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THE TRADEMARK USE REQUIREMENT IN DILUTION CASES*

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Abstract

The trademark use doctrine plays a critical role in ensuring that trademark law serves its proper purpose of encouraging market exchange and lowering consumer search costs. As we have explained in detail elsewhere,¹ the doctrine ensures that trademarks do not become a weapon used to suppress speech or to interfere with rather than promote the efficient operation of the marketplace.

These goals are even more important in the context of trademark dilution. Unlike a normal cause of action for trademark infringement, trademark dilution gives broader rights to a few famous mark owners to prevent even non-confusing uses in order to protect the uniqueness of their marks against blurring and tarnishment. But because trademark dilution can exist even when goods do not compete, and even absent any likelihood of confusion, it is even more critical that the universe of actions that can give rise to dilution be cabined by a clear and effective trademark use doctrine.

The Lanham Act has had a trademark use limitation on dilution since 1996, but recent amendments have changed the language and scope of that limitation, leading to some confusion about what is and is not protected.² In this article, we parse the language and legislative history of the 2006 Trademark Dilution Revision Act and explain why the trademark use requirement in the new statute not only survives but is more robust than before.

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1. See Stacey L. Dogan & Mark A. Lemley, *Grounding Trademark Law Through Trademark Use*, 92 IOWA L. REV. 1669 (2007) [hereinafter Dogan & Lemley, *Grounding Trademark Law*]; Stacey L. Dogan & Mark A. Lemley, *Trademarks and Consumer Search Costs on the Internet*, 41 HOUS. L. REV. 777 (2004).

2. 15 U.S.C.A. § 1125(c)(3)-(4) (West Supp. 2007).