

AMENDMENT NO. _____ Calendar No. _____

Purpose: To amend the Trademark Act of 1946 with respect to dilution by blurring or tarnishment.

IN THE SENATE OF THE UNITED STATES—109th Cong., 2d Sess.

H. R. 683

To amend the Trademark Act of 1946 with respect to dilution by blurring or tarnishment.

Referred to the Committee on _____ and ordered to be printed

Ordered to lie on the table and to be printed

AMENDMENT intended to be proposed by Mr. HATCH

Viz:

1 Strike all after the enacting clause and insert the following:
2

3 **SECTION 1. SHORT TITLE.**

4 (a) **SHORT TITLE.**—This Act may be cited as the
5 “Trademark Dilution Revision Act of 2006”.

6 (b) **REFERENCES.**—Any reference in this Act to the
7 Trademark Act of 1946 shall be a reference to the Act
8 entitled “An Act to provide for the registration and protection
9 of trademarks used in commerce, to carry out the provisions
10 of certain international conventions, and for other

1 purposes”, approved July 5, 1946 (15 U.S.C. 1051 et
2 seq.).

3 **SEC. 2. DILUTION BY BLURRING; DILUTION BY**
4 **TARNISHMENT.**

5 Section 43 of the Trademark Act of 1946 (15 U.S.C.
6 1125) is amended—

7 (1) by striking subsection (c) and inserting the
8 following:

9 “(c) **DILUTION BY BLURRING; DILUTION BY**
10 **TARNISHMENT.—**

11 “(1) **INJUNCTIVE RELIEF.—**Subject to the prin-
12 ciples of equity, the owner of a famous mark that is
13 distinctive, inherently or through acquired distinc-
14 tiveness, shall be entitled to an injunction against
15 another person who, at any time after the owner’s
16 mark has become famous, commences use of a mark
17 or trade name in commerce that is likely to cause di-
18 lution by blurring or dilution by tarnishment of the
19 famous mark, regardless of the presence or absence
20 of actual or likely confusion, of competition, or of ac-
21 tual economic injury.

22 “(2) **DEFINITIONS.—**(A) For purposes of para-
23 graph (1), a mark is famous if it is widely recog-
24 nized by the general consuming public of the United
25 States as a designation of source of the goods or

1 services of the mark's owner. In determining wheth-
2 er a mark possesses the requisite degree of recogni-
3 tion, the court may consider all relevant factors, in-
4 cluding the following:

5 “(i) The duration, extent, and geographic
6 reach of advertising and publicity of the mark,
7 whether advertised or publicized by the owner
8 or third parties.

9 “(ii) The amount, volume, and geographic
10 extent of sales of goods or services offered
11 under the mark.

12 “(iii) The extent of actual recognition of
13 the mark.

14 “(iv) Whether the mark was registered
15 under the Act of March 3, 1881, or the Act of
16 February 20, 1905, or on the principal register.

17 “(B) For purposes of paragraph (1), ‘dilution
18 by blurring’ is association arising from the similarity
19 between a mark or trade name and a famous mark
20 that impairs the distinctiveness of the famous mark.
21 In determining whether a mark or trade name is
22 likely to cause dilution by blurring, the court may
23 consider all relevant factors, including the following:

24 “(i) The degree of similarity between the
25 mark or trade name and the famous mark.

1 “(ii) The degree of inherent or acquired
2 distinctiveness of the famous mark.

3 “(iii) The extent to which the owner of the
4 famous mark is engaging in substantially exclu-
5 sive use of the mark.

6 “(iv) The degree of recognition of the fa-
7 mous mark.

8 “(v) Whether the user of the mark or
9 trade name intended to create an association
10 with the famous mark.

11 “(vi) Any actual association between the
12 mark or trade name and the famous mark.

13 “(C) For purposes of paragraph (1), ‘dilution
14 by tarnishment’ is association arising from the simi-
15 larity between a mark or trade name and a famous
16 mark that harms the reputation of the famous mark.

17 “(3) EXCLUSIONS.—The following shall not be
18 actionable as dilution by blurring or dilution by
19 tarnishment under this subsection:

20 “(A) Any fair use, including a nominative
21 or descriptive fair use, or facilitation of such
22 fair use, of a famous mark by another person
23 other than as a designation of source for the
24 person’s own goods or services, including use in
25 connection with—

1 “(i) advertising or promotion that per-
2 mits consumers to compare goods or serv-
3 ices; or

4 “(ii) identifying and parodying, criti-
5 cizing, or commenting upon the famous
6 mark owner or the goods or services of the
7 famous mark owner.

8 “(B) All forms of news reporting and news
9 commentary.

10 “(C) Any noncommercial use of a mark.

