narrower provisions could have possibly saved them from being deemed viewpoint discrimination.<sup>168</sup> Rewriting a whole statute would be time extensive and with the current track record of Congress being on the same page, it seems highly unlikely a rewritten Lanham Act is a viable solution.

This note traversed the history of trademark law, analyzed the decisions of *Brunetti* and *Tam*, scrutinized the dilution by tarnishment statute under the same lenses of case precedent, and tried to come up with a viable solution to keep the Lanham Act alive. Principles that worried

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<sup>164</sup> Alfred C. Yen, *Choosing the Consequences of Tam and Brunetti*, 19 CHI.-Kent J. INTELL. PROP. 396, 403 (2020).

<sup>165</sup> See 15 U.S.C. 1125(c)(2) (A)(i-iv) (2020).

<sup>166</sup> See *Iancu v. Brunetti*, 139 S. Ct. 2294, 2302 (2019); *Matal v. Tam*, 137 S. Ct. 1744, 1765-66 (2017).

<sup>167</sup> See *Iancu*, 139 S. Ct. at 2300; *Matal*, 137 S. Ct. at 1763.

<sup>168</sup> *Iancu*, 139 S. Ct. at 2300; *Matal*, 137 S. Ct. at 1763.

Justices in *Tam* and *Brunetti* should not be of concern when dealing with the dilution by tarnishment provision. The provision aligns parallel with the ultimate goals of trademark law. Dilution by tarnishment should be able to survive the court's rigorous standard on a legal basis and it should survive on an ethical basis as well.

Famous trademarks are vital to companies and individuals around the world. They provide an identification for consumers, no matter where the demographic, location, and economic status of the consumer. That identification goes through a vigorous legal process to receive dilution by tarnishment protection. The last thing that is needed for both trademark owners and consumers is another portion of the Lanham Act being erased without any remedies in place to pick up the fallen pieces. No timetable is available to determine when this provision could reach the Supreme Court's docket. But with a growing globalized World, and more and more trademarks attempting to be federally registered, it is only a matter of time before the Supreme Court revisits the Lanham Act. And although there is no perfect solution, this note provides optimism that at least one portion can survive.