Examining the Unconstitutionality of Dilution by Tarnishment after *Tam*

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EXAMINING THE
UNCONSTITUTIONALITY OF DILUTION
BY TARNISHMENT AFTER TAM

RYDER HOGAN*

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INTRODUCTION

The Supreme Court decided Matal v. Tam in the summer of 2017, officially striking down a provision of the Lanham Act that had been a staple of trademark law for the past century. The decision elicited mixed responses. On one side, the case was a victory for the First Amendment combating government censorship of a band’s attempt to reclaim a racial slur. On the other side, the case legitimized the registration of racially

1. See Matal v. Tam, 137 S. Ct. 1744, 1768 (2017) (holding the government impermissibly denied registration to the “Slants”).
charged trademarks such as “the Redskins.” Despite the often controversial outcomes of First Amendment case law, protection of free speech is central to the liberty at the heart of the United States’ legal system.

Now, uncertainty abounds as to whether the government is impermissibly censoring speech in other provisions of the Lanham Act. Specifically, dilution by tarnishment, a niche area of trademark law, may not withstand a First Amendment challenge in the wake of the Supreme Court’s recent landmark decision in *Matal*.

This comment argues that dilution by tarnishment violates the First Amendment of the United States Constitution. Part II describes the source, elements, legal theory, and scientific evidence concerning dilution by tarnishment. Part II also explains the interaction between trademark law and First Amendment free speech protections. Part III identifies three potential standards for constitutional analysis of dilution by tarnishment. Part III further asserts that dilution by tarnishment does not survive any of the three potential tests under the First Amendment. Part IV recommends elimination of dilution by tarnishment and further examination of the constitutionality of dilution by blurring, the only other form trademark dilution. Part V reiterates that dilution by tarnishment restricts protected

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4. See Justice Department drops Redskins name fight, CBS NEWS (Jun. 29, 2017), http://www.cbsnews.com/news/justice-department-drops-fight-over-redskins-name (implying that circuit courts have a significant role in shaping the interpretation of trademarks within First Amendment jurisprudence).


6. See Natter, supra note 2 (suggesting the U.S. Patent and Trademark Office may seek alternative methods for rejecting disparaging, scandalous, or offensive marks).

7. See Ramsey, supra note 3 (questioning the future of dilution by tarnishment).

8. See U.S. CONST. amend. I (prohibiting Congress from “abridging the freedom of speech).

9. See infra Part II (discussing the disconnect between dilution by tarnishment and its alleged harm).

10. See infra Part II (identifying the tension between trademark law and the First Amendment).

11. See infra Part III (asserting that dilution by tarnishment targets viewpoint, expressive speech, or, in the alternative, commercial speech).

12. See infra Part III (arguing dilution by tarnishment constitutes viewpoint discrimination, fails the strict scrutiny expressive speech test, or fails the intermediate scrutiny commercial speech test).

13. See infra Part IV (suggesting the government proactively address the constitutional problems of dilution by tarnishment).
speech and should be struck down as an impermissible violation of the free speech protections guaranteed by the First Amendment.14

I. BACKGROUND

A. Dilution by Tarnishment

1. Source of Law

Dilution became an actionable legal theory in the early 20th century, yet Congress did not codify dilution until passing the Federal Trademark Dilution Act of 1995 [FTDA].15 The FTDA did not explicitly include dilution by tarnishment, so the federal circuits did not uniformly allow dilution by tarnishment claims.16 With the Trademark Dilution Revision Act of 2006 [TDRA], Congress clarified the existence of tarnishment claims, defining dilution by tarnishment as the “association arising from the similarity between a mark or a trade name and a famous mark that harms the reputation of the famous mark.”17

2. Elements

The TDRA sets forth four basic elements necessary for a prima facie dilution by tarnishment claim.18 First, the plaintiff’s mark must be famous, which is a relatively high bar.19 For example, Adidas’s “three stripe” mark is famous while “Coach” failed the fame inquiry because the TDRA does not

14. See infra Part V (calling for the invalidation of dilution by tarnishment).
15. See Frank Schechter, The Rational Basis of Trademark Protection, 40 HARV. L. REV. 813, 831 (1927) (arguing for the protection of a trademark’s uniqueness against unauthorized uses of a mark on unrelated products); Federal Trademark Dilution Act of 1995, Pub. L. No. 104-98 § 3(a), 109 Stat. 985 (codified at 15 U.S.C. §§ 1125(c), 1127), superseded by the Trademark Dilution Revision Act of 2006 (protecting famous marks from attacks to the distinctiveness or reputation of the mark, regardless of confusion); see also U.S. CONST. art. 1, § 8, cl. 3 (granting Congress the authority to regulate commerce).
19. See id. (defining fame as “widely recognized by the general consuming public of the United States as a designation of source . . . “).
allow “niche” fame. Second, the defendant must use the plaintiff’s mark in commerce. Third, the defendant’s first use of the mark must have occurred after the plaintiff’s mark achieves fame. Fourth, the defendant’s use of its lesser known mark will likely cause dilution of the plaintiff’s famous mark.

Courts find a likelihood of dilution by tarnishment when a defendant’s use of its lesser known mark associates a famous mark with “unwholesome” or “shoddy” products. For instance, the Ninth Circuit in V. Secret Catalogue, Inc. noted that an “unwholesome” association generally means the association relates to sex or drugs.

3. *Theories of Harm*

The original theory of dilution’s harm was the gradual whittling away of a mark’s distinctiveness. Dilution by tarnishment departs from this objective by focusing instead on harm to the reputation of a famous mark.

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21. See Trademark Dilution Revision Act of 2006, Pub. L. No. 109-312, § 43, 120 Stat. 1730, 1731 (eliminating the “commercial use in commerce” language); see also Mattel, Inc. v. MCA Records, Inc., 296 F.3d 894, 906-907 (9th Cir. 2002) (finding that, while the distribution of records containing the “Barbie Girl” song fulfilled the use in commerce requirement, MCA’s use of the “Barbie” mark was noncommercial).


24. See V. Secret Catalogue, Inc., 605 F.3d at 387-388 (stating that unwholesome association is a general category within dilution by tarnishment); Dan-Foam A/S v. Brand Named Beds, LLC, 500 F. Supp. 2d 296, 324-326 (S.D.N.Y. 2007) (finding a material quality difference in the lesser known mark’s underlying goods that could harm the famous mark’s reputation).


26. See Schechter, *supra* note 15, at 344 (highlighting the harm to a mark’s distinctiveness as dilution’s original priority).

Congress did not explain the nature of this harm or how this harm occurs, and no clear consensus exists among the courts.\textsuperscript{28}

One theory posits that the defendant’s use of a lesser known mark that is similar to a famous mark activates neurological pathways between the two marks in the mind of consumers.\textsuperscript{29} Under this cognitive model theory, the negative connotation of the defendant’s mark relative to the famous mark persists through the activated neural pathways, degrading the famous mark’s reputation in the mind of the consumer.\textsuperscript{30} However, courts are not always receptive to this cognitive model theory.\textsuperscript{31}

Furthermore, Congress has not clearly identified the victims of dilution by tarnishment’s asserted harm, leaving scholars and practitioners to theorize about whom those victims might be.\textsuperscript{32} First, the tarnishing mark may directly harm the famous mark’s owner by creating a negative association in the consumer’s mind.\textsuperscript{33} The plain meaning of the statute supports this interpretation.\textsuperscript{34} Second, the tarnishing mark may harm the consumer by diminishing the value of the famous mark as a source identifier to the consumer.\textsuperscript{35} This interpretation of the harm’s victims assumes that

Stat. 1730, 1731 (lacking the focus on distinctiveness that dilution by blurring features).


