

QUALIFYING FOR TRADE MARK DILUTION PROTECTION: THE FAME STANDARD

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This paper will eventually form a chapter of a book I am writing about dilution in the US and the EU. It also builds on work that I have already done on fame (though now that there is more case law available, I find myself reaching somewhat different conclusions). As you will see, I'm still writing/thinking (and sorting out footnotes!). In particular, highlighted paragraphs are points that I'm not quite sure will make the final cut. Also, I think I may want to do some reordering of the elements of how to prove fame. There are also a couple of cross-references and assumptions in here which refer readers to other parts of the eventual book.

On to the substance. The paper analyses the way in which courts and tribunals in the United States and the European Union have gone about determining whether a mark is famous enough to qualify for protection against dilution. It considers why we require fame for dilution protection, what degree of fame is required and how trade mark proprietors can prove that they have this level of fame. Although this is one aspect of dilution where the US and the EU would appear to diverge, with the US seemingly requiring a much higher knowledge-standard than the EU, this paper shows that, before the courts at least, more similar types of marks than we might expect are getting protection.

The paper also considers two fame-based obstacles to qualifying for dilution protection. The first, from the US, is the requirement imposed by some circuits of distinctiveness, in addition to fame, to qualify for dilution protection. The second, originating in the UK, is the tendency of the courts to limit protection against dilution by reference to the goods or services that the mark is famous for.