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THREATS OF TRADEMARK DILUTION IN THE GLOBAL MARKET: A COMPARATIVE LEGAL ANALYSIS

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Abstract

One of the biggest and most persistent threats to brand equity in today's markets is trademark dilution. Unlike traditional infringement, dilution does not prioritise evidence of consumer confusion; it aims at the gradual tarnishment of a mark's distinctiveness or the degradation of its reputation, consequences that can be significantly more detrimental over time. This paper analyses the characteristics and extent of trademark dilution threats in contemporary commerce, emphasising the ways in which digital transformation, the expansion of social media, virtual goods markets, and challenges in cross-border enforcement have significantly intensified these threats. The paper analyses the legal frameworks of India and the United States to pinpoint significant weaknesses in current protection regimes and assesses the effectiveness of existing doctrinal tools in relation to the contemporary marketplace. The paper contends that as commerce evolves to be more intangible and global, threats to trademark distinctiveness necessitate a more proactive and technologically adaptive legal response.

Keywords: Trademark Dilution, Brand Erosion, Well-Known Marks, Blurring, Tarnishment, Digital Commerce, NFTs, Section 29(4), TDRA 2006

1. Introduction: The Brand as a Vulnerable Asset

A trademark is much more than just a legal way to find out where something came from. At its best, a well-known trademark is a cultural signifier, a promise of quality, and a way for customers to show their loyalty. It represents years, sometimes decades, of work on marketing, building a good reputation, and ensuring the product remains consistent. Companies like Tata, Amul, and Coca-Cola have not only made names people know but also built commercial ecosystems where just seeing a symbol can make people expect certain things, feel certain things, and act in certain ways when they buy something. Trademarks are very easy to hurt because they are so rich. This is true even if there is no confusion, competition, or direct theft.

This harm is called dilution.

Trademark dilution is when a well-known mark loses its uniqueness or reputation because of uses that, when looked at on their own, may not seem important but, when looked at as a whole, cause serious harm to the business. Using a luxury brand on cheap goods doesn't have to make people wonder where the product came from to hurt the brand; the association itself lowers the brand's prestige. A respected pharmaceutical brand used in a satirical but offensive ad campaign doesn't have to lie to hurt years of carefully built trust. These are the dangers that the dilution doctrine was meant to protect against.

In the digital age, these threats have become much more important. Social media sites, online shopping sites, NFT ecosystems, and user-generated content channels have made a huge, mostly unregulated space where famous marks are copied, remixed, and used in new ways millions of times a day. This paper looks at the main dangers that trademark dilution poses to people in the market, putting them in the context of both India's legal system under Section 29(4) of the Trade Marks Act, 1999, and the more developed system in the United States under the Trademark Dilution Revision Act (TDRA) of 2006.

2. The Two Faces of Dilution: Blurring and Tarnishment

Legal scholarship and judicial practice have identified two principal types of trademark dilution: blurring and tarnishment. Each one is a different way that the value of a well-known mark can be systematically lowered.

2.1 Dilution by Blurring

Blurring refers to the impairment of a mark's capacity to uniquely identify and distinguish the goods or services of its owner. The mechanism is one of proliferation — when a distinctive mark is used by multiple unrelated parties across varied commercial contexts, it gradually loses its exclusive association with the original brand. The word 'Kodak', famously cited in early dilution scholarship, derived its commercial strength precisely from its meaninglessness outside the camera context: it meant exactly one thing. Each unauthorised use of 'Kodak' on an unrelated product would chip away at that singularity until the mark becomes just another word in the commercial vocabulary.

Indian courts have recognised this principle in several contexts. In *ITC Limited v. Philip Morris Products SA*, the Delhi High Court examined whether Philip Morris's use of certain marks caused dilution by blurring ITC's famous 'Wills' brand, applying a contextual analysis that

looked beyond mere similarity to examine the broader commercial effect of the association. The judgment acknowledged that blurring must be assessed cumulatively rather than as a single-incident phenomenon — a recognition that has significant implications for brand monitoring strategies in the digital age.

The TDRA of 2006 provides a more structured approach to blurring through its six-factor framework, which examines the degree of similarity between marks, the degree of inherent or acquired distinctiveness of the famous mark, the extent of exclusive use, the degree of recognition, the intent of the defendant, and any actual association between the marks. This multi-factor approach provides analytical clarity that Indian courts have not yet codified but increasingly approximate through case-by-case reasoning.

2.2 Dilution by Tarnishment

Tarnishment operates through a different mechanism: rather than dispersing the mark's meaning, it degrades the mark's image by associating it with inferior products, offensive content, or morally questionable contexts. A well-known children's brand associated with adult content, or a premium food brand placed alongside imagery of unsanitary practices, suffers reputational harm that may be immediate and difficult to reverse. Tarnishment is particularly insidious because the damage is qualitative rather than quantitative — it attacks not the mark's uniqueness but its standing in consumer consciousness.