29. See Ty Inc. v. Perryman, 306 F.3d 509, 511 (7th Cir. 2002) (explaining the human mind’s “inveterate tendency” to create associations).


33. See id. at 190 (noting the potential for reputational harm to affect profitability).


consumers value famous trademarks. The TDRA’s legislative history indicates Congress vacillated between which interpretation fuels dilution by tarnishment.

Another theory is that dilution by tarnishment protects famous marks from free riding by lesser known marks. 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. Accordingly, the free riding theory of harm posits dilution by tarnishment is simply an indirect attempt to protect big brands from free riding, despite any rhetoric otherwise.

B. First Amendment and Trademark Law

The First Amendment prohibits federal regulations from impermissibly infringing on the right to freedom of speech. Courts assess Congress’s ability to regulate speech with different levels of scrutiny depending on the characteristics of the speech and of the regulation.

1. Commercial vs. Expressive Speech

Commercial speech warrants less constitutional protection than expressive
speech. Commercial speech usually “does no more than propose a commercial transaction.” Trademarks exist in commerce and identify a unique source of goods or services. Thus, trademarks encourage commercial transactions. However, trademarks often also have inherent expressive meaning.

Federal courts typically look to the trademark’s function on a case-by-case basis, yet the courts disagree on where to draw the line between expressive and commercial speech. After acknowledging the argument that trademarks could be expressive speech, the Supreme Court declined to provide an answer, leaving open the appropriate framework for analyzing First Amendment free speech challenges to the Lanham Act.

2. Potential Standards of Review

Regulation based on viewpoint discrimination demands the application of strict scrutiny constitutional analysis. Viewpoint-based regulations are presumptively facially unconstitutional. Moreover, viewpoint


44. See, e.g., Mattel, Inc. v. MCA Records, 296 F.3d 894, 906 (9th Cir. 2002) (noting that the boundary between commercial and noncommercial speech has not been clearly delineated).


46. See generally J. Thomas McCarthy, 1 McCarthy on Trademarks and Unfair Competition § 31:139 (4th ed. 2008) (asserting that trademarks encourage consumers to enter into commercial transactions by providing product information).

47. See Mattel, Inc., 296 F.3d at 906-07 (finding the use of “Barbie” in the song “Barbie Girl” expressed criticism of what Barbie represents).


49. See Matal v. Tam, 137 S. Ct. 1744, 1765 (2017) (refusing to establish intermediate scrutiny as the appropriate test for judging the constitutionality of trademarks under the Free Speech Clause of the First Amendment).

50. See Gay & Lesbian Students Ass’n v. Gohn, 850 F.2d 361, 366 (8th Cir. 1988) (stating that the government can justify content-based discrimination only when the “regulation is narrowly drawn and is necessary to effectuate a compelling state interest”).

51. See Rosenberger v. Rector & Visitors of Univ. of Va., 515 U.S. 819, 828-29
discrimination analysis applies to both expressive and commercial speech.\textsuperscript{52} Content-based regulation of expressive speech also calls for the application of strict scrutiny constitutional analysis.\textsuperscript{53} To survive a First Amendment challenge, the face of the regulation must be the least restrictive possible means to achieve a compelling government interest.\textsuperscript{54}

When judging the constitutionality of the regulations relating to commercial speech, courts utilize the intermediate scrutiny test articulated in \textit{Central Hudson}.\textsuperscript{55} The four-part test questions whether the face of the regulation directly advances a substantial government interest and is not more extensive than necessary to serve that interest.\textsuperscript{56}

3. \textit{Disparagement and Scandalousness Clauses}

The Disparagement Clause of the Lanham Act allowed the United States Patent and Trademark Office [USPTO] to deny trademark registration to marks disparaging persons alive or dead.\textsuperscript{57} Similarly, the Scandalousness Clause allowed the USPTO to deny registration to scandalous or offensive marks.\textsuperscript{58}

In \textit{Tam}, the Supreme Court struck down the Disparagement Clause because it violated the First Amendment’s protection of free speech.\textsuperscript{59}

\textsuperscript{52} \textit{See} Sorrell v. IMS Health, Inc., 564 U.S. 552, 566 (2011) (explaining that commercial speech is not an exception to the heightened scrutiny viewpoint discrimination requires); \textit{see also} Rosenberger, 515 U.S. at 829-32 (noting that silencing all sides of a debate makes a law more viewpoint-based).

\textsuperscript{53} \textit{See} Turner Broad. Sys. V. F.C.C., 512 U.S. 622, 624 (1994) (explaining that content-based regulations require strict scrutiny review because they suppress ideas).

\textsuperscript{54} \textit{See} United States v. Playboy Entm’t Grp., Inc., 529 U.S. 803, 813 (2000) (asserting that a narrowly tailored regulation is the least restrictive means to achieving the stated interest).


\textsuperscript{56} \textit{See} id. (questioning “whether (1) the speech concerns lawful activity and is not misleading; (2) the asserted government interest is substantial; (3) the regulation directly advances that government interest; and (4) whether the regulation is ‘not more extensive than necessary to serve that interest’”); \textit{see also} Bd. of Tr. of State Univ. of N.Y. v. Fox, 492 U.S. 469, 479-80 (1989) (explaining that the fourth prong does not require the regulation to be the least restrictive means of achieving the desired interest).

\textsuperscript{57} \textit{See} Lanham Act, 15 U.S.C. § 1052(a) (detailing permissible grounds for registration refusal).

\textsuperscript{58} \textit{See} id. (including immoral marks within the scope of required refusals).

\textsuperscript{59} \textit{See} Matal v. Tam, 137 S. Ct. 1744, 1765 (2017) (finding the Disparagement
Specifically, the *Tam* Court found that the Disparagement Clause regulated based on views with which the government did not approve. After *Tam*, the Federal Court of Appeals in *Brunetti* held that the Scandalousness Clause also violated the First Amendment based on the *Tam* opinion.

II. ANALYSIS

A. Dilution by Tarnishment is Facialy Unconstitutional Under the Free Speech Clause of the First Amendment Because It Discriminates Based on Viewpoint.

Dilution by tarnishment violates the First Amendment’s protection of free speech by suppressing particular views on a subject.

1. Dilution by Tarnishment Targets Viewpoint Because It Suppresses a Mark’s Negative View of a Famous Trademark.

A regulation constitutes viewpoint discrimination when the government targets not the subject matter but the particular ideas, opinions, or perspectives of the speaker. Because it regulates based on a perceived negative opinion of the mark, dilution by tarnishment discriminates based on viewpoint.

Viewpoint discrimination is presumptively invalid because it is an “egregious” form of speech regulation. For example, the Supreme Court in *Rosenberger* held that a University’s rules denying funds to a student group based on the group’s determination to write with religious perspectives

Clause discriminated based on viewpoint and failed intermediate scrutiny).

60. See id. at 1765-66 (Kennedy, J., concurring) (asserting viewpoint discrimination alone was sufficient grounds to invalidate the Disparagement Clause).

61. See *In re Brunetti*, 877 F.3d 1330, 1349-50 (Fed. Cir. 2017) (finding the Scandalousness Clause failed either strict or intermediate scrutiny review), cert. granted, 139 S. Ct. 782 (2019).

62. See *Rosenberger v. Rector & Visitors of Univ. of Va.*, 515 U.S. 819, 830-32 (1995) (proclaiming that viewpoint discriminatory legislation is presumptively unconstitutional, regardless of whether the legislation targets one or multiple viewpoints).

63. See *Gay & Lesbian Students Ass’n v. Gohn*, 850 F.2d 361, 366 (8th Cir. 1988) (holding that regulating speech from a group advocating for equal rights regardless of sexual orientation targeted viewpoint).

64. See *Tam*, 137 S. Ct. at 1766-67 (clarifying that regulating based on “the reaction of the speaker’s audience” does not protect a law from viewpoint discrimination).