11 “(4) BURDEN OF PROOF.—In a civil action for
12 trade dress dilution under this Act for trade dress
13 not registered on the principal register, the person
14 who asserts trade dress protection has the burden of
15 proving that—

16 “(A) the claimed trade dress, taken as a
17 whole, is not functional and is famous; and

18 “(B) if the claimed trade dress includes
19 any mark or marks registered on the principal
20 register, the unregistered matter, taken as a
21 whole, is famous separate and apart from any
22 fame of such registered marks.

23 “(5) ADDITIONAL REMEDIES.—In an action
24 brought under this subsection, the owner of the fa-
25 mous mark shall be entitled to injunctive relief as

1 set forth in section 34. The owner of the famous
2 mark shall also be entitled to the remedies set forth
3 in sections 35(a) and 36, subject to the discretion of
4 the court and the principles of equity if—

5 “(A) the mark or trade name that is likely
6 to cause dilution by blurring or dilution by
7 tarnishment was first used in commerce by the
8 person against whom the injunction is sought
9 after the date of enactment of the Trademark
10 Dilution Revision Act of 2006; and

11 “(B) in a claim arising under this sub-
12 section—

13 “(i) by reason of dilution by blurring,
14 the person against whom the injunction is
15 sought willfully intended to trade on the
16 recognition of the famous mark; or

17 “(ii) by reason of dilution by
18 tarnishment, the person against whom the
19 injunction is sought willfully intended to
20 harm the reputation of the famous mark.

21 “(6) OWNERSHIP OF VALID REGISTRATION A
22 COMPLETE BAR TO ACTION.—The ownership by a
23 person of a valid registration under the Act of
24 March 3, 1881, or the Act of February 20, 1905, or
25 on the principal register under this Act shall be a

1 complete bar to an action against that person, with
2 respect to that mark, that—

3 “(A)(i) is brought by another person under
4 the common law or a statute of a State; and

5 “(ii) seeks to prevent dilution by blurring
6 or dilution by tarnishment; or

7 “(B) asserts any claim of actual or likely
8 damage or harm to the distinctiveness or rep-
9 utation of a mark, label, or form of advertise-
10 ment.

11 “(7) SAVINGS CLAUSE.—Nothing in this sub-
12 section shall be construed to impair, modify, or su-
13 persede the applicability of the patent laws of the
14 United States.”; and

15 (2) in subsection (d)(1)(B)(i)(IX), by striking
16 “(c)(1) of section 43” and inserting “(c)”.

17 **SEC. 3. CONFORMING AMENDMENTS.**

18 (a) MARKS REGISTRABLE ON THE PRINCIPAL REG-
19 ISTER.—Section 2(f) of the Trademark Act of 1946 (15
20 U.S.C. 1052(f)) is amended—

21 (1) by striking the last two sentences; and

22 (2) by adding at the end the following: “A mark
23 which would be likely to cause dilution by blurring
24 or dilution by tarnishment under section 43(c), may
25 be refused registration only pursuant to a pro-

1 ceeding brought under section 13. A registration for
2 a mark which would be likely to cause dilution by
3 blurring or dilution by tarnishment under section
4 43(c), may be canceled pursuant to a proceeding
5 brought under either section 14 or section 24.”.

6 (b) OPPOSITION.—Section 13(a) of the Trademark
7 Act of 1946 (15 U.S.C. 1063(a)) is amended in the first
8 sentence by striking “as a result of dilution” and inserting
9 “the registration of any mark which would be likely to
10 cause dilution by blurring or dilution by tarnishment”.

11 (c) CANCELLATION.—Section 14 of the Trademark
12 Act of 1946 (15 U.S.C. 1064) is amended, in the matter
13 preceding paragraph (1) by striking “, including as a re-
14 sult of dilution under section 43(c),” and inserting “, in-
15 cluding as a result of a likelihood of dilution by blurring
16 or dilution by tarnishment under section 43(c),”.

17 (d) MARKS FOR THE SUPPLEMENTAL REGISTER.—
18 The second sentence of section 24 of the Trademark Act
19 of 1946 (15 U.S.C. 1092) is amended to read as follows:
20 “Whenever any person believes that such person is or will
21 be damaged by the registration of a mark on the supple-
22 mental register—

23 “(1) for which the effective filing date is after
24 the date on which such person’s mark became fa-
25 mous and which would be likely to cause dilution by

1 blurring or dilution by tarnishment under section
2 43(c); or

3 “(2) on grounds other than dilution by blurring
4 or dilution by tarnishment, such person may at any
5 time, upon payment of the prescribed fee and the fil-
6 ing of a petition stating the ground therefor, apply
7 to the Director to cancel such registration.”.

8 (e) DEFINITIONS.—Section 45 of the Trademark Act
9 of 1946 (15 U.S.C. 1127) is amended by striking the defi-
10 nition relating to the term “dilution”.