

**Union Calendar No. 188**

104<sup>TH</sup> CONGRESS  
1<sup>ST</sup> Session

**H. R. 1295**

[Report No. 104-374]

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**A BILL**

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

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NOVEMBER 30, 1995

Reported with an amendment, committed to the Committee of the Whole House on the State of the Union, and ordered to be printed

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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

NOVEMBER 30, 1995

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[Strike out all after the enacting clause and insert the part printed in italics]

[For text of introduced bill, see copy of bill as introduced on March 22, 1995]

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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,*

1 **SECTION 1. SHORT TITLE.**

2 *This Act may be cited as the “Federal Trademark Di-*  
3 *lution Act of 1995”.*

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

5 *For purposes of this Act, the Act entitled “An Act to*  
6 *provide for the registration and protection of trade-marks*  
7 *used in commerce, to carry out the provisions of certain*  
8 *international conventions, and for other purposes”, ap-*  
9 *proved July 5, 1946 (15 U.S.C. 1051 and following), shall*  
10 *be referred to as the “Trademark Act of 1946”.*

11 **SEC. 3. REMEDIES FOR DILUTION OF FAMOUS MARKS.**

12 *(a) REMEDIES.—Section 43 of the Trademark Act of*  
13 *1946 (15 U.S.C. 1125) is amended by adding at the end*  
14 *the following new subsection:*

15 *“(c)(1) The owner of a famous mark shall be entitled,*  
16 *subject to the principles of equity and upon such terms as*  
17 *the court deems reasonable, to an injunction against an-*  
18 *other person’s commercial use in commerce of a mark or*  
19 *trade name, if such use begins after the mark has become*  
20 *famous and causes dilution of the distinctive quality of the*  
21 *mark, and to obtain such other relief as is provided in this*  
22 *subsection. In determining whether a mark is distinctive*  
23 *and famous, a court may consider factors such as, but not*  
24 *limited to—*

25 *“(A) the degree of inherent or acquired distinc-*  
26 *tiveness of the mark;*

1           “(B) *the duration and extent of use of the mark*  
2           *in connection with the goods or services with which*  
3           *the mark is used;*

4           “(C) *the duration and extent of advertising and*  
5           *publicity of the mark;*

6           “(D) *the geographical extent of the trading area*  
7           *in which the mark is used;*

8           “(E) *the channels of trade for the goods or serv-*  
9           *ices with which the mark is used;*

10           “(F) *the degree of recognition of the mark in the*  
11           *trading areas and channels of trade used by the*  
12           *marks’ owner and the person against whom the in-*  
13           *junction is sought;*

14           “(G) *the nature and extent of use of the same or*  
15           *similar marks by third parties; and*

16           “(H) *whether the mark was registered under the*  
17           *Act of March 3, 1881, or the Act of February 20,*  
18           *1905, or on the principal register.*

19           “(2) *In an action brought under this subsection, the*  
20           *owner of the famous mark shall be entitled only to injunc-*  
21           *tive relief unless the person against whom the injunction*  
22           *is sought willfully intended to trade on the owner’s reputa-*  
23           *tion or to cause dilution of the famous mark. If such willful*  
24           *intent is proven, the owner of the famous mark shall also*  
25           *be entitled to the remedies set forth in sections 35(a) and*

1 36, subject to the discretion of the court and the principles  
2 of equity.

3 “(3) The ownership by a person of a valid registration  
4 under the Act of March 3, 1881, or the Act of February  
5 20, 1905, or on the principal register shall be a complete  
6 bar to an action against that person, with respect to that  
7 mark, that is brought by another person under the common  
8 law or a statute of a State and that seeks to prevent dilution  
9 of the distinctiveness of a mark, label, or form of advertise-  
10 ment.

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

13 “(A) Fair use of a famous mark by another per-  
14 son in comparative commercial advertising or pro-  
15 motion to identify the competing goods or services of  
16 the owner of the famous mark.

17 “(B) Noncommercial use of a mark.

18 “(C) All forms of news reporting and news com-  
19 mentary.”.

20 (b) CONFORMING AMENDMENT.—The heading for title  
21 VIII of the Trademark Act of 1946 is amended by striking  
22 “AND FALSE DESCRIPTIONS” and inserting “, FALSE  
23 DESCRIPTIONS, AND DILUTION”.

1 **SEC. 4. DEFINITION.**

2        *Section 45 of the Trademark Act of 1946 (15 U.S.C.*  
3 *1127) is amended by inserting after the paragraph defining*  
4 *when a mark shall be deemed to be “abandoned” the follow-*  
5 *ing:*

6        *“The term ‘dilution’ means the lessening of the capac-*  
7 *ity of a famous mark to identify and distinguish goods or*  
8 *services, regardless of the presence or absence of—*

9            *“(1) competition between the owner of the fa-*  
10 *mous mark and other parties, or*

11            *“(2) likelihood of confusion, mistake, or decep-*  
12 *tion.”.*

13 **SEC. 5. EFFECTIVE DATE.**

14        *This Act and the amendments made by this Act shall*  
15 *take effect on the date of the enactment of this Act.*