The threat of tarnishment has intensified dramatically with the growth of user-generated content platforms. A single viral post misappropriating a famous trademark in a degrading context can reach tens of millions of viewers within hours, causing reputational harm that no legal remedy can fully undo. Platform intermediaries like Instagram, YouTube, and X (formerly Twitter) occupy a complex position in this ecosystem — their content hosting enables both the harm and, potentially, its mitigation — but existing legal frameworks provide inconsistent guidance on their obligations and liability.

3. Structural Threats in the Contemporary Market

3.1 The Digital Marketplace and E-Commerce Proliferation

The migration of commerce to digital platforms has fundamentally changed the threat landscape for trademark dilution. E-commerce giants like Amazon, Flipkart, and Meesho host millions of third-party sellers, many of whom use famous marks in product descriptions, sponsored advertisements, or keyword bidding strategies in ways that may fall short of outright

infringement but nonetheless create dilutive effects. A consumer repeatedly encountering a famous brand name associated with low-quality counterparts, even if they understand the products are distinct, begins to dissociate the mark from its original quality promise. Over time, this erodes the mark's power as a quality signal — one of its most commercially valuable functions.

Industry data paints a troubling picture. Trademark-related complaints on major e-commerce platforms reportedly increased by over 400% between 2020 and 2024, with dilution claims constituting a significant and growing proportion of those complaints. This surge reflects not merely increased infringement but also the growing awareness among brand owners that dilutive harm — distinct from straightforward counterfeiting — is commercially significant and legally actionable. Yet enforcement mechanisms have struggled to keep pace. The volume of potentially dilutive content vastly exceeds the capacity of both rights holders and legal institutions to address it through traditional channels.

3.2 Social Media and User-Generated Content

Perhaps no development has been more destabilising for trademark dilution protection than the explosion of user-generated content on social media platforms. Instagram, TikTok, YouTube, and similar platforms host billions of pieces of content daily, an enormous proportion of which incorporates famous trademarks in some form. Most of these uses are innocent — fans celebrating beloved brands, consumers reviewing products, or creators building cultural commentary. But a meaningful subset creates dilution risks that aggregate into serious systemic harm.

Influencer marketing presents a particularly nuanced challenge. When influencers use luxury or aspirational brand names informally — misattributing products, incorporating marks into memes, or associating famous names with lifestyle content far removed from the brand's carefully managed image — they can dilute both the mark's exclusivity and its carefully cultivated associations. Brand owners monitoring social media for dilutive uses report detecting tens of thousands of potentially problematic incidents monthly, yet fewer than two percent result in formal enforcement action due to practical, legal, and reputational constraints. The algorithmic structure of social platforms compounds these challenges. Content recommendation systems optimise for engagement, which often means amplifying controversial or unusual content. A post that uses a famous trademark in a mildly tarnishing context may be algorithmically boosted precisely because it generates strong reactions, spreading dilutive content far beyond what organic reach would have achieved. This creates a

structural tension between platform incentives and brand protection imperatives that existing legal frameworks are poorly equipped to address.

3.3 Virtual Goods, NFTs, and the Metaverse

The emergence of virtual goods markets, non-fungible tokens (NFTs), and metaverse applications has introduced entirely new categories of trademark dilution threat that existing legal doctrine was not designed to address. When an entrepreneur creates NFTs bearing unauthorised reproductions of famous luxury marks and sells them as digital collectibles, the resulting harm contains elements of both traditional infringement and dilution — yet maps imperfectly onto either framework.

The *Hermès v. Rothschild* dispute in the United States, involving the 'MetaBirkins' NFTs, illustrates the complexity of these cases. The artist Mason Rothschild created and sold NFTs depicting fur-covered versions of the iconic Birkin bag, arguing that his works constituted protected artistic commentary. Hermès contended that the NFTs diluted its famous mark and damaged its carefully controlled brand image. The jury found in favour of Hermès, but the case highlighted the significant doctrinal uncertainty surrounding virtual goods and the adequacy of existing trademark frameworks for addressing them.

Indian law currently provides minimal guidance on these questions. The Trade Marks Act, 1999 was drafted before virtual goods and blockchain-based assets existed as commercially significant phenomena, and subsequent judicial development has not yet produced a coherent framework for their treatment. The immutable, globally accessible, and potentially appreciating nature of NFTs containing unauthorised trademark uses adds a layer of complexity that demands specific legislative and judicial attention.

