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104TH CONGRESS
1ST SESSION

H. R. 1295

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

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

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A BILL

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

Be it enacted by the Senate and House of Representatives of the United States of America in Congress assembled,

SECTION 1. SHORT TITLE.

This Act may be cited as the "Federal Trademark Dilution Act of 1995".

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

For purposes of this Act, the Act entitled "An Act to provide for the registration and protection of trademarks used in commerce, to carry out the provisions of certain international conventions, and for other purposes",

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approved July 5, 1946 (15 U.S.C. 1051 and following), shall be referred to as the "Trademark Act of 1946".

SEC. 3. REMEDIES FOR DILUTION OF FAMOUS MARKS.

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

"(c)(1) The registrant of a famous mark registered under the Act of March 3, 1881, or the Act of February 20, 1905, or on the principal register shall be entitled, subject to the principles of equity and upon such terms as the court deems reasonable, to an injunction against another person's commercial use in commerce of a mark or trade name, if such use begins after the registrant's mark becomes famous and causes dilution of the distinctive quality of the registrant's mark, and to obtain such other relief as is provided in this subsection. In determining whether a mark is distinctive and famous, a court may consider factors such as, but not limited to—

"(A) the degree of inherent or acquired distinctiveness of the mark;

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

"(C) the duration and extent of advertising and publicity of the mark;

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"(D) the geographical extent of the trading area in which the mark is used;

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

"(F) the degree of recognition of the registrant's mark in the trading areas and channels of trade of the registrant and the person against whom the injunction is sought; and

"(G) the nature and extent of use of the same or similar marks by third parties.

"(2) In an action brought under this subsection, the registrant shall be entitled only to injunctive relief unless the person against whom the injunction is sought willfully intended to trade on the registrant's reputation or to cause dilution of the registrant's mark. If such willful intent is proven, the registrant shall also be entitled to the remedies set forth in sections 35(a) and 36, subject to the discretion of the court and the principles of equity.

"(3) The ownership by a person of a valid registration of a mark under the Act of March 3, 1881, or the Act of February 20, 1905, or on the principal register shall be a complete bar to an action against that person, with respect to that mark, that is brought by another person under the common law or a statute of a State and

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that seeks to prevent dilution of the distinctiveness of a mark, label, or form of advertisement.

"(4) The following shall not be actionable under this section:

"(A) Fair use of a registrant's mark by another person in comparative commercial advertising or promotion to identify the registrant's competing goods or services.

"(B) Noncommercial use of a mark.".

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

SEC. 4. DEFINITION.

Section 45 of the Trademark Act of 1946 (15 U.S.C. 1127) is amended by inserting after the paragraph defining when a mark shall be deemed to be "abandoned" the following:

"The term 'dilution' means the lessening of the capacity of a registrant's mark to identify and distinguish goods or services, regardless of the presence or absence of—

"(1) competition between the registrant and other parties, or

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"(2) likelihood of confusion, mistake, or deception.".

SEC. 5. EFFECTIVE DATE.

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

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