

Union Calendar No. 9

109TH CONGRESS
1ST SESSION

H. R. 683

[Report No. 109-23]

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

IN THE HOUSE OF REPRESENTATIVES

FEBRUARY 9, 2005

Mr. SMITH of Texas introduced the following bill; which was referred to the Committee on the Judiciary

MARCH 17, 2005

Reported with an amendment, committed to the Committee of the Whole House on the State of the Union, and ordered to be printed

[Strike out all after the enacting clause and insert the part printed in italic]

[For text of introduced bill, see copy of bill as introduced on February 9, 2005]

A BILL

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,*

3 **SECTION 1. SHORT TITLE.**

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

1 (b) *REFERENCES.*—Any reference in this Act to the
2 *Trademark Act of 1946 shall be a reference to the Act enti-*
3 *tled “An Act to provide for the registration and protection*
4 *of trademarks used in commerce, to carry out the provisions*
5 *of certain international conventions, and for other pur-*
6 *poses”, approved July 5, 1946 (15 U.S.C. 1051 et seq.).*

7 **SEC. 2. DILUTION BY BLURRING; DILUTION BY**
8 **TARNISHMENT.**

9 Section 43 of the Trademark Act of 1946 (15 U.S.C.
10 1125) is amended—

11 (1) by striking subsection (c) and inserting the
12 following:

13 “(c) *DILUTION BY BLURRING; DILUTION BY*
14 *TARNISHMENT.*—

15 “(1) *INJUNCTIVE RELIEF.*—Subject to the prin-
16 ciples of equity, the owner of a famous mark that is
17 distinctive, inherently or through acquired distinctive-
18 ness, shall be entitled to an injunction against an-
19 other person who, at any time after the owner’s mark
20 has become famous, commences use of a mark or trade
21 name in commerce that is likely to cause dilution by
22 blurring or dilution by tarnishment of the famous
23 mark, regardless of the presence or absence of actual
24 or likely confusion, of competition, or of actual eco-
25 nomic injury.

1 “(2) *DEFINITIONS.—(A) For purposes of para-*
2 *graph (1), a mark is famous if it is widely recognized*
3 *by the general consuming public of the United States*
4 *as a designation of source of the goods or services of*
5 *the mark’s owner. In determining whether a mark*
6 *possesses the requisite degree of recognition, the court*
7 *may consider all relevant factors, including the fol-*
8 *lowing:*

9 “(i) *The duration, extent, and geographic*
10 *reach of advertising and publicity of the mark,*
11 *whether advertised or publicized by the owner or*
12 *third parties.*

13 “(ii) *The amount, volume, and geographic*
14 *extent of sales of goods or services offered under*
15 *the mark.*

16 “(iii) *The extent of actual recognition of the*
17 *mark.*

18 “(B) *For purposes of paragraph (1), ‘dilution by*
19 *blurring’ is association arising from the similarity*
20 *between a mark or trade name and a famous mark*
21 *that impairs the distinctiveness of the famous mark.*
22 *In determining whether a mark or trade name is like-*
23 *ly to cause dilution by blurring, the court may con-*
24 *sider all relevant factors, including the following:*

1 “(i) *The degree of similarity between the*
2 *mark or trade name and the famous mark.*

3 “(ii) *The degree of inherent or acquired dis-*
4 *tinctiveness of the famous mark.*

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

8 “(iv) *The degree of recognition of the fa-*
9 *mous mark.*

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

13 “(vi) *Any actual association between the*
14 *mark or trade name and the famous mark.*

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

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

22 “(A) *Fair use of a famous mark by another*
23 *person in comparative commercial advertising or*
24 *promotion to identify the competing goods or*
25 *services of the owner of the famous mark.*

1 “(B) *Fair use of a famous mark by another*
2 *person, other than as a designation of source for*
3 *the person’s goods or services, including for pur-*
4 *poses of identifying and parodying, criticizing,*
5 *or commenting upon the famous mark owner or*
6 *the goods or services of the famous mark owner.*

7 “(C) *All forms of news reporting and news*
8 *commentary.*

9 “(4) *ADDITIONAL REMEDIES.—In an action*
10 *brought under this subsection, the owner of the famous*
11 *mark shall be entitled only to injunctive relief as set*
12 *forth in section 34, except that, if—*

13 “(A) *the person against whom the injunc-*
14 *tion is sought did not use in commerce, prior to*
15 *the date of the enactment of the Trademark Dilu-*
16 *tion Revision Act of 2005, the mark or trade*
17 *name that is likely to cause dilution by blurring*
18 *or dilution by tarnishment, and*

19 “(B) *in a claim arising under this sub-*
20 *section—*

21 “(i) *by reason of dilution by blurring,*
22 *the person against whom the injunction is*
23 *sought willfully intended to trade on the*
24 *recognition of the famous mark, or*

1 “(ii) by reason of dilution by
2 tarnishment, the person against whom the
3 injunction is sought willfully intended to
4 harm the reputation of the famous mark,
5 the owner of the famous mark shall also be entitled
6 to the remedies set forth in sections 35(a) and 36, sub-
7 ject to the discretion of the court and the principles
8 of equity.

9 “(5) OWNERSHIP OF VALID REGISTRATION A
10 COMPLETE BAR TO ACTION.—The ownership by a per-
11 son of a valid registration under the Act of March 3,
12 1881, or the Act of February 20, 1905, or on the prin-
13 cipal register under this Act shall be a complete bar
14 to an action against that person, with respect to that
15 mark, that is brought by another person under the
16 common law or a statute of a State and that seeks to
17 prevent dilution by blurring or dilution by
18 tarnishment, or that asserts any claim of actual or
19 likely damage or harm to the distinctiveness or rep-
20 utation of a mark, label, or form of advertisement.”;
21 and

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

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

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

5 (1) *by striking the last two sentences; and*

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

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

20 (c) *CANCELLATION.*—Section 14 of the Trademark Act
21 of 1946 (15 *U.S.C. 1064*) is amended, in the matter pre-
22 ceding paragraph (1)—

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

25 (2) *by inserting “(A) for which the constructive*
26 *use date is after the date on which the petitioner’s*

1 *mark became famous and which would be likely to*
2 *cause dilution by blurring or dilution by tarnishment*
3 *under section 43(c), or (B) on grounds other than di-*
4 *lution by blurring or dilution by tarnishment” after*
5 *“February 20, 1905”.*

6 *(d) MARKS FOR THE SUPPLEMENTAL REGISTER.—The*
7 *second sentence of section 24 of the Trademark Act of 1946*
8 *(15 U.S.C. 1092) is amended to read as follows: “Whenever*
9 *any person believes that such person is or will be damaged*
10 *by the registration of a mark on the supplemental register—*

11 *“(1) for which the effective filing date is after the*
12 *date on which such person’s mark became famous and*
13 *which would be likely to cause dilution by blurring*
14 *or dilution by tarnishment under section 43(c), or*

15 *“(2) on grounds other than dilution by blurring*
16 *or dilution by tarnishment,*

17 *such person may at any time, upon payment of the pre-*
18 *scribed fee and the filing of a petition stating the ground*
19 *therefor, apply to the Director to cancel such registration.”.*

20 *(e) DEFINITIONS.—Section 45 of the Trademark Act*
21 *of 1946 (15 U.S.C. 1127) is amended by striking the defini-*
22 *tion relating to “dilution”.*

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