65. See *Brunetti*, 877 F.3d at 1349 (noting that the parties did not dispute that the Scandalousness Clause would fail strict scrutiny if strict scrutiny applied).
in their journalistic works constituted viewpoint discrimination. While the University did not forbid discussion of religion in general, the University did reject works written with a religious perspective. Prohibiting religious views violated the Free Speech Clause of the First Amendment because it skewed the “marketplace of ideas.”

In the trademark context, the subject of a mark is normally the mental association the mark evokes in consumers. Because marks consist of language, the subject of a mark depends on the meaning behind the language in that mark. Because the meaning of the mark’s language exists in the mind of the consumers exposed to the mark, the subject of the mark depends on the mental association the mark evokes in the mind of consumers.

The First Amendment prohibits the government from impermissibly suppressing marks based on mental associations, the government does not agree with. For example, the mark “The Slants” consists of the word “slants,” which the dictionary often defines as a slope or leaning position. Yet, the USPTO determined the mark ultimately evoked a mental association with the derogation of Asian persons. By denying trademark registration status based on an allegedly disparaging mental association, the government utilized the Disparagement Clause to engage in a “happy talk” regime that

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66. See Rosenberger, 515 U.S. at 831 (identifying the religious perspective as the primary reason for the denial of funds despite arguments otherwise).

67. See id. (clarifying that, while religion can be a vast subject, the student group used religion as a “standpoint from which [they discussed] a variety of subjects”).

68. See id. (emphasizing the harm of viewpoint discrimination that targets all sides of a debate).

69. See Matal v. Tam, 137 S. Ct. 1744, 1751 (2017) (discussing that the purpose of trademark protection stems from the ability of the mark’s words to help distinguish sources of goods from one another in the mind of the consumer).

70. See Mattel, Inc. v. MCA Records, 296 F.3d 894, 900 (9th Cir. 2002) (reconciling language’s role in defining a mark and a mark’s role in informing language).

71. See id. (respecting the public’s role in defining the mental contours of language and trademarks).

72. See Tam, 137 S. Ct. at 1767 (Kennedy, J., concurring) (asserting that the government cannot shield a law from allegations of viewpoint discriminating by citing the negative reactions of the speaker’s audience).

73. See id. at 1753 (noting that a USPTO examining attorney’s first step in determining whether a mark is disparaging is to consult the dictionary definition of the mark’s words, followed by other considerations such as how people use the mark or its words in the marketplace).

74. See id. at 1756 (dismissing any contention that the Disparagement Clause was an anti-discrimination clause).
discriminated against negative viewpoints. 75

The TDRA does not break from this basic framework for marks, but the TDRA alters its application by artificially treating the famous mark as the subject of the lesser known mark. 76 To satisfy the TDRA requirement of an association between the two marks for any dilution claim, courts must examine the content of the lesser known mark relative to that of the famous mark. 77 Because the famous mark is the focus of this analysis, the mental association the famous mark evokes in consumers remains the subject of the famous mark. 78

Conversely, the TDRA shifts the primary focus of the lesser known mark to the effect the lesser known mark has on the public’s mental association toward the famous mark. 79 The TDRA defines dilution by tarnishment as an “association arising from the similarity between a [lesser known mark] and a famous mark that harms the reputation of the famous mark.” 80 Because the marks must be sufficiently similar to evoke a mental association while only the famous mark’s reputation warrants legal protection, the TDRA effectively treats the famous mark as the relevant subject of the lesser known mark. 81 For example, the Sixth Circuit in *Moseley* found enough similarity between “Victor’s Secret” and “Victoria’s Secret” for Victoria’s Secret to bring a dilution by tarnishment claim because a consumer could create a mental association between the two marks, regardless of any consumer confusion. 82 Thus, the TDRA treats the famous mark as the subject of the defendant’s mark. 83

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75. See id. at 1766 (Kennedy, J., concurring) (recognizing that viewpoint neutral legislation protects the speaker’s “right to create and present argument for particular positions in particular ways, as the speaker chooses”).


77. See, e.g., Mattel, Inc. v. MCA Records, Inc., 296 F.3d 894, 903-04 (9th Cir. 2002) (noting that the parties did not dispute the marks’ similarity).


79. See id. (declaring further that mere association is not enough to establish an actionable dilution claim).


81. See Nissan Motor Co. v. Nissan Comput. Corp., 378 F.3d 1002, 1012 (9th Cir. 2004) (“The point of dilution law is to protect the owner’s investment in his mark”).

82. See *V Secret Catalogue*, 605 F.3d at 389 (assuming no consumer confusion existed between the two marks).

83. See Mattel, Inc. v. MCA Records, 296 F.3d 894, 904 (9th Cir. 2002) (going
Furthermore, dilution by tarnishment suppresses speech based on viewpoint by silencing lesser known marks that likely offer a negative perspective on the famous mark.\(^{84}\) While the TDRA redirects the analytical focus of the lesser known mark, the lesser known mark retains its own, original mental association in the mind of its consumers.\(^{85}\) Accordingly, Victor’s Secret continued to evoke a mental association with sexual material; the court merely conducted its legal analysis as if Victoria’s Secret was the subject of the Victor’s Secret mark, as the TDRA commanded.\(^{86}\)

Although it is not the subject of the defendant’s mark in a dilution claim, the mental association that the defendant’s mark elicits determines the viewpoint that the defendant’s mark takes in a dilution by tarnishment claim.\(^{87}\) Because dilution by tarnishment prohibits associations harming the reputation of the famous mark, courts look to whether the defendant’s mark evokes a negative mental association that would likely harm the mental association inspired by the famous mark.\(^{88}\) The specific viewpoint depends on the nature of the mark, yet the obligation for courts to look for a negative mental association means that dilution by tarnishment necessarily regulates based on viewpoint.\(^{89}\) Accordingly, in *V. Secret Catalogue, Inc.*, the Sixth

\(^{84}\) *See* Matal v. Tam, 137 S. Ct. 1744, 1767 (2017) (Kennedy, J., concurring) (proposing that a law mandating positivity silences dissent and distorts the marketplace of ideas).

\(^{85}\) *See, e.g.*, Pfizer, Inc. v. Sachs, 652 F. Supp. 2d 512, 525 (S.D.N.Y. 2009) (identifying the mental association that “Viva Viagra” evokes from use at various adult conventions before examining the effect of that mental association on the reputation of the famous mark “Viagra”).

\(^{86}\) *See V Secret Catalogue*, 605 F.3d at 388 (acknowledging that Victor’s Secrets evokes a particular mental association from consumers for its sale of sex-related products, but focusing on that mental association’s effect on Victoria’s Secret to determine legal liability).

\(^{87}\) *Compare id.* (perceiving a sex-related, negative mental association), *with* Coca-Cola Co. v. AlmaLeo U.S.A., Inc., 719 F. Supp. 725, 728 (N.D. Ill. 1989) (perceiving a drug-related, negative mental association).

\(^{88}\) *See V Secret Catalogue*, 605 F.3d at 389 (holding that a lesser known mark’s sex-related association creates a rebuttable presumption for a likelihood of tarnishment of the famous mark).

