

109TH CONGRESS
1ST SESSION

H. R. 683

IN THE SENATE OF THE UNITED STATES

APRIL 20, 2005

Received; read twice and referred to the Committee on the Judiciary

AN ACT

To amend the Trademark Act of 1946 with respect to
dilution by blurring or tarnishment.

1 *Be it enacted by the Senate and House of Representa-*
2 *tives of the United States of America in Congress assembled,*

1 **SECTION 1. SHORT TITLE.**

2 (a) SHORT TITLE.—This Act may be cited as the
3 “Trademark Dilution Revision Act of 2005”.

4 (b) REFERENCES.—Any reference in this Act to the
5 Trademark Act of 1946 shall be a reference to the Act
6 entitled “An Act to provide for the registration and protec-
7 tion of trademarks used in commerce, to carry out the pro-
8 visions of certain international conventions, and for other
9 purposes”, approved July 5, 1946 (15 U.S.C. 1051 et
10 seq.).

11 **SEC. 2. DILUTION BY BLURRING; DILUTION BY**
12 **TARNISHMENT.**

13 Section 43 of the Trademark Act of 1946 (15 U.S.C.
14 1125) is amended—

15 (1) by striking subsection (c) and inserting the
16 following:

17 “(c) DILUTION BY BLURRING; DILUTION BY
18 TARNISHMENT.—

19 “(1) INJUNCTIVE RELIEF.—Subject to the prin-
20 ciples of equity, the owner of a famous mark that is
21 distinctive, inherently or through acquired distinc-
22 tiveness, shall be entitled to an injunction against
23 another person who, at any time after the owner’s
24 mark has become famous, commences use of a mark
25 or trade name in commerce that is likely to cause di-
26 lution by blurring or dilution by tarnishment of the

1 famous mark, regardless of the presence or absence
2 of actual or likely confusion, of competition, or of ac-
3 tual economic injury.

4 “(2) DEFINITIONS.—(A) For purposes of para-
5 graph (1), a mark is famous if it is widely recog-
6 nized by the general consuming public of the United
7 States as a designation of source of the goods or
8 services of the mark’s owner. In determining wheth-
9 er a mark possesses the requisite degree of recogni-
10 tion, the court may consider all relevant factors, in-
11 cluding the following:

12 “(i) The duration, extent, and geographic
13 reach of advertising and publicity of the mark,
14 whether advertised or publicized by the owner
15 or third parties.

16 “(ii) The amount, volume, and geographic
17 extent of sales of goods or services offered
18 under the mark.

19 “(iii) The extent of actual recognition of
20 the mark.

21 “(B) For purposes of paragraph (1), ‘dilution
22 by blurring’ is association arising from the similarity
23 between a mark or trade name and a famous mark
24 that impairs the distinctiveness of the famous mark.
25 In determining whether a mark or trade name is

1 likely to cause dilution by blurring, the court may
2 consider all relevant factors, including the following:

3 “(i) The degree of similarity between the
4 mark or trade name and the famous mark.

5 “(ii) The degree of inherent or acquired
6 distinctiveness of the famous mark.

7 “(iii) The extent to which the owner of the
8 famous mark is engaging in substantially exclu-
9 sive use of the mark.

10 “(iv) The degree of recognition of the fa-
11 mous mark.

12 “(v) Whether the user of the mark or
13 trade name intended to create an association
14 with the famous mark.

15 “(vi) Any actual association between the
16 mark or trade name and the famous mark.

17 “(C) For purposes of paragraph (1), ‘dilution
18 by tarnishment’ is association arising from the simi-
19 larity between a mark or trade name and a famous
20 mark that harms the reputation of the famous mark.

21 “(3) EXCLUSIONS.—The following shall not be
22 actionable as dilution by blurring or dilution by
23 tarnishment under this subsection:

24 “(A) Fair use of a famous mark by an-
25 other person in comparative commercial adver-

1 tising or promotion to identify the competing
2 goods or services of the owner of the famous
3 mark.

4 “(B) Fair use of a famous mark by an-
5 other person, other than as a designation of
6 source for the person’s goods or services, in-
7 cluding for purposes of identifying and paro-
8 dying, criticizing, or commenting upon the fa-
9 mous mark owner or the goods or services of
10 the famous mark owner.

11 “(C) All forms of news reporting and news
12 commentary.

