

Calendar No. 195

106TH CONGRESS
1ST SESSION**S. 1259**

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

IN THE SENATE OF THE UNITED STATES

JUNE 22, 1999

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

JULY 1, 1999

Reported by Mr. HATCH, without amendment

A BILL

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

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 Amend-
5 ments Act of 1999”.

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

3 (a) **REGISTRABLE MARKS.**—Section 2 of the Act en-
4 titled “An Act to provide for the registration and protec-
5 tion of trade-marks used in commerce, to carry out the
6 provisions of certain international conventions, and for
7 other purposes” (in this Act referred to as the “Trade-
8 mark Act of 1946”) (15 U.S.C. 1052) is amended by add-
9 ing at the end the following flush sentences: “A mark
10 which when used would cause dilution under section 43(c)
11 may be refused registration only pursuant to a proceeding
12 brought under section 13. A registration for a mark which
13 when used would cause dilution under section 43(c) may
14 be canceled pursuant to a proceeding brought under either
15 section 14 or section 24.”.

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

20 (c) **PETITIONS TO CANCEL REGISTRATIONS.**—Sec-
21 tion 14 of the Trademark Act of 1946 (15 U.S.C. 1064)
22 is amended in the matter preceding paragraph (1) by in-
23 serting “, including as a result of dilution under section
24 43(c),” after “damaged”.

25 (d) **CANCELLATION.**—Section 24 of the Trademark
26 Act of 1946 (15 U.S.C. 1092) is amended in the second

1 sentence by inserting “, including as a result of dilution
2 under section 43(c),” after “register”.

3 (e) EFFECTIVE DATE AND APPLICATION.—The
4 amendments made by this section shall take effect on the
5 date of enactment of this Act and shall apply only to any
6 application for registration filed on or after January 16,
7 1996.

8 **SEC. 3. REMEDIES IN CASES OF DILUTION OF FAMOUS**
9 **MARKS.**

10 (a) INJUNCTIONS.—(1) Section 34(a) of the Trade-
11 mark Act of 1946 (15 U.S.C. 1116(a)) is amended in the
12 first sentence by striking “section 43(a)” and inserting
13 “subsection (a) or (c) of section 43”.

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

17 (b) DAMAGES.—Section 35(a) of the Trademark Act
18 of 1946 (15 U.S.C. 1117(a)) is amended in the first sen-
19 tence by striking “or a violation under section 43(a),” and
20 inserting “a violation under section 43(a), or a willful vio-
21 lation under section 43(c),”.

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

1 (1) by striking “or a violation under section
2 43(a),” and inserting “a violation under section
3 43(a), or a willful violation under section 43(c),”;
4 and

5 (2) by inserting after “in the case of a violation
6 of section 43(a)” the following: “or a willful viola-
7 tion under section 43(c)”.

8 **SEC. 4. LIABILITY OF GOVERNMENTS FOR TRADEMARK IN-**
9 **FRINGEMENT AND DILUTION.**

10 (a) CIVIL ACTIONS.—Section 32 of the Trademark
11 Act of 1946 (15 U.S.C. 1114) is amended in the last un-
12 designated paragraph in paragraph (1)—

13 (1) in the first sentence by inserting after “in-
14 cludes” the following: “the United States, all agen-
15 cies and instrumentalities thereof, and all individ-
16 uals, firms, corporations, or other persons acting for
17 the United States and with the authorization and
18 consent of the United States, and”;

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

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

4 (1) by redesignating subsection (b) as sub-
5 section (c);

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

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

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

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

20 (A) by striking “subsection (a) for a viola-
21 tion described in that subsection” and inserting
22 “subsection (a) or (b) for a violation described
23 therein”; and

24 (B) by inserting after “other than” the fol-
25 lowing: “the United States or any agency or in-

1 strumentality thereof, or any individual, firm,
 2 corporation, or other person acting for the
 3 United States and with authorization and con-
 4 sent of the United States, or”.

5 (c) DEFINITION.—Section 45 of the Trademark Act
 6 of 1946 (15 U.S.C. 1127) is amended by inserting be-
 7 tween the 2 paragraphs relating to the definition of “per-
 8 son” the following:

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

19 **SEC. 5. CIVIL ACTIONS FOR TRADE DRESS INFRINGEMENT.**

20 Section 43(a) of the Trademark Act of 1946 (15
 21 U.S.C. 1125(a)) is amended by adding at the end the fol-
 22 lowing:

23 “(3) In a civil action for trade dress infringement
 24 under this Act for trade dress not registered on the prin-
 25 cipal register, the person who asserts trade dress protec-

1 tion has the burden of proving that the matter sought to
2 be protected is not functional.”.

3 **SEC. 6. TECHNICAL AMENDMENTS.**

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

6 (1) by striking “subsequent purchase” in the
7 second to last sentence and inserting “assignment”;

8 (2) in the first sentence by striking “mark,”
9 and inserting “mark.”; and

10 (3) in the third sentence by striking the second
11 period at the end.

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

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