3.4 Cross-Border Dilution and Jurisdictional Fragmentation

Trademark dilution increasingly occurs in transnational digital environments where the traditional territorial conception of trademark rights becomes deeply problematic. A social media post created in one jurisdiction, hosted on servers in another, and consumed by users in dozens of countries may dilute a famous mark across multiple markets simultaneously. The enforcement response, however, remains fragmented along national lines, creating significant gaps that sophisticated actors can exploit.

The Indian Supreme Court's recognition of transborder reputation in *Toyota Jidosha Kabushiki Kaisha v. Prius Auto Industries Limited* represents an important step in acknowledging that famous marks can acquire protectable reputation in India through exposure in international

media, even without a significant domestic commercial presence. This principle creates a foundation for addressing cross-border dilution but leaves many practical enforcement questions unresolved.

The lack of harmonised evidentiary standards between India and the United States — its largest trading partner in the technology and consumer goods sectors — creates particular challenges. Standards for demonstrating fame, quantifying dilutive harm, and assessing likelihood of association differ substantially between the two systems, complicating efforts to coordinate enforcement and creating opportunities for forum shopping by potential infringers.

4. Institutional and Evidentiary Challenges

4.1 The Proof Problem

One of the most persistent structural threats to effective trademark dilution protection is the difficulty of proving the harm in question. Unlike trademark infringement, where consumer confusion is a familiar and relatively well-understood concept, dilution involves more diffuse and gradual harms that resist easy quantification. How much has a mark's distinctiveness been reduced by a particular use? At what point does repeated association with inferior products cross the threshold into cognisable tarnishment? These questions demand robust evidentiary frameworks that most legal systems, including India's, have not yet fully developed.

Consumer surveys represent the gold standard for dilution evidence in sophisticated jurisdictions, offering direct evidence of how target audiences perceive the marks in question. Yet Indian courts have received limited guidance on how to evaluate such surveys — what methodological standards they must meet, how much weight they should receive, and how to interpret conflicting survey results. This evidential gap creates unpredictability that discourages investment in brand protection while enabling strategic litigation.

Digital analytics offer potentially transformative tools for dilution assessment. Social media monitoring platforms can track the spread of trademark uses across platforms, sentiment analysis tools can measure changes in brand perception over time, and search engine data can reveal shifting associational patterns. But the legal framework for incorporating this evidence into trademark proceedings remains underdeveloped in India, leaving a significant gap between available technology and legal practice.

4.2 The Fame Threshold Debate

The threshold requirement for dilution claims — that the mark in question must be 'well-known'

or 'famous' — represents another area of significant uncertainty. As of early 2025, the Indian Patent Office recognises 345 well-known marks, spanning everything from traditional conglomerates like Tata and Godrej to modern technology brands like Instagram and Paytm. This list represents the formal frontier of dilution protection, but its composition raises important questions about consistency and standards.

The TDRA's requirement that a mark be 'widely recognized by the general consuming public of the United States' establishes a high threshold that restricts dilution protection to genuinely exceptional marks. India's approach, while identifying specific criteria including duration of use, degree of recognition, and geographical area of recognition, has produced less consistent results in judicial application. The danger of an overly expansive interpretation is that dilution protection becomes a general tool for suppressing competition rather than a targeted instrument for protecting genuinely iconic marks. Conversely, an overly restrictive approach leaves legitimate brand equity vulnerable to systematic erosion.

5. The Inadequacy of Traditional Remedies

The traditional arsenal of trademark remedies — injunctions, damages, account of profits — was designed for a commercial environment where infringement occurred at a pace and scale that litigation could address. In the digital age, these tools are frequently inadequate to the threats they must confront. By the time an injunction is obtained against a viral piece of dilutive content, that content may have been viewed and shared millions of times, with its reputational damage already baked in.

Platform-level solutions — automated content detection, expedited takedown procedures, repeat infringer policies — represent the practical front line of dilution enforcement. Yet Indian law provides minimal specific guidance on intermediary obligations in the dilution context, relying on general principles that were not specifically designed for trademark harm. The Information Technology Act's 'safe harbour' provisions, while providing some framework for online intermediary liability, do not specifically address the dilution dynamic, leaving brand owners without clear legal tools to compel platform action.

The United States framework, while more developed, is not without its own gaps. Courts have grappled with the question of whether digital 'uses' of trademarks — including keyword advertising, hashtag incorporation, and metaverse appearances — constitute the kind of commercial use necessary to trigger dilution liability. These doctrinal questions are even less resolved in India, creating substantial uncertainty for rights holders developing digital

enforcement strategies.

6. Balancing Protection with Competitive Freedom

Any honest account of trademark dilution threats must acknowledge the countervailing risks of over-protection. Trademark rights are monopoly grants that, if extended too broadly, can suppress legitimate competition, restrict consumer choice, and chill free expression. Parody, satire, comparative advertising, and scholarly commentary involving famous marks all serve important social functions, and dilution doctrine must be calibrated carefully to avoid sweeping these uses into its prohibition.

