

***In the Senate of the United States,***

*March 8, 2006.*

*Resolved*, That the bill from the House of Representatives (H.R. 683) entitled “An Act to amend the Trademark Act of 1946 with respect to dilution by blurring or tarnishment.”, do pass with the following

**AMENDMENT:**

Strike out all after the enacting clause and insert:

1 ***SECTION 1. SHORT TITLE.***

2       (a) *SHORT TITLE.*—*This Act may be cited as the*

3 *“Trademark Dilution Revision Act of 2006”.*

1       (b) *REFERENCES.*—Any reference in this Act to the  
 2 *Trademark Act of 1946 shall be a reference to the Act enti-*  
 3 *tled “An Act to provide for the registration and protection*  
 4 *of trademarks used in commerce, to carry out the provisions*  
 5 *of certain international conventions, and for other pur-*  
 6 *poses”, approved July 5, 1946 (15 U.S.C. 1051 et seq.).*

7 **SEC. 2. DILUTION BY BLURRING; DILUTION BY**  
 8 **TARNISHMENT.**

9       Section 43 of the Trademark Act of 1946 (15 U.S.C.  
 10 1125) is amended—

11               (1) *by striking subsection (c) and inserting the*  
 12 *following:*

13       “(c) *DILUTION BY BLURRING; DILUTION BY*  
 14 *TARNISHMENT.*—

15               “(1) *INJUNCTIVE RELIEF.*—Subject to the prin-  
 16 *ciples of equity, the owner of a famous mark that is*  
 17 *distinctive, inherently or through acquired distinctive-*  
 18 *ness, shall be entitled to an injunction against an-*  
 19 *other person who, at any time after the owner’s mark*  
 20 *has become famous, commences use of a mark or trade*  
 21 *name in commerce that is likely to cause dilution by*  
 22 *blurring or dilution by tarnishment of the famous*  
 23 *mark, regardless of the presence or absence of actual*  
 24 *or likely confusion, of competition, or of actual eco-*  
 25 *nom ic injury.*

1           “(2) *DEFINITIONS.*—(A) *For purposes of para-*  
2 *graph (1), a mark is famous if it is widely recognized*  
3 *by the general consuming public of the United States*  
4 *as a designation of source of the goods or services of*  
5 *the mark’s owner. In determining whether a mark*  
6 *possesses the requisite degree of recognition, the court*  
7 *may consider all relevant factors, including the fol-*  
8 *lowing:*

9           “(i) *The duration, extent, and geographic*  
10 *reach of advertising and publicity of the mark,*  
11 *whether advertised or publicized by the owner or*  
12 *third parties.*

13           “(ii) *The amount, volume, and geographic*  
14 *extent of sales of goods or services offered under*  
15 *the mark.*

16           “(iii) *The extent of actual recognition of the*  
17 *mark.*

18           “(iv) *Whether the mark was registered*  
19 *under the Act of March 3, 1881, or the Act of*  
20 *February 20, 1905, or on the principal register.*

21           “(B) *For purposes of paragraph (1), ‘dilution by*  
22 *blurring’ is association arising from the similarity*  
23 *between a mark or trade name and a famous mark*  
24 *that impairs the distinctiveness of the famous mark.*  
25 *In determining whether a mark or trade name is like-*

1 *ly to cause dilution by blurring, the court may con-*  
2 *sider all relevant factors, including the following:*

3 *“(i) The degree of similarity between the*  
4 *mark or trade name and the famous mark.*

5 *“(ii) The degree of inherent or acquired dis-*  
6 *tinctiveness of the famous mark.*

7 *“(iii) The extent to which the owner of the*  
8 *famous mark is engaging in substantially exclu-*  
9 *sive use of the mark.*

10 *“(iv) The degree of recognition of the fa-*  
11 *mous mark.*

12 *“(v) Whether the user of the mark or trade*  
13 *name intended to create an association with the*  
14 *famous mark.*

15 *“(vi) Any actual association between the*  
16 *mark or trade name and the famous mark.*

17 *“(C) For purposes of paragraph (1), ‘dilution by*  
18 *tarnishment’ is association arising from the simi-*  
19 *larity between a mark or trade name and a famous*  
20 *mark that harms the reputation of the famous mark.*

21 *“(3) EXCLUSIONS.—The following shall not be*  
22 *actionable as dilution by blurring or dilution by*  
23 *tarnishment under this subsection:*

24 *“(A) Any fair use, including a nominative*  
25 *or descriptive fair use, or facilitation of such fair*

1           *use, of a famous mark by another person other*  
2           *than as a designation of source for the person’s*  
3           *own goods or services, including use in connec-*  
4           *tion with—*

5                     *“(i) advertising or promotion that per-*  
6                     *mits consumers to compare goods or serv-*  
7                     *ices; or*

8                     *“(ii) identifying and parodying, criti-*  
9                     *cizing, or commenting upon the famous*  
10                    *mark owner or the goods or services of the*  
11                    *famous mark owner.*

12                    *“(B) All forms of news reporting and news*  
13                    *commentary.*

14                    *“(C) Any noncommercial use of a mark.*

15                    *“(4) BURDEN OF PROOF.—In a civil action for*  
16                    *trade dress dilution under this Act for trade dress not*  
17                    *registered on the principal register, the person who*  
18                    *asserts trade dress protection has the burden of prov-*  
19                    *ing that—*

