

Public Law 106-43
105th Congress

An Act

Aug. 5, 1999
[S. 1259]

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

Trademark
Amendments Act
of 1999.
15 USC 1051
note.

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 "Trademark Amendments Act of 1999".

SEC. 2. DILUTION AS A GROUNDS FOR OPPOSITION AND CANCELLATION.

(a) **REGISTRABLE MARKS.**—Section 2 of the Act entitled "An Act to provide for the registration and protection of trade-marks used in commerce, to carry out the provisions of certain international conventions, and for other purposes" (in this Act referred to as the "Trademark Act of 1946") (15 U.S.C. 1052) is amended by adding at the end the following flush sentences: "A mark which when used would cause dilution under section 43(c) may be refused registration only pursuant to a proceeding brought under section 13. A registration for a mark which when used would cause dilution under section 43(c) may be canceled pursuant to a proceeding brought under either section 14 or section 24."

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

(c) **PETITIONS TO CANCEL REGISTRATIONS.**—Section 14 of the Trademark Act of 1946 (15 U.S.C. 1064) is amended in the matter preceding paragraph (1) by inserting ", including as a result of dilution under section 43(c)," after "damaged".

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

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

SEC. 3. REMEDIES IN CASES OF DILUTION OF FAMOUS MARKS.

(a) **INJUNCTIONS.**—(1) Section 34(a) of the Trademark Act of 1946 (15 U.S.C. 1116(a)) is amended in the first sentence by striking "section 43(a)" and inserting "subsection (a) or (c) of section 43".

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

(b) **DAMAGES.**—Section 35(a) of the Trademark Act of 1946 (15 U.S.C. 1117(a)) is amended in the first sentence by striking “or a violation under section 43(a),” and inserting “a violation under section 43(a), or a willful violation under section 43(c),”.

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

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

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

SEC. 4. LIABILITY OF GOVERNMENTS FOR TRADEMARK INFRINGEMENT AND DILUTION.

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

(1) in the first sentence by inserting after “includes” the following: “the United States, all agencies and instrumentalities thereof, and all individuals, firms, corporations, or other persons acting for the United States and with the authorization and consent of the United States, and”; and

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

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

(1) by redesignating subsection (b) as subsection (c);

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

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

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

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

(A) by striking “subsection (a) for a violation described in that subsection” and inserting “subsection (a) or (b) for a violation described therein”; and

(B) by inserting after “other than” the following: “the United States or any agency or instrumentality thereof, or any individual, firm, corporation, or other person acting for the United States and with authorization and consent of the United States, or”.

(c) **DEFINITION.**—Section 45 of the Trademark Act of 1946 (15 U.S.C. 1127) is amended by inserting between the 2 paragraphs relating to the definition of “person” the following:

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

SEC. 5. CIVIL ACTIONS FOR TRADE DRESS INFRINGEMENT.

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

“(3) In a civil action for trade dress infringement under this Act for trade dress not registered on the principal register, the person who asserts trade dress protection has the burden of proving that the matter sought to be protected is not functional.”.

SEC. 6. TECHNICAL AMENDMENTS.

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

- “(1) by striking “subsequent purchase” in the second to last sentence and inserting “assignment”;
- “(2) in the first sentence by striking “mark,” and inserting “mark.”; and
- “(3) in the third sentence by striking the second period at the end.

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

15 USC 1051
note, 1053, 1054,
1091, 1124, 1126,
1127.

Approved August 5, 1999.

LEGISLATIVE HISTORY—S. 1259:

CONGRESSIONAL RECORD, Vol. 145 (1999):
July 1, considered and passed Senate.
July 26, considered and passed House.