

106TH CONGRESS
1ST SESSION

S. 1259

AN ACT

To amend the Trademark Act of 1946 relating to dilution
of famous marks, and for other purposes.

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 “Trademark Amend-
5 ments Act of 1999”.

1 **SEC. 2. DILUTION AS A GROUNDS FOR OPPOSITION AND**
 2 **CANCELATION.**

3 (a) REGISTRABLE MARKS.—Section 2 of the Act en-
 4 titled “An Act to provide for the registration and protec-
 5 tion of trade-marks used in commerce, to carry out the
 6 provisions of certain international conventions, and for
 7 other purposes” (in this Act referred to as the “Trade-
 8 mark Act of 1946”) (15 U.S.C. 1052) is amended by add-
 9 ing at the end the following flush sentences: “A mark
 10 which when used would cause dilution under section 43(c)
 11 may be refused registration only pursuant to a proceeding
 12 brought under section 13. A registration for a mark which
 13 when used would cause dilution under section 43(c) may
 14 be canceled pursuant to a proceeding brought under either
 15 section 14 or section 24.”.

16 (b) OPPOSITION.—Section 13(a) of the Trademark
 17 Act of 1946 (15 U.S.C. 1063(a)) is amended in the first
 18 sentence by inserting “, including as a result of dilution
 19 under section 43(c),” after “principal register”.

20 (c) PETITIONS TO CANCEL REGISTRATIONS.—Sec-
 21 tion 14 of the Trademark Act of 1946 (15 U.S.C. 1064)
 22 is amended in the matter preceding paragraph (1) by in-
 23 serting “, including as a result of dilution under section
 24 43(c),” after “damaged”.

25 (d) CANCELLATION.—Section 24 of the Trademark
 26 Act of 1946 (15 U.S.C. 1092) is amended in the second

1 sentence by inserting “, including as a result of dilution
2 under section 43(c),” after “register”.

3 (e) EFFECTIVE DATE AND APPLICATION.—The
4 amendments made by this section shall take effect on the
5 date of enactment of this Act and shall apply only to any
6 application for registration filed on or after January 16,
7 1996.

8 **SEC. 3. REMEDIES IN CASES OF DILUTION OF FAMOUS**
9 **MARKS.**

10 (a) INJUNCTIONS.—(1) Section 34(a) of the Trade-
11 mark Act of 1946 (15 U.S.C. 1116(a)) is amended in the
12 first sentence by striking “section 43(a)” and inserting
13 “subsection (a) or (c) of section 43”.

14 (2) Section 43(c)(2) of the Trademark Act of 1946
15 (15 U.S.C. 1125(c)(2)) is amended in the first sentence
16 by inserting “as set forth in section 34” after “relief”.

17 (b) DAMAGES.—Section 35(a) of the Trademark Act
18 of 1946 (15 U.S.C. 1117(a)) is amended in the first sen-
19 tence by striking “or a violation under section 43(a),” and
20 inserting “a violation under section 43(a), or a willful vio-
21 lation under section 43(c),”.

22 (c) DESTRUCTION OF ARTICLES.—Section 36 of the
23 Trademark Act of 1946 (15 U.S.C. 1118) is amended in
24 the first sentence—

1 (1) by striking “or a violation under section
 2 43(a),” and inserting “a violation under section
 3 43(a), or a willful violation under section 43(c),”;
 4 and

5 (2) by inserting after “in the case of a violation
 6 of section 43(a)” the following: “or a willful viola-
 7 tion under section 43(c)”.

8 (d) **EFFECTIVE DATE AND APPLICATION.**—The
 9 amendments made by this section shall take effect on the
 10 date of enactment of this Act and shall not apply to any
 11 civil action pending on such date of enactment.