\(^{89}\) *See id.* at 389 (establishing that “any new mark with a lewd or offensive-to-some sexual association raises a strong inference of tarnishment”); *see also* Dan-Foam A/S v. Brand Named Beds, LLC, 500 F. Supp. 2d 296, 326 (S.D.N.Y. 2007) (remanding because a material question of fact remained as to whether a jury could form negative opinions of the famous mark after interacting with the lesser known mark and its lower quality products).
Circuit silenced the lesser known mark “Victor’s Secret” because the court thought the mark’s sexually charged association evoked a negative association that could likely tarnish the reputation of Victoria’s Secret.90

While Congress’s recorded discussions of dilution by tarnishment are sparse, the TDRA’s legislative history supports the viewpoint-targeted characteristic of dilution by tarnishment.91 For example, Mr. Conyers explicitly listed a “disparaging usage of a same or similar mark by others” as an example explaining the merits of dilution by tarnishment.92 The explicit likening of dilution by tarnishment to disparagement, especially in the absence of other clear congressional motivations otherwise, indicates Congress likely intended to regulate based on viewpoint.93

Dilution by tarnishment targets viewpoint for government regulation by suppressing a mark’s unwholesome viewpoint toward a famous trademark.94 Therefore, dilution by tarnishment must survive strict scrutiny review to be constitutional under the First Amendment.95


The Government must demonstrate a compelling interest behind a regulation that discriminates based on viewpoint for that regulation to survive strict scrutiny review.96

90. See V Secret Catalogue, 605 F.3d at 389 (discounting the importance of the fact that the owner of “Victor’s Secret” shared the name Victor).

91. See H.R. Rep. No. 109-23, at 4 (2005) (“The purpose of the FTDA is to protect famous trademarks [. . .] from subsequent uses that blur the distinctiveness of the mark or tarnish or disparage it, even in the absence of a likelihood of confusion”) (emphasis added).


93. See V Secret Catalogue, 605 F.3d at 389 (emphasizing that Congress’s revision of the TDRA in direct response to Moseley v. V. Secret Catalogue, 537 U.S. 418 (2003) indicated Congress intended Victor’s Secret to fall under dilution by tarnishment’s scope of speech-suppressing liability).


95. See Rosenberger v. Rector & Visitors of Univ. of Va., 515 U.S. 819, 831-32 (1995) (maintaining that the government’s impermissible suppression of even one perspective within a subject constitutes viewpoint discrimination).

96. See, e.g., Gay & Lesbian Students Ass’n v. Gohn, 850 F.2d 361, 366 (8th Cir.
In general, the government has a compelling interest in promoting the orderly flow of commerce.97 However, the government does not have a compelling interest in regulating offensive speech because the First Amendment protects offensive speech.98 In Tam, the Supreme Court found that the government does not have a compelling interest for regulating disparaging speech.99 Similarly, in Brunetti, the Federal Court of Appeals found no compelling government interest for regulating scandalous speech.100 Although the Brunetti court contemplated the government’s asserted interest “in the orderly flow of commerce”, the court held that the government failed to establish how this interest existed in the regulation of scandalous speech.101

While tarnishing marks technically affect the flow of commerce, the target of dilution by tarnishment is the negative, unwholesome nature of the lesser known mark.102 Because negative, unwholesome speech and disparaging or scandalous speech each represent speech the government does not agree with, the governmental interest behind dilution by tarnishment parallels the government’s attempt to establish a compelling interest in regulating disparaging or scandalous speech.103 Like disparaging and scandalous speech, tarnishing speech communicates a psychologically negative or

97. See U.S. CONST. art. I, § 8, cl. 3 (granting Congress the authority to regulate commerce).
98. See Tam, 137 S. Ct. at 1764-65 (distinguishing the regulation of offensive speech from the regulation of discriminatory conduct).
99. See id. at 1768 (Kennedy, J., concurring) (announcing that the government’s purpose did not fall within the narrow exception to viewpoint discrimination because trademarks are not government speech).
100. See In re Brunetti, 877 F.3d 1330, 1351 (Fed. Cir. 2017) (holding that the government does not have a substantial interest in protecting the public from “off-putting” marks), cert. granted, 139 S. Ct. 782 (2019).
101. See id. (observing that regulating the orderly flow of commerce might have constituted a substantial interest had the regulation actually advanced the orderly flow of commerce).
102. See V Secret Catalogue, Inc. v. Moseley, 605 F.3d 382, 389 (6th Cir. 2010) (contending that Congress designed the TDRA “to protect trademarks from any unfavorable sexual associations”).
103. Compare 152 CONG. REC. H6964 (daily ed. Sept. 25, 2006) (stating that the TDRA “clearly codifies the cause of action of dilution by tarnishment in order to prevent harm to a trademark owner’s reputation, resulting, for example, from a disparaging usage of a same or similar mark by others”) (emphasis added), with Brunetti, 877 F.3d at 1355 (concluding that the government’s proposed interests in regulating disparaging or scandalous speech “boil down to permitting the government to burden speech it finds offensive”).
harmful meaning that the government does not support.\textsuperscript{104} Because the government has no compelling interest in regulating disparaging or scandalous speech, the government has no compelling interest in regulating tarnishing speech.\textsuperscript{105}

Without a compelling governmental interest, dilution by tarnishment cannot survive strict scrutiny.\textsuperscript{106} Therefore, dilution by tarnishment violates the Free Speech Clause of the First Amendment.\textsuperscript{107}

3. \textit{Dilution by Tarnishment Fails Strict Scrutiny Because It Is Not Narrowly Tailored to Achieve a Compelling Government Interest.}

For a regulation to survive strict scrutiny, Congress must narrowly tailor the regulation to achieve a compelling governmental interest.\textsuperscript{108} Under strict scrutiny, a narrowly tailored regulation uses the least restrictive means to achieve the compelling governmental interest.\textsuperscript{109} Dilution by tarnishment, as articulated in the TDRA, does not use the least restrictive means possible because dilution by tarnishment could apply only to lesser known marks that actually tarnish by causing harm to the famous mark.\textsuperscript{110}

In 2003, the Supreme Court in \textit{Moseley} held that dilution required establishing actual harm.\textsuperscript{111} Although courts did not uniformly recognize the

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  \item \textsuperscript{104} Compare \textit{Tam}, 137 S. Ct. at 1757 (concluding that the disparagement clause applies to marks that disparage the members of a racial or ethnic group), \textit{with V. Secret Catalogue, Inc.}, 605 F.3d at 388 (insisting that an association with “lewd or bawdy sexual activity disparages and defiles the famous mark . . . “).
  \item \textsuperscript{105} See \textit{Tam}, 137 S. Ct. at 1764-65 (asserting that the Disparagement Clause did not advance even a substantial interest under intermediate scrutiny); \textit{Brunetti}, 877 F.3d at 1351 (declaring that “the government does not have substantial interest in promoting certain trademarks over others”).
  \item \textsuperscript{106} See \textit{Tam}, 137 S. Ct. at 1766 (denouncing the government’s ability to mandate positivity).
  \item \textsuperscript{107} See \textit{Gay & Lesbian Students Ass’n. v. Gohn}, 850 F.2d 361, 366 (8th Cir. 1988) (requiring the government be able to articulate a compelling governmental interest for enacting a regulation in question).
  \item \textsuperscript{108} See \textit{Turner Broad. Sys. v. F.C.C.}, 512 U.S. 622, 652 (1994) (explaining that the Court will not strike down a constitutional statute based on an alleged illicit legislative motive).
  \item \textsuperscript{109} See \textit{United States v. Playboy Entm’t Grp., Inc.}, 529 U.S. 803, 813 (2000) (asserting that the regulation also needs to be the least restrictive means to achieving the stated interest).
  \item \textsuperscript{110} See \textit{Tam}, 137 S. Ct. at 1764-65 (finding the Disparagement Clause was not the least restrictive possible method of regulation).
  \item \textsuperscript{111} See \textit{Moseley v. V. Secret Catalogue}, 537 U.S. 418, 434 (2003) (positing that circumstantial evidence may have the capacity to reliably prove actual harm).
\end{itemize}
existence of dilution by tarnishment claims, the Supreme Court’s holding extended the actual harm requirement to dilution by tarnishment as well as to dilution by blurring. In response, Congress changed the statute to nullify the Supreme Court’s holding in *Moseley* and codify a likelihood of harm standard.  

