

104TH CONGRESS
1ST SESSION

S. 1513

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

IN THE SENATE OF THE UNITED STATES

DECEMBER 29, 1995

Mr. HATCH introduced the following bill; which was read twice and referred to the Committee on the Judiciary

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,*

3 **SECTION 1. SHORT TITLE.**

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

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

7 For purposes of this Act, the Act entitled “An Act
8 to provide for the registration and protection of trade-
9 marks used in commerce, to carry out the provisions of
10 certain international conventions, and for other purposes”,

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

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

4 (a) REMEDIES.—Section 43 of the Trademark Act of
 5 1946 (15 U.S.C. 1125) is amended by adding at the end
 6 the following new subsection:

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

17 “(A) the degree of inherent or acquired distine-
 18 tiveness of the mark;

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

22 “(C) the duration and extent of advertising and
 23 publicity of the mark;

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

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

3 “(F) the degree of recognition of the mark in
4 the trading areas and channels of trade of the
5 mark’s owner and the person against whom the in-
6 junction is sought;

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

9 “(H) the existence of a registration under the
10 Act of March 3, 1881, or the Act of February 20,
11 1905, or on the principal register.

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

21 “(3) The ownership by a person of a valid registra-
22 tion under the Act of March 3, 1881, or the Act of Feb-
23 ruary 20, 1905, or on the principal register shall be a com-
24 plete bar to an action against that person, with respect
25 to that mark, that is brought by another person under

1 the common law or statute of a State and that seeks to
 2 prevent dilution of the distinctiveness of a mark, label, or
 3 form of advertisement.

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

6 “(A) Fair use of a famous mark by another
 7 person in comparative commercial advertising or
 8 promotion to identify the competing goods or serv-
 9 ices of the owner of the famous mark.

10 “(B) Noncommercial use of a mark.

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

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

17 **SEC. 4. DEFINITION.**

18 Section 45 of the Trademark Act of 1946 (15 U.S.C.
 19 1127) is amended by inserting after the paragraph defin-
 20 ing when a mark shall be deemed to be “abandoned” the
 21 following:

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

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

3 “(2) likelihood of confusion, mistake, or decep-
4 tion.”.

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

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

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