Abstract: ***Finding the Right Factfinder: The Judge-Jury Problem in Trademark Dilution***
David Welkowitz
Professor of Law, Whittier Law School

During the 1990s, jury trial issues were the subject of two Supreme Court decisions, one in copyright, and another in patent. Both of those areas are regulated by federal statute, without the common law overlay that permeates trademark law. However, the 1990s also witnessed the birth of a new federal statutory trademark claim–trademark dilution. Dispensing with the common law requirement of likelihood of confusion, dilution moves trademark law closer to the realm of patent and copyright, in the sense that its protection is more property-like than traditional trademark infringement.

Because the primary intended remedy for trademark dilution is an injunction (and, under some state laws, that is the only possible relief), the issue of the proper factfinder–judge or jury–seldom arises in dilution cases. However, the federal statute and the majority of state statutes permit monetary relief, albeit under limited circumstances. One might expect that the issue of proper factfinder in a federal court would be a simple one: where the relief sought is monetary (at least in part), a jury is required by the Seventh Amendment. However, the issue turns out not to be that simple. For one thing, the statute itself refers to *courts* in its remedial section, as well as the "principles of equity." Although that in itself would not be sufficient to deny a jury trial, other issues make the decision more complex than one might expect. In particular, the monetary remedy most likely to be recovered is more like restitution than compensation. Indeed, few lower courts that have addressed the issue of judge vs. jury in dilution cases are divided. On the other hand, there certainly are jury trials in dilution cases (witness the recent case involving Payless and Adidas, which included both traditional infringement and dilution claims decided by a jury).

The factfinder issue is further complicated by the possible effect of the Supreme Court's decision in *Markman v. Westview Instruments, Inc.*, which tells us that, in patent cases, there are some issues that are for judges to decide, notwithstanding the requirement that the ultimate issues of infringement and damages must be sent to a jury. Although not directly on point, *Markman* suggests the possibility that some portion of a dilution case might be decided by a judge, even if the ultimate issue of dilution is sent to a jury. (In fact, such a suggestion was made, albeit unsuccessfuly, to the Second Circuit in *Wal-Mart v. Samara Bros.*)

The factfinder problem may be divided into three categories: (1) when must *some* part of the case be sent to a jury? (2) if the case must be sent to a jury, must the jury decide *all* issues? (3) assuming that a case is sent to a jury, what are the bounds of the judge's discretion to override the jury's decision? As noted above, lower courts are divided on the first issue. The second issue seems seldom, if ever, to have been litigated in a reported opinion in a dilution case. However, in view of the importance of certain preliminary issues, such as the existence of a famous mark, it is well worth exploring. The third issue was raised, though not in a dilution context, in the Second Circuit in the *Wal-Mart v. Samara Brothers* case. This paper addresses these issues in the hope that by understanding them in the dilution context, we can apply some of the same solutions to trademark cases in general, and, perhaps, to other categories of intellectual property cases.