Because dilution by tarnishment requires only a likelihood of reputational harm, courts often rely solely on the negative viewpoint to calculate whether a likelihood of reputational harm exists. Relying on the lesser known mark’s alleged negative viewpoint not only allows for more dilution by tarnishment claims by decreasing the evidentiary burden on the famous mark, but also condones a margin of error where the court suppresses lesser known marks that ultimately would not tarnish the famous mark’s reputation. Furthermore, the TDRA’s legislative history presents no evidence refuting the viability of the actual harm standard to effectuate the desired governmental interest.

Returning to the actual harm standard would narrow the reach of dilution by tarnishment by decreasing the ability for a famous mark to rely solely on the regulation’s discrimination against negative viewpoints to succeed and reducing the permissible margin of error. Therefore, the TDRA’s version of dilution by tarnishment is not the least restrictive regulation possible and in turn, violates the First Amendment’s Free Speech protections.

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112. See id. (emphasizing the need for proof of actual harm despite the potential difficulties in obtaining it).


114. See, e.g., V Secret Catalogue, Inc. v. Moseley, 605 F.3d at 389 (6th Cir. 2010) (finding a likelihood of dilution by tarnishment without evidence of actual dilution by tarnishment).

115. See id. at 394 (Moore, J., dissenting) (criticizing the majority for requiring only a “mere possibility” of tarnishment because the lesser known mark’s tarnishing effect was nothing more than speculative).

116. See Farley, supra note 28, at 1181-83 (positing that Congress enacted the TDRA because of the aggressive lobbying efforts by owners of famous marks to protect the goodwill of those famous marks).


118. See Matal v. Tam, 137 S. Ct. 1744, 1767 (2017) (Kennedy, J., concurring) (denouncing governmental attempts to burden speech based on the government’s disapproval with the speech’s perspective).
B. Dilution by Tarnishment Also Fails Strict Scrutiny Because It Impermissibly Regulates the Expressive Content of a Mark.

Even if dilution by tarnishment does not discriminate based on viewpoint, dilution by tarnishment still fails strict scrutiny because it impermissibly regulates the expressive content of speech.\(^{119}\) By failing strict scrutiny, dilution by tarnishment violates the Free Speech Clause of the First Amendment.\(^{120}\)

1. Dilution by Tarnishment Regulates the Expressive Content of Speech Because It Does Not Target the Commercial, Source Identifying Function of a Mark.

A regulation targets the expressive content of speech when the content does more than propose a commercial transaction.\(^{121}\) Content-based regulation of expressive speech is presumptively unconstitutional, so the regulation must survive strict scrutiny to remain in effect.\(^{122}\)

Commercial speech content only proposes an immediate or eventual commercial transaction.\(^{123}\) When it created the commercial speech test in \textit{Central Hudson}, the Supreme Court invalidated a regulation banning all public utility advertising promoting the use of electricity because it impermissibly restricted commercial speech.\(^{124}\) The promotional advertising invited consumers to consider purchasing the utility.\(^{125}\) Although the advertisement did not propose an immediate commercial transaction, the only purpose of the advertisement’s regulated content was to eventually lead

\(^{119}\) See \textit{In re Brunetti}, 877 F.3d 1333, 1349 (Fed. Cir. 2017) (noting that the parties did not dispute that the Scandalousness Clause fails strict scrutiny if the regulation targeted expressive content of trademarks), \textit{cert. granted}, 139 S. Ct. 782 (2019).

\(^{120}\) See \textit{United States v. Playboy Entm’t Grp., Inc.}, 529 U.S. 803, 813 (2000) (noting that the right of expression generally prevails over content-based speech restrictions shielding the sensibility of the audience).


\(^{122}\) See \textit{Playboy}, 529 U.S. at 813 (asserting that the content-based regulation also needs to be the least restrictive means to achieving the compelling governmental interest).

\(^{123}\) See \textit{Va. State Bd. of Pharmacy}, 425 U.S. at 762 (defining commercial speech for the first time).


\(^{125}\) See \textit{id.} at 567 (maintaining that this invitation exists even for monopolies because the customer may increase, decrease, or eliminate their purchasing based on the promotional advertising).
consumers to engage in a commercial transaction. Accordingly, any content of speech that does more than immediately or eventually propose a commercial transaction is fully protected expressive content.

Because speech can possess both commercial and expressive content, courts examine the function of contested speech within the context of each case. Thus, courts routinely grant limited constitutional protection to speech that functions only to propose a commercial transaction, despite the speech’s potential expressive capacity outside the scope of the case. Conversely, courts grant full constitutional protection when the speech does not propose a commercial transaction, despite its existence in commerce.

When speech’s commercial content and expressive content function simultaneously, the First Amendment protects the expressive content over the commercial content. For example, the Ninth Circuit in Hoffman held that the First Amendment protected a magazine article containing altered images of celebrities. Although the altered images served the commercial purpose of drawing in consumer attention and selling more copies of the magazine, the Court decided the expressive contents—humor and editorial representation—warranted full constitutional protection.

The expressive content’s priority over the commercial content is important because trademarks can possess both commercial and expressive content.

126. See id. at 561-62 (initiating commercial speech constitutional analysis of the government’s regulation because the regulation applied only to promotional advertising).

127. See id. at 566 (defining expressive speech relative to commercial speech).

128. See id. at 561-63 (distinguishing the requisite judicial analysis for regulation of advertisements functioning to promote a commercial product from that of advertisements functioning to inform consumers about a topic).

129. Compare id. at 563 (avoiding commercial speech constitutional analysis of informational advertisements that did not seek to increase total sales), with Va. State Bd. of Pharmacy v. Va. Citizens Consumer Council, 425 U.S. 748, 761 (1976) (finding that a television commercial informing the public about prescription drug pricings constituted commercial speech because the pharmacist intended for the television commercial to increase sales).


131. See Hoffman v. Capital Cities/ABC, 255 F.3d 1180, 1189 (9th Cir. 2001) (holding that expressive speech gets full First Amendment protection).

132. See id. at 1183 (addressing the right to publicity suit).

133. See id. at 1185-86 (recognizing the article included protected forms of expression).

134. See In re Brunetti, 877 F.3d 1330, 1349 (Fed. Cir. 2017) (arguing that
In *Tam*, the Supreme Court recognized this dichotomy, yet declined to supply any responsive analytical framework at that moment.\(^{135}\)

A mark’s commercial content reigns when the mark’s only function is to identify the source of the mark’s underlying goods and services.\(^{136}\) By identifying the source of certain goods or services, the mark invites its viewers to consider engaging in a commercial transaction with that source.\(^{137}\) Accordingly, trademark law protects the validity of the mark’s source identifying function.\(^{138}\) For example, a typical trademark infringement lawsuit questions whether the defendant’s use of its mark in the marketplace is likely to confuse or mislead relevant consumers as to the source of its underlying goods or services.\(^{139}\) The expressive content of the mark helps inform the court’s analysis because each marks’ expressive meaning affects consumers’ understanding of and ability to distinguish between the marks.\(^{140}\)

However, constitutionality under the First Amendment Free Speech Clause is not an issue in typical trademark infringement cases because the expressive content is useful only to the extent it helps determine consumers’ ability to recognize the mark as a distinct source indicator.\(^{141}\) Moreover, trademark law’s power to suppress marks in such situations extends only to

trademarks’ commercial and expressive contents are often intertwined), *cert. granted*, 139 S. Ct. 782 (2019).

135. *See Matal v. Tam*, 137 S. Ct. 1744, 1763-65 (2017) (refusing to decide whether strict or intermediate scrutiny was appropriate).

136. *See McCarthy*, *supra* note 46, at § 31:139 (arguing the mark is commercial when identifying and distinguishing the source of commercial goods or services by providing information on with whom to enter a commercial transaction).

