

106TH CONGRESS
1ST SESSION

S. 1259

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

IN THE SENATE OF THE UNITED STATES

JUNE 22, 1999

Mr. HATCH (for himself and Mr. LEAHY) 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 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”.

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

8 (a) REGISTRABLE MARKS.—Section 2 of the Act en-
9 titled “An Act to provide for the registration and protec-
10 tion of trade-marks used in commerce, to carry out the

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

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

15 (c) PETITIONS TO CANCEL REGISTRATIONS.—Sec-
 16 tion 14 of the Trademark Act of 1946 (15 U.S.C. 1064)
 17 is amended in the matter preceding paragraph (1) by in-
 18 serting “, including as a result of dilution under section
 19 43(c),” after “damaged”.

20 (d) CANCELLATION.—Section 24 of the Trademark
 21 Act of 1946 (15 U.S.C. 1092) is amended in the second
 22 sentence by inserting “, including as a result of dilution
 23 under section 43(c),” after “register”.

24 (e) EFFECTIVE DATE AND APPLICATION.—The
 25 amendments made by this section shall take effect on the

1 date of enactment of this Act and shall apply only to any
 2 application for registration filed on or after January 16,
 3 1996.

4 **SEC. 3. REMEDIES IN CASES OF DILUTION OF FAMOUS**
 5 **MARKS.**

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

10 (2) Section 43(c)(2) of the Trademark Act of 1946
 11 (15 U.S.C. 1125(c)(2)) is amended in the first sentence
 12 by inserting “as set forth in section 34” after “relief”.

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

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

21 (1) by striking “or a violation under section
 22 43(a),” and inserting “a violation under section
 23 43(a), or a willful violation under section 43(c),”;
 24 and

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

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

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

9 (1) in the first sentence by inserting after “in-
10 cludes” the following: “the United States, all agen-
11 cies and instrumentalities thereof, and all individ-
12 uals, firms, corporations, or other persons acting for
13 the United States and with the authorization and
14 consent of the United States, and”; and

15 (2) in the second sentence by striking “Any”
16 and inserting “The United States, all agencies and
17 instrumentalities thereof, and all individuals, firms,
18 corporations, other persons acting for the United
19 States and with the authorization and consent of the
20 United States, and any”.

21 (b) WAIVER OF SOVEREIGN IMMUNITY.—Section 40
22 of the Trademark Act of 1946 (15 U.S.C. 1122) is
23 amended—

24 (1) by redesignating subsection (b) as sub-
25 section (c);

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

3 “SEC. 40. (a) WAIVER OF SOVEREIGN IMMUNITY BY
4 THE UNITED STATES.—The United States, all agencies
5 and instrumentalities thereof, and all individuals, firms,
6 corporations, other persons acting for the United States
7 and with the authorization and consent of the United
8 States, shall not be immune from suit in Federal or State
9 court by any person, including any governmental or non-
10 governmental entity, for any violation under this Act.

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

13 (3) in the first sentence of subsection (c), as so
14 redesignated—

15 (A) by striking “subsection (a) for a viola-
16 tion described in that subsection” and inserting
17 “subsection (a) or (b) for a violation described
18 therein”; and

19 (B) by inserting after “other than” the fol-
20 lowing: “the United States or any agency or in-
21 strumentality thereof, or any individual, firm,
22 corporation, or other person acting for the
23 United States and with authorization and con-
24 sent of the United States, or”.

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

5 “The term ‘person’ also includes the United States,
 6 any agency or instrumentality thereof, or any individual,
 7 firm, or corporation acting for the United States and with
 8 the authorization and consent of the United States. The
 9 United States, any agency or instrumentality thereof, and
 10 any individual, firm, or corporation acting for the United
 11 States and with the authorization and consent of the
 12 United States, shall be subject to the provisions of this
 13 Act in the same manner and to the same extent as any
 14 nongovernmental entity.”.

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

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

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

1 **SEC. 6. TECHNICAL AMENDMENTS.**

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

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

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

8 (3) in the third sentence by striking the second
9 period at the end.

10 (b) ADDITIONAL CLERICAL AMENDMENTS.—The text
11 and title of the Trademark Act of 1946 are amended by
12 striking “trade-marks” each place it appears and inserting
13 “trademarks”.

