

TiVo Proves More than 15 Minutes of Fame to Succeed on Trademark Dilution Claim

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by Sandra Edelman

Andy Warhol once famously commented that “In the future everybody will be world famous for fifteen minutes.” For trademarks, fifteen minutes of fame is not sufficient to assert a trademark dilution claim. The timing of when a mark first became famous and how long that fame must endure was the subject of a recent decision by the Trademark Trial and Appeal Board in TiVo Brands LLC v. Tivoli, LLC. In a precedential opinion, the Board held that to prevail on a dilution claim in an opposition proceeding, the opposer’s mark must have become famous before applicant’s first use of its mark and the mark must continue to be famous at the time of trial in the proceeding.

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The *TiVo* case involved applications by Tivoli to register the marks TIVOTAPE and TIVOBAR for lighting fixture products, alleging a date of first use of May 2010 for TIVOTAPE and September 2015 for TIVOBAR. TiVo opposed registration on the grounds of both dilution by blurring and likelihood of confusion, relying on registrations for its TIVO mark for DVR products and related services and merchandise, as well as two TIVO composite marks.

Analyzing the dilution claim in detail, the Board confirmed established precedent that TiVo was required to prove its mark had become famous before Tivoli's first use of TIVOTAPE in May 2010. This was amply demonstrated by revenues generated and advertising and publicity disseminated by the company for TiVo products and services over many years. The Board put significant emphasis on unsolicited media attention for the TIVO mark, holding that "it is this third-party recognition of the mark that tips the balance in favor of our finding that Opposer's TIVO mark is famous for dilution purposes." The evidence included clips of Hillary Clinton on *The Late Show with David Letterman* in 2008 stating "the #6 reason she loves America is TIVO"; Anderson Cooper on *Ellen* in 2007 saying "Forget the Internet, for me TIVO is the greatest technological revolution"; Oprah in 2006 giving everyone in the audience a TIVO DVR. Based on all evidence and factors bearing on fame of the mark, the Board held that "public recognition of the mark from at least as early as 2002 was widespread" and by 2010, TIVO had become a household term with which almost everyone was familiar.

But the Board did not consider "whether a plaintiff alleging dilution must further show that its mark is famous at trial, when defendant's rights are being determined." Precedent on this question was designated "precedential". The Board stated it had no precedent and the parties had not cited any, addressing this as a first impression. It ultimately determined that such an additional requirement exists contrary to the statutory scheme on dilution claims in Section 29 of the Lanham Act, which requires that a plaintiff must prove that its mark "is" famous (emphasis in original). In addition, the statute permits only the owner of a famous mark that is distinctive, inherently or through acquired distinctiveness, to bring a dilution claim. "Accordingly, unless the plaintiff owns a famous mark at the time it brings the claim and by extension, retains its fame through trial, this provision of the statute cannot be satisfied To find otherwise would allow a mark that has lost its fame to continue to enjoy the widest penumbra of protection available accorded by the extraordinary protection of the dilution statute. This approach also accounts for any significant changes in the marketplace between the date of Applicant's first use of its mark and the date of trial."

The Board concluded that the TIVO mark remained famous and inherently distinctive and was sufficiently similar to TIVOTAPE and TIVOBAR such that applicant's marks would impair the distinctiveness of the TIVO mark. Because the Board sustained TiVo's opposition on the ground of dilution, it did not reach the issues of the likelihood of confusion claim.

As a practice tip, if your company's brand has become famous, it's helpful to remember to introduce evidence of fame early in the proceedings.