137. *See Mattel, Inc.*, 296 F.3d at 906 (acknowledging that using “Barbie” in the song title would attract attention, proposing further commercial transactions).


139. *See generally* Virgin Enterprises Ltd. v. Nawab, 335 F.3d 141 (2d Cir. 2003) (applying the six likelihood of confusion factors Judge Friendly established in the seminal case Polaroid Corp. v. Polaroid Electronics Corp., 287 F.2d 492 (2d Cir. 1961)).

140. *See Physicians Formula Cosmetics v. West Cabot Cosmetics*, 857 F.2d 80, 84 (2d Cir. 1977) (analyzing the similarity of meaning between the mark “PHYSICIANS FORMULA” and the mark “PHYSICIANS & SURGEONS” while applying the Polaroid likelihood of confusion test); see also *Two Pesos*, 505 U.S. at 796 (explaining that trademark law does protect descriptive marks that have acquired distinctiveness as secondary meaning in the minds of consumers).

141. *See Physicians Formula Cosmetics*, 857 F.2d at 84 (limiting legal protection of the plaintiff’s mark “to preventing competing products from using a mark that conveys the concept of medical endorsement in language likely to confuse a purchaser as to the source of the product”) (emphasis added).
the source identifying function of the marks’ commercial content.\textsuperscript{142}

Because the mark’s commercial content reigns only when the mark’s sole function is to identify the source of its underlying goods or services, the mark’s expressive content necessarily reigns in all other circumstances.\textsuperscript{143} For example, the Ninth Circuit recognized the song “Barbie Girl” used the mark “Barbie” in the title for both commercial and expressive functions.\textsuperscript{144} Like the court in Hoffman, the Ninth Circuit dismissed the case, despite the mark’s promotional advertising function, because the First Amendment prioritizes a mark’s expressive function over the commercial function.\textsuperscript{145} The Ninth Circuit listed some clear examples of a mark’s potential expressive function, such as political advocacy, but this list was not exhaustive.\textsuperscript{146} Thus, the First Amendment entitles a mark to full constitutional protection unless the mark has no meaning, under the circumstances, beyond its source identifying function.\textsuperscript{147}

Congress did not create dilution by tarnishment to regulate a mark’s commercial, source identifying content.\textsuperscript{148} In typical trademark infringement, Congress cares about preventing consumers’ confusion as to the source of a trademark.\textsuperscript{149} Even in dilution by blurring, Congress cares

\begin{itemize}
\item \textsuperscript{142} See Virgin Enterprises Ltd., 335 F.3d at 152 (granting a preliminary injunction to prohibit the defendant from continuing to use its infringing mark in commerce because of the likelihood of consumer confusion from such use).
\item \textsuperscript{143} See, e.g., Trademark Dilution Revision Act of 2006, § 43(c), 120 Stat. 1730, 1731 (codified as amended in scattered sections of 26 U.S.C.) (excluding from dilution liability any fair use, all news reporting and commentary, and any noncommercial use). Cf. Mattel, Inc. v. MCA Records, Inc., 296 F.3d 894, 904-05 (9th Cir. 2002) (identifying the conflict between the TDRA’s use in commerce requirement and the TDRA’s noncommercial use exception to liability and then adopting First Amendment case law’s commercial speech versus expressive speech paradigm).
\item \textsuperscript{144} See Mattel, Inc., 296 F.3d at 906 (comparing the mark’s commercial, attention-drawing purpose with its the humorous, editorial purpose).
\item \textsuperscript{145} See id. at 907 (exempting the mark from any dilution claim).
\item \textsuperscript{146} See id. at 904-05 (grappling with the tension between the First Amendment and the absence of an objective to prevent consumer confusion in the purpose behind dilution law).
\item \textsuperscript{147} See id. at 900-01 (announcing that a mark owner’s right to silence other marks ceases “whenever the public imbibes [the first] mark with a meaning beyond its source-identifying function”).
\item \textsuperscript{148} See Trademark Dilution Revision Act of 2006, § 43, 120 Stat. 1730, 1731 (codified as amended in scattered sections of 26 U.S.C.) (creating dilution by blurring to prohibit dilution related to the degradation of a famous mark’s source identifying capacity).
\item \textsuperscript{149} See Lanham Act, 15 U.S.C. § 1125(a)(1)(A) (targeting the affiliation, connection, or association of a mark or the origin, sponsorship, or approval of a mark’s
\end{itemize}
about preventing the weakening of a famous mark’s source identifying capabilities.\textsuperscript{150} In both situations, Congress regulates a mark’s commercial content because the regulation attaches to the trademark’s central function as a source identifier.\textsuperscript{151}

Conversely, in dilution by tarnishment, Congress cares about preventing the unwholesome, negative nature of a lesser known mark from harming the reputation of a famous mark.\textsuperscript{152} Because Congress’s concern does not attach to the lesser known mark’s commercial, source identifying function, dilution by tarnishment inherently targets an expressive function of the lesser known mark.\textsuperscript{153} Congress did not mention a mark’s capacity to identify a source as a relevant consideration for dilution by tarnishment in either the face of the TDRA or the TDRA’s legislative history.\textsuperscript{154} Thus, trademark law’s protection of the source identifying function of a mark does not attach to dilution by tarnishment.\textsuperscript{155}

Instead, dilution by tarnishment regulates the expressive content of speech because it targets the lesser known mark’s perceived negative mental association.\textsuperscript{156} For example, the Ninth Circuit in \textit{V. Secret Catalogue, Inc.} held that “Victor’s Secret” constituted dilution by tarnishment because the mark evoked negative association in the mind of consumers.\textsuperscript{157} Specifically,

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  \item \textsuperscript{151} See \textit{Mattel Inc.}, 296 F.3d at 905 (conceding that dilution by blurring’s source designating function protects only trademark owners while typical trademark infringement also protects consumers).
  \item \textsuperscript{153} See \textit{Mattel Inc.}, 296 F.3d at 905 (defining “expression” with an open-ended list of examples, focusing uniformly on the expression’s divergence from the mark’s commercial, source identifying function).
  \item \textsuperscript{154} See, e.g., 152 \textit{Cong. Rec.} H6964 (daily ed. Sept. 25, 2006) (statement of Sen. Sensenbrenner) (advancing only that dilution by blurring regulates conduct relating to the distinctiveness of the famous mark).
  \item \textsuperscript{155} See \textit{V. Secret Catalogue, Inc.} v. Moseley, 605 F.3d 382, 389 (6th Cir. 2010) (acknowledging that dilution by tarnishment protects the famous mark’s reputation and symbolism).
  \item \textsuperscript{156} See \textit{In re Brunetti}, 877 F.3d 1330, 1349 (Fed. Cir. 2017) (suggesting, but not holding, that the regulation of offensive speech inherently targets expressive content), \textit{cert. granted}, 139 S. Ct. 782 (2019).
  \item \textsuperscript{157} See \textit{V. Secret Catalogue, Inc.}, 605 F.3d at 389 (requiring only a likelihood of tarnishment).
\end{itemize}
“Victor’s Secret” elicited an association with sex because the underlying store sold sex-related products.158 Because the court interpreted Congress’s intent for enacting the TDRA as the protection of famous trademarks from “any unfavorable sexual associations”, the court used dilution by tarnishment to suppress the lesser known mark based on the lesser known mark’s sex-related expressive content.159 Thus, dilution by tarnishment targets the expressive rather than the commercial content of marks, violating the Free Speech Clause of the First Amendment.160

2. Dilution by Tarnishment Fails Strict Scrutiny for Content-Based Expressive Speech Regulations Because It Does Not Serve a Compelling Governmental Interest.