12 **SEC. 4. LIABILITY OF GOVERNMENTS FOR TRADEMARK IN-**
 13 **FRINGEMENT AND DILUTION.**

14 (a) **CIVIL ACTIONS.**—Section 32 of the Trademark
 15 Act of 1946 (15 U.S.C. 1114) is amended in the last un-
 16 designated paragraph in paragraph (1)—

17 (1) in the first sentence by inserting after “in-
 18 cludes” the following: “the United States, all agen-
 19 cies and instrumentalities thereof, and all individ-
 20 uals, firms, corporations, or other persons acting for
 21 the United States and with the authorization and
 22 consent of the United States, and”; and

23 (2) in the second sentence by striking “Any”
 24 and inserting “The United States, all agencies and
 25 instrumentalities thereof, and all individuals, firms,

1 corporations, other persons acting for the United
2 States and with the authorization and consent of the
3 United States, and any”.

4 (b) WAIVER OF SOVEREIGN IMMUNITY.—Section 40
5 of the Trademark Act of 1946 (15 U.S.C. 1122) is
6 amended—

7 (1) by redesignating subsection (b) as sub-
8 section (c);

9 (2) by striking “SEC. 40. (a) Any State” and
10 inserting the following:

11 “SEC. 40. (a) WAIVER OF SOVEREIGN IMMUNITY BY
12 THE UNITED STATES.—The United States, all agencies
13 and instrumentalities thereof, and all individuals, firms,
14 corporations, other persons acting for the United States
15 and with the authorization and consent of the United
16 States, shall not be immune from suit in Federal or State
17 court by any person, including any governmental or non-
18 governmental entity, for any violation under this Act.

19 “(b) WAIVER OF SOVEREIGN IMMUNITY BY
20 STATES.—Any State”; and

21 (3) in the first sentence of subsection (c), as so
22 redesignated—

23 (A) by striking “subsection (a) for a viola-
24 tion described in that subsection” and inserting

1 “subsection (a) or (b) for a violation described
2 therein”; and

3 (B) by inserting after “other than” the fol-
4 lowing: “the United States or any agency or in-
5 strumentality thereof, or any individual, firm,
6 corporation, or other person acting for the
7 United States and with authorization and con-
8 sent of the United States, or”.

9 (c) DEFINITION.—Section 45 of the Trademark Act
10 of 1946 (15 U.S.C. 1127) is amended by inserting be-
11 tween the 2 paragraphs relating to the definition of “per-
12 son” the following:

13 “The term ‘person’ also includes the United States,
14 any agency or instrumentality thereof, or any individual,
15 firm, or corporation acting for the United States and with
16 the authorization and consent of the United States. The
17 United States, any agency or instrumentality thereof, and
18 any individual, firm, or corporation acting for the United
19 States and with the authorization and consent of the
20 United States, shall be subject to the provisions of this
21 Act in the same manner and to the same extent as any
22 nongovernmental entity.”.

1 **SEC. 5. CIVIL ACTIONS FOR TRADE DRESS INFRINGEMENT.**

2 Section 43(a) of the Trademark Act of 1946 (15
3 U.S.C. 1125(a)) is amended by adding at the end the fol-
4 lowing:

5 “(3) In a civil action for trade dress infringement
6 under this Act for trade dress not registered on the prin-
7 cipal register, the person who asserts trade dress protec-
8 tion has the burden of proving that the matter sought to
9 be protected is not functional.”.

10 **SEC. 6. TECHNICAL AMENDMENTS.**

11 (a) ASSIGNMENT OF MARKS.—Section 10 of the
12 Trademark Act of 1946 (15 U.S.C. 1060) is amended—

13 (1) by striking “subsequent purchase” in the
14 second to last sentence and inserting “assignment”;

15 (2) in the first sentence by striking “mark,”
16 and inserting “mark.”; and

17 (3) in the third sentence by striking the second
18 period at the end.

19 (b) ADDITIONAL CLERICAL AMENDMENTS.—The text
20 and title of the Trademark Act of 1946 are amended by

- 1 striking “trade-marks” each place it appears and inserting
- 2 “trademarks”.

Passed the Senate July 1, 1999.

Attest:

Secretary.

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