

The TDRA Case Law After One Year: A “Whole New Ballgame”?

Trademark Dilution: Theoretical and Empirical Inquiries
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Outline

- I. Research Questions
- II. The Set of Opinions
- III. Findings

I. Research Questions

- How many reported TDRA opinions have there been so far?
 - Where are these opinions coming from and in what postures?
 - What proportion found dilution? Of these, what mode, if any, of dilution was found (blurring or tarnishment)?
 - What proportion found no dilution? On what basis (insufficient showing of famousness, of similarity, of association)?
- How often did the courts' ruling as to infringement coincide with its ruling as to dilution?
- What role, if any, has state antidilution law played?
- How prevalent and persuasive is survey evidence?
- More generally, what can a quantitative method tell us that a qualitative method cannot?

II. The Set of Opinions

- Lexis federal court cases combined: *trademark and dilution and date geq (10/01/2006)*
 - 9/20/07, search yielded 275 documents
 - 9/30/07, search yielded 265 documents, two of which did not appear in the results of the 9/20/07 search
- Any significant treatment of dilution, federal or state
- 77 total opinions
- Atlas.ti and Stata

III. Findings

A. Persistence of the FTDA

- 66 of the 77 opinions addressed federal antidilution law (58 district, 8 circuit); 11 addressed only state-level dilution actions
- 13 of these 66 opinions explicitly relied only on the FTDA (12 district, 1 circuit)
 - 11 made no mention of the TDRA
 - 2 mentioned the TDRA but held, without analysis, that the FTDA applied
- Thus, 53 total TDRA opinions (46 district, 7 circuit)

III. Findings

B. Venues

- Circuit court opinions: 3 from 2d Circuit, 1 each from 6th, 9th, and 10th Circuits.
- District court opinions:

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. tab venue if tdra==1 & circ==0, sort
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Venue	Freq.	Percent	Cum.
NORTHERN DISTRICT OF CALIFORNIA	5	10.87	10.87
NORTHERN DISTRICT OF TEXAS	4	8.70	19.57
SOUTHERN DISTRICT OF NEW YORK	4	8.70	28.26
DISTRICT OF ARIZONA	3	6.52	34.78
NORTHERN DISTRICT OF ILLINOIS	3	6.52	41.30
EASTERN DISTRICT OF CALIFORNIA	2	4.35	45.65
EASTERN DISTRICT OF MICHIGAN	2	4.35	50.00
EASTERN DISTRICT OF PENNSYLVANIA	2	4.35	54.35
EASTERN DISTRICT OF VIRGINIA	2	4.35	58.70
NORTHERN DISTRICT OF GEORGIA	2	4.35	63.04
SOUTHERN DISTRICT OF CALIFORNIA	2	4.35	67.39
CENTRAL DISTRICT OF CALIFORNIA	1	2.17	69.57
CENTRAL DISTRICT OF ILLINOIS	1	2.17	71.74
DISTRICT OF CONNECTICUT	1	2.17	73.91
DISTRICT OF MINNESOTA	1	2.17	76.09
DISTRICT OF NEVADA	1	2.17	78.26
DISTRICT OF NEW JERSEY	1	2.17	80.43
DISTRICT OF OREGON	1	2.17	82.61
DISTRICT OF UTAH	1	2.17	84.78
EASTERN DISTRICT OF NEW YORK	1	2.17	86.96
MIDDLE DISTRICT OF TENNESSEE	1	2.17	89.13
NORTHERN DISTRICT OF NEW YORK	1	2.17	91.30
SOUTHERN DISTRICT OF TEXA	1	2.17	93.48
WESTERN DISTRICT OF MICHIGAN	1	2.17	95.65
WESTERN DISTRICT OF TENNESSEE	1	2.17	97.83
WESTERN DISTRICT OF WASHINGTON	1	2.17	100.00
Total	46	100.00	

III. Findings

C. Postures and Outcomes

District Court Opinions

POSTURE AND DILUTION OUTCOME IN REPORTED
DISTRICT COURT TDRA OPINIONS,
OCT. 6, 2006 TO OCT. 4, 2007

Posture	Court Found:			
	Dilution	No Dilution	Fact Issue	
MTD	0	5	2	7
PI	1	5	0	6
SJP	4	0	1	5
SJD	0	8	4	12
SJC	1	3	1	5
BT	2	0	0	2
Other*	4	1	0	9*
	12	22	8	46

*A total of nine opinions fell within the "Other" category in the following postures: one plaintiff's motion to reconsider, one defendant's motion for judgment as a matter of law, one plaintiff's motion to compel discovery, one motion for attorneys' fees, three motions for default judgment one motion in limine, and one whose posture was unclear.

