

104TH CONGRESS
1ST SESSION

H. R. 1295

IN THE SENATE OF THE UNITED STATES

DECEMBER 13, 1995

Received

AN ACT

To amend the Trademark Act of 1946 to make certain revisions relating to the protection of famous marks.

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 This Act may be cited as the “Federal Trademark
5 Dilution Act of 1995”.

1 **SEC. 2. REFERENCE TO THE TRADEMARK ACT OF 1946.**

2 For purposes of this Act, the Act entitled “An Act
3 to provide for the registration and protection of trade-
4 marks used in commerce, to carry out the provisions of
5 certain international conventions, and for other purposes”,
6 approved July 5, 1946 (15 U.S.C. 1051 and following),
7 shall be referred to as the “Trademark Act of 1946”.

8 **SEC. 3. REMEDIES FOR DILUTION OF FAMOUS MARKS.**

9 (a) REMEDIES.—Section 43 of the Trademark Act of
10 1946 (15 U.S.C. 1125) is amended by adding at the end
11 the following new subsection:

12 “(c)(1) The owner of a famous mark shall be entitled,
13 subject to the principles of equity and upon such terms
14 as the court deems reasonable, to an injunction against
15 another person’s commercial use in commerce of a mark
16 or trade name, if such use begins after the mark has be-
17 come famous and causes dilution of the distinctive quality
18 of the mark, and to obtain such other relief as is provided
19 in this subsection. In determining whether a mark is dis-
20 tinctive and famous, a court may consider factors such
21 as, but not limited to—

22 “(A) the degree of inherent or acquired distinc-
23 tiveness of the mark;

24 “(B) the duration and extent of use of the
25 mark in connection with the goods or services with
26 which the mark is used;

1 “(C) the duration and extent of advertising and
2 publicity of the mark;

3 “(D) the geographical extent of the trading
4 area in which the mark is used;

5 “(E) the channels of trade for the goods or
6 services with which the mark is used;

7 “(F) the degree of recognition of the mark in
8 the trading areas and channels of trade used by the
9 marks’ owner and the person against whom the in-
10 junction is sought;

11 “(G) the nature and extent of use of the same
12 or similar marks by third parties; and

13 “(H) whether the mark was registered under
14 the Act of March 3, 1881, or the Act of February
15 20, 1905, or on the principal register.

16 “(2) In an action brought under this subsection, the
17 owner of the famous mark shall be entitled only to injunc-
18 tive relief unless the person against whom the injunction
19 is sought willfully intended to trade on the owner’s reputa-
20 tion or to cause dilution of the famous mark. If such will-
21 ful intent is proven, the owner of the famous mark shall
22 also be entitled to the remedies set forth in sections 35(a)
23 and 36, subject to the discretion of the court and the prin-
24 ciples of equity.

1 “(3) The ownership by a person of a valid registra-
2 tion under the Act of March 3, 1881, or the Act of Feb-
3 ruary 20, 1905, or on the principal register shall be a com-
4 plete bar to an action against that person, with respect
5 to that mark, that is brought by another person under
6 the common law or a statute of a State and that seeks
7 to prevent dilution of the distinctiveness of a mark, label,
8 or form of advertisement.

9 “(4) The following shall not be actionable under this
10 section:

11 “(A) Fair use of a famous mark by another
12 person in comparative commercial advertising or
13 promotion to identify the competing goods or serv-
14 ices of the owner of the famous mark.

15 “(B) Noncommercial use of a mark.

16 “(C) All forms of news reporting and news
17 commentary.”.

18 (b) CONFORMING AMENDMENT.—The heading for
19 title VIII of the Trademark Act of 1946 is amended by
20 striking “AND FALSE DESCRIPTIONS” and inserting
21 “, FALSE DESCRIPTIONS, AND DILUTION”.

22 **SEC. 4. DEFINITION.**

23 Section 45 of the Trademark Act of 1946 (15 U.S.C.
24 1127) is amended by inserting after the paragraph defin-

1 ing when a mark shall be deemed to be “abandoned” the
2 following:

3 “The term ‘dilution’ means the lessening of the ca-
4 pacity of a famous mark to identify and distinguish goods
5 or services, regardless of the presence or absence of—

6 “(1) competition between the owner of the fa-
7 mous mark and other parties, or

8 “(2) likelihood of confusion, mistake, or decep-
9 tion.”.

10 **SEC. 5. EFFECTIVE DATE.**

11 This Act and the amendments made by this Act shall
12 take effect on the date of the enactment of this Act.

Passed the House of Representatives December 12,
1995.

Attest:

ROBIN H. CARLE,
Clerk.