Much like viewpoint discrimination, regulation of a mark’s expressive content must further a compelling governmental interest to survive strict scrutiny.161 The alleged governmental interest for dilution by tarnishment remains the same for content-based regulations as for viewpoint discrimination: the constitutionality tests differ primarily in the circumstances necessary to trigger strict scrutiny.162

The Supreme Court’s holding in Tam and the Federal Court of Appeal’s extension of Tam in Brunetti control the disposition of dilution by tarnishment.163 The Brunetti court contemplated the government’s asserted interest “in the orderly flow of commerce”, yet the court did not find even a substantial governmental interest because the government failed to articulate how this interest existed in the suppression of scandalous speech.164

158. See id. at 387-88 (charting the consensus in the case law that an association with sex-related products is negative).
159. See id. (commenting that any mark with “ude or offensive-to-some sexual associations” would likely constitute tarnishment).
161. See United States v. Playboy Entm’t Grp., Inc., 529 U.S. 803, 813 (2000) (asserting that the regulation also needs to be the least restrictive means to achieving the stated interest).
162. See In re Brunetti, 877 F.3d 1330, 1342 (Fed. Cir. 2017) (implying the Scandalousness Clause would also fail strict scrutiny if the Scandalousness Clause regulated the expressive content of the mark), cert. granted, 139 S. Ct. 782 (2019).
163. See Tam, 137 S. Ct. at 1768 (Kennedy, J., concurring) (finding neither a compelling interest behind the government’s censorship nor an exception to exempt the government from the application of strict scrutiny analysis); see also Brunetti, 877 F.3d 1330 (holding that the government does not have a substantial interest in promoting certain trademarks over others or in protecting the public from “off-putting” marks).
164. See Brunetti, 877 F.3d at 1349 (noting that regulating the orderly flow of
Furthermore, a purported Congressional interest in regulating the orderly flow of commerce is not compelling because dilution by tarnishment merely regulates the expressive content of certain allegedly negative marks, rather than the mark’s commercial, source identifying content.165

Although allegedly tarnishing lesser known marks exist in and affect the flow of commerce, the government does not have a compelling interest backing dilution by tarnishment because dilution by tarnishment targets a lesser known mark’s expressive content, rather than the lesser known mark’s commercial, source identifying content.166 The Disparagement and Scandalousness Clauses similarly violated the First Amendment because the government failed to articulate a single compelling governmental interest.167 Just as the government has no compelling interest in regulating disparaging or scandalous speech, the government similarly has no compelling interest in regulating tarnishing speech.168 Therefore, dilution by tarnishment does not serve a compelling governmental interest.169

The government cannot regulate a mark based on the mark’s expressive content, even if that content is disparaging or offensive to many people.170 Due to the government’s lack of a compelling interest in regulating the expressive content of a mark, dilution by tarnishment violates the First Amendment’s Free Speech protections.171

commerce would have constituted a substantial interest, had it existed).

165. See U.S. Const. art. I, § 8, cl. 3 (granting Congress the authority to regulate commerce); see also Tam, 137 S. Ct. at 1764-65 (distinguishing regulating offensive speech from regulating discriminatory conduct).

166. See V. Secret Catalogue, Inc. v. Moseley, 603 F.3d 382, 389 (6th Cir. 2010) (contending Congress designed the TDRA “to protect trademarks from any unfavorable sexual associations”).

167. See Tam, 137 S. Ct. at 1764-65 (asserting that the Disparagement Clause did not advance even a substantial interest under intermediate scrutiny); Brunetti, 877 F.3d at 1350 (declaring that “the government does not have substantial interest in promoting certain trademarks over others”); see also 152 Cong. Rec. H6964 (daily ed. Sept. 25, 2006) (using “tarnishing” and “disparaging” interchangeably when explaining dilution by tarnishment).

168. Compare Tam, 137 S. Ct. at 1757 (concluding that the disparagement clause applies to marks that disparage the members of a racial or ethnic group), with V. Secret Catalogue, Inc., 603 F.3d at 388 (insisting that an association with “lewd or bawdy sexual activity disparages and defiles the famous mark . . . “).

169. See Tam, 137 S. Ct. at 1766 (Kennedy, J., concurring) (denouncing the government’s ability to mandate positivity).

170. See id. at 1767 (suggesting the suppression of offensive ideas is especially dangerous because the audience’s reaction to the offense may spurn more thoughtful and tolerant positions).

171. See id. (noting the long history of cases prohibiting the government from

Congress must utilize the least restrictive means of achieving a compelling governmental interest for that regulation to survive strict scrutiny.\(^{172}\) Under the TDRA, dilution by tarnishment is not the least restrictive means possible because Congress could amend the TDRA to require proof of actual dilution.\(^{173}\)

Before the TDRA, dilution required the plaintiff to establish actual reputational harm because a likelihood of harm was too speculative, thereby stifling fair competition.\(^{174}\) The Supreme Court in *Moseley* clarified this requirement and extended it to dilution by tarnishment claims.\(^{175}\) In response, Congress changed the statute for dilution by tarnishment to require only a likelihood of reputational harm.\(^{176}\)

Because the actual harm standard presented Congress with a plausible, less restrictive method for serving Congress’s alleged interest, dilution by tarnishment fails strict scrutiny analysis.\(^{177}\) In *Playboy Entm’t Grp. Inc.*, the Supreme Court held that the government bears the burden of proving a less restrictive alternative regulation is ineffective when the regulation targets the expressive content of speech.\(^{178}\) However, Congress did not articulate a

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suppressing speech based on predicted audience reactions).

172. See *Turner Broad. Sys. v. F.C.C.*, 512 U.S. 622, 624 (1994) (announcing strict scrutiny applies to governmental suppression or burdening of speech because of the speech’s content); *United States v. Playboy Entm’t Grp., Inc.*, 529 U.S. 803, 813 (2000) (asserting that the government must use the least restrictive method to advance its proposed interest).

173. See *Tam*, 137 S. Ct. at 1764-65 (finding the Disparagement Clause was not the least restrictive possible method of regulation).


175. See id. at 434 (emphasizing the need for proof of actual harm despite the potential difficulties in obtaining proof of actual harm).

176. See *Trademark Dilution Revision Act*, Pub. L. No. 109-312, § 43, 120 Stat. 1730, 1730 (codified as amended in scattered sections of 26 U.S.C.) (changing the standard after the Supreme Court held the FTDA required actual harm); see also *V Secret Catalogue, Inc. v. Moseley*, 605 F.3d 382, 389 (6th Cir. 2010) (accepting Congress’s intent to enact the TDRA despite the Supreme Court’s legitimate concerns about the risk of utilizing the easily surmountable likelihood of tarnishment standard).


178. See *United States v. Playboy Entm’t Grp. Inc.*, 529 U.S. 803, 823 (2000) (indicating that the government, not the District Court, bears the responsibility to prove
reason why the actual harm standard might be ineffective.\textsuperscript{179} Furthermore, the actual harm standard is less restrictive than the likelihood of harm standard because the actual harm standard eliminates the ability to presume harm based only on the expressive content of the lesser known mark.\textsuperscript{180}

Without a compelling reason behind Congress’s switch to the likelihood of harm standard, dilution by tarnishment fails strict scrutiny and violates the First Amendment’s protection of expressive speech.\textsuperscript{181}

C. Alternately, Dilution by Tarnishment Fails Intermediate Scrutiny for Commercial Speech Regulations Because Congress Did Not Narrowly Tailor It to Advance a Substantial Governmental Interest.

While dilution by tarnishment likely regulates a mark’s viewpoint or a mark’s expressive content, dilution by tarnishment nonetheless fails intermediate scrutiny for commercial speech regulations.\textsuperscript{182} Dilution by tarnishment does not advance even a substantial governmental interest and is not narrow enough to survive the Central Hudson intermediate scrutiny test.\textsuperscript{183} Therefore, dilution by tarnishment still violates the Free Speech Clause of the First Amendment.\textsuperscript{184}

First, a commercial speech regulation survives intermediate scrutiny only when the regulation advances a substantial governmental interest.\textsuperscript{185} The government does not have a substantial interest in protecting the public from an alternative would be ineffective).

