

102D CONGRESS
1ST SESSION

S. 759

To amend certain trademark laws to clarify that States, instrumentalities of States, and officers and employees of States acting in their official capacity, are subject to suit in Federal court by any person for infringement of trademarks, and that all the remedies can be obtained in such suit that can be obtained in a suit against a private entity.

IN THE SENATE OF THE UNITED STATES

MARCH 21 (legislative day, FEBRUARY 6), 1991

Mr. DECONCINI (for himself and Mr. HATCH) introduced the following bill;
which was read twice and referred to the Committee on the Judiciary

A BILL

To amend certain trademark laws to clarify that States, instrumentalities of States, and officers and employees of States acting in their official capacity, are subject to suit in Federal court by any person for infringement of trademarks, and that all the remedies can be obtained in such suit that can be obtained in a suit against a private entity.

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 Remedy
5 Clarification Act".

1 **SEC. 2. REFERENCE TO THE TRADEMARK ACT OF 1946.**

2 Except as otherwise expressly provided, whenever in
3 this Act an amendment is expressed in terms of an amend-
4 ment to a section or other provision, the reference shall
5 be considered to be made to a section or other provision
6 of the Act entitled "An Act to provide for the registration
7 and protection of trademarks used in commerce, to carry
8 out the provisions of certain international conventions,
9 and for other purposes", approved July 5, 1946 (15
10 U.S.C. 1051 et seq.) (commonly referred to as the Trade-
11 mark Act of 1946).

12 **SEC. 3. LIABILITY OF STATES, INSTRUMENTALITIES OF**
13 **STATES, AND STATE OFFICIALS.**

14 (a) **LIABILITY AND REMEDIES.**—Section 32(1) of the
15 Act (15 U.S.C. 1114(1)) is amended by adding at the end
16 thereof the following:

17 "As used in this subsection, the term 'any person'
18 includes any State, any instrumentality of a State, and
19 any officer or employee of a State or instrumentality of
20 a State acting in his or her official capacity. Any State,
21 and any such instrumentality, officer, or employee, shall
22 be subject to the provisions of this Act in the same manner
23 and to the same extent as any nongovernmental entity."

24 (b) **LIABILITY OF STATES, INSTRUMENTALITIES OF**
25 **STATES, AND STATE OFFICIALS.**—The Act is amended by

1 inserting after section 39 (15 U.S.C. 1121) the following
2 new section:

3 “SEC. 40. (a) Any State, instrumentality of a State
4 or any officer or employee of a State or instrumentality
5 of a State acting in his or her official capacity, shall not
6 be immune, under the eleventh amendment of the Con-
7 stitution of the United States or under any other doctrine
8 of sovereign immunity, from suit in Federal court by any
9 person, including any governmental or nongovernmental
10 entity for any violation under this Act.

11 “(b) In a suit described in subsection (a) for a vio-
12 lation described in that subsection, remedies (including
13 remedies both at law and in equity) are available for the
14 violation to the same extent as such remedies are available
15 for such a violation in a suit against any person other than
16 a State, instrumentality of a State, or officer or employee
17 of a State or instrumentality of a State acting in his or
18 her official capacity. Such remedies include injunctive re-
19 lief under section 34, actual damages, profits, costs and
20 attorney’s fees under section 35, destruction of infringing
21 articles under section 36, the remedies provided for under
22 sections 32, 37, 38, 42 and 43, and for any other remedies
23 provided under this Act.”.

1 (c) FALSE DESIGNATION OF ORIGIN AND FALSE DE-
2 SCRIPTIONS FORBIDDEN.—Section 43(a) of the Act (15
3 U.S.C. 1125(a)) is amended—

4 (1) by inserting “(1)” after “(a)”; and

5 (2) by adding at the end thereof:

6 “(2) As used in this subsection, the term ‘any person’
7 includes any State, instrumentality of a State or employee
8 of a State or instrumentality of a State acting in his or
9 her official capacity. Any State, and any such instrumen-
10 tality, officer, or employee, shall be subject to the provi-
11 sions of this Act in the same manner and to the same
12 extent as any nongovernmental entity.”.

13 (d) DEFINITION.—Section 45 of the Act (15 U.S.C.
14 1127) is amended by inserting after the fourth undesig-
15 nated paragraph the following:

16 “The term ‘person’ also includes any State, any in-
17 strumentality of a State, and any officer or employee of
18 a State or instrumentality of a State acting in his or her
19 official capacity. Any State, and any such instrumentality,
20 officer, or employee, shall be subject to the provisions of
21 this Act in the same manner and to the same extent as
22 any nongovernmental entity.”.

1 **SEC. 4. EFFECTIVE DATE.**

2 The amendments made by this Act shall take effect
3 with respect to violations that occur on or after the date
4 of the enactment of this Act.

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