



Jeff Geiger Counters

Sex Tarnishes Victoria's Secret?

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By: [Jeff Geiger](#).

Victoria's Secret seems poised to take the "sex" out of "sexy" with its crusade against a small retail store in Kentucky, "Victor's Little Secret," that sells sexually oriented merchandise. In this never ending courtroom saga, the [Sixth Circuit Court of Appeals concluded](#) that Victor's Little Secret tarnished Victoria's Secret's trademark because it, get ready, sold sex-related products. At this point, you might be asking yourself "What the hell does Victoria's Secret sell?"

First, let's look at what was at issue. The concept of dilution by tarnishment refers to circumstances where a trademark is undermined by a negative association. For example, associating the [Dallas Cowboys' cheerleaders](#) with the adult film, "[Debbie Does Dallas](#)," in which a "lady" parades (and eventually discards) a Dallas Cowboys-style cheerleading outfit in an adult film. [Dallas Cowboys Cheerleaders, Inc. v. Pussycat Cinema, Ltd.](#)

Jumping back to 2003, the [Supreme Court ruled](#) the first time around that Victoria's Secret failed to show that it sustained "actual harm" versus mere "likelihood of tarnishment." Commercial interests were unamused and legislation passed (the [Federal Trademark Dilution Revision Act](#)) providing that the trademark holder need only prove likely (as opposed to actual) tarnishment.

What is remarkable, and has many intellectual property professionals aghast, is the Sixth Circuit's contention that the "new Act creates a rebuttable presumption, or at least a very strong inference, that a new mark used to sell sex related products is likely to tarnish a famous mark if there is a clear semantic association between the two." Yes, association with sex (or at least lurid sex) can tarnish a mark. But I find it nonsensical to place the burden on the junior or new user of a mark to prove a negative, i.e. that there is no likelihood or probability of tarnishment.

I am troubled further in several respects.

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While I may be accused of taking the quote out of context, the Court of Appeals contends that Victor's Little Secret did not prove that it was **not** likely to tarnish Victoria's Secret and that "[T]he fact that Congress was dissatisfied with the [first case's] result and the [first case's] standard of liability, as well as apparently the [first case's] burden of proof, supports the view of Victoria's Secret that the present record—in the eyes of the legislative branch—shows a likelihood of tarnishment." Since when does (should) the judicial branch care what the legislative branch thinks of a particular case?

Still, Victoria's Secret provided ample evidence to support the ruling, right? Wrong. The evidence consisted of an affidavit from a military officer who, upon seeing an ad for Victor's Little Secret, was offended as his wife and daughter shopped at Victoria's Secret and the ad "denigrate[d] a store frequented by members of his family." Additionally, a Victoria's Secret corporate officer averred that the retail chain tries to "maintain[] an image that is sexy and playful" but "avoid[s] sexually explicit or graphic imagery." I am here to tell that there are a lot of teenage boys who would respectfully disagree with that statement. As the Court's dissenting member notes, there was no evidence to indicate any negative association between the two marks. If anything, the military officer confined his distaste to Victor's Little Secret such that Victoria's Secret's reputation remained unblemished.

Finally, while trademark holders should be afforded protection against those that would tarnish their good will and valuable marks, concern is had that the "rebuttable presumption" will tip the scales of justice unduly in favor of the senior user, who may also be in a superior financial position. Trademark litigation is not cheap and can easily run in to the six figures fast. By putting the burden on the junior user of a mark, the Sixth Circuit's decision hands trademark holders with a potential club to cudgel new competition.

And that's no secret.

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