\textsuperscript{179} See Farley, supra note 28, at 1181-83 (suggesting that trademark owners lobbied fiercely for dilution law to protect their marks’ goodwill).

\textsuperscript{180} See Moseley v. V Secret Catalogue Inc., 537 U.S. 418, 434 (2003) (maintaining that the difficulties inherent to demonstrating actual dilution do not cause the actual dilution standard to be ineffective).

\textsuperscript{181} See Playboy, 529 U.S. at 826-27 (refuting any perception that “shabby, offensive, or even ugly” speech does not deserve full constitutional protection, even when the desired legislation addressed a serious problem).


\textsuperscript{184} See Matal v. Tam, 137 S. Ct. 1744, 1764-65 (2017) (holding invalid the Disparagement Clause under the Central Hudson intermediate scrutiny test).

\textsuperscript{185} See Cent. Hudson Gas & Elec. Corp., 447 U.S. at 568-69 (stating that the regulation of energy consumption is a substantial interest because the country depends on energy resources, and the regulation of utility rates was a substantial interest because it involves issues of economic supply and distributional fairness).
disparaging or offensive speech because doing so impermissibly suppresses
the freedom to express ideas.\textsuperscript{186} If dilution by tarnishment targets the
commercial content of speech, then the government has a stronger argument
for an interest in promoting the orderly flow of commerce because the marks
are acting within their source identifying functions.\textsuperscript{187} However, the
government still does not have a substantial interest in regulating tarnishing
marks because dilution by tarnishment puts the government in a position of
protecting famous marks over perceived negative marks, and “the
government does not have a substantial interest in promoting certain
trademarks over others.”\textsuperscript{188}

Second, the government must narrowly tailor a regulation of commercial
speech for that regulation to survive intermediate scrutiny; unlike strict
scrutiny, intermediate scrutiny does not require the least restrictive means to
achieve the stated substantial interest.\textsuperscript{189} In \textit{Central Hudson}, the Supreme
Court determined the government’s ban on promotional advertising was too
expansive because the regulation affected all promotional advertising, even
if the advertisement did not violate the government’s substantial interest in
conserving energy.\textsuperscript{190} Similarly, dilution by tarnishment allows the famous
mark to suppress all lesser known marks that may create a negative
association with the famous mark because the negative association
unilaterally indicates a likelihood of reputational harm.\textsuperscript{191}

\textsuperscript{186} See \textit{Tam}, 137 S. Ct. at 1764 (rejecting a governmental interest in “preventing
speech expressing ideas that offend” and abstaining from determining whether the
government has a substantial interest in “driving out trademarks that support invidious
discrimination”); see also \textit{Brunetti}, 877 F.3d at 1350 (emphasizing that precedent and
the purpose of the First Amendment prevent the government from having a substantial
interest in protecting the public from negative marks).

\textsuperscript{187} See \textit{Cent. Hudson Gas & Elec. Corp.}, 447 U.S. at 566-67 (finding that the
government had a substantial interest in regulating a utility company’s promotional
advertising because the advertising only proposed a commercial transaction, and the
utility industry has a substantial commercial impact).

\textsuperscript{188} See \textit{Brunetti}, 877 F.3d at 1350 (explaining that the government does not have an
interest in choosing certain trademarks over others because trademarks are not
government speech).

\textsuperscript{189} See \textit{Tam}, 137 S. Ct at 1764-65 (asserting Congress did not sufficiently tailor the
Disparagement Clause to drive out trademarks that support invidious discrimination
because the Clause also prohibited disparagement of discriminating groups of people like
racists).

\textsuperscript{190} See \textit{Cent. Hudson Gas & Elec. Corp.}, 447 U.S. at 570 (highlighting that the
government failed to show why “a more limited restriction on the content of promotional
advertising would not serve adequately the State’s interests”).

\textsuperscript{191} See V. Secret Catalogue, Inc. v. Moseley, 603 F.3d 382, 392 (6th Cir. 2010)
(Moore, J., dissenting) (exposing that, on the same facts, the Supreme Court previously
Furthermore, although the actual harm standard increases the famous mark’s evidentiary burden, the Supreme Court in *Moseley* defended the actual harm standard because the government had presented no credible reason why the heightened burden would fail to adequately serve the government’s interests. 192 Thus, Congress did not narrowly tailor dilution by tarnishment in the TDRA.193

Because dilution by tarnishment does not serve a substantial interest or because Congress did not narrowly tailor dilution by tarnishment, dilution by tarnishment fails the commercial speech intermediate scrutiny test and violates the Free Speech Clause of the First Amendment.194

### III. POLICY RECOMMENDATION

Because it violates the First Amendment’s speech protections, dilution by tarnishment is vulnerable to judicial invalidation. Congress should preemptively repeal dilution by tarnishment to avoid judicial embarrassment. Furthermore, a preemptive repeal would grant Congress the discretion to decide how to proceed, free from judicial mandates or limitations.

Congress will likely have tremendous difficulty articulating a constitutional version of dilution by tarnishment within trademark law because dilution by tarnishment primary focus is a mark’s viewpoint and/or expressive content instead of the mark’s source identifying capacity. However, if Congress commits to maintaining legislation in the spirit of dilution by tarnishment, then Congress should initiate much more discussion and research into discovering a constitutionally viable purpose for dilution by tarnishment.

### CONCLUSION

Dilution by tarnishment discriminates based on the viewpoint of the lesser known mark toward the famous trademark, regardless of whether the lesser

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193. See *Brunetti*, 877, F.3d at 1354-55 (leaving the “difficult task to determine public perceptions of a trademark’s morality or immorality, offensiveness, or even vulgarity” to the individual, and thus largely out of the government’s purview).

194. See *Matal v. Tam*, 137 S. Ct. 1744, 1765 (2017) (lambasting the argument that the commercial speech label permits the suppression of “any expression likely to cause offense” or “that may lead to political or social ‘volatility’”).
known mark functions as expressive or commercial speech.\textsuperscript{195} Because dilution by tarnishment does not advance a compelling governmental interest or is not narrow enough to survive strict scrutiny, dilution by tarnishment violates the Free Speech Clause of the First Amendment.\textsuperscript{196}

If dilution by tarnishment does not discriminate based on viewpoint, then it impermissibly regulates the expressive content of speech because it targets a perceived negative mental association rather than a mark’s source identifying function.\textsuperscript{197} By still failing strict scrutiny, dilution by tarnishment violates the Free Speech Clause of the First Amendment.\textsuperscript{198}

Even if dilution by tarnishment regulates the commercial content of speech, it fails the \textit{Central Hudson} intermediate scrutiny test because Congress did not narrowly tailor it to advance a substantial governmental interest.\textsuperscript{199} Therefore, Congress should repeal dilution by tarnishment.

\textsuperscript{195} See \textit{id}. at 1763 (asserting that offensive speech is protected speech); \textit{Brunetti}, 877 F.3d at 1351 (declaring that “the government does not have substantial interest in promoting certain trademarks over others”).


\textsuperscript{197} See Hoffman v. Capital Cities/ABC, Inc., 255 F.3d 1180, 1184 (9th Cir. 2001) (holding that expressive speech gets full First Amendment protection because the speech does more than merely promote commercial transactions).

\textsuperscript{198} See United States v. Playboy Entm’t Grp., Inc., 529 U.S. 803, 814 (2000) (rejecting the notion that the government has compelling interest in regulating negative, sexually graphic speech to protect public sensibility).

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