III. Findings

D. Correlation of Infringement and Dilution Outcomes

- 37 opinions addressed both infringement and dilution (32 district; 5 circuit)

III. Findings

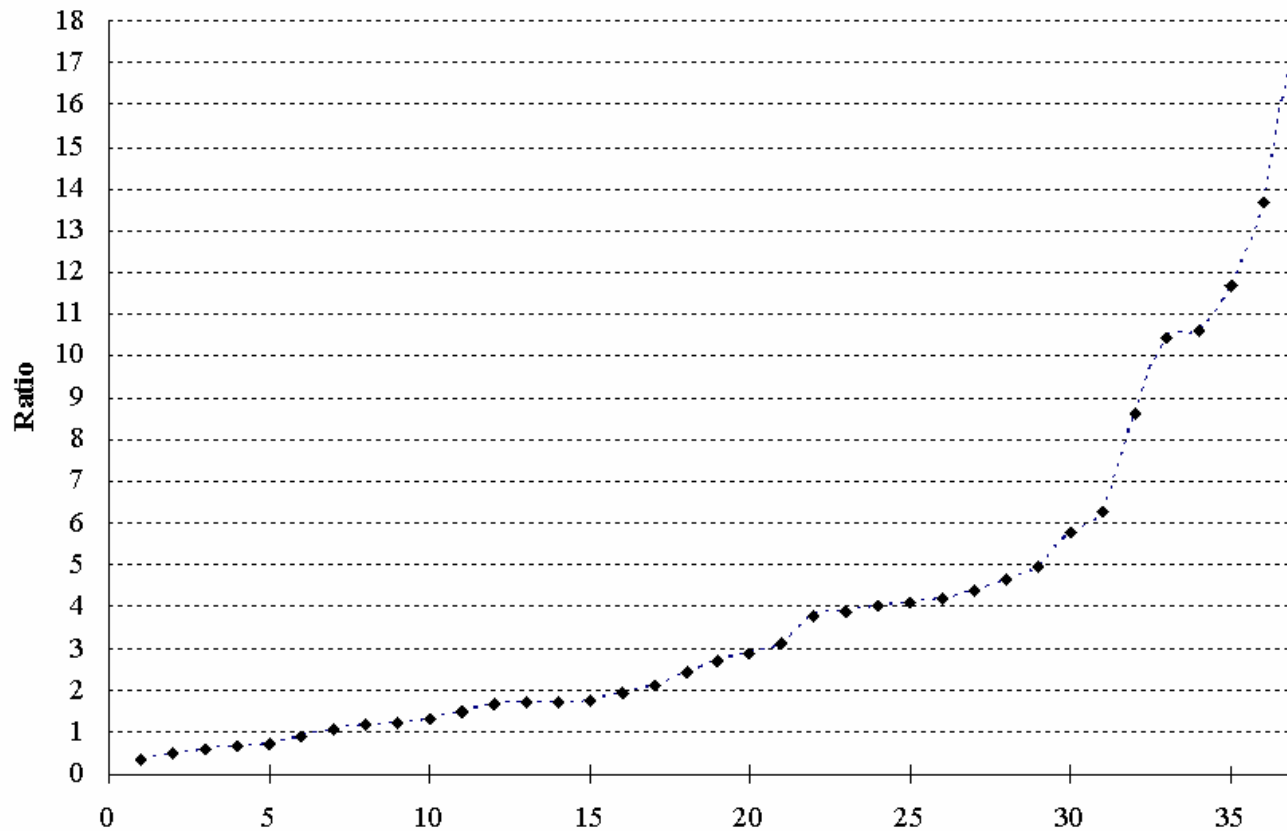
D. Correlation of Infringement and Dilution Outcomes

- 37 opinions addressed both infringement and dilution (32 district; 5 circuit)
 - 34 of these 37 reached the same result as to infringement and dilution
 - Correlation of .939
- Word count relations in these 37 opinions
 - Word count of infringement analysis as proportion of opinion's overall word count, mean: .293
 - Word count of dilution analysis as proportion of opinion's overall word count, mean: .117
 - Ratio of infringement proportion to dilution proportion, mean: 4.078

