

Union Calendar No. 188

104TH CONGRESS
1ST Session

H. R. 1295

[Report No. 104-374]

A BILL

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

NOVEMBER 30, 1995

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

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IN THE HOUSE OF REPRESENTATIVES

MARCH 22, 1995

Mr. MOORHEAD (for himself, Mr. SENSENBRENNER, Mr. COBLE, Mr. CANADY of Florida, Mr. GOODLATTE, Mr. BONO, and Mr. BOUCHER) introduced the following bill; which was referred to the Committee on the Judiciary

NOVEMBER 30, 1995

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 italics]

[For text of introduced bill, see copy of bill as introduced on March 22, 1995]

A BILL

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,*

1 **SECTION 1. SHORT TITLE.**

2 *This Act may be cited as the “Federal Trademark Di-*
3 *lution Act of 1995”.*

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

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

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

12 *(a) REMEDIES.—Section 43 of the Trademark Act of*
13 *1946 (15 U.S.C. 1125) is amended by adding at the end*
14 *the following new subsection:*

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

25 *“(A) the degree of inherent or acquired distinc-*
26 *tiveness of the mark;*

1 “(B) *the duration and extent of use of the mark*
2 *in connection with the goods or services with which*
3 *the mark is used;*

4 “(C) *the duration and extent of advertising and*
5 *publicity of the mark;*

6 “(D) *the geographical extent of the trading area*
7 *in which the mark is used;*

8 “(E) *the channels of trade for the goods or serv-*
9 *ices with which the mark is used;*

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

14 “(G) *the nature and extent of use of the same or*
15 *similar marks by third parties; and*

16 “(H) *whether the mark was registered under the*
17 *Act of March 3, 1881, or the Act of February 20,*
18 *1905, or on the principal register.*

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

1 36, subject to the discretion of the court and the principles
2 of equity.

3 “(3) The ownership by a person of a valid registration
4 under the Act of March 3, 1881, or the Act of February
5 20, 1905, or on the principal register shall be a complete
6 bar to an action against that person, with respect to that
7 mark, that is brought by another person under the common
8 law or a statute of a State and that seeks to prevent dilution
9 of the distinctiveness of a mark, label, or form of advertise-
10 ment.

11 “(4) The following shall not be actionable under this
12 section:

13 “(A) Fair use of a famous mark by another per-
14 son in comparative commercial advertising or pro-
15 motion to identify the competing goods or services of
16 the owner of the famous mark.

17 “(B) Noncommercial use of a mark.

18 “(C) All forms of news reporting and news com-
19 mentary.”.

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

1 **SEC. 4. DEFINITION.**

2 *Section 45 of the Trademark Act of 1946 (15 U.S.C.*
3 *1127) is amended by inserting after the paragraph defining*
4 *when a mark shall be deemed to be “abandoned” the follow-*
5 *ing:*

6 *“The term ‘dilution’ means the lessening of the capac-*
7 *ity of a famous mark to identify and distinguish goods or*
8 *services, regardless of the presence or absence of—*

9 *“(1) competition between the owner of the fa-*
10 *mous mark and other parties, or*

11 *“(2) likelihood of confusion, mistake, or decep-*
12 *tion.”.*

13 **SEC. 5. EFFECTIVE DATE.**

14 *This Act and the amendments made by this Act shall*
15 *take effect on the date of the enactment of this Act.*