13 “(4) ADDITIONAL REMEDIES.—In an action
14 brought under this subsection, the owner of the fa-
15 mous mark shall be entitled only to injunctive relief
16 as set forth in section 34, except that, if—

17 “(A) the person against whom the injunc-
18 tion is sought did not use in commerce, prior to
19 the date of the enactment of the Trademark Di-
20 lution Revision Act of 2005, the mark or trade
21 name that is likely to cause dilution by blurring
22 or dilution by tarnishment, and

23 “(B) in a claim arising under this sub-
24 section—

1 “(i) by reason of dilution by blurring,
2 the person against whom the injunction is
3 sought willfully intended to trade on the
4 recognition of the famous mark, or

5 “(ii) by reason of dilution by
6 tarnishment, the person against whom the
7 injunction is sought willfully intended to
8 harm the reputation of the famous mark,
9 the owner of the famous mark shall also be entitled
10 to the remedies set forth in sections 35(a) and 36,
11 subject to the discretion of the court and the prin-
12 ciples of equity.

13 “(5) OWNERSHIP OF VALID REGISTRATION A
14 COMPLETE BAR TO ACTION.—The ownership by a
15 person of a valid registration under the Act of
16 March 3, 1881, or the Act of February 20, 1905, or
17 on the principal register under this Act shall be a
18 complete bar to an action against that person, with
19 respect to that mark, that is brought by another
20 person under the common law or a statute of a
21 State and that seeks to prevent dilution by blurring
22 or dilution by tarnishment, or that asserts any claim
23 of actual or likely damage or harm to the distinctive-
24 ness or reputation of a mark, label, or form of ad-
25 vertisement.”; and

1 (2) in subsection (d)(1)(B)(i)(IX), by striking
2 “(c)(1) of section 43” and inserting “(c)”.

3 **SEC. 3. CONFORMING AMENDMENTS.**

4 (a) MARKS REGISTRABLE ON THE PRINCIPAL REG-
5 ISTER.—Section 2(f) of the Trademark Act of 1946 (15
6 U.S.C. 1052(f)) is amended—

7 (1) by striking the last two sentences; and

8 (2) by adding at the end the following: “A mark
9 which would be likely to cause dilution by blurring
10 or dilution by tarnishment under section 43(c), may
11 be refused registration only pursuant to a pro-
12 ceeding brought under section 13. A registration for
13 a mark which would be likely to cause dilution by
14 blurring or dilution by tarnishment under section
15 43(c), may be canceled pursuant to a proceeding
16 brought under either section 14 or section 24.”.

17 (b) OPPOSITION.—Section 13(a) of the Trademark
18 Act of 1946 (15 U.S.C. 1063(a)) is amended in the first
19 sentence by striking “as a result of dilution” and inserting
20 “the registration of any mark which would be likely to
21 cause dilution by blurring or dilution by tarnishment”.

22 (c) CANCELLATION.—Section 14 of the Trademark
23 Act of 1946 (15 U.S.C. 1064) is amended, in the matter
24 preceding paragraph (1)—

1 (1) by striking “, including as a result of dilu-
2 tion under section 43(c),”; and

3 (2) by inserting “(A) for which the constructive
4 use date is after the date on which the petitioner’s
5 mark became famous and which would be likely to
6 cause dilution by blurring or dilution by tarnishment
7 under section 43(c), or (B) on grounds other than
8 dilution by blurring or dilution by tarnishment”
9 after “February 20, 1905”.

10 (d) MARKS FOR THE SUPPLEMENTAL REGISTER.—

11 The second sentence of section 24 of the Trademark Act
12 of 1946 (15 U.S.C. 1092) is amended to read as follows:

13 “Whenever any person believes that such person is or will
14 be damaged by the registration of a mark on the supple-
15 mental register—

16 “(1) for which the effective filing date is after
17 the date on which such person’s mark became fa-
18 mous and which would be likely to cause dilution by
19 blurring or dilution by tarnishment under section
20 43(c), or

21 “(2) on grounds other than dilution by blurring
22 or dilution by tarnishment,

23 such person may at any time, upon payment of the pre-
24 scribed fee and the filing of a petition stating the ground

1 therefor, apply to the Director to cancel such registra-
2 tion.”.

3 (e) DEFINITIONS.—Section 45 of the Trademark Act
4 of 1946 (15 U.S.C. 1127) is amended by striking the defi-
5 nition relating to “dilution”.

Passed the House of Representatives April 19, 2005.

Attest:

JEFF TRANDAHL,

Clerk.