

Identifying Information

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Paper Information

Title:	The Slippery Road From Tarnishment To Protected Commercial Speech: Unconstitutional Trademark Dilution In The Light Of Tam
Abstract:	<p>The strongest and most famous of trademarks are protected against dilution. Federal trademark dilution law protects famous trademarks from dilution by blurring and dilution by tarnishment. There is also a substantial body of state anti-trademark dilution law. However, this article will focus on The Trademark Dilution Revision Act of 2006 (TDRA) and its impermissible regulation of commercial speech. Dilution by blurring is an association between the famous mark and another mark that lessens the capacity of the famous mark to serve as a unique identifier. One doubts whether a rational owner of a famous mark would ever litigate a positive association that improves the reputation or value of the mark. Dilution by tarnishment is an association between a mark and the famous mark that harms the reputation of the famous mark. Dilution by blurring is arguably content neutral; however, dilution by tarnishment punishes the content of the speech. This non-content neutral impermissible result is the same under either federal or state anti-trademark dilution law. Section 43(c) of the Lanham Act only prohibits negative associations that tarnish the mark. This impermissible content-based prohibition raises significant first amendment issues. Recently in <i>Matal v. Tam</i>, the U.S. Supreme Court considered §2(a) of the Lanham Act. The Court held that the disparaging clause of §2(a) was an impermissible content-based regulation of speech. This Article posits that by analogy, the analysis in <i>Tam</i> applies with equal force to the law of tarnishment of famous marks which prohibits only negative associations with the famous mark. Instead of tarnishment Congress could have used the term disparagement and forbidden dilution by disparagement with equal rhetorical and legal force. Although § 43(c) has vigorous protections for non-commercial free speech uses of the mark, these protections arguably do not protect commercial speech or commercial-speech-uses of the famous mark. This article will analyze trademark dilution and the first amendment implications of <i>Tam</i>; and absent congressional action amending §43(c), it will conclude by questioning the continued viability of dilution by tarnishment as a constitutionally sound cause of action.</p>