20                    *“(A) the claimed trade dress, taken as a*  
21                    *whole, is not functional and is famous; and*

22                    *“(B) if the claimed trade dress includes any*  
23                    *mark or marks registered on the principal reg-*  
24                    *ister, the unregistered matter, taken as a whole,*

1            *is famous separate and apart from any fame of*  
2            *such registered marks.*

3            “(5) *ADDITIONAL REMEDIES.—In an action*  
4            *brought under this subsection, the owner of the famous*  
5            *mark shall be entitled to injunctive relief as set forth*  
6            *in section 34. The owner of the famous mark shall*  
7            *also be entitled to the remedies set forth in sections*  
8            *35(a) and 36, subject to the discretion of the court*  
9            *and the principles of equity if—*

10            “(A) *the mark or trade name that is likely*  
11            *to cause dilution by blurring or dilution by*  
12            *tarnishment was first used in commerce by the*  
13            *person against whom the injunction is sought*  
14            *after the date of enactment of the Trademark Di-*  
15            *lution Revision Act of 2006; and*

16            “(B) *in a claim arising under this*  
17            *subsection—*

18            “(i) *by reason of dilution by blurring,*  
19            *the person against whom the injunction is*  
20            *sought willfully intended to trade on the*  
21            *recognition of the famous mark; or*

22            “(ii) *by reason of dilution by*  
23            *tarnishment, the person against whom the*  
24            *injunction is sought willfully intended to*  
25            *harm the reputation of the famous mark.*

1           “(6) *OWNERSHIP OF VALID REGISTRATION A*  
 2           *COMPLETE BAR TO ACTION.*—*The ownership by a per-*  
 3           *son of a valid registration under the Act of March 3,*  
 4           *1881, or the Act of February 20, 1905, or on the prin-*  
 5           *cipal register under this Act shall be a complete bar*  
 6           *to an action against that person, with respect to that*  
 7           *mark, that—*

8                   “(A)(i) *is brought by another person under*  
 9                   *the common law or a statute of a State; and*

10                   “(ii) *seeks to prevent dilution by blurring*  
 11                   *or dilution by tarnishment; or*

12                   “(B) *asserts any claim of actual or likely*  
 13                   *damage or harm to the distinctiveness or reputa-*  
 14                   *tion of a mark, label, or form of advertisement.*

15           “(7) *SAVINGS CLAUSE.*—*Nothing in this sub-*  
 16           *section shall be construed to impair, modify, or super-*  
 17           *seede the applicability of the patent laws of the United*  
 18           *States.”; and*

19                   (2) *in subsection (d)(1)(B)(i)(IX), by striking*  
 20                   *“(c)(1) of section 43” and inserting “(c)”.*

21 **SEC. 3. CONFORMING AMENDMENTS.**

22           (a) *MARKS REGISTRABLE ON THE PRINCIPAL REG-*  
 23           *ISTER.*—*Section 2(f) of the Trademark Act of 1946 (15*  
 24           *U.S.C. 1052(f)) is amended—*

25                   (1) *by striking the last two sentences; and*

1           (2) *by adding at the end the following: “A mark*  
2           *which would be likely to cause dilution by blurring*  
3           *or dilution by tarnishment under section 43(c), may*  
4           *be refused registration only pursuant to a proceeding*  
5           *brought under section 13. A registration for a mark*  
6           *which would be likely to cause dilution by blurring*  
7           *or dilution by tarnishment under section 43(c), may*  
8           *be canceled pursuant to a proceeding brought under*  
9           *either section 14 or section 24.”.*

10          (b) *OPPOSITION.—Section 13(a) of the Trademark Act*  
11          *of 1946 (15 U.S.C. 1063(a)) is amended in the first sentence*  
12          *by striking “as a result of dilution” and inserting “the reg-*  
13          *istration of any mark which would be likely to cause dilu-*  
14          *tion by blurring or dilution by tarnishment”.*

15          (c) *CANCELLATION.—Section 14 of the Trademark Act*  
16          *of 1946 (15 U.S.C. 1064) is amended, in the matter pre-*  
17          *ceding paragraph (1) by striking “, including as a result*  
18          *of dilution under section 43(c),” and inserting “, including*  
19          *as a result of a likelihood of dilution by blurring or dilution*  
20          *by tarnishment under section 43(c),”.*

21          (d) *MARKS FOR THE SUPPLEMENTAL REGISTER.—The*  
22          *second sentence of section 24 of the Trademark Act of 1946*  
23          *(15 U.S.C. 1092) is amended to read as follows:*

1 “Whenever any person believes that such person is or will  
2 be damaged by the registration of a mark on the supple-  
3 mental register—

4 “(1) for which the effective filing date is after the  
5 date on which such person’s mark became famous and  
6 which would be likely to cause dilution by blurring  
7 or dilution by tarnishment under section 43(c); or

8 “(2) on grounds other than dilution by blurring  
9 or dilution by tarnishment, such person may at any  
10 time, upon payment of the prescribed fee and the fil-  
11 ing of a petition stating the ground therefor, apply to  
12 the Director to cancel such registration.”.

13 (e) *DEFINITIONS.*—Section 45 of the Trademark Act  
14 of 1946 (15 U.S.C. 1127) is amended by striking the defini-  
15 tion relating to the term “dilution”.

Attest:

*Secretary.*

109<sup>TH</sup> CONGRESS  
2<sup>D</sup> SESSION

**H. R. 683**

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**AMENDMENT**