The TDRA explicitly preserves fair use defences for comparative advertising, parody, criticism, and commentary — recognising that the social value of these practices must be weighed against brand protection interests. Indian law provides less explicit guidance on these balancing questions, leaving courts to develop proportionality analysis on a case-by-case basis. This creates uncertainty for content creators and commentators operating in the vicinity of famous marks, potentially chilling legitimate expression.

The intersection of trademark dilution with constitutional free speech protections adds further complexity. In both India and the United States, courts have had to navigate situations where commercial trademark rights conflict with fundamental rights of expression, and the resolution of these conflicts requires nuanced analysis that dilution doctrine's current tools are not always equipped to provide.

7. Towards a More Effective Protection Framework

The threats examined in this paper suggest a clear agenda for reform. First, statutory clarification of dilution standards — including explicit definitions of blurring and tarnishment, structured frameworks for evaluating fame, and specific provisions for digital and virtual goods contexts — would reduce judicial uncertainty and provide clearer guidance to rights holders and potential infringers alike.

Second, the evidential infrastructure for dilution claims needs development. Judicial guidance on consumer survey standards, digital analytics admissibility, and expert testimony requirements would enable more objective and consistent adjudication of dilution claims. This would benefit both rights holders seeking effective protection and defendants seeking predictable standards.

Third, platform intermediary obligations in the trademark dilution context deserve specific

statutory attention. The volume of potentially dilutive content on social platforms is simply too great to address through individual litigation; systemic solutions requiring platform cooperation in monitoring and removal are a practical necessity. Drawing on comparative experience from the European Union's Digital Services Act and similar frameworks would provide valuable models for Indian legislative development.

Fourth, international cooperation in dilution enforcement needs strengthening. Bilateral and multilateral frameworks for evidence sharing, cross-border injunctions, and mutual recognition of famous mark status would address the jurisdictional fragmentation that currently undermines enforcement in the digital environment. India's growing engagement with international intellectual property institutions provides a foundation for developing these cooperative mechanisms.

8. Conclusion

Trademark dilution represents a threat to brand equity that has grown more complex and more pervasive with each wave of technological change. The mechanisms of harm — blurring and tarnishment — remain conceptually clear, but their expression in digital commerce, social media ecosystems, and virtual goods markets presents challenges that existing legal frameworks in both India and the United States only partially address.

The stakes are considerable. Famous marks represent enormous accumulated investments in quality, reputation, and consumer trust. Their erosion harms not only their owners but also consumers who rely on distinctive marks as quality signals, competitors who invest in their own brand development on the expectation that the law will protect their efforts, and the broader market ecosystem that depends on effective brand differentiation for its proper functioning.

The path forward requires legislative evolution, judicial sophistication, platform accountability, and international cooperation. The conceptual foundation — Frank Schechter's insight that some marks deserve protection simply by virtue of their distinctiveness and the harm that uniqueness-erosion causes — remains as relevant as ever. The task for contemporary trademark law is to develop institutional responses equal to the scale and complexity of the threats that foundation must now support.

References

1. Frank I. Schechter, 'The Rational Basis of Trademark Protection', *Harvard Law Review*, Vol. 40, No. 6 (1927), pp. 813–833.
2. J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition*, 5th Edition, Thomson Reuters (2023).
3. Trade Marks Act, 1999 (India), Section 29(4) and Sections 11(6)–11(10).
4. Trademark Dilution Revision Act of 2006, 15 U.S.C. § 1125(c) (United States).
5. *ITC Limited v. Philip Morris Products SA & Others*, Delhi High Court (2010).
6. *Toyota Jidosha Kabushiki Kaisha v. Prius Auto Industries Limited*, Supreme Court of India (2017).
7. *Hermès International S.A. v. Mason Rothschild*, United States District Court, Southern District of New York (2023).
8. Barton Beebe, 'The Semiotic Account of Trademark Doctrine and Trademark Culture', *UCLA Law Review*, Vol. 51 (2004), pp. 621–704.
9. Suneal Bedi and David Reibstein, 'Measuring Trademark Dilution by Tarnishment', *Indiana Law Journal* (2020).
10. Varsha Dogra, 'Doctrine of Dilution of Trade Marks in India: A Comparative Study with the United States of America', Punjab University (2022).
11. Keola R. Whittaker, 'Trademark Dilution in the Global Age: Challenges and Comparative Perspectives', International Trademark Association Publication.
12. Indian Patent Office, List of Well-Known Trademarks (February 2025), available at ipindia.gov.in.

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