III. Findings

D. Correlation of Infringement and Dilution Outcomes

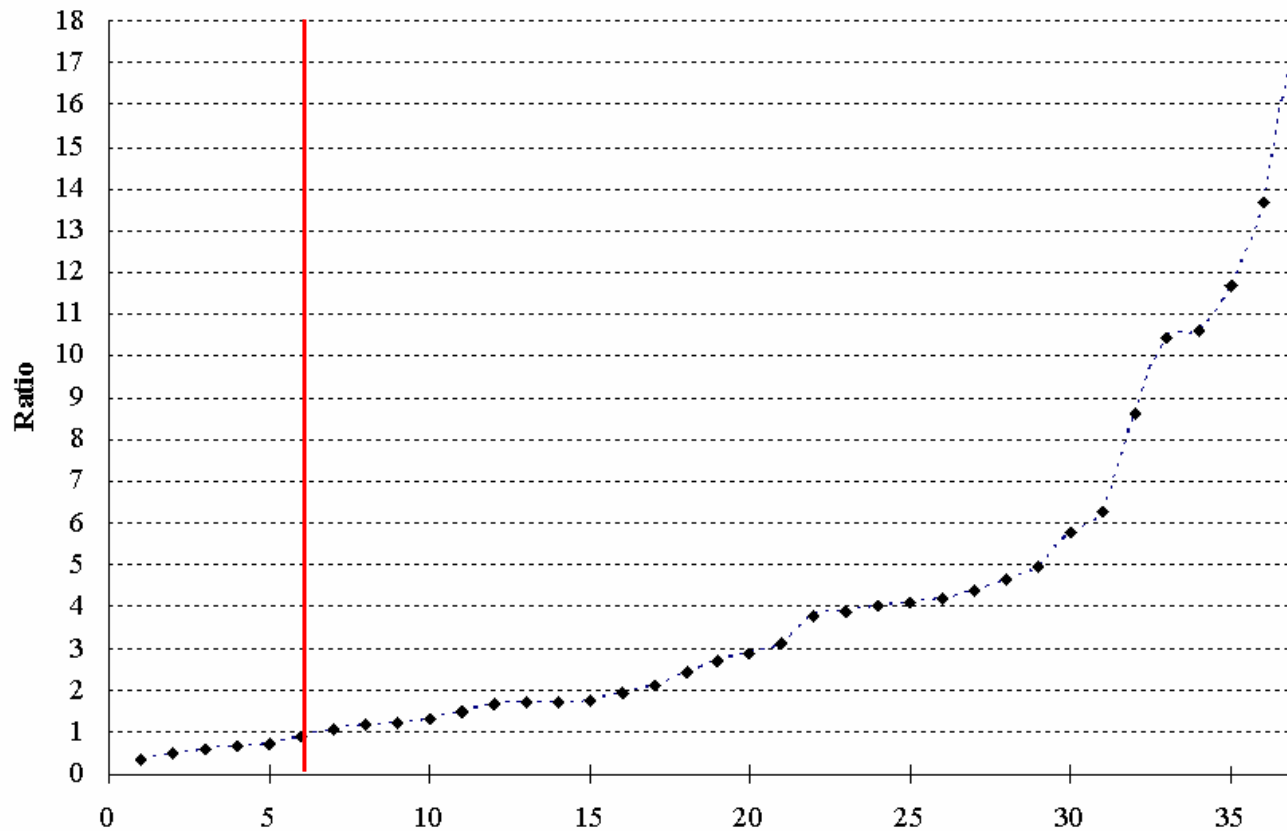
RATIO OF PROPORTION OF OPINION WORD COUNT CONSIDERING INFRINGEMENT TO PROPORTION OF OPINION WORD COUNT CONSIDERING DILUTION IN 37 TDRA OPINIONS



III. Findings

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III. Findings

E. Modes of Dilution

- 13 of the 53 TDRA opinions found dilution
 - 3 explicitly found tarnishment
 - 1 explicitly found blurring
 - 2 found that defendant's mark lessened the capacity of the the plaintiff's mark to "identify and distinguish" plaintiff's products
 - the remaining 7 did not specify a mode of dilution

III. Findings

F. Bases for Rejection of Dilution Claim

- 24 of the 53 TDRA opinions rejected the dilution claim
 - 9 found insufficient fame
 - State-level dilution cause of action?
 - 4 found insufficient similarity
 - 4 found no use in commerce
 - the remaining 7 did not specify a mode of dilution

III. Findings

G. State-Level Dilution Claims

- 11 of the 77 opinions addressed only a state-level dilution cause of action
 - 4 New York, 3 Florida, 1 each of Ohio, Texas
Pennsylvania, California
 - Three found no dilution, eight found fact issues

