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104TH CONGRESS  
1ST SESSION

# H. R. 1295

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

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## IN THE HOUSE OF REPRESENTATIVES

MARCH 22, 1995

Mr. MOORHEAD (for himself, Mr. SENSENBRENNER, Mr. COBLE, Mr. CANADY of Florida, Mr. GOODLATTE, Mr. BONO, and Mr. BOUCHER) introduced the following bill; which was referred to the Committee on the Judiciary

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## 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 registrant of a famous mark registered  
8 under the Act of March 3, 1881, or the Act of February  
9 20, 1905, or on the principal register shall be entitled,  
10 subject to the principles of equity and upon such terms  
11 as the court deems reasonable, to an injunction against  
12 another person's commercial use in commerce of a mark  
13 or trade name, if such use begins after the registrant's  
14 mark becomes famous and causes dilution of the distinc-  
15 tive quality of the registrant's mark, and to obtain such  
16 other relief as is provided in this subsection. In determin-  
17 ing whether a mark is distinctive and famous, a court may  
18 consider factors such as, but not limited to—

19 "(A) the degree of inherent or acquired distinc-  
20 tiveness of the mark;

21 "(B) the duration and extent of use of the  
22 mark in connection with the goods or services with  
23 which the mark is used;

24 "(C) the duration and extent of advertising and  
25 publicity of the mark;

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

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

5           “(F) the degree of recognition of the reg-  
6           istrant’s mark in the trading areas and channels of  
7           trade of the registrant and the person against whom  
8           the injunction is sought; and

9           “(G) the nature and extent of use of the same  
10          or similar marks by third parties.

11          “(2) In an action brought under this subsection, the  
12          registrant shall be entitled only to injunctive relief unless  
13          the person against whom the injunction is sought willfully  
14          intended to trade on the registrant’s reputation or to  
15          cause dilution of the registrant’s mark. If such willful in-  
16          tent is proven, the registrant shall also be entitled to the  
17          remedies set forth in sections 35(a) and 36, subject to the  
18          discretion of the court and the principles of equity.

19          “(3) The ownership by a person of a valid registra-  
20          tion of a mark under the Act of March 3, 1881, or the  
21          Act of February 20, 1905, or on the principal register  
22          shall be a complete bar to an action against that person,  
23          with respect to that mark, that is brought by another per-  
24          son under the common law or a statute of a State and

1 that seeks to prevent dilution of the distinctiveness of a  
2 mark, label, or form of advertisement.

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

5 “(A) Fair use of a registrant’s mark by another  
6 person in comparative commercial advertising or  
7 promotion to identify the registrant’s competing  
8 goods or services.

9 “(B) Noncommercial use of a mark.”.

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

14 **SEC. 4. DEFINITION.**

15 Section 45 of the Trademark Act of 1946 (15 U.S.C.  
16 1127) is amended by inserting after the paragraph defin-  
17 ing when a mark shall be deemed to be “abandoned” the  
18 following:

19 “The term ‘dilution’ means the lessening of the ca-  
20 pacity of a registrant’s mark to identify and distinguish  
21 goods or services, regardless of the presence or absence  
22 of—

23 “(1) competition between the registrant and  
24 other parties, or

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

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

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

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